
Newsletter 1/2012

Information on Amendments of the Procedure after Initiation of the Grant Phase under Rule 71(3) EPC

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1. Introductory remarks

With decision of October 26, 2010, the Administrative Council of the European Patent Organisation has amended the procedure to be followed after the Examining Division has informed the applicant of the text in which it intends to grant the European patent (communication pursuant to Rule 71(3) EPC), and has specified the circumstances concerning the conclusion of the grant procedure (pursuant to new Rule 71a EPC).

These amendments will enter into force on April 1, 2012 and will apply to all European patent applications in respect of which a communication under previous Rule 71(3) EPC has not yet been despatched by that date.

This Newsletter gives information about these amendments

2. What is new

In the communication pursuant Rule 71(3) EPC, the applicant is informed by the Examining Division of the text and the claims intended for grant. Furthermore, the appli-

cant is invited to pay the fees for grant and publishing and to file a translation of the claims within a non-extendable period of four months.

In the previous procedure filing of a translation of the claims in the two languages of the European Patent Office (EPO) other than that of the proceedings was required even if the applicant did not approve the text intended for grant and carried out changes to the claims or requested that a grant be based on a higher request. If the Examining Division did not consent to an amendment carried out by the applicant and further amendments were necessary this sometimes led to a multitude of unnecessary translations. The procedure under new Rule 71 EPC will avoid this since it will no longer be necessary to file translations in response to the communication pursuant to Rule 71(3) EPC if the applicant refuses to approve the text and claims intended for grant.

There are several ways to proceed in response to a communication under new Rule 71(3) EPC depending on whether the text intended for grant is acceptable for the applicant or not.

3. Applicant approves the text

Within a non-prolongable period of time of four months the applicant has the possibility to accept the text intended for grant. However, even if the applicant does not expressly give his consent to the text but fulfills all other requirements, i.e. he pays all necessary fees (fees for grant and publishing and potential excess claims and description pages fees) and files the translations of the claims without submitting any corrections or amendments he is deemed to have approved the text intended for grant.

Care must be taken in that regard since the text and claims annexed to a Rule 71(3) EPC communication may sometimes include amendments and corrections made by the Examining Division on its own initiative. According to a recent notice from the EPO only such amendments and corrections are envisaged where the Examining Division can reasonably expect that these amendments are acceptable for the applicant. Considering the EPO's effort to accelerate the examination procedure we think it will become more common for examiners to carry out substantial amendments to applications in the future. Notwithstanding, one has to keep in mind that the applicant is responsible for any amendments to the application made or agreed upon by him during examination. It is therefore necessary to carefully check whether the amendments and corrections made by the Examining Division meet the requirements of the EPC (in particular Article 123(2) EPC).

4. Applicant does not approve the text

In case the text proposed for grant is not acceptable for the applicant he may reply to a Rule 71(3) EPC communication by requesting reasoned amendments or corrections to the communicated text or by submitting arguments why he disagrees with the Examining Division.

The Examining Division will then either give its consent and issue a new commu-

nication under Rule 71(3) EPC or it will resume the examination proceedings. In any case, the applicant will not be required to pay the fee for grant and publishing or any claims fee in reply to the first communication under Rule 71(3) EPC, nor will he be required to file any translations of the claims within this period.

This also applies if the applicant requests the reversal of amendments done by the Examining Division or if the Rule 71(3) EPC communication was based on an auxiliary request and the applicant submits that a grant be based on a higher request.

The applicant may also reply to the communication under Rule 71(3) EPC by simply disapproving of the text proposed therein and not paying any fees or filing the translations. In such a case the application will be refused, if each of the following criteria are fulfilled:

- (i) the Examining Division did not propose any amendments or corrections to the application in the communication under Rule 71(3) EPC,
- (ii) the Rule 71(3) EPC communication was not based on an auxiliary request, and
- (iii) the applicant did not file any amendments/corrections or arguments with his disapproval.

Already if one of these criteria does not apply, i.e. the Examining Division proposed amendments, the claims intended for grant are based on an auxiliary request or amendments or arguments were submitted, this will not lead to refusal of the application. In this case either examination is re-opened or, if the applicant's submission results in an allowable text, a second Rule 71(3) EPC communication is sent.

The issuance of a second (or any further) communication pursuant to Rule 71(3) EPC will set a new four month time limit within which filing translations of the agreed claims and paying the required fees will become due.

It is to be noted that new Rule 71 EPC requires that the amendments or corrections filed in response to the Rule 71(3) EPC communication are “reasoned”. In the previous procedure it was deemed appropriate to admit only minor amendments which do not appreciably delay the issue of the decision to grant. It remains to be seen what the EPO will consider as reasoned amendments or corrections in the procedure under new Rule 71 EPC.

5. Applicant fails to react

If the applicant does not file any response to the communication under Rule 71(3) EPC and also fails to pay all necessary fees and/or fails to file the translations in due time, the application will be deemed to be withdrawn. In this case the applicant may request further processing under Article 121 EPC.

6. New Rule 71a EPC

New Rule 71a EPC complements amended Rule 71 EPC and is directed to the conclusion of the grant procedure.

Rule 71a(1) EPC sets out all the requirements that have to be met before issuance of a decision to grant the European patent:

- (i) payment of all necessary fees,
- (ii) filing of a translation of the claims in the two official languages of the EPO other than the language of the proceedings, and
- (iii) agreement as to the text to be granted.

Once these requirements are met, the decision to grant the European patent is issued, however under the further provision that renewal fees and any additional fees already due have been paid. If the renewal fee or any additional fee is not paid in time, the application will be

deemed to be withdrawn.

According to new Rule 71a(2) EPC the Examining Division is allowed to resume examination proceedings at any time until the decision to grant, or more precisely up to the moment the decision to grant is handed over to the EPO’s internal postal service for transmittal to the applicant.

This had already been practice before the EPO in cases where the Examining Division became aware of circumstances which are such as to render non-patentable the subject-matter claimed (e.g. such circumstances brought to the Examining Division’s attention following observations by third parties under Art. 115 EPC). New Rule 71a(2) EPC reflects this common practice.

In the rare case that examination was accelerated to such an extent that the communication under Rule 71(3) EPC is issued before the designation fee becomes due, pursuant to Rule 71a(3) EPC the decision to grant will not be issued and the mention of the grant of the patent will not be published until the designation fee has been paid. The applicant is informed accordingly.

Summary

The new procedure following the communication pursuant to Rule 71(3) EPC will become effective on April 1, 2012. The new procedure avoids unnecessary preparation of claim translations in response to Rule 71(3) EPC communications in cases where the applicant desires further amendments since filing same only becomes due after a final agreement with the Examining Division as to the text to be granted has been reached.

New Rule 71a(2) EPC represents the common practice before the EPO that the Examining Division can restart examination at any time until the decision to grant.