



Institut der beim Europäischen Patentamt zugelassenen Vertreter
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Ausschuss für Europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

18 October 2019

Report from the Guidelines sub-committee

Point 1

As mentioned in my last report, we received preliminary revision drafts of EPC Guidelines parts B, D, E and H and EPO-PCT Guidelines parts B, C and D for the 2019 versions of the guidelines.

On 29 April 2019, I send **epi** comments/suggestions to the EPO. Thanks to everyone who have contributed

On 20 May 2019, the EPO thanked for these comments/suggestions and informed that these comments/suggestions had led to some clarifications in the EPC Guidelines, Part E-IX, 2.1 to 2.3 as well as in H-VI, 2.1 to 6., and included an additional example in Part H-V, 3.3.

Other of the comments/suggestions were to be discussed at the 18th SACEPO WPG.

Point 2

On 1 August 2019 we received the full revised 2019 EPC GL and on 28 August 2019 we received the full revised 2019 EPC GL. These Guidelines have now been published on the EPO website:

A very good review of the major changes from the 2018 version to the 2019 version of the EPC GL can be found here:

<http://patentblog.kluweriplaw.com/2019/10/01/top-10-changes-to-the-2019-epo-guidelines-for-examination/>

Comments/suggestions to these 2019 revised guidelines were collected. Thanks to the many contributors.

On 17-18 September, we held a Guidelines sub-committee meeting in Munich. We went through all the comments/suggestions, including those from April 2019. Each comment/suggestion was discussed and refined and final comment/suggestion lists (enclosed as annex A and B) were formed.

These final comment/suggestion lists were send to the EPO on 30 September 2019.



Point 3

These comments/suggestions will be discussed on the 18th SACEPO WPG on 27 November 2019 in Munich.

Appendixes

A: Comments/suggestions to the EPC Guidelines

B: Comments/suggestions to the PCT-EPO Guidelines

EPC 2019 – 30 September 2019

Comments/suggestions to the EPC Guidelines incl. comments from April to parts B, D, E, H from the EPI**Comments from April 2019 are marked green**General comment: References to case law should include reference to specific reasons(s) whenever possible.

Part	Chap-ter	Section	Comments/ suggestion
General		3	<p><i>In case of diverging decisions of the Legal or Technical Boards of Appeal, EPO examiners and formalities officers will, as a rule, follow the common practice as described in the Guidelines, which applies until further notice. Furthermore, the Guidelines reflect only those decisions of the boards of appeal incorporated into the EPO's general practice due to their general procedural significance; they do not take into account any deviating decisions taken in the individual case, given that the binding effect referred to in Art. 111(2) applies to that specific case only.</i></p> <p>This provides clarity, but highlights an issue of importance. Namely, what happens to changes in practice during the year due to "deviating decisions"? Some get notified in procedural notices, but many are incorporated as a change in approach that only becomes evident at the next revision.</p> <p>When the Office changes practice this should be announced openly and promptly.</p>

Part	Chapter	Section	Comments/ suggestion
A	II	I	<p>This section including the sub-sections is now more clearly structured.</p> <p>A pity that again the EPO renumbers sections and subsection: this is causing a lot of extra work for people who write reference books.</p> <p>In the introductory text, a description of and reference to Rule 1 EPC would also be helpful. In particular, explaining what 'in legible form' in Rule 1 EPC means.</p>
A	II	1.1	<p>Here the EPO Filing Offices are mentioned - my advice is to add a reference to Art. 75(1) and Rule 35 EPC is in place.</p> <p>What is the status of the sentence:</p> <p style="text-align: center;"><i>"The automated mail box facility is currently not available at the filing offices at Munich's Isar building and The Hague. Outside office hours documents may be handed in to the porter"</i></p> <p>The closure of the mailbox in the Isar Building was ordered by the previous president EPO (afraid of bombs?). The mailbox is still in place on the wall of the building close to the Kohlstr.</p>
A	II	1.1	<p>last line: 'see A-II, 1.7' should be 'see A-II, 1.6'</p>
A	II	1.3	<p>What is the status of the wording "at present" in the sentence:</p> <p style="text-align: center;"><i>"The filing of European patent applications by other means such as email is at present not allowed (see also the Notice dated 12 September 2000, OJ EPO 2000, 458)."</i></p> <p>Can the wording "at present" not simply be deleted. Why generating the impression for 20 years that it may one day change?</p>

A	II	3.1	<p>New sentence at the end of the first paragraph:</p> <p>The EPO will in principle no longer issue an acknowledgement of receipt by fax (see the Decision of the President dated 20 February 2019, OJ EPO 2019, A18, and the Notice from the EPO dated 20 February 2019, OJ EPO 2019, A15).</p> <p>What if an acknowledgement is requested?</p>
A	II	4.1.2	<p>Suggest to add:</p> <p>(e) an E-mail address</p>
A	II	5.4.1	<p>We have mentioned this several times: the later insertion of a priority claim is contrary to Art.5(6)(b) Patent Law Treaty which states that the priority claim must have been made on the date of filing.</p> <p>Is it true that the EPO is working on amending Rule 56 EPC to this incorporate this requirement into Rule 56(3) EPC?</p>
A	II	5.4.3	<p>2§</p> <p>Suggest to delete “at all” in line 3.</p>
A	II	5.4.3	<p>Delete the list of applications to be included in the file by the EPO under Rule 53(2) EPC and refer to A-III 6.7 which specifically deals with this topic.</p>
A	III	3.2	<p><u>When evaluating the quality of the application documents and their suitability for electronic and direct reproduction, the Receiving Section's objective must be to ascertain the discernibility of all details originally disclosed in the documents received on the date of filing, either by way of improved scanning or, when unsuccessful, requesting the applicant to provide the document in a form that improves discernibility of the originally disclosed details upon reproduction (see J 4/09).</u></p>

