

**Consultation results concerning comments on the EPO Guidelines 2018**  
**16th meeting of the SACEPO Working Party on Guidelines, held on 21 November 2018**

| General         | Comments/ suggestion  | Consultation results   |
|-----------------|---|--|
| New rule 28(2)  | The epi has prepared an analysis of the amendments in the GL/EPO in respect of Rule 28(2). Our comments focus on those parts relating to the introduction of a disclaimer in relation to new rule 28(2) , e.g.( Part F (IV, 4.12 - p IV-24) and Part G (II, 5.2 - p II-35; II, 5.4 - p II-38; II, 5.4.2.1 - p II-41. See attached document.   | Issues relating to biotechnology, particularly to the patentability of plants (Rule 28(2) EPC will be discussed in an extraordinary meeting to be scheduled in Q1/2019.  |
| General comment | <p>A significant change is switching from "examiner" to "search division"/"examining division"/ "division", or not so often "member of the Search/examining division". This caused changing from "he" and "his" to "it" and "its" respectively, when referring to the search/examining division. While this could be fine grammatically, generally we do not like how this reads and it is even confusing sometimes, especially when there is another "it" in the same sentence.</p> <p>In Art.18 and 19 EPC, the word 'examiners' is employed.</p> <p>In addition, the amendments of wording [examiner] v [division] is inconsistent. It is not clear why in some places the wording was amended and in another was left.</p> <p>Which is the principle for this wording?</p> <p>We suggest</p> <ul style="list-style-type: none"> <li>- Instead of "it", when referring to the search/examining division, we prefer having it repeated as "the division", which would provide more clarity, even being redundant. To</li> </ul> | <p>The change was requested by epi. For consistency reasons the expression was changed throughout the Guidelines. From a legal point of view "examining division" is the correct term to be used. Also replacing the "examining division" with "it" is correct.</p> <p>The GL version as approved by the President which is sent to SACEPO WP GL in June, has not yet undergone the editorial and linguistic checks. Therefore, the text may contain inconsistencies. This is usually pointed out in the e-mail from SACEPO Secretariat forwarding the approved version of the GL.</p> |

|                 |  |  |
|-----------------|--|--|
|                 | <p>further elaborate on this suggestion, "search division"/"examining division"/ could be abbreviated (e.g. SD/ED), although using untypical abbreviations is rare in GL. Following the same logic, "its" should become "search division's"/"examining division's" or "SD's"/ED's if abbreviation is at all suitable;</p> <ul style="list-style-type: none"> <li>- If "examiner" is always substituted with "member(s) of the search/examining division" then the previous use of "he", "his" might remain;</li> <li>- If "examiner" in search is always substituted with "search examiner", the previous use of "he", "his" might remain again. However, the term "search examiner" seem to have become obsolete, perhaps because the aim is to get rid of using the term "examiner" when referring to members of the search division, and also because "search division" encompasses one or more members;</li> <li>- Paraphrasing the sentences in the part with "it", which is often possible.</li> </ul> |  |
| General comment | <p>Most words "should" or "should be" have been replaced by "must", "will", "need to be", "is", "are" or "is to" or "may". What is the purpose of this?</p> <p>In for example <b>E-X 2.6</b> the word 'should' was not replaced by another word. Why?</p>  | <p>The consistent elimination of the word "should" as an expression being too vague was discussed last year. The term "should" has been replaced with "must" or "may". The expression "shall" (denoting "must") used throughout the EPC does not correspond to the language of the GL.</p> |

| Part | Chapter | Section | Comments/ suggestion  | Consultation results |
|------|---------|---------|---|----------------------|
| A    | II      | 1.2     | <p>2<sup>nd</sup> §<br/>Suggested amendment<br/>"Where a document transmitted using such technical means <b>by fax</b> is illegible..."</p> | Agreed.              |

|   |    |         |   |   |
|---|----|---------|---|---|
| A | II | 1.3     | <p>Point (i)</p> <p>“another software” or “a software not provided by the EPO” would be clearer</p>   | <p>Not agreed. The current wording will be maintained. It reflects the wording of the relevant decision of the President, Article 8(1), 2<sup>nd</sup> sentence: “Subject to prior acceptance by the EPO, other software may also be used (OJ EPO 2018, A45.)</p> |
| A | II | 1.6     | <p>“Only if an application is filed with a competent national authority (Art. 75(1)(b)) on paper may a paper debit order for the fees intended to be paid on the date of filing be included with that application on mandatory Form 1020”</p> <p>Proposed rephrasing for clarification:</p> <p>A paper debit order for the fees intended to be paid on the date of filing may be included on mandatory Form 1020 with an application only if that application is filed on paper with a competent national authority (Art. 75(1)(b)).</p>  | <p>The Office will rephrase the sentence.</p>   |
| A | II | 4.1.3.1 | <p>3<sup>rd</sup> §</p> <p>“The applicant must supply a <del>certified</del> copy of the previously filed application <b>certified as correct by the authority with which that application was filed</b> within two months of the filing date (Rule 40(3)).”</p> <p>We prefer the original wording, which corresponds to R 40(3) and to add a definition of “certification”. The word “correct” is not clear. This is also in line with the reference to “certified copy” at A-II, 4.1.5 last paragraph.</p> <p>Suggested to change to:</p> <p>The applicant must supply a certified <del>certified</del> copy of the</p> | <p>Not agreed. The current wording will be maintained.</p> <p>The term “correct” relates to both content and application-related data, e.g. date of filing, and corresponds to Rule 53(1), Rule 2(4)(ii) PLT, Rule 4(2) and (3) PLT.</p>                          |

|   |    |       |  |   |
|---|----|-------|--|---|
|   |    |       | <p>previously filed application within two months of the filing date (Rule 40(3)). <b>Certification is a declaration from the authority with which the previous application was filed that the copy is identical to the previously filed application.</b></p> <p>Further, a line break is missing after 2<sup>nd</sup> § and 4<sup>th</sup> §.</p>   | Editorial issue. Such things are dealt with before publication of the GL.   |
| A | II | 4.1.2 | <p>Point (ii)</p> <p>Any kind of information which allows the applicant to be contacted will be considered to fulfil requirement (ii), <del>in particular</del> <b>as for example</b>:<br/> “as for example” is weird. Suggest to change to “such as”.</p>   | Not agreed. This is a language issue. Changing the wording of the sentence is considered not to improve it.   |
| A | II | 4.1.4 | <p>2<sup>nd</sup> paragraph, 2<sup>nd</sup> last sentence:</p> <p>“In the absence of any allowable means of redress all documents relating to the purported European patent application will have to be re-filed.”</p> <p>We still find that the wording “will have to be refiled” is incorrect. The applicant <b><u>may choose</u></b> to refile!</p> <p>***</p> <p>Added sentence is unclear:</p> <p><b>They will be accorded the date on which all requirements of Rule 40 are fulfilled as the date of filing.</b></p> <p>What does “They” refer to?</p> <p>***</p> <p>Further, a line break is missing after the §.</p> | <p>The Office will rephrase the sentence.</p> <p>It was explained that, if a filing date cannot be accorded under Article 80 i.c.w. Rule 40 EPC or within the time limit under Rule 55 EPC, the European patent application does not come into existence. Consequently, the request for grant (EPO Form 1001) and all application documents (“they”) must be re-filed if the applicant still intends to obtain a European patent for his invention. Of course, this is up to the applicant.</p> |
| A | II | 4.1.5 | <p>“The date of filing accorded to the application is the date the application meets the requirements of A-II, 4.1 and is</p>  | The Office agreed to rephrase the sentence by replacing the references to sections by the pertinent Rules.  |

|   |     |       |  |  |
|---|-----|-------|--|--|
|   |     |       | <p>either:....”</p> <p>Suggested amendment:<br/>The date of filing accorded to the application is the date the application meets the requirements of <b><u>Rule 40(1) or Rule 55 (See A-II, 4.1)</u></b> and is either:<br/>Replace reference to GL/EPO with reference to rules.</p> |  |
| A | II  | 5.4   | <p><b>A-II 5.4</b> The title has been amended: would be better to add the word 'the' in:<br/>"Missing parts based on <b>the</b> priority <b>application</b>, no change in filing date"</p>   | Agreed.  |
| A | II  | 5.4.3 | <p>2<sup>nd</sup> paragraph<br/>In view of the definition of “priority document” given at A-III 6.7, “a copy of the priority document” could be replaced with “the priority document”</p>  | Agreed.  |
| A | III | 6     | <p><del>This in particular encompasses search results with respect to <b>applications for patents or utility models filings</b> whose priority is not being claimed. <b>It, and it also</b></del><br/><del>Should the EPO identify such related applications ?</del></p>             | Comment refers to part <b>C-III, 6.</b>  |
| A | III | 6.7   | <p>1<sup>st</sup> line<br/>The first sentence contradicts the second sentence which allows digitally signer electronic priority documents.<br/><br/>We suggest to delete “paper” in line 1.</p>  | Agreed.  |
| A | III | 6.8   | <p>This section relates to translation of the 'previous' application. For clarity and consistency, it is suggested to replace in the title of <b>6.8.4</b> the wording "priority document"</p>   | <p>Agreed. The Office will modify the section as proposed and check other sections for more conformity.</p> <p>The Office pointed out that full harmonization is, strictly</p> |

|   |     |      |  |  |
|---|-----|------|--|--|
|   |     |      | <p>by "the translation of <b>the previous application</b> already filed' .</p> <p>In 6.8.6 it is called "priority application".</p> <p>Language is not consistent:<br/>"priority document" – "priority application" – "previous application"</p>   | <p>speaking, not required since there are different terms relating to and describing "the previous application".</p>   |
| A | III | 6.12 | <p>Last line of 1<sup>st</sup> §.</p> <p>Reference to C-III 5 should be C-III, <u>6</u>.</p>   | <p>Agreed.</p>   |
| A | III | 13.2 | <p>Starting line 20:<br/>"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."<br/>The page fee for an application filed with claims must be paid within one month of filing (<u>R.38(3)</u>). Since this month expires before the deadline for correcting formal deficiencies of the application under <u>R.57(i)</u> and <u>R.58</u>, the number of pages can only be determined on the documents as filed.<br/>There is no legal basis for requesting payment of the page fee after the one-month period of <u>R.38(3)</u>. It is already mentioned in §2 "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."<br/>Hence, it is suggested to delete the first mentioned passage alternatively add "if the corrected application is</p> | <p>Not agreed.</p> <p>The Office explained its intention when introducing the additional fee ("page fee") in 2009:</p> <p>The "page fee" payable on filing was introduced to provide an incentive to applicants to shorten, in particular, the description part of the application and compensate for the extra work involved with large applications (CA/44/07 Rev. 1). Also, more of the costs of processing and examining were to be shifted to applicants (cf. OJ EPO 2009, 118, point 3).</p> <p>The pages filed in reply to the communication under Rule 58 EPC replace the respective pages of the application as originally filed and are those used for further proceedings (in particular search, A-publication).</p> <p>If the application documents do not comply with the standard of formal presentation, the Office gives the</p> |

|   |    |       |   |   |
|---|----|-------|---|---|
|   |    |       | <p>filed within this month.”</p>  | <p>applicant the chance to pay the correct amount of the additional fee within the same time limit as applicable for filing the application documents complying with Rules 46 and 49 instead of issuing a noting of loss of rights due to any resulting underpayment, thereby further delaying the start of the search.</p> <p>The Office will update the GL to clarify this and specifically mention those paragraphs of Rules 49 and 46 that may have an impact on the (new) basis for the additional fee, in particular, Rules 49(5), 49(8), 46(1), 46(2)(c), 46(2)(g) EPC.</p>  |
| A | IV | 1.1.1 | <p>If the parent application is withdrawn by the applicant, a divisional application can be filed up to (i.e. including) the date on which the declaration of withdrawal is received by the EPO.</p> <p>Is there any basis in case-law? Maybe, like with a withdrawal of an appeal, the actual sequence of receipt at the EPO could be relevant? What if withdrawal and filing of the divisional are both done electronically on the same day, i.e. with time stamps in this sequence, i.e. withdrawal followed by filing of a divisional application on the same date?</p> | <p><u>Reply by the Office:</u></p> <p>Under the EPC, the smallest time unit is a day. See e.g. Rule 131(1) in respect of the calculation of periods. This is supported by, e.g., Art. 97(3) EPC where it is stated that the decision to grant takes effect on the date (German version: der Tag; French version: la date) on which the mention of the grant is published. The Article does not refer to an hour or the chronological order of events on a specific date. Furthermore, Art. 64(1) stipulates that the date of the publication and not the event of publication as such is the precondition for conferring the protection provided for by that Article (J 24/10, point 6 of the reasons). Apart from this general principle, it must be considered that not all means of filing allow determining the exact filing “time” during a day (i.e. filing by mail or by delivery by hand). Applying smaller time units than a day would, unavoidably, result in an unequal treatment of applicants.</p> <p>In T 517/97, indeed the sequence of receipt of the</p> |

|   |    |     |  |  |
|---|----|-----|--|--|
|   |    |     |  | <p>withdrawal of the appeal and the intervention of the assumed infringer was taken into account and the board found that the appeal's withdrawal took effect at the specific time of its receipt.</p> <p>However, for reasons of legal certainty and to ensure the equal treatment of applicants, the EPO has decided not to follow this decision and incorporate it in its general processing principles. This is not considered to be in conflict with decisions G 8/91 and G 8/93, which deal with the effect of the withdrawal of an appeal rather than the specific time of its receipt.</p> <p>Accordingly, the application is pending until the end of the day on which the withdrawal of the application is received. Consequently, a divisional application can be filed on the entire day on which the parent application is withdrawn.</p> <p>The Office will reflect whether a clarification is required.</p> |
| A | VI | 2.5 | <p>Amended Article 11 Rfees entered into force on 1 July 2016 regarding the refund of examination fee. Specifically, Article 11(b) Rfees states that the examination fee provided for in Article 94(1) EPC shall be refunded: <i>“at a rate of 50% if the European patent application is withdrawn after substantive examination has begun and <u>before expiry of the time limit for replying to the first invitation under Article 94, paragraph 3, of the Convention issued by the Examining Division proper</u>”</i> (emphasis added).</p> <p>However, in the event that the deadline for responding to the first examination report is extended under Rule 132(2) EPC, it is unclear whether <i>“the time limit for replying to the first invitation under Article 94, paragraph 3”</i> by which to withdraw the application to receive the 50% refund is the date set by the invitation itself or the extended deadline.</p> | <p>The Office will rephrase the sentence in order to clarify that the extended time limit replaces the original time limit.</p>  |



