

SUBJECT: Amendments to the Implementing Regulations to the EPC -
Rule 71 EPC

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: 1. Budget and Finance Committee (for opinion)
2. Administrative Council (for decision)
3. Committee on Patent Law (for information)

SUMMARY

In the context of the "Raising the Bar" initiative, amendments to Rule 71 EPC are proposed. They are aimed at introducing an additional procedural step for cases where the applicant requests amendments or corrections in response to the communication under Rule 71(3) EPC as the current provision has proved to be burdensome for applicants and the Office. Together with these amendments, the Office will reinstate its pre-2002 practice concerning the suggestion of changes made by the examining divisions as to the text intended for grant. On this occasion, Rule 71 EPC as a whole has been revisited and further amendments are suggested which are aimed at making the final stage of the proceedings less complex and the provisions more transparent.

This document is a clean version of CA/PL 7/10 Rev. 1 which was submitted to the Committee on Patent Law for its 39th meeting on 27 September 2010. The Committee has given a unanimous favourable opinion on the proposal with the understanding that some minor changes be made. They have been included in the present document.

CA/PL 7/10 Rev. 1 is based on CA/3/10 and takes account of the results of the discussions in the Committee on Patent Law at its 38th meeting on 23 and 24 February 2010 and in the SACEPO Working Party Rules at its meeting on 1 July 2010 and the subsequent comments received during the written consultation.

This document replaces CA/81/10 dated 15.09.2010. The amendments are indicated by grey hatching.

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PART I

I. **STRATEGIC / OPERATIONAL**

1. Operational.

II. **RECOMMENDATION**

2. The Budget and Finance Committee is requested to give its opinion on the proposals for amendment of the Implementing Regulations and the Rules relating to Fees outlined below.

The Administrative Council is requested to approve the draft decision in Part II.

III. **MAJORITY NEEDED**

3. Budget and Finance Committee: Not applicable.

Administrative Council: Three quarters.

IV. **CONTEXT**

4. Rule 71 EPC has undergone important changes in the last decade which were focused on reducing the period between the communication by which the applicant is informed of the examining division's intention to grant a European patent and the mention of the decision to grant in the European Patent Bulletin.
5. Further potential for reducing time delays has been identified. These further reductions can be achieved by addressing the case where an applicant requests amendments under Rule 137 EPC and/or the correction of errors under Rule 139 EPC following a communication under Rule 71(3) EPC. According to current practice, in order to secure the applicant's right to be heard, procedures not specified within the wording of Rule 71 EPC have to be employed to process amendments requested by applicants at this stage of the procedure. These processes are not best suited to this task and lead to avoidable delays and costs for the EPO and for applicants. Therefore, an additional step should be introduced in the procedure only for the case of amendments or corrections requested by the applicant, thereby retaining the efficiency gains already achieved by the previous rule changes.

6. It is EPO long standing practice to have examining divisions making suggestions for changes in the communication under Rule 71(3) EPC. However, in the light of the applicant's obligation to fulfil the formal requirements in response to the communication under Rule 71(3) EPC, in particular the claims' translations, examining divisions have been instructed to be reserved in making suggestions in the text intended for grant on their own initiative. As an additional step in case of amendments or corrections should be introduced, this allows reinstatement of the EPO's practice prior to the rule change in 2002 as the current inconvenience for the applicant will have been removed. In many cases the need to issue a communication under Article 94(3) and Rule 71(1), (2) EPC for making suggestions which the applicant can reasonably be expected to approve will be avoided. Every communication under Article 94(3) and Rule 71(1), (2) EPC adds approximately further 8 to 12 months to the overall examination procedure.
7. In the light of the discussion in the Committee on Patent Law, the wording of Rule 71 EPC has been completely revised and simplified, and the procedures have been streamlined without changing the general concept. The existing Rule 71 EPC has been divided into two in order to make it easier to read.

V. ARGUMENTS

A. MAIN PROPOSALS FOR AMENDMENT OF RULE 71 EPC

a) Background

8. Before 2002, the applicant was asked in a first step to approve the text intended for grant and, in a second step, to fulfil the formal requirements, in particular to pay the fees for grant and printing and to file the translations of the claims in the two official languages of the EPO other than the language of the proceedings. Under this regime, it was the practice of examining divisions to make, in the former Rule 51(4) EPC 1973 communication, useful suggestions for amendments as to the text intended for grant which could reasonably be expected to be agreed by the applicant.
9. In 2002, this procedure was replaced by a single step procedure according to which the applicant was invited to immediately file the translations of the claims and to pay the prescribed fees. Fulfilling the formal requirements implied approval of the text for grant (cf. CA/D 27/01 Corr. 1, amended Rule 51 EPC 1973 in force as of 01.07.2002).