			Additions meant to clarify what J 4/09 actually dealt with.
A	III	11.3.1	A-III, 11.3.1/11.3.2/11.3.4/11.3.7/11.3.8/11.3.9: why 'old version' in margin? Why is this still relevant? Which version is "old version"?
A	III	13.2	If the applicant explicitly states that application documents filed on entry into the European phase have merely been reformatted (so as to reduce the number of pages subject to payment of an additional fee) rather than substantively amended, the EPO disregards these reformatted application documents and does not accept them as the basis for calculation of the additional fee. What is the basis for this? Consider a situation where the applicant of a Euro-PCT application wants to reduce the spacing from 3 to 1.5, in full compliance with R 49(8). This should be possible / not incur page fees.
A	III	13.2	In particular those deficiencies relating to the minimum margins (Rule 46(1), Rule 49(5)), the start on a new sheet of each document making up the application (Rule 49(4)), line-spacing and character size (Rule 49(8)) as well as the scale of drawings (Rule 46(2)(c)) potentially have an impact on the number of pages. Where this is the case, any additional fee due for the higher number of pages may be paid within two months of the invitation pursuant to Rule 58 drawing the applicant's attention to this requirement. It might also happen that non-compliance with one of the above-mentioned Rules actually results in a <i>higher</i> number of pages. For instance, if the typing is not 1.5 spaced as required by R

			49(8), but rather 3 spaced. I wonder whether i) an invitation to correct is sent out in such cases, too; and ii) whether this triggers a refund of additional fees already paid for pages > 35?
A	VIII	1.5	<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 actionact on behalf of a party to proceedings, e.g. filing a reply to the communication under Rule 71(3), provided that it is apparent from the filehis submission that he is acting at the request of that party without the intention to take over representation.</p> <p>Why the example of R 71(3)? Would it be different if an office action under Art. 94 is answered on the merits by a professional representative, without taking over representation?</p>
A	IX	1	<p>When will colour drawings be allowed?</p> <p>When will colour drawing be visible in the register?</p>
A	X	4.2.4	<p>Once a debit order cannot be executed in full due to insufficient funds, no other debit order is booked until the account is duly replenished.</p> <p>What means "duly replenished"? Until the account is replenished to the extent where all pending debit orders can be executed, or just to the extent where the next pending debit order can be executed?</p>
A	X	4.4	Request from epi granted: for credit card payments: The EPO bears any transaction-related charges. We appreciate this change.
A	X	9.2.1	Following a recent case law (J 4/18) to this respect, the EPO has acknowledged that only one of the applicants must fulfil the requirements for fee reduction under the language arrangements:

			<p>If there are multiple applicants, each one must be an entity or a natural person within the meaning of Rule 6(4) for the fee reduction to apply; it is however sufficient for only one of them to be entitled to use an admissible non-EPO language (Art. 14(4), Rule 6(3)).</p> <p>Why did the EPO decide not to mention the case law J 4/18 ?</p>
A	X	9.2.1	<p>"If there are multiple applicants, each one must be an entity or a natural person within the meaning of Rule 6(4) for the fee reduction to apply; it is however sufficient for only one of them to be entitled to use an admissible non EPO language (Art. 14(4), Rule 6(3))"</p> <p>Suggested amendments:</p> <p>"If there are multiple applicants, each one must be an entity or a natural person within the meaning of Rule 6(4) for the fee reduction to apply; it is however sufficient for only one of them to be entitled to use an admissible non EPO language (Art. 14(4), Rule 6(3), <u>J 4/18</u>)"</p> <p>Comments:</p> <p>The legal basis for the additional sentence appears to be J 4/18. If so, reference to this decision should be included.</p>
A	X	10.3.1	<p>Refund instructions, i.e. to which deposit account refunds are to be made, are to be filed in an electronically processable format (XML), namely via OLF or CMS, using EPO Form 1001E, 1200E or 1038E, and <u>should be filed</u> as early as possible in the proceedings before the EPO.</p> <p>the "are to be filed" from the first part of the sentence cannot apply to the second part of the sentence here (see last para of this section where it is made clear that refund instructions need not be on file). The addition of "should be filed" clarifies this.</p>

A	X	10.3.1	<p>If no refund instructions are on file when a refund becomes due or if they are ambiguous, the EPO may decide whether it can make a refund to a deposit account held by the appointed professional representative or by the applicant (opponent/appellant).</p> <p>It is unusual that in case of ambiguity the EPO can just make a choice. The ambiguity should be resolved before the refund is made to any account.</p>
A	XI	4	2 nd paragraph. Which circumstances would be considered “exceptional” ?

Part	Chapter	Section	Comments/ suggestion
General part B			Throughout: corrections of typos and style. “should do X” replaced with “does X”
B	II	4.3.2	<p>According to the preamble, this is based on decision of the AC – which are published in the OJ. Reference to the OJ should be kept. This is different to case-law (for which I understand references will be more and more omitted).</p> <p>References to the OJ are selectively deleted. This should not be the case: the Guidelines should refer to the relevant Decisions, etc.</p>

			<p>This is caused, because the EPO made a mess of the decisions relating to reduction of search fees. There is no consolidated version of the applicable fee reductions.</p> <p>EPO has not maintained OJ references-why not?</p>
B	VI	6.2	<p>2nd paragraph, 3rd line: add “meaningful machine translation” or something similar</p> <p>EPO did not take this onboard- Why not?</p>
B	VII	1.1	<p>“When determining which invention is the invention or unitary group of inventions first mentioned in the claims, the search division takes account of the content of the dependent claims, disregarding trivial claims relating exclusively to features that seem unimportant in the light of the invention or that are generally known in the technical field of the invention (see B III, 3.8).”</p> <p>Why is the paragraph deleted? (B-III, 3.8: Search on dependent claims)</p> <p>The § remains deleted – why?</p>
B	VII	1.2.2	<p>Comment on § 3</p> <p>Cascading unity objections should be avoided, because it deprives the applicant of a search report on the claimed subject-matter and it goes against the general purpose mentioned in B-VII, 1, §2.</p> <p>For discussion</p>
B	VIII	3	<p>Revised §(1) first 3 lines.</p> <p>Even if a small part of the scope is speculative, a full search should be possible.</p>