|   |      |     |   |  |
|---|------|-----|---|--|
|   |      |     | <p>Additionally, the notice from the EPO dated 30.06.2016 concerning refunds of the examination fee (OJ EPO 2016, A49) provides no comment on the scenario in which the application is withdrawn after the deadline for responding to the first examination report is extended, but before the extended deadline.</p> <p><b>Proposal:</b> Add a discussion in Guidelines, A-VI, 2.5 to clarify the position. For example, either:</p> <ol style="list-style-type: none"> <li>1. If the deadline for responding to the first invitation under Article 94, paragraph 3 is extended under Rule 132, paragraph 2, and the application is subsequently withdrawn before expiry of the extended time limit for replying to the first invitation under Article 94, paragraph 3, then the examination fee is refunded at a rate of 50%.; or</li> <li>2. The deadline for responding to the first invitation under Article 94, paragraph 3 may be extended under Rule 132, paragraph 2. However, if the application is subsequently withdrawn before the extended deadline, then the examination fee is not refunded.</li> </ol> |  |
| A | VIII | 1.5 | <p>2<sup>nd</sup> paragraph, added text;</p> <p>No authorisation is required where a professional representative other than the appointed one (and not being a member of the same association or law firm) performs a procedural action on behalf of a party to proceedings, provided that it is apparent from the file that he is acting at the request of that party. In case of doubt about a professional representative's entitlement to act on behalf of a party, the EPO may require the filing of an authorisation (see Art. 1(3) of the above-mentioned Decision). Professional representatives other than the representative of record are therefore recommended to clearly indicate</p>  | <p>The Office agreed to clarify the wording.</p> <p>The Office explained that the paragraph was amended to avoid that</p> <ol style="list-style-type: none"> <li>a) any doubt about the entitlement to act on behalf of the applicant arises where a representative new to a particular file performs a procedural act and</li> <li>b) such representative is recorded as the new representative, while he may wish to perform an individual act rather than take over representation.</li> </ol> <p>The clear indication on whose request he is acting is</p> |

|   |   |      |   |  |
|---|---|------|---|--|
|   |   |      | <p>that they act at the request of the party to proceedings and, where their mandate refers to future proceedings, to state so and file the required authorisation.</p> <p>We find it quite strange. First, it states that no authorization is required if it is apparent from the file that he is acting at the request of that party.</p> <p>Thereafter, it states (emphasis added) “<i>that Professional representatives other than the representative of record are therefore <u>recommended to clearly indicate</u> that they act at the request of the party to proceedings and, where their mandate refers to future proceedings, <u>to state so and file the <b>required</b> authorisation.</u></i>”</p> <p>Rewording is required to make it clear when an authorization is required and when it is not.</p> <p>Further, we are not sure what the marked wording is supposed to mean. Does it make a difference if the representative writes “it is requested” vis-à-vis “on behalf of the applicant, it is requested”?</p> | <p>considered as evidence for his entitlement to act on the party’s behalf, comparable to a sub-authorisation. This may concern one or more submissions by the “other” representative.</p> <p>The practice is confirmed by the case law: see T 382/03, particularly p. 5.6, 5.7 of the Reasons.</p>  |
| A | X | 4.4  | <p><b>A-X 4.4</b> In the section on payment by credit card, it should be made clear that the EPO bears any transaction-related charges (OJ EPO 2017 A73, Item 3).</p>   | Agreed.  |
| A | X | 10.3 | <p>If the person to whom the refund is payable holds a deposit account with the EPO, the refund shall take the form of crediting that deposit account. Otherwise refunds will be made by means of a cheque. <b>This also applies to the refund of fees paid by credit card (see the Notice from the EPO dated 22 August 2017, OJ EPO 2017, A73).</b></p> <p>It is as it is. But why is it that the refund is not done on the</p>  | <p><u>The Office gave the following explanation:</u></p> <p>Not refunding to credit card has practical reasons: Refunds are often initiated a long time after payment of the fee. Such late refunds are not accepted by the credit card companies. Furthermore, a verification of the credit card details by Finance after years is very time consuming and,</p> |

|   |    |     |   |   |
|---|----|-----|---|---|
|   |    |     | credit card instead of issuing a cheque? Refund on the credit card appears to be much easier ... (?)  | thus, inefficient.  |
| A | XI | 5.2 | <p>Any priority document (i.e. the certified copy of the European patent application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or his successor in title <b>on written request. If such request is missing, the EPO will invite the requester to file it and will supply the certified copy only once this requirement has been fulfilled.</b></p> <p>We would like to understand the background of it. Is this meant to not allow orders by phone? Has this ever been an issue?</p> <p>How can the EPO invite the “requester” if no written request has been filed?</p> <p>What happens if there are joint applicants and only one of them requests the certified priority document?</p> | <p><u>The Office gave the following explanation:</u></p> <p>The legal basis is Rule 54 and Rule 74 EPC. A priority document or a certified copy of the patent certificate can only be issued on request to the applicant. Thus, any such request must be submitted via one of the allowed means of filing under Rule 2(1) EPC, bearing a signature as proof of authenticity according to Rule 2(2) EPC.</p> <p>Payment of the fee only, occurring regularly in practice, would allow the EPO to contact the requester.</p> <p>In the case of more than one applicant, Rule 151 EPC applies. The common representative (all applicants from EPC state) or representative may request the certified copy.</p> |

| Part | Chapter | Section | Comments/ suggestion   | Consultation results  |
|------|---------|---------|--|---|
| B    | I       | 1       | Line 4, reference should be B-II, 4.4-4.6  | Agreed.   |
| B    | I       | 2.1     | Replace « examiners » with « members »   | Not agreed.<br><br>The Office prefers to revert to the original title of B-I, 2.1 “Consultation with other examiners”, keep the term “examiners” and add a cross-reference to B-I, 2.2. |
| B    | I       | 2.2     | <i>in consultation with the <del>examiner</del> members expert(s) in the other technical field(s)</i> – change “members” to “member(s)”, delete “expert(s)” OR use “member expert(s)”. | This has already been corrected. The published text reads “member expert(s)”.   |

|   |     |       |   |  |
|---|-----|-------|---|--|
| B | I   | 2.2.2 | <p>(a)</p> <p>“The search on the invention first mentioned in the claims...”</p> <p>The phrases “the invention first mentioned in the claims“ or ”the invention first claimed“ or simply “the first invention” are frequently used in part B and specifically in chapter B-VII.</p> <p>B-III, 3.12<br/>B-VII, 1.1</p> <p>The GL should explain how the EPO define the first invention.</p> <p>These phrases are not defined and may be interpreted by the examining division as it pleases</p> <p>It would be very helpful if there were some examples?</p> | The Office will add cross-references, e.g. to F-V, 4.4, and an example for illustration.           |
| B | III | 2.2   | <p>Similarly <del>he</del>it <del>need</del>needs only consult – change to “Similarly it needs only <u>to</u> consult” OR “Similarly it need only consult”.</p>   | The wording will be improved.  |
| B | IV  | 1.3   | <p>3<sup>rd</sup> paragraph</p> <p>Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, as showing the state of the art, or as giving alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application (see, however, B-IV, 2.4).</p> <p>“...necessary for a correct understanding of the</p>   | The Office agrees to delete the reference to B-IV, 2.4 and to improve the wording of the sentence. |

|   |    |     |   |   |
|---|----|-----|---|---|
|   |    |     | <p><b>application</b>...”</p> <p>The search division should understand the subject of the <b>invention</b> or the <b>content</b> of the application, not the application. Correction is suggested.</p> <p>The reference to B-IV, 2.4 seems odd in particular with the “however” in front.</p>   |   |
| B | IV | 1.3 | <p>3<sup>rd</sup> paragraph, last period and 4<sup>th</sup> paragraph</p> <p>In the exceptional case that the application cites a document that is not published or otherwise not accessible to the search division and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, <u>the search division should apply the procedure under Rule 63 and invite the applicant to either submit the document or indicate the subject-matter to be searched</u> (see B-VIII, 3).</p> <p>Rule 63 explicitly concern an invitation to indicating the subject-matter to be searched. Not an invitation to submit a document.</p> <p>In addition, it is unclear if the search division can invite the applicant to submit the document without simultaneously inviting the applicant to indicate the subject-matter to be searched or if the invitation should include both invitation to submit the document OR to indicate the subject-matter to be searched.</p> | <p>The Office will rephrase the 3<sup>rd</sup> paragraph.</p> <p>The proposal by epi is taken on board.</p> |

|  |  |  |  |  |
|--|--|--|--|--|
|  |  |  | <p>In addition, if the search division exclusively invite the applicant to indicate the subject-matter to be searched (wiz R. 63(1)), why should the invitation have the content specified in the following 4<sup>th</sup> paragraph:</p> <p>***</p> <p>The invitation should contain the following information:</p> <ul style="list-style-type: none"> <li>(i) which cited document is needed;</li> <li>(ii) why the document is needed;</li> <li>(iii) the consequences of not supplying the document in time (see below).</li> </ul> <p>***</p> <p>In addition, if the search division cannot understand the subject of the invention without the document, what good will it do if the applicant indicate the subject matter to be searched?</p> <p>In addition the last period seems to indicate that later furnishing of the document after the search report and opinion have been prepared may have relevance for fulfilment of Art. 83 EPC if such document is relevant for sufficiency.</p> <p>We suggest to delete or to reformulate as follows:</p> <p><del>However, a</del> Applicants must be aware that <del>such later</del> <del>furnished</del> information <b><u>contained in documents referred to in the application</u></b> can only be taken into account for sufficiency of disclosure pursuant to Art. 83 under certain circumstances (see F-III, 8).</p> |  |
|--|--|--|--|--|

|   |    |     |   |  |
|---|----|-----|---|--|
| B | IV | 2.6 | <p>Starting line 2</p> <p>The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve inventive step. <u>The search for <b>conflicting applications</b> should, however, always be completed to the extent that these are present in the available documentation.</u></p> <p>What is meant by “conflicting applications”? Is it prior art under Art. 54(3) EPC?<br/>Suggest to clarify.</p> <p>See B-X 9.2.6</p> | The Office will add a cross-reference to B-VI, 4.  |
| B | VI | 2   | <p><i>However, the <del>examiner</del> search division, in carrying out a European search, should cite an oral description, etc. as prior art only if <b>he</b> has available –</i></p> <p>”he” should be ”it” or preferably “search division” in accordance with the adopted substitution.</p>   | The text as published reads “it has available”. Therefore, no action is required.  |
| B | VI | 5.4 | <p>1<sup>st</sup> paragraph</p> <p>The search does not normally take into consideration documents published after the filing date of the application. However, some extension is necessary for specific purposes, as is apparent from B-VI, 2 to B-VI, 4, and B-VI, 5.3.<br/>B-VI, 2 to B-VI, 4, and B-VI, 5.3 only relates to search in documents before the filing date – the reference to these</p>  | <p>The Office agreed to rephrase the paragraph for clarification. The following was explained:</p> <p>The reference to B-VI, 2 appears relevant in the situation where the oral disclosure occurs before the effective date of the searched application and is followed by a written report published on or after the effective date (see IB-VI, 2.1). Furthermore, extension may be needed for conflicting applications or when the validity of the priority cannot be established or is doubtful</p> |

|   |      |     |   |  |
|---|------|-----|---|--|
|   |      |     | sections appear to be incorrect.  |  |
| B | VI   | 6.4 | <i>In general the <del>examiner</del>search division should</i> – comma is missing after "in general"   | Agreed.  |
| B | VIII | 2.2 | <p>Last paragraph</p> <p>If the <del>examiner</del>search division considers that some claim features do not contribute to the technical character of the claimed invention, this should be indicated in the search opinion. If a lack of inventive step objection is raised <u>where at least some of the distinguishing features are found not to have a technical effect contributing to the solution of a technical problem as set out in G-VII, 5.4</u>, this finding is substantiated.</p> <p>It is sufficient for inventive step that one distinguishing technical feature have a technical effect. Whether or not other distinguishing features do not have a technical effect contributing to the solution of the technical problem is not relevant.</p> <p>We suggest to clarify the last sentence by replacing "where" with "and":</p> <p>If a lack of inventive step objection is raised <del>where</del> <b>and</b> at least some of the distinguishing features are found not to have a technical effect contributing to the solution of a technical problem as set out in G-VII, 5.4, this finding is substantiated.</p> | The proposal is taken on board.  |
| B | VIII | 3   | <p>5<sup>th</sup> paragraph, point (i),</p> <p>One example would be the case of a broad or speculative claim supported by only a limited disclosure covering a small part of</p>  | The Office agrees that the broadness of a claim alone should not be a reason for not performing a full search, and that the problem arises when at least part of such claims |



|  |  |  |  |   |
|--|--|--|--|---|
|  |  |  | <p>the scope of the claim. This could be the case if the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and where a meaningful search could only be performed on the basis of the narrower, disclosed invention. This may mean a search of the specific examples. In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because of the broad drafting style. Accordingly, the procedure under Rule 63(1) may be applied (see B-VIII, 3.1 to 3.4). Here, the requirements underlying the application of Rule 63 would be those of sufficiency of disclosure and support set out in Art. 83 and 84 (see F-III, 1 and 2, and F-IV, 6). The <del>examine</del> <b>search division</b> should however bear in mind that the requirements under Art. 83 and Art. 84 concerning sufficiency of disclosure and support should be seen in relation to the person skilled in the art.</p> <p>The broadness of a claim should not be a reason for not performing a full search. The problem is where the claim is speculative and not supported. We suggest the following amendments:</p> <p>One example would be the case of a broad <del>or</del> <b>and</b> speculative claim supported by <del>only</del> a limited disclosure covering <b>only</b> a small part of the scope of the claim. This could be the case if the <del>broadness</del> <b>unsupported part</b> of the claim is such as to render a meaningful search over the whole of the claim impossible, and where a meaningful search could only be performed on the basis of the narrower, disclosed invention. This may mean a search <del>of the</del> <b>directed to the supported part of the claim, which may be a search directed to a</b> specific examples. <del>In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because</del></p> | <p>are speculative and not supported (due to their broadness). Therefore, the proposal is taken on board.</p> |
|--|--|--|--|---|