10. In 2005, in order to further improve the time saving effect of the 2002 amendment (cf. CA/PL 23/04, p.1), the period for fulfilling the requirements mentioned in Rule 51(4) EPC 1973 (in practice four months) was changed into a non-extendable period (cf. CA/D 19/04, entering into force on 01 April 2005). The possibility of requesting further processing if the time limit was missed remained unaltered.
11. In the cases where the applicant directly approved the text intended for grant, these rule changes have substantially reduced the average time from the communication under Rule 51(4) EPC 1973 to the publication of the mention of the grant from circa 10 months in 2000 to 7 months in 2004 and to about five-and-a-half months in 2007.
12. Statistics show that the percentage of the cases in which applicants approve the text proposed for grant have not been affected by changes to the rule. In respect of the cases which led to the grant of a European patent, applicants approved the text intended for grant in about 85% of the cases, irrespective of a one step or two step procedure:
 - in 2000, i.e. prior to 2002-revision, applicants explicitly approved the text in response to the communication informing of the text proposed for grant in over 84% of cases;
 - in 2004, i.e. after the 2002-revision but prior to the time limit amendment in 2005, applicants fulfilled the formal requirements which implied their approval in 84% of cases,
 - in 2007, i.e. after the time limit amendment of 2005, implied approval was given in just under 85% of cases.
13. Therefore, the single step procedure as introduced in 2002 shows its streamlining effect where the applicant agrees to the text in which the examining division intends to grant a patent (i.e. in around 85% of cases).
14. In the other 15% of cases, the applicant responded to the intention to grant by requesting amendments and/or correction of errors. This percentage has also remained stable irrespective of the 2002 and 2005 changes. This leads therefore

to the conclusion that the percentage reflects the number of cases where the situation is not sufficiently ripe for proceeding to the grant thus making it necessary for the applicant to request amendments or corrections.

15. The changes to procedure according to Rule 71 EPC (former Rule 51 EPC 1973) did not affect the basic right to be heard under Article 113(1) EPC. The possibility to request amendments under Rule 137 EPC (Rule 86 EPC 1973) and/or the correction of errors under Rule 139 EPC (Rule 88 EPC 1973) at this stage is guaranteed. The boards of appeal confirmed in case law (e.g. T 1064/04) that the principles set out in G 7/93 (OJ EPO 1994, 775) apply also after the structural amendment of Rule 51 EPC 1973 in 2002.
- b) Additional step in cases of amendments or corrections requested by the applicant in response to the communication under Rule 71(3) EPC**
16. It is in the 15% of cases where the applicant does not agree to the text in which the examining division intends to grant the patent, but requests amendments or correction of errors in response to the communication under Rule 71(3) EPC, the procedure is complicated and may cause avoidable costs and additional work for both the applicant and the EPO.
17. The procedure is inefficient for the EPO, because the applicant's obligation to fulfil the formal requirements of the claims' translations and fee payment does not apply in three special situations in which amendment requests do not represent amendments within the meaning of Rule 137(3) EPC (defined in the Guidelines for Examination, C-VI, 14.4.1). In order to establish whether one of these situations applies and to decide which further procedure to follow the formalities officer has to involve the examining division.
18. The current situation regarding these 15% of cases is also disadvantageous for applicants. A request for amendment or correction in response to a communication under Rule 71(3) EPC normally requires the simultaneous filing of the claims' translations, i.e. at a moment where it is not yet clear whether the examining division would agree. This incurs avoidable costs for applicants and also for the EPO as this represents additional documents to be processed and stored while additional sets of translation might be required later if the examining division does not approve the amendments.
19. In order to avoid these disadvantages, the present proposal introduces a separate step only for these problematic cases. Where amendments or corrections are

requested by the applicant, agreement on the text intended for grant should be established in a first step before fulfilment of the formal requirements is required.