			We suggest to go back to the old version.
B	VIII	3	<p>revised § (i)</p> <p>This proposition takes into account some of our previous comments that it should still be possible to perform a search on specific examples, even in cases where a claim is so broadly formulated that part of its scope is not supported by the disclosure.</p> <p>From the consultation results of 2018: <i>“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 are speculative and not supported (due to their broadness). Therefore, the proposal is taken on board.”</i></p> <p>Example (i) on “meaningful search” issue re-worded</p> <p>Suggest further amendment: “may mean a search directed to the supported part of the claim, which may be directed only to (one or more of) the specific examples disclosed in the description.”</p> <p>Reason: The supported part of the claim may be (often is) broader than the specific example(s).</p> <p>EPO did not take this onboard</p>
B	X	9.2.5	new § 2-3

			<p>A “T” document should not be sufficient as basis for an Art. 84 objection only because an explanation offered by the applicant proves to be wrong based on the T document, especially when the T document does not contradict the fact that the invention was really obtained.</p> <p>“Consequently the fact that it is published after the priority or filing date of the application being searched is of no relevance.”</p> <p>The wording of the last sentence, 2nd paragraph seems to describe that a “T” document is a document published after the priority date, which is not the case.</p> <p>EPO did not take this onboard</p>
B	X	9.3	<p>X-9.3:</p> <p>We fully agree with the change that “all claims” are mentioned in the search report at least once, not only the independent claims as in the GL2018. It would be useful to convey that indicating “claims 1-15” for “the whole document” is generally not what is intended by the GL.</p>
B	X	9.3	<p>Rewording suggestion for last paragraph</p> <p>Furthermore, in general, all each independent claim claims are should be mentioned in the search report at least once in relation to <u>specific part(s) of</u> at least one document published before the earliest priority date (unless the independent claim in question is excluded from the search by virtue of a restriction of the subject of the search mentioned in B-X, 8) (see B-IV, 2.5).</p>

Part	Chapter	Section	Comments/ suggestion
C	III	3.1	<p>Amendments introduced according to 2018 consultation results.</p> <p>Suggest to add the underlined expression</p> <p><u>“... objected to by the applicant in his/her response to communication pursuant to Rule 161(1) or 161(2) EPC ..”</u></p>

Part	Chapter	Section	Comments/ suggestion
D	II	4.3	<p>revised § 3-4</p> <p><i>“the copyright of the document in question is not owned by a party to the proceedings”</i></p> <p>How will the OD ascertain whether the copyright of the document at issue is owned by a party to the proceedings? Based on inventorship vs authorship? Based on © mentions on the publication? What about scientific publications? Their copyright is often assigned to the editor or the journal, not to the employer(s) of the author(s).</p> <p><i>“the document in question is relatively easily retrievable including against payment”</i></p> <p>What does “relatively easily retrievable” mean? To what standard does it correspond? The party requesting that the document be excluded from public file inspection should show how the document may be accessed.</p>

			<p>Should the other party(ies) be heard on the question not to make a document available via public file inspection?</p> <p>For discussion</p>
D	VI	1	<p>The new text puts emphasis on what is considered as late filed.</p> <p>The parties in inter partes cases are subject to a particular duty to facilitate due and swift conduct of the proceedings, in particular by submitting all relevant facts, evidence, arguments and requests as early and completely as possible. The evidence must be submitted as soon as possible (see D-IV, 1.2.2.1 and E-IV, 1.2). Furthermore any ground, fact and evidence filed by the opponents after the expiry of the opposition period are considered as late filed, unless they are due to a change of the subject of the proceedings; see E-VI, 2 and E-VI, 2.1 for more details. Admissibility of amendments by the proprietor is treated in detail in H-II, 3 to H-II, 3.5.</p> <p>This is already current practice and also anticipates the new Rules of Procedure of the Boards of Appeal (entry into force around January 2020).</p> <p>For discussion</p>
D	VI	1	<p>The parties in inter partes cases are subject to a particular duty to facilitate due and swift conduct of the proceedings, in particular by submitting all relevant facts, evidence, arguments and requests as early and completely as possible. The evidence must be submitted as soon as possible (see D-IV, 1.2.2.1 and E-IV, 1.2).</p>

			<p>This goes beyond the meaning of the next (now deleted) sentence. In particular, the explicit mentioning of arguments and requests might give rise to undue denial of submitting them late (mere arguments are OK anyway, at any times).</p> <p>EPO did not take this onboard</p>
D	VI	1	<p>Furthermore any ground, fact and evidence filed by the opponents after the expiry of the opposition period are considered as late filed, unless they are due to a change of the subject of the proceedings and/or in reply to the other party's submission;</p> <p>This addition would be appreciated as clarification.</p> <p>EPO did not take this onboard</p>

Part	Chapter	Section	Comments/ suggestion
E	III	8.6	<p>Examples of possible abuse of the proceedings would be:</p> <ul style="list-style-type: none"> - - The opponent files knowingly abstains from raising an assertion of public prior use, based on its own activities until late in the proceedings, even though the evidence in its support had become fully available earlier of the opponent himself, late in the absence of good reasons for the delay (see T 534/89). <p>Why is "good reasons" as an excuse for the delay deleted? Indeed, most companies (being the party to the proceedings) don't know what they know. There might e.g. be situations where a key person was just not available for health reasons, and this might formerly have been sufficient to excuse a delay. Is that an intended tightening of the procedure?</p>