|   |    |     |  |  |
|---|----|-----|--|--|
|   |    |     | <p><del>of the broad drafting style.</del> Accordingly, the procedure under Rule 63(1) may be applied (see B-VIII, 3.1 to 3.4). Here, the requirements underlying the application of Rule 63 would be those of sufficiency of disclosure and support set out in Art. 83 and 84 (see F-III, 1 and 2, and F-IV, 6). The <del>examiner</del> <b>search division</b> should however bear in mind that the requirements under Art. 83 and Art. 84 concerning sufficiency of disclosure and support should be seen in relation to the person skilled in the art.</p> |  |
| B | X  | 1   | <p>2<sup>nd</sup> paragraph, last period<br/> A partial search report according to Rule 64(1) (case <b>(iv)</b> above), however, is only transmitted to the applicant, but is made available for inspection in the public part of the <u>examination file</u> according to Art. 128(4).<br/> Strange wording “however, ...only... but” why this wording? “examining file” should be “file” or “file held by the EPO”, e.g. with a reference to the European Patent Register (R. 143)register</p>   | <p>Not agreed, but the sentence will be reworded for clarification.</p> <p>The Office explained that the term “however” is correctly used, because there is a difference between publication of search reports of types (i)-(iii) on the publication server of the EPO (see GL, A-VI, 1.4) and partial search reports, which are only accessible as part of the electronic file in the Register.</p> |
| B | XI | 3.4 | <p>1<sup>st</sup> sentence<br/> It is emphasised that the first sentence of B-XI, 3 only sets out the general rule. There may be cases in which the application is generally deficient.</p> <p>B-XI, 3 first sentence says “Where it is held that the application and/or the invention to which it relates does not satisfy the requirements of the EPC, then corresponding objections are raised in the search opinion.”</p> <p>Hence the 1<sup>st</sup> sentence of B-XI, 3.4 does not make sense.</p>   | <p>Agreed to clarify the wording.</p>  |

|   |    |     |   |                                |
|---|----|-----|---|--------------------------------|
|   |    |     | <p>If an application is generally deficient, it does not meet the requirement of the EPC.</p> <p>It is therefore suggested to delete the 1<sup>st</sup> sentence of B-XI, 3.4</p>   |                                |
| B | XI | 3.4 | <p>3<sup>rd</sup> sentence</p> <p>In these cases the <del>examiner</del>search division should not carry out a detailed analysis, but should send a search opinion to the applicant informing him of this <u>fact</u>, mentioning the major deficiencies and saying that when the application enters the examination stage, further examination will be deferred until these have been removed by amendment.</p> <p>If the search division finds that the application is generally deficient, this finding is NOT a fact but an opinion, which may be rebutted. Hence, the word “fact” should be replaced with another word, e.g. “opinion”</p> | Agreed to clarify the wording. |

| Part | Chapter | Section | Comments/ suggestion  | Consultation results  |
|------|---------|---------|---|---|
| C    | III     | 3.1     | <p>2<sup>nd</sup> paragraph</p> <p>In response to an objection of lack of unity, the applicant must clearly indicate which searched invention he wishes to prosecute further. If the response is unclear, the examining division must seek clarification before continuing with examination (see T 736/14).</p> <p>What if the applicant disagree in the unity findings. It should be reflected that if the applicant disagree, he should explain why, e.g. as follows:</p> | The Office agreed to clarify the wording in this paragraph and its subsections to make clear that the applicant must be heard in respect of non-unity objections. |

|   |     |   |  |  |
|---|-----|---|--|--|
|   |     |   | <p>In response to an objection of lack of unity <b><u>and the applicant does not objects to the unity objection</u></b>, the applicant must clearly indicate which searched invention he wishes to prosecute further. If the response is unclear, the examining division must seek clarification before continuing with examination (see T 736/14). <b><u>Where the applicant objects to the unity objection, he must give his reasons for the objection.</u></b></p> <p>Concerning time limit, please make a reference to part E-VIII, 1.2.</p> |  |
| C | III | 5 | <p>1<sup>st</sup> paragraph</p> <p>– in its opinion, there is no prospect of granting the application, even taking into account the applicant's reply to the search opinion;</p> <p>“a patent” instead of “the application”</p> <p>2nd paragraph</p> <p>The division may inform the applicant in a telephone call if it is considering issuing summons to oral proceedings as the first action in examination (C-VII, 2.7).</p> <p>We would prefer this to read s.th. like “will contact the applicant well in advance and inform him that”</p>  | <p>Agreed. The EPO will take up the proposed wording.</p> <p>Not agreed. The Office considers the current wording preferable. It invites the division to consider the possibility of previously informing the applicant without introducing a further compulsory step into the proceedings.</p> <p>In addition, the 6-month notice before the oral proceedings allows sufficient time for the applicant for the applicant to make any submissions and, as a result of them, maybe avoid the oral proceedings.</p> <p>A summons as first action is issued for only 0.3 % of all first actions in examination. So far, no appeal has been filed for the European patent applications rejected in such summons.</p> |

|   |          |       |   |   |
|---|----------|-------|---|---|
| C | III      | 6     | <p><i>This in particular encompasses search results with respect to applications for patents or utility models <del>filings</del> whose priority is not being claimed. <del>It, and it</del> also (...)</i></p> <p>Should the EPO identify such related applications?</p>   | <p>The Office explained that the transcribed paragraph of the GL is related to the application of Rule 141(3) EPC, which implements Art. 124 EPC.</p> <p>When issuing an invitation under Rule 141(3) EPC, the EPO does not currently identify the related applications in respect of which the information on prior art must be filed.</p> <p>These invitations are however extremely exceptional, because when coming across such related applications the examiner himself will normally be in a position to obtain the search or examination results by himself, without having to request them to the applicant.</p> |
| C | IV       | 3     | <p>3<sup>rd</sup> paragraph</p> <p>However, where there is a reasonable prospect that an additional invitation to overcome the objection(s) could lead to the grant of the application, the examiner will send a further written communication or contact the applicant by telephone. The examiner may also make suggestions on how to overcome the raised objections (see B-XI, 3.8, and C-III, 4.1.2).</p> <p>"a patent" instead of "the application"</p>   | <p>Agreed. "... of the application" will be deleted.</p>  |
| C | III + IV | 5 + 3 | <p>We are keen that there should be no erosion of written proceedings. We understand that the intention of clarification of the Summons to Oral Proceedings as a first action in examination is to make it less available to Examiners and we believe this is extremely important. It should of course be remembered that the role of the EPO is to grant, not to refuse patent applications and this carefully chosen statutory wording should be reflected wherever possible in the Guidelines – the changes at</p> | <p>The Office takes note of the comment.</p>  |

|   |   |         |   |  |
|---|---|---------|---|--|
|   |   |         | Chapter IV Part 3 appear to reflect this which is welcomed.   |  |
| C | V | 1.1     | <p>(i) Suggested amendments</p> <p>(i) deletion of redundant claims (e.g. omnibus claims and other claims <b>the features of</b> which the applicant has incorporated into other claims but forgotten to delete).</p>   | Agreed.  |
| C | V | 1.1 (i) | <p>Reference to the applicant “forgetting” to delete the claims is a little subjective and potentially could be clarified. An example of an amendment which may not be proposed without consulting the applicant is an amendment which “significantly” changes the meaning and scope of the claims – this appears to be too broad a test. Any amendment that changes the scope of the claims could be of potentially enormous significance to an applicant and should not simply be inserted into a 71(3) communication as the impact could be significant.</p>   | <p>1) “forgetting”</p> <p>The Office will look into this. The reference to the applicant forgetting to delete claims is however made as an example of redundant claims. In such a context, it does not appear particularly unclear or ambiguous.</p> <p>2) “significantly”</p> <p>The Office will clarify the wording of this passage, possibly including some examples.</p> |
| C | V | 3       | <p>1<sup>st</sup> paragraph</p> <p><b>3. No reply in time – application-Application deemed withdrawn</b></p> <p>If the applicant fails to pay the fee for grant and publishing or the claims fees or to file the translation in due time, the application is deemed to be withdrawn <u>unless, within the period under Rule 71(3), the applicant files or requests corrections or amendments to the text proposed for grant in the Rule 71(3) communication (see C-V, 4.1).</u></p> <p>It is suggested to amend to the following wording:</p> <p>If the applicant fails to pay the fee for grant and publishing</p> | Agreed.  |

|   |   |         |  |  |
|---|---|---------|--|--|
|   |   |         | or the claims fees or to file the translation <del>in due time</del> <b>within the period under Rule 71(3)</b> , the application is deemed to be withdrawn unless, within the <b>same period</b> <del>period under Rule 71(3)</del> , the applicant files or requests corrections or amendments to the text proposed for grant in the Rule 71(3) communication (see C-V, 4.1). |  |
| C | V | 4       | If the Rule 71(3) communication was based on an auxiliary request and the applicant replies by requesting that a grant be based on a higher <b>ranking</b> request (see C-V, 4.6.2 and 4.7.1.1).<br><br>like in 3(ii)(c)   | Agreed.  |
| C | V | 4.7.1.1 | Last paragraph, line 2<br><br>“rank” should be “ranking”   | Agreed.  |
| C | V | 4.7.1.1 | <b>C-V 4.7.1.1</b> New section on auxiliary requests: In our opinion, this belongs to H-III 3.1 or there should be a reference thereto.  | The Office will consider adding a reference to H-III, 3.3.2  |
| C | V | 4.7.1.1 | Reference to outright refusal after 71(3) makes sense but may take some practitioners by surprise. Whilst they should be aware of the risks of effectively reneging on previously submitted requests, it’s nonetheless worth flagging that this is an extremely risky approach especially if Oral Proceedings have been exhausted.   | The Office explained that the possibility of a refusal is considered in this section for the (rare) case where the objections against the amendments requested by the applicant have already been given in the communication under Rule 71(3) EPC and the applicant replies to the communication sticking to them. In such a special case, the refusal can hardly be surprising for the applicant; especially, if oral proceedings have already been exhausted. That would mean that the unallowable or inadmissible amendments would have already been discussed and, after hearing the applicant, the division still considered them unallowable or inadmissible. Otherwise, |

|   |      |     |  |   |
|---|------|-----|--|---|
|   |      |     |  | the subject of the proceedings would be different, and new oral proceedings could be requested. |
| C | V    | 4.9 | 3)<br>“higher request” should be “higher ranking request” – should also be corrected elsewhere   | Agreed.   |
| C | VIII | 2.6 | The references to improved minutes represent an important discipline which is welcomed from the EPO and potentially extremely important in some instances in view of the proposed changes to the rules and procedures of the Boards of Appeal. | Note is taken.  |

| Part | Chapter | Section | Comments/ suggestion   | Consultation results  |
|------|---------|---------|--|---|
| D    | I       | 3       | <p><b>D-I 3</b> What is the reason why the text is changed:<br/> <i>"Thus the opposition <del>should</del> formally <b>ought to</b> be in respect of all the designated states."</i></p> <p>The common meaning of "ought" is: "to express the view that something is the right thing to do, because it's morally correct, polite, or someone's duty". But Art. 99(2) says: "shall apply". Why then change to "ought to"?</p> | <p>The Office explained that the term “<i>should</i>” has been removed from the entire Guidelines to reflect the actual practice of the EPO and give users certainty about the next action of the EPO.</p> <p>The Office pointed out that the final text of the GL2018 reads: “<i>The opposition has, in principle, to be in respect of all the designated states.</i>”</p> |
| D    | II      | 4.3     | <p>3rd (addad) paragraph</p> <p>Suggested amendment</p> <p><b>If a party requests the EPO to exclude an otherwise public non-patent literature document from the EPO public file</b></p>   | <p>Agreed. The Office will reword the paragraph paragraph as follows:</p> <p>“... However, the page(s) carrying the bibliographic details</p>   |



|   |      |       |  |   |
|---|------|-------|--|---|
|   |      |       | inspection for reasons of copyright, the opposition division will interpret this as a request not to make the document freely available for third parties in the public part of the file. This request, in the above interpretation, is normally granted. However, the cover page <b>and/or the page(s) carrying the bibliographic details of the non-patent literature</b> of the document will be made available via the EPO public file inspection, in order to ensure that members of the public are in the position to retrieve the entire document. The non-patent literature document is not considered as being excluded from file inspection within the meaning of Rule 144, and can be used as evidence in the opposition proceedings. | of the non-patent literature of the document (normally the cover page) will be made available via the EPO public file inspection, ..."  |
| D | III  | 3.1   | The notice of opposition must be filed in writing and <b>should must</b> be typewritten or printed, with a margin of about 2.5 cm on the left hand side of each page. It would be appropriate if the notice of opposition also satisfied the requirements laid down in Rule 49(3).<br>"should" is better than "must". Why changing this wording?   | Regarding the word "should" the Office gave the explanation as at D-I.3.<br><br>According to Rule 76(3) EPC, Part III of the Implementing Regulations shall apply <i>mutatis mutandis</i> to the notice of opposition, i.e. the formal requirements of Rules 46, 49 and 50 EPC are applicable. See also OJ EPO 2013, 603. |
| D | VI   | 7.2.2 | <b>D-VI 7.2.2</b> What is the meaning of the new green text which says that the interlocutory decision " <b>nevertheless qualifies as a grant decision in the sense of G 1/10</b> "?   | The Office explained that after the decision to maintain the patent in amended form is announced by the opposition division, corrections to the text of the patent " <i>can only be requested in the narrow ambit provided for in Rule 140</i> ". This is indicated in the remaining part of the added sentence.          |
| D | VIII | 1.4.1 | If the opposition division is of the opinion that, taking into consideration the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates meet the requirements of the EPC, it will issue <b>a-an interlocutory</b> decision to  | This has already been fixed in the published version of the GL2018.   |

|   |    |     |   |  |
|---|----|-----|---|--|
|   |    |     | maintain the European patent as amended.<br>Typographical error   |  |
| D | IX | 1.3 | <p>Last paragraph:</p> <p>In the order of apportionment as part of its decision, the opposition division will state the kind of costs to be differently apportioned and reimbursed to the receiving party as clearly and precisely as possible.</p> <p>Add “ly”</p> <p>The phrase “kind of” is unclear – we suggest to delete.</p>  | <p>The Office will take up the proposal to add a “ly” to “precise”.</p> <p>The expression “kind of” will not be deleted. The Office explained that the sentence in question clarifies the practice that the decision of the opposition division is more detailed than simply ordering a generic refund of costs.</p> |
| D | IX | 1.4 | <p>Accordingly, costs incurred as a result of default or of inappropriate legal means used by either party may be charged to the party responsible, even if he has been successful in the opposition proceedings. Situations resulting from “force majeure” (such as absence at oral proceedings due to a sudden serious illness) do in general not lead to the apportionment of costs.</p> <p>Where does this come from?</p> <p>Why “in general”. “force majeure” should prevent apportionment of costs, shouldn’t it ?</p> <p>See our comment to E-III, 7</p> | <p>The Office briefly explained the EPO practice and stated that the sentence correctly reflects this practice. The term “in general” is correct and still valid since exceptional cases may occur.</p>  |
| D | IX | 2.2 | <p>Clerical error:</p> <p>iss<u>ue</u></p>  | <p>This has already been fixed in the published version of the GL2018.</p>   |