20. It is expected that reasonably acting applicants would not file such requests with the intention to delay the proceedings at this stage so that the introduction of this additional step will not affect the proportion of 85% to 15% amongst the applications that proceed to grant. Current statistics show that possibilities of retarding the procedure after the communication of the intention to grant are, in general, used infrequently in this phase of the proceedings. In 2000, for example, where the time limit set with notification of the intention to grant could be extended on request without the need of providing reasons and at no cost, the applicant's approval was given in about 79% of the cases leading to the grant of a patent within the initial time limit, and only in about 5% of the cases the applicant approved after having requested a time extension (thereby gaining effectively slightly less than 4 months on average). In 2007, the time limit set in the communication under Rule 71(3) EPC was met in about 78% of the cases, and in just under 7% of the cases further processing was requested prior to approval (with payment of the further processing fee of EUR 210,- and an effective gain of time of just over 4 months on average).
- c) Reintroduction of the pre-2002 practice concerning suggestions made by the Examining Division in the Rule 71(3) EPC communication**
21. Before 2002 it was usual that the text intended for grant communicated to the applicant included suggestions for changes in the text intended for grant made by the examining division on its own initiative which it could reasonably expect the applicant to accept. Since the 2002 rule change the examining divisions have been instructed, in order to avoid undue incurrence of cost and uncertainty for applicants caused by the difficulties of the current procedure under Rule 71 EPC (cf. point 18), to only propose minor corrections to the text intended for grant and otherwise to despatch a further communication under Article 94(3) EPC and Rule 71(1), (2) EPC. Even though it was usual for examiners to make suggestions to a much larger extent before the 2002 revision, the proportion of requests for amendment (15%) remained stable between 2000 and 2007 (cf. point 14).
22. In the light of the proposed introduction of an additional step, the practice should be reintroduced according to which examining divisions may make useful suggestions in the text communicated under Rule 71(3) EPC on their own initiative which they can reasonably expect the applicant to agree. If an examining division makes such suggestions, it must give reasons therefore in the communication under Rule 71(3) EPC.

23. The option of including such suggestions in the communication under Rule 71(3) EPC will also become important in combination with the changes of the first basket of "Raising the Bar" which entered into force on 01.04.2010 (cf. CA/D 3/09). Pursuant to the new provisions a reply to the search opinion and any amendments of the applicant's own volition should be on file when the substantive examination phase starts (see Rules 70a, 137 and 161 EPC as of 01.04.2010). It is expected that in a substantial number of cases further deficiencies noted could be overcome if the examining division ~~included~~ suggested, as it was the case prior to the 2002-change, amendments or corrections with the above proviso in the text proposed for grant.
24. In contrast to CA/3/10, it is no longer proposed to include this option in the rule itself. Before the 2002 rule change, this right of the examining divisions was also not laid down in the Implementing Regulations itself, but was established practice of the departments of first instance and permitted by the boards of appeal with the proviso that the right to be heard and the principle that a patent may only be granted on a text submitted or agreed by the applicant (Articles 113(1), (2) EPC) be respected. As the intention of the Office is to reinstate the pre-2002 practice an explicit provision in the rule does not appear necessary.
25. The Office has come to the conclusion that it would be best not to include this right of the examining divisions in the rule, even not for declaratory purposes, but to explicitly address it in the Guidelines for Examination. The latter is considered to be the most appropriate place, because all necessary details regarding the kind of suggestions and the circumstances under which they may be made can be set out therein.
26. Making suggestions for changes as to the text extensively in communications under Rule 71(3) EPC bears the risk that applicants will reply by not accepting these proposals or will take this occasion to file further amendments. However, as the percentage of applicant's amendments before and after the 2002 reform has remained basically unchanged, it can be concluded that examining divisions are able to make acceptable suggestions when appropriate. It is this reasonable and efficient practice which it is intended to reinstate for the benefit of both the applicants and the Office.
27. The Office itself has a great interest in that the high numbers where the applicant directly approves continue to apply. Therefore, the Office will do appropriate monitoring in order to be able to promptly react on any changes and propose necessary measures. Depending on the experience made with the amended provision, Rule 71 EPC might be revisited again in the event that the desired benefits of the amendment are not achieved.