			EPO did not take this onboard-why
E	III	11.2.1	<p>It is important that the starting time and the videoconference dial-up number are communicated to the applicant by the formalities officer, as at The date, time and the video-conference contact details to be used to establish the connection will be communicated by the formalities officer by means of a written communication, fax or email containing any further appropriate information. At the time so arranged, it is the applicant who has dials the number to establish the connection with the EPO; he is responsible, and bears the costs, for his own connection to the internet videoconference link (the applicant making the request bears the transmission costs).</p> <p>Email only possible? How will proper receipt be tracked?</p> <p>For discussion</p>
E	VIII	1.7	<p>VIII, 1.7</p> <p>a registered letter or equivalent</p> <ul style="list-style-type: none"> An equivalent to a registered letter is open to interpretation and could lead to a lack of legal certainty of whether a late-received document will be deemed to have been received in due time. <p>if posted outside Europe, by airmail.</p> <ul style="list-style-type: none"> The phrase “outside Europe” is not very clear on its own. <p>For discussion</p>
E	VIII	1.7	<p>This legal fiction applies to all time limits to be observed vis-à-vis the EPO and/or the national authorities, including the priority period laid down in Art. 87(1). Despite this legal fiction that the</p>

			<p>time limit has been observed, the filing date of the document remains the day on which it was actually received.</p> <p>Just to be clear on the consequences: This means that a European patent can run 20y 3m at max, when the late received document is the European patent application claiming priority of an earlier application(?).</p> <p>For discussion</p>
E	VIII	1.7	<ul style="list-style-type: none"> - Is the legal fiction also applicable all deadlines? Including the priority deadline? - What does “the designated operators within the meaning of Article 1 of the Universal Postal Convention” mean?
E	VIII	2	<p>The explanation what is a 'flat fee' for further processing in case of a Rule 71(3) communication has been expanded.</p> <p>Approval of the text communicated under Rule 71(3) requires paying the fee for grant and publishing and, where applicable, claims fees (Rule 71(4)) and filing the translations of the claims within a four-month period (Rule 71(5)). As these actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. By way of exception to the principle that the single fee for further processing is computed on the basis of the number of omitted acts, Art. 2(1), item 12, second indent, RFees stipulates that only one flat fee for further processing is due in the event of late performance of any or all of the acts required under Rule 71(3), i.e. paying the fee for grant and publishing and filing the translations of the claims. If in addition claims fees were not paid in due time, the single fee for further processing amounts to the sum of the flat fee and 50% of the claims fees (see Art. 2(1), item 12, second and first indent, RFees). If only the claims fees were not paid in due time, the single fee for further processing amounts</p>

			<p>to 50% of the claims fees (Art. 2(1), item 12, first indent, RFees). Any page fees under Art. 2(2), item 7.2, RFees are part of the fee for grant and printing. Therefore, if only page fees were not paid in due time, the fee for further processing amounts to the flat fee (Art. 2(1), item 12, second indent, RFees).</p> <p>Why has this procedure been made so complicated? The fee for grant and publishing, the claims fees and the translations of the claims are all three mentioned in Rule 71(7) EPC where non-fulfilment results in deemed withdrawal. So, we now have to understand that the claims fees are not part of the flat fee for further processing.</p> <p>What is the meaning of the wording 'page fee'? Is this the 'additional fee' in Rule 38(2) EPC? Until now the EPO avoids using the wording 'page fee'. Is this a change of policy?</p> <p>For discussion</p>
E	VIII	3	“page fee” not clarified vs “additional fee” under Rule 38(2) EPC.
E	VIII	4	<p>The EPO will issue an acknowledgement of receipt promptly.</p> <p>It would be much appreciated if a confirmation would be issued that the application is actually treated under the PACE programme. E.g., when an applicant has responded to the R161 notification early and requests PACE but does not explicitly waive the rest of the time period, the EPO still waits for the whole 6 months to lapse. While the applicant typically - and erroneously - believes that his application is already under PACE.</p>
E	VIII	4.2	<p>For PCT applications entering the European phase where the EPO also acted as (S)ISA, accelerated examination can, in principle, be requested at any time, for example</p> <ul style="list-style-type: none"> – on entry into the European phase before the EPO, or – together with any response to the WO-ISA, IPER or SISR required under Rule 161(1).

			<p>The problem here is that the EPO still awaits the whole 6m to lapse, even in case of a very early response; see https://www.epo.org/law-practice/legal-texts/official-journal/2015/11/a94.html. Applicants are typically not aware of that and expect to be on the fast track - while nothing actually happens.</p>
E	IX	2.3.5.3	<p>Consequently, if the applicant wants the priority claim to be valid in the procedure before the EPO as designated/elected Office, a request for restoration must always be filed if, in the procedure before the receiving Office:</p> <ul style="list-style-type: none"> Perhaps useful to indicate the procedure, e.g. how is the applicant heard by the EPO as dO before a decision is taken? (Article 113(1) EPC). Is a specific request to be file by the applicant explaining why he considers the finding of the rO / IB to be incorrect? <p>EPO did not take this onboard</p>
E	IX	2.3.8	<p>Last paragraph reads “Features of a claim deemed to have been abandoned pursuant to Rule 162(4) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims.”</p> <p>While this is in principle correct the criteria for support in the description is worded differently in the Guidelines E 1.2.1 “<i>What a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed</i>”. The wording “found” is shorter but may differ from the gold standard in E 1.2.1.</p> <p>EPO did not take this onboard</p>