| Part | Chapter | Section | Comments/ suggestion   | Consultation results  |
|------|---------|---------|--|---|
| E    | III     | 6       | <p>“New documents may be cited in the annex to the summons (T 120/12), together with an explanation of their significance.”</p> <p>Citing new documents in Summons to Oral Proceedings appears to me to be a violation of the party’s right to be heard</p>  | <p>The Office explained that this practice does not violate the right to be heard. T120/12 (at 4.4) expressly recognises this possibility, provided the new documents are sufficiently discussed during oral proceedings. The sentence must be read in the context of the whole paragraph in which also the limits to cite new documents are outlined.</p> <p>The Office asked to provide examples if it is believed that the practice of E-III.6 is not correctly followed.</p>  |
| E    | III     | 7       | <p><a href="http://www.epo.org/law-practice/case-law-appeals/pdf/t130447eu1.pdf">http://www.epo.org/law-practice/case-law-appeals/pdf/t130447eu1.pdf</a></p> <p>This case is very important and should be reflected in GL/EPO E-III,7.</p> <p>The representative was ill, presumably at home, and it would be disproportionate to require a medical certificate because this would delay the request. If the representative was too ill to participate in the oral proceedings this must be considered to be “serious illness”</p> | <p>Not agreed.</p> <p>The EPO expressed reservations to reflect decision T 447/13. The GL are not the place to define each and every reason for postponement in great detail. In the underlying case, the division came to an obviously wrong result, because they should have stated clearly that they wanted to be presented with a medical certificate. Yet, any further explanation would also imply a danger of limiting the scope of application of the given exception (e.g. a limitation to a representative or other person due to present the case – as in T 447/13).</p> <p>It was clarified that a medical certificate may be filed subsequently if it cannot be provided immediately due to the circumstances. However, the person concerned should inform the EPO as soon as possible that s/he cannot attend the oral proceedings. Medical certificates are kept in the non-public part of the file and, as a rule, do not indicate the diagnosis.</p> |

|   |     |     |   |   |
|---|-----|-----|---|---|
| E | III | 7.1 | <p>Last year we had the comment:</p> <p>2<sup>nd</sup> paragraph, 1<sup>st</sup> pin:</p> <ul style="list-style-type: none"> <li>- a previously notified summons to oral proceedings in other proceedings before the EPO or a national court</li> </ul> <p>Suggest deletion with respect to "same party". It doesn't matter whether or not it is the same party.</p> <p>The EPO replied:</p> <p>The Office clarified that the wording in the GL is in line with OJ EPO 2009, 68. The "same party" clearly refers to party requesting the postponement, not the opponent.</p> <p>In my opinion OJ 2009,68 does not clarify that the party may be the representative. Actually in point 2.5 the representatives and parties are mentioned separately:</p> <p>2.5 In order to make effective use of the available meeting rooms, and as Mondays and Fridays are normal working days, oral proceedings will also be scheduled for these days. The fact that the representative and/or the parties have to travel on weekends is not a sufficient reason to change the date of the oral proceedings. The departments of first instance will, however, circumstances permitting, try to be flexible where it has been requested that the starting time be postponed in order to enable the party to travel on the same day.</p> <p>We suggest that the EPO clarify that the "party" may</p> | <p>The Office brought forward that the situation from last year has not changed and clarified the following:</p> <ol style="list-style-type: none"> <li>1. The wording is in line with point 2.3 of the notice OJ 2009, 68; it must, furthermore, be read in the context of the entire paragraph (see point 4, below);</li> <li>2. A broad interpretation (including both applicants/opponent and their respective representatives) has been consistently applied. We are not aware of any cases where a summons for the same representative was not accepted as reason for postponing oral proceedings;</li> <li>3. The division is anyway called upon to exercise its discretion – hence, an absolute right to have the oral proceedings postponed does not exist;</li> <li>4. The term "parties" in point 2.5 of the 2009 notice is clearly to be interpreted differently than in point 2.5 of the GL, which is clear from the juxtaposition with representatives and the use, in the German version, of a different term (Beteiligter vs. Verfahrensbeteiligter in 2.3). Moreover, section 2.5 of the 2009 notice is not included in the GL and cannot, therefore, be relied on when interpreting the GL. Rather, the forth para. in section 7.1 shows that - for all possible grounds - the reasons "apply only to those participants whose presence is essential to the oral proceedings." This makes clear that the reference to "the same party" is not limited to individual applicants, proprietors or opponents, but includes the respective representatives and possibly employees in charge of the specific case.</li> </ol> |
|---|-----|-----|---|---|

|   |        |       |   |   |
|---|--------|-------|---|---|
|   |        |       | be the representative and/or the proprietor/opponent or specifically mentions the representative.   | <p>➤ The Office agreed to add a definition of “party to the proceedings” in the General Part of the Guidelines.</p>   |
| E | IV-III | 7.1.1 | With reference to non-attendance at Oral Proceedings, the pressures on practitioners should be borne in mind – also the availability of video conferences should be considered carefully and we understand that this is being looked at in other areas of the EPO at the moment. Suggestions have been made by various bodies for “case management conferences” or similar, and setting an agreed date with the parties for a hearing would be more in line with many court practices, and less likely to lead to acceptable reasons for absence.     | <p>The Office stated the following:</p> <ul style="list-style-type: none"> <li>• The situation of the representatives and of the parties is certainly taken into account, when exercising the discretion to take a decision to postpone.</li> <li>• ViCo oral proceedings are generally possible (subject to availability of facilities), see GL E-III, 11.</li> <li>• The proposal to have a “case management conference” is probably out of scope here (for the GL), as it would imply a general change of the procedure. It may be included on the general “wish list”. Note that, already now, there is the possibility to have informal consultations, including prior to oral proceedings, where such issues could be reflected.</li> </ul> <p>Agreeing on a date for oral proceedings with parties appears very difficult to handle in practice; in view of the standardised periods for summons, there is sufficient advance notice. The legitimate interests of the parties are adequately taken into account by means of a clear and transparent description of reasons for postponement.</p> |
| E | III    | 8.9   | <i>If the competent department intends to depart from a previous legal assessment of the situation with which the parties are acquainted or from a prevailing legal opinion, or if facts or evidence already introduced into the proceedings are seen in a different light – e.g. during the deliberations of the examining or opposition division (see E-III, 8.11) – so that the case takes a significant turn, and there have not been any discussions on that during oral proceedings, the parties must<del>should</del> be informed thereof.</i> | <p>The Office agreed to reword the paragraph in a slightly different way than proposed by the users, and in addition it gave the following explanation:</p> <p>The additional qualification added last year was due to the switch from “should” to “must” – to include the flexibility inherent in the term “should”. Examiners are aware that they must give applicants the right to be heard, including in situations like the one addressed here, i.e. that</p>  |

|   |     |        |   |  |
|---|-----|--------|---|--|
|   |     |        | <p>This could be taken as a relaxation of the requirement to inform the parties of a significant turn when the previous legal assessment is changed. The definition of “discussions” during oral proceedings is a bit vague. If for instance the examining or opposition division briefly mention or hint at a different principal view during oral proceedings, the added text indicates that the parties do not have to be informed?</p> <p>We suggest that the newly added exception is deleted. We assume that this situation is not so common and then the burden of the EPO to inform the parties should not be too high.</p> | <p>“discussion” in this context cannot be equal to a “short hint” or a “brief mentioning”.</p>   |
| E | III | 10.3   | <p>The references to improved minutes represent an important discipline which is welcomed from the EPO and potentially extremely important in some instances in view of the proposed changes to the rules and procedures of the Boards of Appeal.</p>   | <p>The Office took note of the comment.</p>  |
| E | IV  | 1.10.3 | <p>Adding a reference to an OJ of 1983 is not very convenient.</p> <p><i>“see OJ EPO 1983, 100”</i></p> <p>We suggest to incorporate the most important information in the GL. At least the main issues should be mentioned.</p>  | <p>The Office clarified that the GL must not paraphrase the publications of the OJ. The Notice concerned is still informative. Furthermore, the <a href="#">OJ of 1983</a> is (almost) as easily accessible as that of 2018.</p>   |
| E | IV  | 1.11.3 | <p>The original “should be” is correct.</p>   | <p>Agreed.</p>   |
| E | V   | 5      | <p>However, employees <del>may</del><del>should</del> not depart from the language of the proceedings without good reason. <del>Unless, and unless the parties involved are competent in the language used and express no objection, the EPO provides</del><del>should provide</del> for interpreting into the language of the proceedings at its own expense.</p> <p>Disagree. Assume the language of proceedings is EN. The representative is German and the applicant is English.</p>  | <p>The Office clarified that it follows from the previous paragraph (quoted below), that such an assumption (that there are no objections to a different language being used) may be based primarily on requests of the parties, not on the nationality of the representative.</p> <p>“Employees of the EPO may use in oral proceedings an official language of the EPO other than the language of</p> |

|   |    |       |   |  |
|---|----|-------|---|--|
|   |    |       | The German representative may not want the OD to switch to German of their own volition just because the representative is German native speaker and they feel more comfortable with German than English. There should only be a departure from the language of proceedings with the consent of the party/parties.  | proceedings. The parties must be informed accordingly prior to the oral proceedings, unless it can be reasonably assumed that they would not object to this, e.g. because they have equally requested to use that different official language."  |
| E | VI | 2.1   | E-VI 2.1 – mis-spelling of "they are"   | This will be corrected (in the 4 <sup>th</sup> para.)  |
| E | VI | 2.2   | a) third paragraph<br>If during the oral proceedings the opposition division, contrary to its provisional opinion set out in the annex to the summons, reaches the conclusion that the patent <del>must</del> <del>should</del> be revoked, a request of the proprietor for (further) amendment <del>can</del> <del>should</del> be admitted into the proceedings (see E-III, 8.6).<br><br>Keep the "should". "can" is too vague. | The Office agreed to reword the sentence in a slightly different way.  |
| E | IX | -     | Why not deal with the procedural aspects of Euro-PCT applications in the EPO/PCT Guidelines?<br><br><b>Repeated request:</b> As usual there is a great overlap between the GL/EPO, the GL-PCT/EPO and the <i>Euro-PCT Guide</i> .<br>Why not incorporate the content of the Euro-PCT Guide into the Guidelines?   | The Office clarified that part E of the EPC-GL relate to the procedure before the EPO as designated or elected Office whereas the PCT-EPO GL deal with the search and examination at the EPO as PCT-Authority.<br><br>The Euro-PCT Guide informs <u>applicants</u> about the PCT-related procedures before the EPO. The GL are instructions to the EPO <u>examiners</u> .<br><br>The issue of quoting the Euro-PCT Guide is further addressed in the comments to the PCT-EPO GL. |
| E | IX | 2.1.2 | At the end a sentence has been added about translations. Art. 14(2) EPC talks about " <b>into</b> conformity" not " <b>in</b> conformity".<br><br><i>"A translation, whether filed on entry into the European phase under Art. 153(4) or in the international phase under Rule 12.3 or Rule 12.4 PCT, may always be brought in</i>  | This is a language issue and will be dealt with by the EPO's language service.   |



|   |    |       |  |  |
|---|----|-------|--|--|
|   |    |       | <i>conformity with the application as filed."</i>  |  |
| E | IX | 2.2   | <p><b>E-IX 2.2, 2.3, 2.3.7, 2.4, 2.5</b> "Provisions" has been replaced by "Instructions". What is the reason for this?</p> <p>In <b>E-IX 2.3.9</b> "Provisions" has <b>not</b> been replaced by "Instructions". What is the reason for this?</p>  | <p>The Office clarified that the GL do not contain (legal) provision but rather instructions to EPO examiners and other staff. Therefore, the term "provisions" is misleading, when referring to sections in the GL. The term "instructions" was considered to better reflect the character of the individual statements in the GL.</p> <p>E-IX 2.3.9 reflects on (legal) provisions of the EPC and of the PCT – and not of the GL. In this context the term is, thus, correctly used.</p> |
| E | IX | 2.3.5 | <p>For the claim to priority a reference to Rule 17.1(b-bis) should be added in the last sentence (see underlining):</p> <p><i>Where the applicant has complied with Rule 17.1(a) and (b) PCT <u>and Rule 17.1(b-bis) PCT</u>, the EPO may not ask the applicant himself to furnish a copy.</i></p>  | <p>The Office agreed to reword the sentence.</p>   |
| E | IX | 3.2   | <p>The first sentence is not in line with Rule 161(1) EPC:</p> <p><i>If the EPO acted as ISA, the authority specified for the supplementary international search (SISA) and/or IPEA, a written opinion of the ISA (WO ISA), a supplementary international search report (SISR) and/or an international preliminary examination report (IPER) will already have been transmitted to the applicant during the PCT phase.</i></p> <p>Rule 161(1), first sentence, EPC contains the word '... also ...' which implies that the EPO does not ask for comments/amendments if the EPO ONLY acted as IPEA.</p> | <p>The Office agreed to consider rewording the paragraph in order to avoid misunderstandings.</p>  |