d) Outline of the proposed procedures

28. As set out in section b), it is not intended to change the current procedure in place for the cases where the applicant agrees with the text communicated to him under Rule 71(3) EPC. This means he is deemed to have given his approval where he files the translations of the claims and pays the fee for grant and publishing and, if applicable, the claims fees (cf. Rule 71(5) EPC).
29. Under the new regime, the communication under Rule 71(3) EPC may contain reasoned suggestions for changes as to the text intended for grant made by the examining division on its own initiative (see above section c)). This means in particular the following:
30. The kind of amendments or corrections **proposed** may only be those which the division can reasonably expect the applicant to accept. This may depend on the experience of the members of the examining division and their knowledge of the applicant's behaviour. Alternatively or in cases of doubt, the examining division may contact the applicant by telephone or issue a communication under Article 94(3) EPC. In any case, the examining division has to give reasons for the amendments or corrections proposed in the communication under Rule 71(3) EPC.
31. If the applicant does not approve the text communicated to him under Rule 71(3) EPC, he has the following options:
- he can request, within the set four months, amendments under Rule 137 or corrections under Rule 139 for which he has to give reasons (proposed Rule 71(6) EPC),
 - he can keep to the latest text submitted by him; this may occur in a case where the text communicated to him contained suggestions for changes made by the examining division of its own initiative which he does not accept,
 - he can not react at all to the communication resulting in the application being deemed withdrawn (proposed Rule 71(7) EPC),
 - he can actively withdraw the application,
 - he can indicate that he does not approve the text without simultaneously requesting amendments or corrections or keeping to the latest text submitted by him. This leads to a refusal of the application for lack of a text agreed by

the applicant (Article 113(2) EPC). However, has the examining division made suggestions for changes as to the text intended for grant, a mere non-approval of such a text implies that the applicant maintains his text on file preceding the communication under Rule 71(3) EPC.

32. Where he reacts with a request for amendment under Rule 137 EPC and/or correction of errors under Rule 139 EPC as to the text communicated under Rule 71(3), an additional step should be introduced in order to obtain first an agreement on the text (see proposed Rule 71(6), last two sentences, EPC). Thereby, and in these cases only, the obligation to fulfil the formal requirements of filing the claims' translations and paying the prescribed fees will be postponed for the benefit of the applicant and the EPO until an agreement on the text has been reached (see section b)). All of the amendments or corrections requested by the applicant have to be reasoned, in particular those which have not been on file yet. The details of the reasons to be given will depend on the individual case and examples should be given in the Guidelines for Examination.
33. If the examining division consents to the amendments under Rule 137 EPC or corrections under Rule 139 EPC requested, it will despatch a further communication under Rule 71(3) EPC setting again a period of four months for fulfilling the formal requirements. This will give the applicant sufficient time for preparing the translations of the claims, will cause less implementation effort than a dedicated communication by which a different time limit should be set, and will simplify the reading of the rule. This further Rule 71(3) EPC communication may also comprise suggestions for changes made by the examining division on its own initiative in accordance with point 30, but examining divisions will be instructed not to re-introduce changes which the applicant already rejected in response to the first communication under Rule 71(3) EPC.
34. If the examining division does not give its consent to the requested amendments or corrections, the examining division will resume the examination proceedings to the extent necessary. The actual next step will depend on the circumstances of the individual case. For example, it may be a communication under Article 94(3) EPC and Rule 71(1), (2) EPC, an informal interview or a phone call, or, if the applicant's response was combined with a request for oral proceedings or where considered as expedient by the examining division, it may be a summons to oral proceedings.
35. Where the examining division has made suggestions for changes as to the text intended for grant, the applicant may respond with maintaining his text on file preceding the communication under Rule 71(3) EPC. Depending on the

circumstances either a new communication under Rule 71(3) EPC as foreseen in Rule 71(6) EPC will be dispatched (for example where the applicant provided convincing arguments as to why his version is allowable) or the examining division will resume the examination proceedings to the extent necessary (see previous point). However, had the examining division not made any suggestions for changes and had the applicant replied only by maintaining his text on file preceding the communication under Rule 71(3) EPC but had not fulfilled the formal requirements, the application would be deemed withdrawn in accordance with Rule 71(7) EPC.