E	IX	2.5.1	<p>In the 2019 GL/EPO, the EPO has added a lot of text from the Euro-PCT Guide, such as e.g. about the provisional protection after filing the translation of the Euro-PCT application (GL/EPO E-IX 2.5.1):</p> <p><i>The EPO will publish the translation of the application submitted by the applicant upon entry into the European phase. [...] In that case the provisional protection is, subject to Art. 67(2) and (3), only effective as from the date of publication of the translation by the EPO.</i></p> <p>We would like that it be added that "<i>The publication of the translation triggers the prior art effect of that Euro-PCT application</i>" or something the like.</p> <p>EPO did not take this onboard</p>
E	IX	3.3.1	<p>"A reply to the invitation under Rule 161(1) may not be necessary"</p> <p>Suggested amendments:</p> <p>"A reply to the invitation <u>communication</u> under Rule 161(1) may not be necessary"</p> <p>Comments:</p> <p>If the Rule 161(1) communication includes an invitation, a response is mandatory. However, if e.g. amendments have already been filed, the R161(1) communication will still be issued but a reply may not be necessary.</p>
E	XII	7.1	<p>Please re-introduce that interlocutory revision does apply when there are no opposing parties anymore (withdrawn opposition). See T1558/18 where the current practice was considered a substantial procedural</p>

			violation; https://register.epo.org/application?documentId=E3ETCNJK1984DSU&number=EP12810278&lng=en&proc=EP-PCT
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Part	Chapter	Section	Comments/ suggestion
General part F			<p>A lot of references to the case law have been deleted:</p> <ul style="list-style-type: none"> • F-IV 3.3 : T 1073/98 • F-IV 4.12 : T 150/82, T 20/94, T 205/83 • F-V 2 : W 45/92 • F-V 3 : T 1073/98 • F-V 4/2 : T 2/83 <p>What are the reasons for these deletions?</p> <p>The word "examiner" has often been replaced by the "division" or by the "examining division" (see e.g. F-V 4). What is the reason for this?</p>
General			In some instances 'examiner' has been replaced by 'division', in other instances by 'examining division'. For consistency, we suggest using the latter everywhere (e.g. F-V, 3 and 4).
F	II	2.1	New text transferred from F-II, 2.2.

F	II	15-Annex	<p>There is only one section to be revised, i.e. F-II 15 Annex 2 (SI Units). In fact, the definitions of mass, current, temperature and amount of matter are simply outdated. New standards are in force as of May 20, 2019.</p> <p>We herewith attach the official documents by the Bureau International des Poids et Mesures. A brief summary can be found here.</p> <p>We believe that the GL should report the official definition verbatim.</p>
F	III	2	<p>Contains reference to F-IV, 4.18 for methods for measuring parameters. But F-IV, 4.18 (on parameters) has been transferred to F-IV, 4.11.</p> <p>Reference should be corrected.</p>
F	IV	2.1	<p>We like very much F-IV 2.1 first paragraph: removing "non technical" allows more consistent application of the ComVik Approach (CII).</p> <p>Further, we like very much the removal of "exceptional case"-language from the sections on parameters' measurement and product-by-process.</p>
F	IV	4.4	<p>4th paragraph:</p> <p>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. The term "claim-like clauses" means clauses present in the description which use claim language such as "according to the preceding clause", "according to clause 1", "characterised in that", "further comprising", and so on. These claim-like clauses are usually found at the end of the description and/or in the form of numbered paragraphs.</p>

			<p>"characterised in that" and "further comprising" are not specifically linked to claim-like clauses and including these expression makes it unclear what is meant by "claim-like clauses".</p> <p>Suggest to delete "characterised in that" and "further comprising"</p>
F	IV	4.13.3	<p>Our suggestions with regard to decision T 1931/14 were incorporated into the GL, i.e. in particular the differentiation between a) purpose features in method claims that define a specific application and imply necessary additional steps, without which the claimed process would not achieve the stated purpose, and b) purpose features that merely describe a technical effect which inevitably arises from the recited method steps.</p> <p>Why was the paragraph referring to a "method of manufacture" maintained.</p>
F	V	2	<p>7th paragraph</p> <p>"In contrast, features that are not shared, i.e. the rich varieties in features that only appear in some but not in other claims, cannot be part of the single general inventive concept (W-45/92)."</p> <p>Suggested amendments:</p> <p>"In contrast, features that are not shared, i.e. the rich varieties in features that only appear in some but not in other claims, cannot be part of the single general inventive concept (W-45/92)."</p> <p>Comments:</p> <p>No antecedence for "rich varieties".</p>

Part	Chapter	Section	Comments/ suggestion
G	II	3.3	<p>GII 3.3, added paragraph on well-recognized meaning of terms:</p> <p>Such an added paragraph is very dangerous. In CII there are no updated and well-recognized dictionaries, so that it is difficult to establish the “well-recognized” meaning. This can be a cause of many discussions with the examining division, which can cost very much to the Applicant. It is not the fault of the applicant if other patent disclosures use some terms improperly.</p> <p>Either remove this paragraph (best solution) or add that “the examining division will provide evidence of such a lack of well-recognized meaning and why this lack should be interpreted as a lack of technical character of the feature/claim.”</p>
G	II	3.5.3	<p>13th paragraph:</p> <p><i>As a further example, in a method for carrying out electronic financial transactions with credit cards at a point of sale, the administrative decision to dispense with the need to obtain 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 measure, on its own, 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.</i></p>

			<p>Should be modified as follows:</p> <p><i>As a further example, in a method for carrying out electronic financial transactions with credit cards at a point of sale, the administrative decision to dispense with the need to obtain 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 measure, on its own, 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. <u>However, if the sequence of steps are changed instead of changing the administrative content of the exchanged information, or if there is no more need for such information because the system can obtain the same information extracting it from the new sequence of steps, i.e. it is a technical consequence and not an administrative decision, then the solution may be technical and solve a technical problem.</u></i></p> <p>The current amendment would be a basis for killing many applications in the filed, because the examining division may not immediately see the difference between moving information from step to step to have less traffic and dropping it completely.</p>
G	II	4.2.1.1	<p>Examples of excluded treatments by surgery are the injection of a contrast agent into the heart, catheterisation and endoscopy.</p> <p>Please consider to also include an example of a method that is not excluded, e.g. T 2699/17, to clarify the extent of the exclusion. https://register.epo.org/application?documentId=E23CIQTK3027DSU&number=EP05101327&lng=en&npl=false</p>
G	II	4.2.1.1	<p>The aim of Art. 53(c) is to guarantee that medical and veterinary practitioners should be free to use their skills and knowledge of the best available treatments to achieve the utmost benefit for</p>