|   |     |     |  |   |
|---|-----|-----|--|---|
|   |     |     | <p>The latter is possible if a Patent Office in an EPC State acted as ISA and subsequently the EPO was asked to act as IPEA. In this case, the Euro-PCT application is treated under Rule 161(2) and 164(1) EPC.</p> <p>This situation is not reflected in the first sentence of the GL/EPO E-IX 3.2. The rest of the text does not make it any clearer.</p>                   |   |
| E | X   | 3   | <p>E-X 3 – last sentence is unclear – do they mean “the reasons <b>may</b> be given only in the final decision (but could also be given in an interlocutory decision)” or “ the reasons <b>must only</b> be given in the final decision”.</p>  | <p>Not agreed. The Office stated that the sentence is not unclear if read in its entirety. In order to avoid any misunderstandings when just looking at the last half sentence, the Office will reword the paragraph in a slightly different way..</p>            |
| E | XII | 6   | <p>E-XII 6 “reduced” should read “lower”.</p>  | <p>The Office explained that “reduced” is the wording in the OJ notice and elsewhere, hence it should remain also in the GL.</p>  |
| E | XII | 7.1 | <p>If the department whose decision is contested considers the appeal to be admissible and well founded, it must rectify its decision. <b>This does not apply where the appellant is opposed by another party to the proceedings.</b><br/>We would like to revisit why interlocutory revision is not possible anymore when the sole opponent has withdrawn the opposition.</p> | <p>The Office explained that the paragraph including the highlighted sentence corresponds to Article 109(1) EPC. Changing the practice would, therefore, be <i>contra legem</i>.</p>  |
| E | XII | 8   | <p>A reference to Rules 12a-12d EPC would be suitable here.</p>  | <p>The Office stated that the GL, relating to the proceedings before the 1<sup>st</sup> instance, should not be overloaded with references to institutional provisions, such as the one setting out the legal basis for the Boards of Appeals unit, BOAC etc.</p> |

| Part | Chapter | Section | Comments/ suggestion  | Consultation results  |
|------|---------|---------|---|---|
| F    | General |         | <p>There are significant changes to the unity and clarity sections. It would be beneficial to have an understanding of where these changes come from as, in some instances, they do not appear to refer to case law decisions. I would urge that practitioners are closely involved in these discussions in particular in relation to clarity as this is an essential part of the drafting process and useful input would definitely be available from patent draftspersons as a result.</p> <p><b>Chapter on Unity of Invention</b> – the reference to “rich varieties” from decision W45/92, whilst being taken from case law, doesn’t actually make any sense and should be deleted!</p> | <p>It was agreed to remove the reference to W 45/92.</p> <p>The Office underlined that the practice of the 1<sup>st</sup> instance can be based on decisions of the BoA but is in no way limited to it.</p> <p>The Office welcomes input of practitioners, therefore groups such as SACEPO exist.</p> |
| F    | II      | 2.2     | <p>2<sup>nd</sup> paragraph<br/> The abstract <del>should</del> <b>needs</b> to be <del>se</del> drafted <b>so</b> that it constitutes an efficient instrument for searching in the particular technical field <b>and for</b> evaluating <b>if</b> it is worth considering the whole content of the application!<br/> “S” and period are missing.</p>   | <p>This has already been fixed in the published version of the GL2018.</p>  |
| F    | II      | 2.2     | <p>“The abstract <del>should</del> <b>need</b> to be <del>se</del> drafted <b>so</b> that it constitutes an efficient instrument for searching in the particular technical field <b>and for</b> evaluating <b>if</b> it is worth considering the whole content of the application.” This sentence appears to belong to section 2.1?<br/> I would replace “needs to” with “must” in this paragraph, but also in many other parts of this chapter.<br/> I also believe it would be beneficial to review the English language aspects of this chapter in particular.</p>   | <p>The Office agreed to reword the paragraph in a slightly different way than proposed by the users.</p>  |
| F    | II      | 2.3     | <p>(iii) and (vi)<br/> See the marked corrections:</p>  | <p>The Office agreed to the proposed correction of subsection (iii) and to reword subsection (iv).</p>  |

|   |    |     |  |  |
|---|----|-----|--|--|
|   |    |     | <p>contain a concise summary of the disclosure as contained in the description, <b>the</b> claims and <b>any</b> drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use <b>or uses</b> of the invention and, where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention;</p> <p><b>if appropriate</b> be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, <del>should</del> <b>needs to</b> be followed by a reference sign in parenthesis.</p>  |  |
| F | II | 3   | <p><b>2<sup>nd</sup> paragraph</b></p> <p>The title should clearly and concisely state the technical designation of the invention and should exclude all fancy names (see A-III, 7.1). While any obvious failures to meet these requirements are likely to be noted during the formalities examination (and possibly during the search, see B-X, 7(ii)), the <b>search division or the examining division-examiner should</b> reviews the title in the light of <del>his-its</del> reading of the description and claims and any amendments thereto, <del>as well as of being concise,</del> to make sure that the title <del>,as well as being concise,</del> gives a clear and adequate indication of the subject of the invention. Thus, if amendments are made which change the categories of claims, the <b>examining division-examiner should</b> checks whether a corresponding amendment is needed in the title.</p> | The Office agreed to reword the paragraph.       |
| F | II | 4.3 | <p><b>4.3 Background art</b></p> <p>The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" <del>[in 4.2 the first portion is a prior art one – please see above]</del> portion of the independent claim or claims (see F-IV, 2.2).</p> <p>Be consistent</p>   | The Office agreed to reword the paragraph.       |
| F | II | 4.3 | <p><b>2<sup>nd</sup> paragraph, last line</b></p> <p><b>H-IV, 2.2.7</b> [please check maybe H-IV, 2.2.6].</p>  | Agreed. The reference must refer to H-IV, 2.2.6. |

|   |    |         |  |   |
|---|----|---------|--|---|
| F | II | 4.5     | 4 <sup>th</sup> paragraph<br>“problem-solution” “without “and”<br>Same correction elsewhere  | The Office agreed to align the spelling.                                |
| F | II | 4.10    | Correction:<br>The manner and order of presentation of the description should be that specified in Rule 42(1), i.e. as set out above, unless, because of the nature of the invention, a different manner or a different order would afford a better understanding <b>or</b> a more economic presentation.<br>“or” instead of “and”                                   | The Office agreed to clarify this paragraph.                            |
| F | II | 5.2     | <u>The examining division</u> <del>He should</del> needs to, however, beware of any extension of subject-matter (Art. 123(2)). “The examining division” instead of “It” Same elsewhere   | The Office stated that “it” clearly relates to the examining division.  |
| F | II | 7.4     | The third category is irrelevant matter <b>or unnecessary</b> : <del>It should be noted, however, that</del> such matter is specifically prohibited under Rule 48(1)(c) only if it is "obviously irrelevant or unnecessary", for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art (see also F-II, 4.4). | The Office agreed to align the paragraph to the wording of the Rule.    |
| F | II | Annex 2 | <u>1.1</u><br>Small letters for “m” and “s”<br><u>1.2.2</u><br>Small letters for “cd”<br><u>1.4</u><br>Small letters for “t” and “bar”<br><u>2</u><br>Small letters for “degree”<br><u>3</u><br>Small letter for “u”<br><u>4</u><br>Small letter for “b”   | Agreed. The Office will furthermore check other units and measurements. |
| F | II | Annex   | °C   | Agreed.   |

|   |     |         |  |   |
|---|-----|---------|--|---|
|   |     | 2       |  |   |
| F | II  | Annex 2 | Food note page II-15<br>Mainly based on <b>Chapter I</b> [please kindly check since it appears that not everything is based on this Chapter] of the Annex to EEC Directive 80/181/EEC of 20.12.1979, as amended by EEC Directives 85/1/EEC of 18.12.1984, 89/617/EEC of 27.11.1989, 1999/103/EC of 24.01.2000 and 2009/3/EC of 11.03.2009.   | It was agreed that “Mainly” needs to be included.   |
| F | III | 1       | 2 <sup>nd</sup> paragraph<br><br>However when assessing sufficiency of disclosure, the intrinsic limitations that a sensible reading imposes on the subject-matter of the independent claims must be taken into consideration; in other words the person skilled in the art wishing to implement the claimed <u>invention</u> will exclude any embodiment that is meaningless and not consistent with the teaching of the application (see T 521/12).<br>“invention” instead of “objection” and period in the end. | This has already been fixed in the published version of the GL2018.   |
| F | III | 8       | <b>H-IV, 2.2.7</b> [please check maybe <b>H-IV, 2.2.6</b> ]).  | Agreed to correct the reference to H-IV, 2.2.6  |
| F | III | 10      | <b>H-IV, 2.3.2</b> - please check since this reference relates to the divisional application?]).   | Agreed to correct the reference to H-IV, 2.2.2  |
| F | IV  | 2.1     | 1 <sup>st</sup> paragraph<br>“or other non-technical matters” should be deleted.   | The Office agreed to consider replacing the term “matters” with a better expression to clarify the sentence.  |
| F | IV  | 2.2     | <br><br>1 <sup>st</sup> line: The respective Rule uses the term “shall”. Why is “should” replaced by “must”?<br><br>The rule says “shall”  | The Office reiterated that the term “ <i>should</i> ” has been removed from the entire Guidelines to reflect the actual practice of the EPO and give users certainty about the next action of the EPO.<br><br>Rule 43(1) is expressing a necessary condition for the form and content of the claims. According to the <a href="#">OED</a> (Oxford English dictionary) “ <i>shall</i> ” is a synonym of “ <i>will have to</i> ”, “ <i>must</i> ” |

|   |    |       |   |  |
|---|----|-------|---|--|
| F | IV | 2.2   | This section uses too many synonyms for pre-characterizing part for example: “first part”, “statement of prior-art features”, “features stated in sub-paragraph (a)”, “the prior-art part” “preamble”, “pre-characterising portion”. Characterizing part is described as “the second part”, “characterising portion” “characterising part”. Why using different terms?  | Agreed to revise the section.  |
| F | IV | 3.7   | A claim, whether independent or dependent, may refer to alternatives, provided that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe and provided that the claim meets the requirements of unity (see also F-V, 4 please check maybe F-V, 2.2.2.2 and 9 please check maybe F-V, 5). In case of a claim defining (chemical or non-chemical) alternatives, i.e. a so-called “Markush-grouping”, unity of invention <del>is</del> should be considered to be present if the alternatives are of a similar nature and can fairly be substituted for one another (see F-V, 5 please check maybe F-V, 2.2.2.2). | This has already been fixed in the published version of the GL2018.  |
| F | IV | 3.9.1 | Penultimate paragraph G-II, 3.7.2. [please check maybe G-II, 3.6.3.]  | This has already been fixed in the published version of the GL2018.  |
| F | IV | 4.4   | Last paragraph “Finally claim-like clauses appended at the end of the description must also be deleted prior to grant, since they otherwise may lead to unclarity as to the actual scope of protection.”<br><br>Ambiguous paragraph. To be deleted or “since they otherwise may lead to” should be replaced with “if they lead to”.   | The Office agreed to better define what is meant by “claim-like clauses”.  |
| F | IV | 4.4   | This refers to deletion of “claim like clauses appended at the end of the description”. Currently this appears to be exercised as a matter of discretion by Examiners but can give rise to concerns with applicants especially from the   | The office agreed to clarify what is meant with “claim-like clauses”.<br>The fact that the Guidelines clearly indicate that the EPO requests the deletion, eliminates any issue about the “ <i>intention</i> ” of the applicant. |

|   |    |       |  |   |
|---|----|-------|--|---|
|   |    |       | US simply because deletion may be available as indication in US litigation of the intent of the patentee. There is no particular downside from a legal perspective that can be identified to maintaining the clauses and removal would appear to be an additional burden on all parties for no obvious reason. It would be useful if this could be reconsidered for purposes of expediency.  | If the clauses are kept, then they need to be checked one-by-one for compliance with the claims, hence, for reasons of expediency, the passage is kept.                         |
| F | IV | 4.6.1 | General comment: We need to discuss clarity in general. Is a feature unclear because it is relative or is it unclear when the skilled person cannot assess objectively if it is or it is not comprised by the prior art (see the last sentence in example (ii) in 4.7.2)?  | The Office stated that section 4.6.1 is clear enough by indicating when a relative term is unclear, i.e. because it renders comparing the claims with the prior art impossible. |
| F | IV | 4.6.1 | <b>Correction</b><br>Relative or similar terms as "thin", "wide" or "strong" constitute a potentially unclear element due to the fact that they may <b>change of meaning</b> depending on the context. For these terms to be allowed, their meaning must be clear in the context of the whole disclosure of the application or patent.   | This has already been fixed in the published version of the GL2018.   |
| F | IV | 4.6.1 | 3rd paragraph<br><b>Correction:</b><br>Where the <b>relative</b> term has no well-recognised meaning <b>the division invites the applicant to replace it</b> <del>should, if possible, be replaced</del> , if possible, by a more precise wording found elsewhere in the original disclosure. Where there is no basis in the <b>original</b> disclosure for a clear definition and the term is not <b>anymore the only distinguishing feature</b> <del>essential having regard to the invention</del> , it <b>may</b> <del>should normally</del> be retained in the claim, because <b>excising to excise</b> it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of Art. 123(2). | Agreed to amend.  |

|   |    |       |  |   |
|---|----|-------|--|---|
|   |    |       |  |   |
| F | IV | 4.6.2 | Are the examples based on case law?  | The Office explained that these examples reflect the practice of the first instance (and of the BoA).   |
| F | IV | 4.6.2 | <p>1<sup>st</sup> paragraph</p> <p>When the use of a relative term is allowed in a claim, this term is interpreted by the division in the <b>least restrictive possible</b> way when determining the extension of the subject-matter of the claim. <b>As a consequence, in most cases, a relative term is simply not limiting the scope of a claim.</b></p> <p><b>“the least restrictive possible”</b></p> <p>It is suggested to replace this phrase with “broadest reasonable”.</p> <p>“As a consequence, in most cases, a relative term is simply not limiting the scope of a claim.”</p> <p>Delete this phrase or change to “As a consequence, in <del>most</del> <u>some</u> cases, a relative term is <del>simply</del> not limiting the scope of a claim.”</p> <p>2<sup>nd</sup> paragraph</p> <p>For example, the expression “<i>a thin metal plate</i>” does not limit the feature “<i>metal plate</i>” against the prior art: a metal plate is “<i>thin</i>” only once compared against another one, but it does not define an objective and measurable thickness. So a metal plate three millimetres thick is thin when compared against a plate five millimetres thick but thick when compared against a plate one millimetre thick. Don’t necessarily agree. This is too absolute.</p> | <p>The Office explained that the claim must always be read “with an attempt to make technical sense” as indicated in F-IV, 4.2.</p> <p>The Office agreed to replace the word “most” with “many”.</p> <p>Not agreed.</p> |