36. Not explicitly dealt with in the Rule are the infrequent cases that the applicant withdraws the application or indicates within the four-month period that he does not approve the text communicated to him under Rule 71(3) EPC without requesting amendments or corrections or referring to an earlier text submitted by him. A mere non-approval leads, in general, to a refusal of the application for lack of a text agreed by the applicant under Article 113(2) EPC. However, has the examining division made suggestions for changes as to the text intended for grant, a non-approval of such a text is to be understood in the sense that the applicant keeps to his text on file preceding the communication under Rule 71(3) EPC and the procedure set out in the previous point applies.

B. BIBLIOGRAPHIC DATA

37. It is further proposed to clarify that, in the communication under Rule 71(3) EPC, the applicant is informed of the bibliographic data. Fulfilling the formal requirements under Rule 71(5) EPC should not only establish the legal fiction of the applicant's approval of the text as proposed for grant but also that he verified the bibliographic data. This should enhance the applicant's awareness to also check these data.
38. It is to be expected that requests for corrections or changes of these data will be filed at an earlier stage than at present. Now they are received quite often only after the decision to grant was issued. This generates a lot of work for formalities officers and substantially delays the conclusion of the procedure before the EPO, and in some cases procedures before the national offices become necessary. Requests for correction or changes of the bibliographic data will be dealt with under the known procedures, i.e. outside the procedures covered by Rule 71 EPC. In particular, Rule 71(6) EPC is not applicable.
39. After adoption of this amendment, the EPO will not reduce its efforts on the most possible accuracy when entering the data submitted by the applicant into the

databases and will not lower its quality control in this respect. Despite the legal fiction of having verified the bibliographic data, the legal remedies provided in Rules 139 and 140 EPC remain applicable.

C. FURTHER CHANGES

40. For increasing the transparency of the provisions governing the last phase of the grant proceedings, current Rule 71 EPC has been split up into two separate rules: proposed new Rule 71 EPC focuses on the work of the examining division and Rule 71a EPC on issues which arise when the grant procedure is concluded and which are mainly dealt with by the formalities officer acting on behalf of the division.
41. For systematic and clarity reasons, the paragraph concerning the payment of any further claims fees should be positioned directly after Rule 71(3) EPC so that all formal requirements which the applicant must fulfil within the four-month time limit set by the examining division would appear in one place. In addition, the wording has been brought into conformity with the language used in Rules 45 and 162 EPC (see proposed Rule 71(4) EPC). The procedure concerning the payment of such claims fees has also been simplified compared to the proposal contained in CA/3/10 and the current regime: Where amendments or corrections are requested within the time limit under Rule 71(3) EPC, payment of such claims fees will, in all cases, have to be made only after an agreement on the text intended for grant has been reached. The applicant should therefore no longer be obliged to pay such claims fees at a stage where, in the light of any amendments requested, the fate of the application is unclear and a refusal might still occur.
42. Rule 71(10) EPC concerning the reference in the communication under Rule 71(3) EPC to the EPO's website where information concerning translation requirements under Article 65(1) EPC is published, is proposed to be deleted. The Office will not change its practice in publishing the relevant information on its website. The deletion is only proposed in order to keep the rule as compact as possible.
43. It is further proposed to introduce a clarifying sentence at the beginning of former Rule 71(11) EPC summarising the requirements for the grant of the European patent to be checked by the Office prior to despatch of the decision to grant (cf. proposed Rule 71a(1) EPC).
44. The following issue should also be explicitly addressed, namely that the examining division may resume the examination proceedings at any time until the decision to grant. This is particularly important where e.g. highly relevant third party's observations have been filed at this late stage (see proposed Rule 71a(2) EPC).

45. The references in Rules 71a(3)-(4) EPC should be adjusted to the new structure of the rules.
46. It is proposed to insert a new Rule 71a(5) EPC in order to create a legal basis which allows that the paid and the due amounts are balanced in situations where the applicant has already paid the required fees following a first invitation under Rule 71(3) EPC, but a further Rule 71(3) EPC communication is issued. Insertion of this new provision aims at avoiding unnecessary money transfers thus reducing the administrative burden for applicants and the Office.
47. For systematic reasons, the legal basis for refunding the fee for grant and publishing should be transferred from Rule 71(5), third sentence, EPC into a separate paragraph (see proposed Rule 71a(6) EPC). It should further be clarified that for a refund being allowed, the application must be withdrawn or deemed withdrawn prior to notification of the grant decision. This reflects the current EPO practice.
48. Claims fees should no longer be refunded once a communication under Rule 71(3) EPC is issued. The payment of claims fees for the sixteenth and each subsequent claim represents a financial compensation for the extra work of examiners in handling applications with a large number of claims. Therefore, it seems justified that once this additional work has been performed and the claims have been assessed, such claims fees are no longer refunded.