			<p>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>Please consider the above amendment, to precisely reflect the wording of G 1/07. There is no mentioning whatsoever of "guarantee". Based on a "guarantee" approach, more than necessary might be rejected.</p>
G	II	5.2	<p>"More detailed instructions on the exclusions on plant varieties can be found in 5.4.1"</p> <p>Suggested amendments:</p> <p>"More detailed instructions on the exclusions on plant varieties can be found in <u>G-II</u>, 5.4.1"</p> <p>Comments:</p> <p>For consistency of internal cross-references.</p>
G	II	5.4	<p>Furthermore, for living matter to be patentable, it must be possible to reproduce it in a way that has exactly the same technical features. Reproducibility can be assured for example:</p> <p>Is "exactly the same technical features" a new patentability condition ???</p> <p>I would rephrase:</p> <p>Furthermore, for living matter to be patentable, it must be possible to reproduce it without undue burden. Reproducibility can be assured for example:</p>
G	II	5.4.1	<p>Two new paragraphs added to further explain the exclusion of plant varieties. The hybrid of two varieties is not necessarily a variety itself. It would be only if the resulting hybrid is distinguished, homogenous and stable (DHS criteria for a variety, under the UPOV convention).</p>

G	VI	7.1.1	<p>"<u>Guidance on products which can be seen as "substances or compositions" in this context can be found in T 1758/15, which relates to a biocompatible filler material for use in a specific therapeutic method."</u></p> <p>Suggested amendments:</p> <p>"Guidance on products which can be seen as "substances or compositions" in this context can be found in T 1758/15, which relates to a biocompatible filler material for use in a specific therapeutic method."</p> <p>Comments:</p> <p>Appears to be a formatting error with underlined text.</p>
G	VI	7.1.1	<p>The reasons of T 1758/15 are rather lengthy, and it would be appreciated to include the general test (r. 5.2.6) and the specific example in this chapter in the next revision.</p> <p>Further, it would be helpful to also include an example how the filler material of T 1758/15 would have been considered a compound/composition, to clarify the metes and bounds of the exclusion.</p> <p>R. 5.2.9 provides guidance in this respect: If the material would have had a relevant radiation-reducing effect on the tissue that could be ascribed to its chemical properties, it would have been considered a compound/composition.</p>
G	VI	8	<p>(ii) A sub-range selected from a broader numerical range of the prior art is considered novel if both of the following twothree criteria are satisfied (see T 198/84 T 261/15 and T 279/89):</p> <ul style="list-style-type: none"> (a) the selected sub-range is narrow compared to the known range; (b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range;

			<p>with reference to the third criterion (criterion (c)), several decisions consider that purposive selection is relevant for assessing inventive step but not novelty (see T 1233/05, T 1131/06, T 230/07, T 913/07, T 1130/09, T 2041/09, T 492/10, T 1948/10, T 423/12, T 378/12, T 1404/14, T 261/15, some of which are reported below). However see for example decision T 66/12, in which the board left it open as to whether the first two criteria were satisfied in light of its conclusion that the third criterion was not met (conclusion – lack of novelty). See also the detailed decision T 673/12, which recalled the three criteria for the examination of novelty.</p> <p style="color: red;">not a mere in, new technical</p> <p>3.1).</p> <p>We suggest retaining condition (c) at present.</p> <p>There are constant rumors that the question of whether or not criterion c) might be sth for the EBoA to finally clarify. Even T 261/15 only says that 'the majority of the more recent jurisprudence' ignores criterion c). But this issue is clearly not yet settled. Isn't it a bit too early to change the practice now? Before the GL is changed, we need enlarge Board of Appeal to decide.</p> <p>In addition, there is a contradiction between deletion of (c) and the following paragraph.</p>
G	VII	13	<p>"If researchers are aware when embarking on their research that, in order to reach a technical solution, they will need not only technical skill but also the ability to make the right non-trivial decisions along the way, this cannot be regarded as a "reasonable expectation of success""."</p> <p>Comments:</p> <p>The amendment introduces the concept "non-trivial decisions", which is ill-defined. The abilities of the skilled person usually includes a lot of non-trivial skills. Therefore, please change the phrase or add an explanation, for example "decisions falling outside the abilities of the skilled person".</p>

Part	Chapter	Section	Comments/ suggestion
H	II	2.3.1.1	<p>II. 2.3.1.1.</p> <p>The examining division will not admit any (further) amendment under Rule 137(3) Unless 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 not admit any (further) amendment under Rule 137(3), because normally, information has to be added in order to overcome the objection under Article 83 EPC. Adding information usually infringes Article 123(2) EPC.</p> <ul style="list-style-type: none"> Amending the claims to restrict to the enabled embodiment is certainly possible and does not require “adding information”. If claim 1 is insufficiently disclosed because it is a broad claim covering both enabled and non-enabled embodiments, then amending claim 1 to restrict to the enabled embodiments is possible without infringing Article 123(2) EPC. Whether or not the amended claim is sufficiently disclosed, is a matter of <i>allowability</i> of the request, not of admissibility. <p>EPO did not take this onboard-why not?</p>
H	III	3.3.1	<p>HIII 3.3.1 – the second paragraph places a booby trap in front of the applicant and should be deleted. Rule 137(4) second sentence provides the Examining Division a remedy if there has been no explanation. To sneakily find an amendment inadmissible rather than seeking clarification shows bad faith to applicants.</p> <p>EPO did not take this onboard – why not?</p>

H	III	3.3.1	<p>Alternatively, where Rule 137(4) is not complied with in respect of a specific request (main or auxiliary), this request may be rejected as inadmissible under Rule 137(3). The exercise of discretion under Rule 137(3) needs to be reasonable.</p> <p>A decision on inadmissibility may be reasoned, but unreasonable (overly formalistic). I guess “reasonable” is meant here. Or, say “shall not be overly formalistic” instead of reasoned / reasonable</p> <p>EPO did not take this onboard – why not?</p>
H	III	3.3.1	<p>2nd §</p> <p>Alternatively, where Rule 137(4) is not complied with in respect of a specific request (main or auxiliary), this request may be rejected as inadmissible under Rule 137(3). The exercise of discretion under Rule 137(3) needs to be reasoned.</p> <p>This goes against R137(4):</p> <p>When filing any amendments referred to in paragraphs 1 to 3, the applicant shall identify them and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.</p> <p>In addition, provision of Rule 137(4) requiring identification of amendments, and providing a mechanism for dealing with non-compliance should not be circumvented by using discretion under another rule that does not refer to Rule 137(4). If a mechanism is there use it: if not, change the rule.</p>