|   |    |       |  |  |
|---|----|-------|--|--|
|   |    |       | <p>3rd paragraph</p> <p>As another example, when considering “<i>an element mounted near the end of a truck</i>”, is this element mounted 1 mm from the end of the truck, 10 cm or 2 m? The only limitation of such an expression is that the element must be nearer to the end of the truck than to its front, i.e. the element can be mounted anywhere in the second half of the truck.</p> <p>Strongly disagree. If it’s very close to the middle, it is not to be interpreted to be “near the end”. That would be unreasonable.</p> <p>4th paragraph</p> <p>Also defining a material as “<i>elastic</i>” does not limit the type of material, because elasticity is an intrinsic property of any solid material measured by the module of Young. Therefore an elastic material <i>per se</i> can be anything from rubber to diamond.</p> <p>Again, depending on the context, it may be just absurd to read a diamond on a claimed “elastic material”. Overly simplistic example.</p> | <p>Agreed to limit and rephrase the example.</p> <p>Agreed to reword. The Office explained that the example is based on a T-decision. The Office furthermore suggested that the epi provide examples that are more illustrative.</p> |
| F | IV | 4.6.2 | <p>The expression “module of Young” in</p> <p>“Also defining a material as “<i>elastic</i>” does not limit the type of material, because elasticity is an intrinsic property of any solid material measured by the module of Young. Therefore an elastic material <i>per se</i> can be anything from rubber to diamond. “</p> <p>Suggest expression: “<b>Young’s modulus</b>” instead</p> <p><a href="https://en.wikipedia.org/wiki/Young%27s_modulus">https://en.wikipedia.org/wiki/Young%27s_modulus</a></p>   | Agreed.  |

|   |    |       |   |   |
|---|----|-------|---|---|
| F | IV | 4.7.2 | <p>2<sup>nd</sup> paragraph</p> <p>Suggested correction</p> <p>For example, if the application suggests that an icosagon (<del>twenty-sided polygon</del> <del>20-gon polymer</del>) is also a “<i>substantially circular circumference</i>” for a metal tray realised by a CNC water cutting machine, this renders the scope of the claims unclear because:</p> <p>(i) the tolerance indicated by the application is outside the tolerance of the manufacturing method (a CNC water cutting machine approximates a circular circumference by using a polygon with hundreds of sides); and</p> <p>(ii) if an icosagon is also a “<i>substantially circular circumference</i>”, what about an enneadecagon (<del>nineteen-sided polygon</del> <del>19-gon polymer</del>) or an octadecagon (<del>eighteen-sided polygon</del> <del>18-gon polymer</del>)? When does a polymer stop being a “<i>substantially circular circumference</i>”? How can this be assessed objectively by the person skilled in the art?</p> | This has already been fixed in the published version of the GL2018.   |
| F | IV | 4.9   | <p>1<sup>st</sup> paragraph</p> <p><del>—Expressions of this kind have no limiting effect on the scope of a claim</del></p> <p>has been deleted. What is the reason for this?</p> <p>2<sup>nd</sup> paragraph</p> <p>These expressions introduce ambiguity and render the</p>   | The Office explained that it is implicit that features which are “regarded as entirely optional” have no limiting effect on the claims. |

|   |    |      |  |  |
|---|----|------|--|--|
|   |    |      | <p>scope of the claim unclear if they do not lead to a restriction to the features of the claim.</p> <p>What is the legal basis for this addition? Is there case law to support this?</p> <p>This second paragraph is inconsistent with the first paragraph and should be deleted or reworded. An optional feature can be either (i) a more precisely defined variant of a broader feature recited in the claim; or (ii) it can be directed to just a further feature that has no antecedent basis at all in the claim. We assume the second paragraph shall deal with (i), but not (ii).</p> <p>3<sup>rd</sup> paragraph</p> <p>For example the wording “<i>a method to manufacture an artificial stone, such as a clay brick</i>” does not fulfil the requirements of Art. 84, because a clay brick is not a type of artificial stone. Hence it is unclear which product is manufactured by the method of the claim.</p> <p>We find this example unclear; no good choice to explain clarity.</p> | <p>Agreed to improve the wording.</p><br><br><br><br><br><br><br><br><br><br><p>The Office explained that it is the purpose of the example to give a notion for a formulation that is not clear. It raises the question in the reader how a clay brick can be equalled with an artificial product.</p> |
| F | IV | 4.16 | Is this example appropriate (method claim)?  | The Office explained that the example refers to the paragraph above it. A claim can either be a process or a method. It may be considered to remove old examples.  |
| F | IV | 4.20 | Last paragraph “disclaimer not disclosed” should be “undisclosed disclaimer”   | The Office agreed to reword the paragraph.   |
| F | IV | 4.21 | <p>3<sup>rd</sup> and 4<sup>th</sup> paragraph</p> <p>Corrections:</p>   | This has already been fixed in the published version of the GL2018.  |

|   |    |     |   |   |
|---|----|-----|---|---|
|   |    |     | <p>In the case of chemical compounds or compositions, the use of “<i>consisting essentially of</i>” or “<i>comprising substantially</i>” means that specific further components can be present, namely those not materially affecting the essential characteristics of the compound. For any other apparatus/method/product these terms have the same meaning <del>as</del> “<i>comprising</i>”.</p> <p>Regarding Art. 123(2), “<i>comprising</i>” does not provide <i>per se</i> an implicit basis for either “<i>consisting of</i>” or “<i>consisting essentially of</i>” (T 759/10).</p>   |   |
| F | IV | 6.2 | <p>Corrections:</p> <p>Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the <del>division-examiner</del> must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant <del>are is should be</del> allowed to cover all obvious modifications of, equivalents to and uses of that which he has described. In</p> | This has already been fixed in the published version of the GL2018.               |
| F | IV | 6.3 | <p>2<sup>nd</sup> paragraph<br/>Correction:<br/>The <del>division-examiner should</del> raises an objection of lack of support only if <b>it/the division</b> has well-founded reasons.</p>   | This is a linguistic issue and will be referred to the EPO’s language department. |
| F | V  | 2   | <p>Consider replacing the term “embodiments” in the 2<sup>nd</sup> paragraph.</p> <p>The requirement of unity of invention needs to be assessed only if a group of inventions is claimed. A group of inventions may be formed, for example, by a plurality of</p>   | Agreed. Suggestion taken on board.  |

|   |   |         |  |  |
|---|---|---------|--|--|
|   |   |         | independent claims in the same or in different categories, or a plurality of alternative <b>embodiments inventions</b> defined within a single independent claim (see also F-IV, 3.7).   |  |
| F | V | 2       | <p>6<sup>th</sup> paragraph<br/>Correction:</p> <p>The term ‘corresponding’ means that the special technical features achieve the same technical effect or solve the same technical problem. Correspondence may be found for example in alternative solutions, or interrelated features e.g. the interaction between a plug and a socket causing a releasable electrical connection, or in a causal relationship, such as a step in a manufacturing process that causes a certain structural feature in a product. For example, an application might include two <b>sets</b> of claims, one comprising a metal spring, and another comprising a block of rubber. The metal spring and block of rubber may be considered to be corresponding technical features as they both achieve the same technical effect of resilience.</p> | This has already been fixed in the published version of the GL2018.                        |
| F | V | 2.1     | <p>4<sup>th</sup> paragraph</p> <p><b>F-V, 2.1.2</b> – please check this reference does not exist).</p>  | This has already been fixed in the published version of the GL2018.                        |
| F | V | 2.2.2.3 | <b>G-II, 4.2</b> – please check maybe better G-VI, 7.1?.   | The Office will correct the reference to G-VI, 7.1.  |
| F | V | 2.3     | The relevance of paragraph 7.2 in the Reasons of T1073/98 is not clear.  | The Office agreed to remove the mention of the T-decision. It has already become practice. |
| F | V | 3       | Note that in the new structure <b>there is no F-V 3</b> . The paragraph numbering jumps from § 2.3 to § 4.   | This has already been fixed in the published version of the GL2018.                        |

|              |                |                  |   |   |
|--------------|----------------|------------------|---|---|
| F            | V              | 4.1              | <p>5<sup>th</sup> paragraph:</p> <p>The paragraph “Features that are part of the common knowledge ... feature per se”.</p> <p>“Features..” should be “A feature”.</p>                                   | Not agreed. The expression is correct: a special technical feature can be constituted by a collection of several technical features. This has been defined by the Boards of Appeal.   |
| F            | V              | 4.2              | The relevance of T 2/83 with the issue of a posteriori non-unity is not clear.  | The Office agreed to remove the reference to the T-decision.  |
| F            | V              | 6.1              | <p>2<sup>nd</sup> paragraph: too strong statement. What if the non-unity objection is withdrawn?</p> <p>Suggested amendment:</p> <p>“A reply ... will <u>normally</u> not be taken into account...”</p> | <p>The Office explained that this EPO practice is not open for discussion (cf. Rule 64(2) EPC). The search division cannot withdraw a non-unity. Either the applicant pays the additional fees or the inventions are not searched. The findings of non-unity can be questioned only in examination (Rule 64(2) EPC).</p> <p>Either the further search fee is paid and reimbursement is asked, or the fee is not paid and the examining division is asked to order a further search. In the second case however if the examining division does not accede to the request, the non-searched subject-matter can be only prosecuted in a divisional.</p> <p>If the additional search fee(s) is (are) not paid, the search will be automatically based on the first invention.</p> |
| <del>F</del> | <del>IX</del>  | <del>2.3.9</del> | <del>Here "Provisions" has <b>not</b> been replaced by "Instructions". What is the reason for this? See comment to E-IX, 2.2</del>  | Relates to E-IX, 2.3.9  |
| <del>F</del> | <del>XII</del> | <del>8</del>     | <del>A reference to Rules 12a-12d EPC would be suitable here.</del>   | Relates to E-XII, 8   |

| Part | Chapter | Section | Comments/ suggestion  | Consultation results  |
|------|---------|---------|---|---|
| G    | General |         | The significant rewrite is of some concern as this would appear to be jurisprudence that the Guidelines appears to have adopted and present as their own synthesis of T decisions even though the principles seem to be significant enough that the Enlarged Board could perhaps be involved. Again it is not the place of this discussion to go into a detailed review as the changes are effectively made, but I look forward to being involved in future discussions to understand how significant changes like this are worked through and presented. A point worth raising, for example in relation to the discussion on machine learning/AI type inventions is that according to least some commentators there is a significant divergence in the treatment of, for example, cryptography-related inventions and machine in learning in relation to the above treatment as patentable subject matter. | See minutes of the meeting, point 5.  |
| G    | II      | 3.3     | <p>9<sup>th</sup> paragraph<br/>Suggested change:<br/>"A <b>generic</b> purpose <u>expressed by using meta-language</u> such as "controlling a technical system" is not sufficient to confer technical character to the mathematical method. The technical purpose must be a <u>more</u> <b>specific</b> one."<br/>***</p> <p>Last paragraph<br/>In section 3.3 last paragraph, we ask for a change of language:<br/>If the mathematical method does not serve a technical purpose and the claimed technical implementation does not go beyond a generic technical implementation</p>   | <p>This issue was already discussed with some epi members on 30.10.2018.</p> <p>Not agreed. The Office explained that the term "meta language" was used previously in the GL, but often lead to questions and was found unclear. The proposal, particularly the term "meta-language", is considered to make the sentence more complex.</p> <p>Not agreed. The addition of "more" is also not favored, since the message is that there should be a "<u>specific</u> technical purpose" (not <u>relatively</u> specific). (Emphasis added).</p> |

|   |    |       |   |  |
|---|----|-------|---|--|
|   |    |       | <p><u>expressed by using meta-language such as “controlling a technical system”</u>, the mathematical method does not contribute to the technical character of the invention. <del>In such a case, it is not sufficient that the mathematical method is algorithmically more efficient than prior art mathematical methods</del></p> <p>Such technical purpose/implementation defined by meta-language is insufficient, however, anything beyond that we believe must be assessed with very much care and thus should not be “killed” at first sights the section would promote. We note that care must be taken to find a right balance on the level of specificity, which should also be expressed.</p>   | Not agreed. However, the Office agrees to complement the paragraph to make it more clear.      |
| G | II | 3.3.1 | <p>It is proposed to reword the first <b>two</b> paragraphs as follows:</p> <p>Artificial intelligence and machine learning are based on computational models and algorithms for classification, clustering, regression and dimensionality reduction, such as neural networks, genetic algorithms, support vector machines, k-means, kernel regression and discriminant analysis. The guidance provided in G-II, 3.3 generally applies also to such computational models and algorithms. Artificial intelligence and machine learning find applications in various fields of technology ... because the term "AI" may encompass technical and non-technical meanings and therefore this should be assessed on a case-by-case basis.</p> <p>We think this is a very important point. One main problem we have is that the suggested amendment effectively rules out the use of what has been established standard language. We don't want to get to the same point where</p> | <p>This was discussed on 30.10.2018.</p> <p>Agreed to consider rewording of the paragraph.</p> |



|   |    |       |  |   |
|---|----|-------|--|---|
|   |    |       | we are with CII regarding clear/unclear language. If there is a risk of non-technical interpretations, clarification in the specification as to the defined meaning should be observed.  |   |
| G | II | 3.3.2 | <p>8<sup>th</sup> paragraph</p> <p><i>“In contrast, where the computer-aided determination of the technical parameters depends on decisions to be taken by a human user and the technical considerations for taking such decisions are not specified in the claim, a technical effect of improved design cannot be acknowledged since such an effect would not be causally linked to the claim features (T 835/10).”</i></p> <p><b>Question –</b><br/>Is there a better decision to support the general comment? T835/10 makes an uncontentious conclusion “<i>De-automation is not per se inventive</i>” and is limited to the specific circumstances in which its claimed partially-automated solution was being compared with a “maximally automated” prior art solution. The case does not appear to support the more general comment in the proposed guideline. If there is no better decision, the paragraph should be deleted or revised.</p> | <p>The Office argued that the paragraph was covered by T 835/10, points 5.1.6 and 5.1.9 of the reasons.</p> <p>The users brought forward that the examples do not seem to be appropriate. The Office agreed to check the section in respect of the contributions concerning the technicality.</p> |
| G | II | 3.5.1 | <p>4<sup>th</sup> paragraph</p> <p>Concerning speed and efficiency, it is suggested that in the inventive step section be added that once a method is technical then improving efficiency is a technical problem. This is suggested in section 3.5.2 when speaking of "improving the efficiency of an implementation". We believe</p>  | <p>It seems that the comment is addressed to G-II, 3.3 (see above). The Office will therefore add a reference to G-II, 3.3. The Office stressed that the paragraph deals with the technicality but will re-check the text.</p>  |