D. CONSEQUENTIAL CHANGES IN OTHER PROVISIONS

49. In the light of the deletion of Rule 71(10) EPC it is proposed to remove, for consistency reasons, the corresponding provisions in Rule 82(2) EPC and Rule 95(3) EPC as amended by decision of the Administrative Council CA/D 4/08 of 21 October 2008 (cf. OJ EPO 2008, 513) which entered into force on 01 April 2009. Also here, the Office will continue to include the reference to the relevant place on the EPO's website being a standard text in the relevant forms.
50. Since the provision of Rule 71(6) EPC should be transferred to Rule 71(4) EPC, Article 2(1) No.15 of the Rules relating to Fees needs to be aligned.

E. IMPLEMENTATION

51. The envisaged date of entry into force of the provisions as amended is 1 April 2012.

52. Rule 71 EPC as amended and new Rule 71a EPC should apply to European patent applications in respect of which a communication under existing Rule 71(3) EPC has not yet been despatched by the date of entry into force of the provisions.

VI. FINANCIAL IMPLICATIONS

53. N/A

VII. LEGAL BASIS

54. Article 33(1)(c) and (2)(d) EPC.

VIII. DOCUMENTS CITED

55. CA/3/10, CA/D 27/01 Corr. 1, CA/PL 23/04, CA/D 19/04, Guidelines for Examination in the EPO, CA/D 3/09, CA/D 4/08.

IX. PROPOSED CHANGES

A. IMPLEMENTING REGULATIONS

Present wording

Rule 71 EPC Examination procedure

(1) In any communication under Article 94, paragraph 3, the Examining Division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified.

(2) Any communication under Article 94, paragraph 3, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

(3) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period of four months. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.

*[See Rule 71(6) EPC:
If the European patent application in the text intended for grant comprises more than fifteen claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period under paragraph 3, and, where applicable, paragraph 5, unless the said fees have already been paid under Rule 45 or Rule 162.]*

Proposed wording

Rule 71 EPC Examination procedure

(1) *unchanged*

(2) *unchanged*

(3) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it **and of the related bibliographic data. In this communication the Examining Division** shall invite **the applicant** to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period of four months.

(4) If the European patent application in the text intended for grant comprises more than fifteen claims, the Examining Division shall invite the applicant to pay claims fees in respect of **the sixteenth and each subsequent** claim within the period under paragraph 3 [...] unless the said fees have already been paid under Rule 45 or Rule 162.

(4) If the applicant, within the period laid down in paragraph 3, requests amendments under Rule 137, paragraph 3, or the correction of errors under Rule 139, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.

(5) If the Examining Division does not consent to an amendment or correction requested under paragraph 4, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fee for grant and publishing, and any claims fees paid under paragraph 6, shall be refunded.

(6) If the European patent application in the text intended for grant comprises more than fifteen claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period under paragraph 3, and, where applicable, paragraph 5, unless the said fees have already been paid under Rule 45 or Rule 162.

(7) If the fee for grant and publishing or the claims fees are not paid in due time, or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn.

(5) If the applicant, within the period laid down in paragraph 3, [...] pays the fees under paragraph 3 and, where applicable, paragraph 4 and files the translations under paragraph 3, he shall be deemed to have approved the text communicated to him under paragraph 3 and verified the bibliographic data.

(6) If the applicant, within the period under paragraph 3, requests reasoned amendments or corrections to the communicated text or keeps to the latest text submitted by him, the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise, it shall resume the examination proceedings.

Deleted

see new Rule 71(4) EPC

(7) If the fee for grant and publishing or the claims fees are not paid in due time, or if the translations are not filed in due time, the European patent application shall be deemed to be withdrawn.

(8) If the designation fee becomes due after the communication under paragraph 3, the mention of the grant of the European patent shall not be published until the designation fee has been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 3 and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 3 shall contain a reference to the website of the European Patent Office where information concerning translation requirements under Article 65, paragraph 1, in the Contracting States is published.

(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the decision.