H	III	4.4	<p>HIII 4.4 – this highlights the possible problems that may arise if the unitary patent goes ahead. Clarification of the meaning of Rule 138 (or an amended rule) may be required. This just flags an issue.</p> <p>For discussion</p>
H	V	3	<p>H-V 3</p> <p>If several features are deleted from an independent claim, so that for example it is restricted to only part of the originally claimed apparatus subject-matter, the subject-matter of the amended claim must be directly and unambiguously derivable from the application as filed as being an invention <i>per se</i>, i.e. it must solve a technical problem and be able to work in the absence of any of the particular features being deleted (T 545/92).</p> <ul style="list-style-type: none"> • T 545/92 was really about claiming an equipment component instead of the whole apparatus. So, claim 1 as filed was for the apparatus comprising a circulation tank, and amended claim 1 was for the circulation tank only. The proposed amendment severely obscures the point of T 545/92. <p>EPO did not take this onboard – Why not?</p>
H	V	3.1	<p>E-V 3.1 in relation to replacement or removal of features from a claim: in time (iii) the EPO effected a removal:</p> <p>(iii) the skilled person would directly and unambiguously recognise that the replacement or removal requires no modification of one or more features to compensate for the change (it does not in itself alter the invention).</p> <p>What is the reason for this deletion?</p>

H	V	3.3	<p>HV 3.3 – the second to last sentence might perhaps read “A combination of specific features may be allowable if the application as filed provided a pointer towards that particular combination, e.g. by reference to preferred <u>particular embodiments</u>”.</p> <p>Use of the word “<i>preferred</i>” could be misinterpreted as requiring singling out an embodiment, as opposed to particularly indicating an embodiment (preferred or not).</p> <p>EPO did not take this onboard – Why not?</p>
H	V	3.3	<p>A combination of specific features may be allowable if the application as filed provided a pointer towards that particular combination, e.g. by reference to preferred embodiments. These principles apply also to the combination of features resulting from dependent claims.</p> <p>What is the basis for this? Combination of claim 1 with various dependent claims that are all “according to any preceding claim” has always been accepted. Is that upon to change? Suggest to delete this sentence</p> <p>EPO did not take this onboard – Why not?</p>
H	VI	6	<p>"Therefore a request for correction of errors in the publication of the B1 specifications filed during opposition proceedings is dealt with by the opposition division."</p> <p>Suggested amendments:</p> <p>Deletion of this paragraph.</p> <p>Comments:</p>

			Appears inconsistent with H-VI, 3.3 "Thus the opposition division refers to the examining division any request under Rule 140 to correct such errors filed by the patent proprietor while opposition proceedings are pending."
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PCT-EPO epi comments_ 20190930

Comments/suggestions to the PCT-EPO Guidelines incl. comments from April to parts B, C, HComments from April 2019 that we wish to discuss are marked green and EPO's response is noted marked yellow

Part	Chapter	Section	Comments/ suggestion
General part A			<p>Chapter II is entirely new - in the previous version there was only a title and no text.</p> <p>Chapter II "Filing of international applications and examination on filing" deals with filing and formalities examination of an international application filed at the EPO as receiving Office. This is 'strange' content in relation to the title of the Guidelines:</p> <p><i>"Guidelines for Search and Examination at the European Patent Office as PCT Authority".</i></p> <p>This title should be amended and refer also to the filing of an international application, such as:</p> <p><i>"Guidelines for Filing, Search and preliminary Examination at the European Patent Office as PCT Authority"</i></p> <p><i>The same applies for Chapter V - Drawings - see also below</i></p>
A	I	1	Part A chapter I section 1. Instead of "introduction" use "formalities examination" as in General Part, section 2.1
A	II	1.1	A-II-1.1 Here the wording ' national office ' is employed. It would be good to add that according to PCT Art. 2(xii) a "national Office" may also mean an intergovernmental authority entrusted with the task of granting regional patents - such as the EPO.
A	II	1.1	A-II-1.1 Here the wording ' IB ' is employed. Although a list of abbreviation is given in the General Part, it would be good to indicate at least once in part A that this an abbreviation of the International; Bureau.

			In the HTML version a link to the abbreviation would be good.
A	II	1.2.1	Which is the date of the supposed delivery of the application in EPO? Rule 82 PCT, which does not apply to priority, assumes 5 days. The availability of restoration according to R.26bis.3 should be mentioned. If the application arrives late due to the postal provider, will the EPO accept restoration of the priority. R 26bis PCT should be discussed in the text.
A	II	1.2.2	3rd paragraph: What happens if the statement "the confirmation copy has been filed separately" is missing? This requirement is not in the PCT. See Rule 92.4(e). The GL may suggest this statement, but not make any requirement. In addition, we suggest to add a reference to AI 331.
A	II	1.2.3	ePCT and PCT-SAFE are offered by WIPO, but may also be used for filing with EPO as RO. This should be mentioned.
A	II	1.3	If filed with the IB, will EPO RO consider the authorization as filed, for example of a representative, who is not epi member? (for the priority document there is not any issue)
A	II	1.3	Add a reference to Rule 82 PCT and filing documents by post. Optionally add a reference to 1.2.1.
A	II	2	Assuming that the fees have to be paid later to the IB-RO. Is the 50% penalty applicable? Add reference to PCT Rule 19.4(c).