|   |    |       |  |  |
|---|----|-------|--|--|
|   |    |       | this is a very important point given the fact that many times the Examiners confuse efficiency in discussion of technical subject matter and inventive step.   |  |
| G | II | 3.5.3 | <p>Examples where assessment of a claim having an administrative or organizational nature is improper and vice versa is asked, to avoid misuse of the terms when assessing technicality of software. It appears unclear if “organisational nature” is meant to be understood as “business organisational nature” (or which else). The terminology should be clarified.</p> <p>Again, we believe that too destructive language in the Guidelines may prompt too restrictive handling of these applications and would like to avoid this in the interest of allowing Examiner’s to make case-by-case decisions within certain limitations rather than just demoting any development in this area.</p> <p>10<sup>th</sup> paragraph:<br/>As a further example, in a method for carrying out electronic financial transactions with credit cards at a point of sale, not requiring the transmission of the name or address of the buyer to authorise the transaction may result in saving time and reducing data traffic. However, this is not a technical solution to the technical problem of the bandwidth bottleneck of communication lines and the limited capacity of server computers, but an administrative measure which does not contribute to the technical character of the claimed subject-matter. It is suggested to remove this example, since it is not unequivocal. <b>In fact, not requiring the transmission of an information may be the result of a technical concept and not the result of a circumvention.</b> It can, but it need not. Eliminating a</p> | <p>Not agreed. The paragraph is clear if read in the context of the entire section. However, the Office will monitor any user comments and reconsider its position if deemed necessary.</p> <p>Agreed to reconsider the wording.</p> |

|   |    |     |   |  |
|---|----|-----|---|--|
|   |    |     | <p>step which is technically redundant may well be of a technical nature, if it does not change the business rules alone.</p> <p>Last paragraph:<br/>The prioritization of the sensor data over the data provided by the patient is an administrative rule. Establishing it lies within the competence of an administrator, e.g. the head of the clinic, rather than within that of an engineer.<br/>Comment: The prioritization is set by the medically trained person dependent on the question which data allow for a reliable treatment under certain circumstances. Why should an administrator care about this? So it is more a question: Is it possible to determine the clinical state of a patient with sufficient reliability.<br/>It would be highly appreciated if examples of further technical effects are listed out (similarly to the list of examples with mathematical methods contributing to the technical character). This would render the specific section in the guidelines a lot better and give much better overall understanding. Alternatively delete the sentence.</p> | <p>The Office explained that the administrative rule is derived from the case law and is, therefore, in favour to keep it.</p> <p>In view of the users' comments the Office agreed to review the examples.</p> |
| G | II | 3.6 | <p>Paragraph before "<i>computer implemented inventions</i>"<br/>If a claim is directed to a computer program which does not have a technical character, it is objected to under Art. 52(2)(c) and (3). If it passes the test for having technical character, the examiner then proceeds to the questions of novelty and inventive step (see G-VI and G-VII, in particular G-VII, 5.4).</p>   | Agreed   |
| G | II | 3.6 | <p>5<sup>th</sup> Paragraph, last sentence<br/>"<i>Likewise, comparing a computer program with how a human being would perform the same task is not a suitable basis for assessing if the computer program</i>"</p>   | Agreed.  |

|   |    |         |   |  |
|---|----|---------|---|--|
|   |    |         | <p><i>has a technical character (T1358/09)."</i></p> <p>This is not incorrect, but we <b>suggest</b> expanding the sentence as follows:</p> <p><i>"Likewise, comparing a computer program with how a human being would perform the same task is not a suitable basis for assessing if the computer program has a technical character <u>(although where the design of a computer program is motivated by technical considerations of the internal functioning of the computer, it may provide a technical contribution to the invention)</u>" (T1358/09)."</i></p> <p><b>Reasons:</b></p> <p>There is heavy reliance on decision T1358/09 (it is mentioned several times and there are fewer references now to T258/03), yet there are other computer program cases in which the difference between automated steps and manual steps may help to show inventive step. This is acknowledged in 3.3, but section 3.6 is a separate heading.</p> |  |
| G | II | 3.6.3   | <p>2<sup>nd</sup> paragraph</p> <p>Concerning definition and value of cognitive data, there should be a reference to the exception of "visual indicators about the state of a device".</p> <p>State of a device can be technical.</p>   | Not agreed. The comment relates to the technicality in the context of presenting the cognitive information to the user. This section is not about presentation of information. |
| G | II | 4.1.2   | <p>Special attention <del>should</del> <b>must</b> be paid to applications in which the invention has both an offensive and a non-offensive use, e.g. a process for breaking open locked safes, the use by a burglar being offensive but the use by a locksmith in the case of emergency <b>is</b> non-offensive.</p>   | Agreed.  |
| G | II | 4.2.1.1 | <p>This comments is from last year and the EPO agreed to reword but has not done so:</p> <p><b>If a surgical method claim is objectionable under Art. 53(c), this also</b></p>  | The Office apologized for having omitted the revision in the GL2018 edition. The passage will be rephrased in the GL2019 edition.  |

|   |     |         |  |  |
|---|-----|---------|--|--|
|   |     |         | <p>applies to a corresponding claim directed to a computer-implemented surgical method. In other words, surgical methods for which European patents cannot be granted according to Art. 53(c) do not avoid exclusion merely through computer implementation.</p> <p><b>[If “computer-assisted” is meant, OK. But “computer-implemented” might cover mere simulation or training devices/methods which are not excluded.]</b></p>   |  |
| G | II  | 4.2.1.1 | <p>Headline</p> <p>Please add some BoA decisions to be included in this chapter in the next revision. The chapter as it stands has NO effect at all to harmonize the practice of the 1<sup>st</sup> instance bodies.</p> <p>2<sup>nd</sup> paragraph</p> <p>The aim of Art. 53(c) is to guarantee that medical and veterinary practitioners <del>should be</del> are free to use their skills and knowledge of the best available treatments to achieve the utmost benefit for their patients uninhibited by any worry that some treatment might be covered by a patent (see G 1/07, Reasons 3.3.6).</p> <p>There is NO reason to deviate from the “should be”, which is literally recited from G1/07, r. 3.3.6.</p> | <p>The Office agreed to add some BoA decisions based on this year’s BoA decision selection if deemed indispensable.</p> <p>The Office will furthermore try to find a suitable example for “surgery”.</p> <p>The correction of “should be” to “are” will be re-checked.</p> |
| G | III | 4       | <p>Last sentence</p> <p>Alternatively, when a nucleotide sequence is not used to produce a protein or a part of a protein, the function to be indicated could e.g. be that the sequence exhibits a certain transcription promoter activity.</p>  | <p>It was noted that the comment probably relates to the previous “a” (“a part of a protein”).</p> <p>Not agreed. The proposal does not change anything in the meaning.</p>  |
| G | IV  | 3       | <p>Last paragraph</p> <p>(see H-IV, 2.3.3). please check maybe H-IV, 2.2.3</p>   | <p>The Office will check and correct the references if required.</p>   |

|   |    |       |  |   |
|---|----|-------|--|---|
| G | IV | 5.4   | <p>In relation to double patenting, the following sentence has been added:</p> <p><i>"The prohibition of double patenting applies to three types of combinations of European applications by the same applicant: two applications filed on the same day, parent and divisional applications, or an application and its priority application."</i></p> <p>What is the basis for this?</p> | <p>The Office explained the following:</p> <p>This passage is just a clarification of the different situations where the prohibition on double patenting applies.</p> <p>The <i>epi</i> objection relates to the application of the prohibition on double patenting in the case of an EP application and its priority application.</p> <p>T 1423/07 saw, in case of an application conflicting with its priority application, a legitimate interest in the grant of a second patent for the same invention, since its grant results in an extension of patent protection. Decision T 1423/07 does not inscribe itself in established case law but stands rather isolated in its approach.</p> <p>Reference was made to decision T 2461/10, which was erroneously mentioned as T 2402/10. Decision T 2461/10 clarifies the prohibition on double patenting under the EPC. It shows that T 1423/07 does not take into account the Travaux Préparatoires. Namely, the case of double patenting caused by internal priority was explicitly discussed during the preparatory meetings to the EPC 1973 (see the Minutes of the 10th meeting of Working Party I, held in Luxembourg from 22 to 26 November 1971, BR/144/71, points 117-118). The Office stated that this decision is an important decision since it summarises all issues related to double-patenting.</p> |
| G | IV | 7.2.2 | <p>1<sup>st</sup> paragraph, penultimate sentence</p> <p>A parent company – subsidiary relationship, a relationship of good faith and trust, a joint venture, the delivery of test specimens. The following may be indicators of the absence</p>   | <p>Not agreed. It is not required to amend the paragraph for the following reasons:</p> <p>The next sentence indicates that an ordinary commercial</p>  |

|   |    |       |   |   |
|---|----|-------|---|---|
|   |    |       | <p>of such an agreement:</p> <p>Trust in what? That the invoice gets paid? We would like this to be deleted. "Good faith and trust" can be argued in by far the most business transactions, and is no good indicator for a tacit secrecy agreement.</p> | <p>transaction may be indicator of the absence of a tacit secrecy agreement.</p> <p>Hence, a relationship of faith and trust must be more than just the trust that the invoice gets paid.</p> <p>In T 799/91, for instance, the board considered that the prior use was not public, taking into account the relationship of trust between the opponent and the third company (that was a sub-contractor of the opponent).</p>   |
| G | IV | 7.2.2 | <p>"As a rule, the general standard "balance of probabilities" applies "This appears confusing to me ; and perhaps contrary to the case law? I thought it was always "up to the hilt" for proving prior use?</p>  | <p>Not agreed – the sentence is correct. The Office clarified the following:</p> <p>The standard of balance of probabilities is applicable when both the patent proprietor and the opponent had access to the material of which public prior use is alleged (see e.g. T 363/96, T 12/00, T 1105/00, T 2043/07, T 1464/05, point 4.3 of the Reasons; T 202/13, point 15.6.2 of the Reasons; T 1170/13, point 2.3 of the Reasons).</p> <p>By contrast, in cases where all evidence in support of an alleged public prior use lies within the power and knowledge of the opponent, while the patentee has barely any or no access to it at all, it is incumbent upon the opponent to prove the alleged prior use up to the hilt (T 472/92, OJ 1998, 161; cf. T 782/92 referring to proof "beyond any reasonable doubt").</p> <p>(See Case Law book, 2016, III.G.4, 4.3.2 Public prior use)</p> |
| G | IV | 7.6   | <p>Last sentence</p> <p>(see also F-III, 7, F-IV, 4.8, and H-IV, 2.2.9). [ please</p>   | <p>This has already been corrected in the published version of the GL2018.</p>  |

|   |     |     |  |  |
|---|-----|-----|--|--|
|   |     |     | <b>check maybe H-IV, 2.2.8?]</b>   |  |
| G | IV  | 9   | <p>in case (ii), the disclosure of the passage containing the error is not taken into account;</p> <p>We do not necessarily agree. E.g., if there are two possible (or a limited number of possible) corrections, why shouldn't they both be taken into account? What if both possible corrections would result in that the document will be novelty destroying?</p> <p>We are not discussing the R. 139 standard here.</p>  | <p>The Office intends to maintain the approach indicated in case (ii) for the following reasons:</p> <p>The same concept of disclosure applies to novelty, priority and assessment of compliance with Art. 123(2) EPC. Therefore, if there is more than one possible correction, the EPO does not consider the two (or limited number of possible) corrections as disclosed in the prior art document.</p> <p>The Office may consider reformulating the passage for clarification.</p> |
| G | VI  | 7   | G-II, 4.2. <b>[please check maybe G-II 7.1]</b>  | The reference seems to be correct.   |
| G | VI  | 7.1 | <p>5<sup>th</sup> paragraph</p> <p>(see F-V, 7). <b>[ please check maybe F-V 2.2.2.3]</b></p> <p>Last paragraph (ii)</p> <p>(T 1673/11, see also H-IV, 3.5). <b>[ please check maybe H-IV, 3.4]</b></p>  | The Office will check and correct the references if required.  |
| G | VII | 1   | (see G-IV, 5 <b>[please check maybe rather G-V ?])</b>   | The Office will check and correct the references if required.  |
| G | VII | 2   | <p>It is to be understood as concerning such kind of information as is relevant to some field of technology (see T 172/03).</p> <p>This is taken from a hn of T172/03, but this decision is heavily criticized, not only but in particular in T2101/12. We suggest to skip reference to this isolated decision; see <a href="https://www.patentlitigation.ch/state-of-the-art-which-art-has-to-be-considered/">https://www.patentlitigation.ch/state-of-the-art-which-art-has-to-be-considered/</a> for detailed discussion.</p> | Not agreed. The reference to T 172/03 will be maintained. It is also cited in other chapters of the GL.  |
| G | VII | 5.1 | "In particular in opposition proceedings the structure of the problem-solution approach is not that of a forum where the opponent can freely develop as many inventive step  | Not agreed. This passage of T 320/15 will be maintained  |



|   |     |     |   |                                   |
|---|-----|-----|---|-----------------------------------|
|   |     |     | attacks as he wishes in the hope that one of said attack has the chance of succeeding (T 320/15, Reasons 1.1.2).”<br>This would, in my opinion, violate the Opponent’s right to be heard.   |                                   |
| G | VII | 5.3 | <b>2<sup>nd</sup> paragraph</b><br><br>A “hope” to success is not sufficient to remove inventive step – see the paper:<br><br><a href="https://www.deepdyve.com/lp/ou-press/a-hope-to-succeed-are-the-epo-guidelines-misleading-i3gHcwASz7?key=OUP">https://www.deepdyve.com/lp/ou-press/a-hope-to-succeed-are-the-epo-guidelines-misleading-i3gHcwASz7?key=OUP</a> | Agreed to rephrase the paragraph. |

| Part | Chapter | Section | Comments/ suggestion  | Consultation results   |
|------|---------|---------|---|--|
| H    | II      | 2.2     | “IPER” should be replaced with “IPRP” to update to currently used terminology in PCT<br>This should be done everywhere  | See also consultation results regarding the comments to the PCT-EPO Guidelines, H-II, 2.2.2.2<br><br>The Office clarified that the term “IPER” is correct. The end product of the PCT procedure is the IPRP Chapter I or Chapter II. The term “IPRP Chapter II” is no more than a different name for the IPER. Using the term “IPRP” without further indications instead of “IPER” would not be correct. |
| H    | II      | 2.3.1.1 | Unless the applicant is able to demonstrate to the satisfaction of the examining division that the application contains enough information to enable the person skilled in the art to carry out the invention, the examining division will <del>normally</del> not admit any (further) amendment under Rule 137(3), because, normally, information has to be added in | The Office agreed to change the order of the sentence: first, “the examining division will not admit...”, and then, “unless the applicant is able to demonstrate...”.<br><br>“Normally” will however not be reinstated in the previous   |