Deleted
see new Rule 71a(3) EPC

Deleted
see new Rule 71a(4) EPC

Deleted

Deleted
see new Rule 71a(1) EPC

Proposed wording

Rule 71a EPC

Conclusion of the grant procedure

*[See Rule 71(11) EPC:
The decision to grant the European patent shall state which text of the European patent application forms the basis for the decision.]*

(1) The decision to grant the European patent **shall be issued if all fees have been paid, a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings has been filed and there is agreement as to the text to be granted.** It shall state which text of the European patent application forms the basis for the decision.

Rule 71 EPC does not contain an equivalent provision.

*[See Rule 71(8) EPC:
If the designation fee becomes due after the communication under paragraph 3, the mention of the grant of the European patent shall not be published until the designation fee has been paid. The applicant shall be informed accordingly.]*

*[See Rule 71(9) EPC:
If a renewal fee becomes due after the communication under paragraph 3 and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.]*

Rule 71 EPC does not contain an equivalent provision.

*[See Rule 71(5), third sentence, EPC:
If the European patent application is refused, withdrawn or deemed to be withdrawn, the fee for grant and publishing, and any claims fees paid under paragraph 6, shall be refunded.]*

(2) Until the decision to grant the European patent, the Examining Division may resume the examination proceedings at any time.

(3) If the designation fee becomes due after the communication under **Rule 71**, paragraph 3, the mention of the grant of the European patent shall not be published until the designation fee has been paid. The applicant shall be informed accordingly.

(4) If a renewal fee becomes due after the communication under **Rule 71**, paragraph 3, and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(5) If, in response to an invitation under Rule 71, paragraph 3, the applicant has already paid the fee for grant and publishing or the claims fees, the paid amount shall be credited if a further such invitation is issued.

(6) If the European patent application is refused, withdrawn **prior to notification of the decision on the grant of a European patent** or, **at that time**, deemed to be withdrawn, the fee for grant and publishing [...] shall be refunded.

Present wording

Rule 82 EPC

Maintenance of the European patent in amended form

(2) If a party disapproves of the text communicated by the Opposition Division, examination of the opposition may be continued.

Otherwise, the Opposition Division shall, on expiry of the period under paragraph 1, invite the proprietor of the patent to pay the prescribed fee and to file a translation of any amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months. This invitation shall contain a reference to the website of the European Patent Office where information concerning translation requirements under Article 65, paragraph 1, in the Contracting States is published.

Present wording

Rule 95 EPC

Decision on the request

(3) If a request for limitation is allowable under paragraph 2, the Examining Division shall communicate this to the requester and invite him to pay the prescribed fee and to file a translation of the amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months; Rule 82, paragraph 3, first sentence, shall apply mutatis mutandis. If the requester performs these acts in due time, the Examining Division shall limit the patent. The invitation shall contain a reference to the website of the European Patent Office where information concerning translation requirements under Article 65, paragraph 1, in the Contracting States is published.

Proposed wording

Rule 82 EPC

Maintenance of the European patent in amended form

(2) If a party disapproves of the text communicated by the Opposition Division, examination of the opposition may be continued.

Otherwise, the Opposition Division shall, on expiry of the period under paragraph 1, invite the proprietor of the patent to pay the prescribed fee and to file a translation of any amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months.[...]

Proposed wording

Rule 95 EPC

Decision on the request

(3) If a request for limitation is allowable under paragraph 2, the Examining Division shall communicate this to the requester and invite him to pay the prescribed fee and to file a translation of the amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months; Rule 82, paragraph 3, first sentence, shall apply mutatis mutandis. If the requester performs these acts in due time, the Examining Division shall limit the patent. [...]

B. RULES RELATING TO FEES

Present wording

Article 2

Fees provided for in the Convention and in the Implementing Regulations

(1) The fees due to be paid to the Office under Article 1 , unless otherwise provided in paragraph 2, shall be as follows:

15. Claims fee (Rule 45, paragraph 1, Rule 71, paragraph 6, and Rule 162, paragraph 1) in respect of an application filed on or after 1 April 2009

- for the 16th and each subsequent claim up to the limit of 50 210

- for the 51st and each subsequent claim 525

Proposed wording

Article 2

Fees provided for in the Convention and in the Implementing Regulations

(unchanged)