			Add the EPO does not charge the transmittal fee for transmitting the documents to the IB.
A	II	2	It is to be noted that the EPO as ISA also accepts Dutch as the language of international search, but this only applies where the receiving Office is the industrial property Office of the Netherlands (see Annex A of the Agreement between the IB of WIPO and the EPO; see OJ 2017 A115 and 2018 A24).
A	II	3.1	Is EPO 1031 usually sent within 4 working days?
A	II	3.1	However the EPO does not verify the number of sheets making up a given document. Why ? This could be very important for the applicant.
A	II	3.2	Title should be changed to “Compulsory filing via national authority” to reflect the actual content.
A	II	3.2	Which are the national authorities of EPC-MSs (member states) that act as filing offices for the EPO-RO?
A	II	3.2	Are there contracting states for which EPO is RO, i.e. the PTO of the Contracting State is not PCT-RO?
A	II	3.2	Can the EPO be receiving office on behalf of a national office of a contracting state?
A	II	5	In view of the provisions submitted for approval to the PCT Assembly in September 2019, why does the EPO acting as RO not apply (R19.4)? GL/RO 205D is general and does not contradict such an action. Provided than the Assembly adopts the new provisions, they will come into force 1 July, 2020.
A	II	5	6th § is in our opinion not correct – why does the EPO not send the document to the IB – other offices may accept replacement based on priority?
A	II	5	The text in relation to file missing parts or missing elements is written well and specifies nearly all the requirements. What is missing here is the time limit of two months from the international filing date (own volition) or two months from an invitation of the receiving Office.

A	III	4.4	Add a reminder that EPO now gives a DAS code to all EP first filings and PCT applications files at RO/EP.
A	III	4.4	Good that WIPO DAS is mentioned in relation to obtaining priority documents. After many requests from us, PCT Rule 17.1(b-bis) is now mentioned – we appreciate this.
A	III	9	<p>The Guidelines should specify the requirements for refund of fees and should not refer to OJ: "Detailed guidance on how and when to file refund instructions is provided in OJ EPO 2019, A26." This is not helpful.</p> <p>Detailed guidelines should be stated here and the reference to the OJ should be in the margin.</p>
A	IV	2	After many requests from our side, it is now indicated: "Any such withdrawal is free of charge." including the references to the PCT AG-IP. We appreciate this.
A	V		The text in relation to drawings is a mere repetition of texts in the PCT Applicant's Guide - International phase. This seems a bit superfluous information. Is this necessary?
A	V	Title	Suggested to change to “DRAWINGS AND OTHER FORMS OF GRAPHIC PRESENTATION”
A	V	1.2	<p>The front page of international publications may contain an indication that the original document contained color, if the RO has tagged the application with the indicator of possible color drawing. For example in ePCT the system detects whether the pdf, tiff, docx jpeg etc files contain any images with greater than single bit color depth. The purpose of such an indication is to tell the DO/EOs that they may look at the as filed document and act according to their practice.</p> <p>Add this paragraph.</p> <p>It would be an improvement if the EPO would accept drawings with colors.</p>

A	V	6	A-V 6 is about prohibited matter - this has no relation to the topic of the Chapter "Drawings". Suggestion is to move this to another chapter.
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Part	Chapter	Section	Comments/ suggestion
C	IV	5.1	<p>C-IV 5.1 The issuance of the WO-IPEA by the EPO as IPEA is set to be 'one month from the start of international preliminary examination'.</p> <p>The IPEA simply has to wait until it has all the required information (demand, fee payment and ISR + WO-ISA) and then should start. Hence, there is no longer a time limit (see).</p> <p>As there is no longer a 'time limit' for the start of the international preliminary examination it is a bit strange that this topic "Start of the international preliminary examination" is in the chapter "Time limits". Would be better / more logical to move this section to Chapter II, before or after E-II 8.</p> <p>In addition, the wording "In the same vein" in the new third paragraph of E-VI 1 is a bit strange. We are not talking about blood vessels. Better to write: "In the same manner".</p> <p>EPO did not take this onboard. Why?</p>
C	VI	1	<p>C-VI 1 The text in relation to the start of the international preliminary examination has to be changed because PCT Rule 69.1(a) will be amended effective 1 July 2019. The IPEA no longer needs to wait until the time limit in PCT Rule 54bis.1(a) has expired (of course unless the applicant expressly requests so).</p> <p>However, there seems to be an error in the green text in the second paragraph ():</p>

			<p>Where the international preliminary examination is to take into account amendments under Article 34 but the applicant failed to submit them with the demand, the International Preliminary Examining Authority invites the applicant (Form 431) to submit the amendments within a reasonable time limit fixed in the invitation (Rules 53.9(c), 60.1(g) and 69.1(e)). The international preliminary examination shall not start until the International Preliminary Examining Authority has received the amendments or before the time limit fixed in the invitation pursuant to Rule 60.1(g) has expired, whichever occurs first.</p> <p>EPO did not take this onboard – this is contrary to PCT rule 69.1 as amended.</p>
C	IX	1	<p>Is it possible for the office to inform the applicant in advance, when the preliminary examination starts, as in an examination under EPC?</p> <p>For discussion</p>

Parts E, F and G – No comments

Part	Chapter	Section	Comments/ suggestion
H	I	3	<p>The new text solves a problem that applicants sometimes encounter: they tick the wrong box in Section in Form PCT/IPEA/401 in relation to filing amendments/arguments. In the past the EPO was a bit stubborn and took the ticked box as 'law'. E.g. the applicant filed amendments/arguments together with the demand, but ticked the box that they would not file amendments/arguments. Even if the text of the amendments/arguments were annexed to the demand, the EPO as IPEA would ignore these amendments/arguments. The new text now obliges the EPO to invite for any amendments/arguments when the applicant ticks the box that they are included in the demand, but actually have been forgotten. The logical background is, that filing a demand makes no sense if the applicant does not file amendments/arguments.</p> <p>EPO did not take this onboard. Why</p>
H	II	2.2	<p>Correction in lay-out: reference to rule 20.6 should be in margin</p> <p>EPO did not take this onboard – maybe corrected in the final version?</p>