|   |    |     |   |   |
|---|----|-----|---|---|
|   |    |     | <p>order to overcome <del>the only way</del> the objection under Article 83 EPC.</p> <p>Keep the “normally” here.</p>   | position.   |
| H | II | 2.7 | <p>1st paragraph , second sentence:</p> <p>Another exception is a request filed in response to a change of the subject of the proceedings, e.g. when a further relevant document is cited for the first time during the oral proceedings,. In such a case the request has to be admitted under Rule 116(2) (T 951/97).</p> <p>We suggest to amend to the following:</p> <p>An exception is a request filed in response to a change of the subject of the proceedings, e.g. when a further relevant document is cited for the first time during the oral proceedings,. In such a case the request has to be admitted under Rule 116(1), 4th sentence (T 951/97).</p> | <p>Not agreed. The Office stressed that the paragraph must be read in its context and clarified the following:</p> <p>A first exception is where the summons was issued as a first action. Therefore the reference to “another” is justified in this case.</p> <p>The Office also disagreed to the reference to Rule 116(1), 4<sup>th</sup> sentence since this part of Rule 116(1) deals with new facts and evidence whereas H-II, 2.7 deals with new requests filed by the applicant. The reference to Rule 116, paragraph 2 is the appropriate one, as it relates to the filing of amendments by the applicant. In addition, this paragraph expressly refers to the last (fourth) sentence of paragraph 1, which acknowledges the admissibility of late filed submissions if the subject of the proceedings changes (as here). The cited decision refers to Rule 71a(2) EPC1973 (equivalent to Rule 116(2) EPC2000) in that respect.</p> |
| H | II | 2.7 | <p>2<sup>nd</sup> paragraph</p> <p>The examining division <b>should</b> first consider the requests before deciding on their admissibility. The mere fact that they are filed late is not <i>per se</i> a reason for not admitting them. This issue will normally be dealt with during oral proceedings.</p>  | Agreed.   |

|   |    |       |  |   |
|---|----|-------|--|---|
|   |    |       | Maybe better: “will” instead of “should”?  |   |
| H | II | 2.7   | <p>Comment from last year</p> <p>[repeated partially in amended form]</p> <p>In the third paragraph, “<i>good reasons</i>” should be amended to read “<i>acceptable reasons</i>” or any other wording reflecting that the reasons have to be accepted as “<i>good</i>” by the Examining Division.</p> <p><b>Why was our request not accepted?</b></p>  | <p>Not agreed. The expression “good reasons” is consistently used in the case law in connection with amendments occasioned by developments during the proceedings. It should therefore remain not to give the impression that different standards coexist.</p> <p>The Office agreed to consider removing the two T-decisions cited in that paragraph.</p> |
| H | II | 2.7.1 | <p>Second paragraph</p> <p>We acknowledged that the EPO made an amendment, but it is further restricted than the earlier text.</p> <p>These late-filed <del>Late-filed</del> claims will only be admitted into the proceedings if they are clearly allowable. This means that it must be immediately apparent to the examining division that the amendments successfully <del>overcome the objections</del> <del>address the issues raised</del> without giving rise to new ones (<i>prima facie</i> assessment).</p> <p>We submit that the proposed amendment goes in the wrong direction and we suggest to amend to:</p> <p>These late-filed <del>Late-filed</del> claims will only be admitted into the proceedings if they are clearly allowable. This means that it must be immediately apparent to the examining division that the amendments <del>successfully</del> <i>prima facie</i> address the issues raised without giving rise to new ones</p> | <p>The Office noted that this is a recurrent issue, which is discussed every year.</p> <p>The proposal seems not acceptable because it lowers too much the standard to be applied. However, the Office commits to look into the matter.</p>   |

|  |  |  |   |  |
|--|--|--|---|--|
|  |  |  | <p>(prima facie assessment).</p> <p>We disagree that the test is one of "<i>overcoming the objections</i>" nor even "<i>successfully address the issues raised</i>". The threshold for allowability should be no higher than: "address the issues raised without without giving rise to new ones."</p> <p>The reason is because Decision T1273/04 ruled:</p> <p>"It would <b>not be appropriate</b> to require that an amended claim should be <b>clearly allowable</b> in the sense of clearly involving an inventive step."</p> <p>(In that case, examination of inventive step had not begun.)<br/>The Board said (in T1273/04) that it had developed a practice whereby claims which are clearly not allowable will not normally be admitted. More difficult is the higher threshold of amendments that pass the hurdle of "clearly not allowable" and are nevertheless not clearly allowable. The Board set a three-part test:</p> <ul style="list-style-type: none"> <li>i) the amendments should be clearly permissible under provisions of the EPC explicitly or implicitly governing amendment of the application (Article 123(2), Article 84 EPC, Rule 86(4) EPC, Rule 88 EPC),</li> <li>(ii) the newly defined subject-matter should represent a convergent development of the subject-matter which has been the subject of the examination and appeal procedure to date and</li> <li>(iii) the subject-matter of the thus amended claims</li> </ul> |  |
|--|--|--|---|--|

|   |    |     |  |  |
|---|----|-----|--|--|
|   |    |     | <p>should be clearly new.</p> <p>The Guidelines should not set a standard higher for the Examining Divisions than that set by the Boards of Appeal. To do so would deny due process and lead to more appeals.</p> <p>It should be sufficient that, <i>prima facie</i>, the amendments address the issues raised. Provided that no new issues are raised, the amendment should be admitted and the Applicant should be given the opportunity to present oral argument as to how the amendments purport to overcome the objections.</p> <p>If, then, the Applicant is unsuccessful, the state of the file has progressed and the issues to be considered in the event of appeal are reduced.</p> <p>3<sup>rd</sup> paragraph:</p> <p>Last year we suggested the amendment:</p> <p><i>For example, late-filed requests will not be admitted if they <del>do not</del> clearly <u>do not</u> meet the requirements under Art. 123(2) or Art. 84 ...</i></p> <p>We wish to repeat that we maintain our opinion and ask the EPO to once more consider our suggested amendment in 3<sup>rd</sup> paragraph:</p> |  |
| H | II | 6.2 | From last year   | The Office apologized for having omitted the revision in the |

|   |     |     |  |  |
|---|-----|-----|--|--|
|   |     |     | <p>Penultimate paragraph, 2<sup>nd</sup> sentence:<br/> “so the examining division...” should be “therefore in this case the examining division...”</p> <p><b>No amendment was introduced, why?</b></p>  | GL2018 edition. The passage will be rephrased as agreed.   |
| H | II  | 7.1 | <p>From last year</p> <p>[2<sup>nd</sup> repeated]</p> <p>The exception mentioned in paragraph 3 of H-II, 5 should be copied here:</p> <p><i>, unless the applicant can convincingly argue that the invitation sent under Rule 62a(1) and/or Rule 63(1) was not justified.</i></p> <p><b>Agreed reference not introduced, why?</b></p>                               | The Office apologized for having omitted the revision in the GL2018 edition. The reference to H-II, 5 will be introduced as agreed.  |
| H | III | 2.1 | <p><del>. These arguments will be taken into account by the division for the assessment of Art. 123(2).</del> These arguments <del>They</del> are particularly important for the outcome of the division’s assessment of Art. 123(2) where literal support for the amendment(s) is not present in the application as filed.</p> <p>Maintain the marked sentence.</p> | Not agreed. The Office stated that the proposal would not change the meaning of the sentence, particularly if read in the context of the whole paragraph.  |
| H | III | 2.2 | <p>From last year</p> <p><i>This will normally be done by submitting missing documents or by filing replacement pages.</i></p> <p>DG1 has repeatedly mentioned that it would be possible (if not encouraged) to file replacement paragraphs instead of</p>   | The Office clarified that referring to paragraphs is feasible during opposition proceedings, but not during examination proceedings due to technical reasons. The Office will reflect this difference in the Guidelines. |

|   |     |     |  |  |
|---|-----|-----|--|--|
|   |     |     | <p>replacement pages when the original document comprises numbered paragraphs. This possibility should be added.</p> <p>Or is this no longer an option?</p> <p><b>Has there been any development on this issue?</b></p>  |  |
| H | III | 4.2 | <p>Francis Leyder has already sent this comment. What is the EPO solution to this?</p> <p>In H-III, 4.2, it is proposed to move the last two lines into part (i). Moving the sentence is fine, but the sentence is not in my opinion.</p> <p>On 13.12.2007, the EPC2000 entered into force, and the Transitional Provisions have to be taken into account. Article 1 TP states that Article 54(3) "shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time."</p> <p>To me, this is clear and means that Article 54(3) EPC1973 has been replaced by Article 54(3) EPC.</p> <p>Article 1 TP further states that "Article 54(4) of the version of the Convention in force before that time shall continue to apply to these applications and patents."</p> <p>Thus, Article 54(4) EPC1973 still exists.</p> <p>Thus, I would think that the error is the reference to Article 54(3) EPC1973, and that it could easily be corrected without affecting the layout by deleting "EPC1973".</p> <p>However, such easy correction would not make the situation clear, as shown by the most ambiguous title of H-III, 4.2 "... according to Art. 54(3) and Art 54(4) EPC1973".</p> <p>The least that should be done would be e.g. to write in both cases "... according to Art. 54(3) EPC and Art 54(4) EPC1973".</p> <p>This would deal with the error and clarify the title without</p> | <p>The Office agreed to include the reference to Article 54(3) EPC2000.</p> <p>The reference to Rule 80 EPC1973 should, however, stay to clarify the reference to the EPC2000. The wording may be clarified.</p> |

|   |    |       |   |   |
|---|----|-------|---|---|
|   |    |       | <p>affecting the "layout".<br/> It would then be nice to clarify the moved sentence.<br/> I do not know what means "Rule 80 applies to amendments ..." because to me Rule 80 applies to any amendment.<br/> What I understand is that "In opposition proceedings, the existence of relevant state of the art according to Art. 54(3) EPC and 54(4) EPC1973 is one of the grounds referred to in Rule 80".</p>   |   |
| H | IV | 2.2   | Suggest to add a reference to T2255/12  | Not agreed. The Office explained that the T 2255/12 decision merely follows (and cites) two decisions already cited in this section, namely T 99/13 and T 667/08. It does not add any further significant findings. |
| H | IV | 2.2.6 | <p>The deleted paragraph</p> <p>If EPO thinks, it can not happen, then it is OK</p>   | The Office stated that the situation cannot happen anymore. Therefore, the deletion is to be maintained.  |
| H | V  | 3.1   | <p>The text for removing/replacing of features from a claims has been updated:</p> <p><b>3.1 Replacement or removal of features from a claim</b></p> <p><i>The requirements of Art. 123(2) are only met if the replacement or removal of a feature lies within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing (or the date of priority according to Art. 89) from the whole of the application documents (G 3/89, G 11/91 and G 2/10).</i></p> <p><i>If the amendment by <del>The</del> replacement or removal of a feature from a claim fails to pass the following test by at least one criterion, it necessarily contravenes the requirements of <del>does not violate</del> Art. 123(2) <del>if the skilled</del></i></p> | It was agreed to delete the expression "directly and unambiguously", highlighted in yellow.   |



|   |   |     |   |  |
|---|---|-----|---|--|
|   |   |     | <p><del>person would directly and unambiguously recognise that:</del></p> <ul style="list-style-type: none"> <li>(i) the <i>replaced or removed</i> feature was not explained as essential in the <i>originally filed disclosure</i>;</li> <li>(ii) the <i>skilled person would directly and unambiguously recognise that the</i> feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve (<i>in this context special care needs to be taken in cases where the technical problem is reformulated during the proceedings, see H-V, 2.4 and G-VII, 11</i>); and</li> <li>(iii) the <i>skilled person would</i> <b>directly and unambiguously</b> recognise that the replacement or removal requires no <del>real</del> modification of one or more <del>other</del> features to compensate for the change (<i>it does not in itself alter the invention</i>).</li> </ul> <p><i>However, even if the above criteria are met, the division must still ensure that the amendment by the replacement or removal of a feature from a claim satisfies the requirements of Art. 123(2) as they also have been set out in G 3/89 and G 11/91, to which G 2/10 refers as “the gold standard”. <del>In case of a replacement by another feature, the replacing feature must of course find support in the original application documents, so as not to contravene Art. 123(2) (see T 331/87).</del>!</i></p> <p>What is the reason for this? Where is the basis for the yellow amendment?</p> |  |
| H | V | 3.1 | <p>From last year<br/>3<sup>rd</sup> paragraph, line 2 “apparatus” should be “invention”.<br/><b>Not clear why amendment was not introduced.</b></p>  | <p>The Office agreed to reword the paragraph, whereby “apparatus” will be replaced by “subject-matter”. This corresponds to the expression used in the keyword of the cited decision T 545/92.</p> |

|   |    |     |   |  |
|---|----|-----|---|--|
| H | V  | 4.1 | <p>2<sup>nd</sup> paragraph</p> <p><del>However,</del> These criteria notwithstanding the introduction of the undisclosed disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. The undisclosed disclaimer (which inevitably quantitatively reduces the original technical teaching) may not qualitatively change the original technical teaching in the sense that the applicant's or patent proprietor's position with regard to other requirements for patentability is improved. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. Hence, the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer.<br/>Ref. to G1/16 missing</p> | The Office agreed to add a reference to G 1/16 at the end of this paragraph.   |
| H | VI | 2.1 | <p>From last year</p> <p>Point (ii), 5<sup>th</sup> line “first” should be first or earlier:<br/><b>The addition of the “earlier” is not contrary to J6/91</b></p>  | <p>The Office clarified that the wording used is taken verbatim from J 6/91. Where a passage of a decision from the boards is transcribed, the wording should not be altered.</p> <p>The expression “the addition of a first priority” is clear enough; it clearly means “an earlier priority”. This may be included between brackets.</p> |
| H | VI | 3.5 | <p>Clerical error:<br/>Even during opposition proceedings, the examining division is competent for correcting errors in its decision to grant, in particular errors in the decision's reasoning, in bibliographic data or formatting/editing errors in the text of the B1 publication (see H-VI, 3.2, and H-VI, 4).</p>   | Agreed.  |