15. Claims fee (Rule 45, paragraph 1, Rule 71, paragraph 4, and Rule 162, paragraph 1) in respect of an application filed on or after 1 April 2009

- for the 16th and each subsequent claim up to the limit of 50 210

- for the 51st and each subsequent claim 525

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
amending the Implementing Regulations
to the European Patent Convention
and the Rules relating to Fees

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention (hereinafter referred to as "EPC") and in particular Article 33(1)(c) and (2)(d) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law and of the Budget and Finance Committee,

HAS DECIDED AS FOLLOWS:

Article 1

1. Rule 71 of the Implementing Regulations to the EPC shall be amended as follows:

Paragraphs 3 to 11 shall be replaced by the following paragraphs 3 to 7:

"(3) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data. In this communication the Examining Division shall invite the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within four months.

(4) If the European patent application in the text intended for grant comprises more than fifteen claims, the Examining Division shall invite the applicant to pay claims fees in respect of the sixteenth and each subsequent claim within the period under paragraph 3 unless the said fees have already been paid under Rule 45 or Rule 162.

(5) If the applicant, within the period laid down in paragraph 3, pays the fees under paragraph 3 and, where applicable, paragraph 4 and files the translations under paragraph 3, he shall be deemed to have approved the text communicated to him under paragraph 3 and verified the bibliographic data.

(6) If the applicant, within the period under paragraph 3, requests reasoned amendments or corrections to the communicated text or keeps to the latest text submitted by him, the Examining Division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings.

(7) If the fee for grant and publishing or the claims fees are not paid in due time, or if the translations are not filed in due time, the European patent application shall be deemed to be withdrawn."

2. The following new Rule 71a shall be added in Part IV, Chapter IV:

"Rule 71a

Conclusion of the grant procedure

(1) The decision to grant the European patent shall be issued if all fees have been paid, a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings has been filed and there is agreement as to the text to be granted. It shall state which text of the European patent application forms the basis for the decision.

(2) Until the decision to grant the European patent, the Examining Division may resume the examination proceedings at any time.

(3) If the designation fee becomes due after the communication under Rule 71, paragraph 3, the mention of the grant of the European patent shall not be published until the designation fee has been paid. The applicant shall be informed accordingly.

(4) If a renewal fee becomes due after the communication under Rule 71, paragraph 3, and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(5) If, in response to an invitation under Rule 71, paragraph 3, the applicant has already paid the fee for grant and publishing or the claims fees, the paid amount shall be credited if a further such invitation is issued.

(6) If the European patent application is refused, withdrawn prior to notification of the decision on the grant of a European patent or, at that time, deemed to be withdrawn, the fee for grant and publishing shall be refunded."

Article 2

1. Rule 82, paragraph 2, of the Implementing Regulations to the EPC shall read as follows:

"(2) If a party disapproves of the text communicated by the Opposition Division, examination of the opposition may be continued. Otherwise, the Opposition Division shall, on expiry of the period under paragraph 1, invite the proprietor of the patent to pay the prescribed fee and to file a translation of any amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months."

2. Rule 95, paragraph 3, of the Implementing Regulations to the EPC shall read as follows:

"(3) If a request for limitation is allowable under paragraph 2, the Examining Division shall communicate this to the requester and invite him to pay the prescribed fee and to file a translation of the amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months; Rule 82, paragraph 3, first sentence, shall apply mutatis mutandis. If the requester performs these acts in due time, the Examining Division shall limit the patent."

Article 3

Article 2, paragraph 1, item 15, of the Rules relating to Fees shall read as follows:

"Claims fee (Rule 45, paragraph 1, Rule 71, paragraph 4, and Rule 162, paragraph 1) in respect of an application filed on or after 1 April 2009

- for the 16th and each subsequent claim up to the limit of 50 210
- for the 51st and each subsequent claim 525"

Article 4

(1) The provisions mentioned in Articles 1, 2 and 3 of this decision shall enter into force on 1 April 2012.

(2) Rule 71 EPC as amended and Rule 71a EPC as added by Article 1 of this decision, and Article 2 of the Rules relating to Fees as amended by Article 3 of this decision shall apply to European patent applications in respect of which a communication under existing Rule 71(3) EPC has not yet been despatched by the date of entry into force of these provisions.

Done at Munich, [date of decision]

For the Administrative Council
The Chairman

Jesper KONGSTAD