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Transitional regime for divisional applications with sequence listings

Dear Mr Thomsen,

I would like to come back to you regarding the concerns that the epi has raised with the EPO on several occasions relating to WIPO Standard ST.26 for the presentation of sequence listings which entered into force on 1 July 2022. Those concerns primarily apply to the transitional regime applicable to divisional applications. I have good news to pass on and would be grateful if you could share it with the epi Biotech Committee.

We understand that the concerns relate to potential conversion errors when converting sequence listings from ST.25 to ST.26 and the risk of added or lost subject-matter. To avoid this risk, the EPO permits applicants, as a safeguard, to file the ST.25 sequence listing of the parent application in PDF format when filing the divisional application. This safeguard does not exempt applicants from the obligation to file an ST.26-compliant sequence listing subsequently to avoid any loss of rights.

To support the use of this safeguard, I am pleased to inform you that the EPO has decided to waive any additional page fees which may be due when it is used. Similarly, in cases where the divisional application is filed by reference to the parent application, the EPO will not charge any additional page fees for an ST.25 sequence listing contained in the certified copy under Rule 40(3) EPC. Users will be informed of this change of practice in a notice from the EPO to be published in the Official Journal 11/2023, of which I am happy to attach an advance copy.

In addition, we intend to further clarify the information contained in the Guidelines for Examination and in the FAQ published on our website. We are also assessing the possibility of offering additional practical guidance in the form of an online seminar, noting that this topic has been addressed in detail

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in previous online seminars organised by the EPO and WIPO which are still available on both organisations' websites.

With regard to the other measures proposed, allow me to share with you the reasons why we consider that the requested measures cannot be implemented.

First, the EPO has decided to maintain the transitional regime for divisional applications. This regime is in line with the practice of several other offices and with the internationally agreed principle that the filing date should be the reference date for the applicability of WIPO Standard ST.26.

Although in general we understand users' concerns regarding added subject-matter, the EPO has implemented the filing of the "statement" in line with the Administrative Instructions under the PCT (Annex C). The filing of this statement is required when the standard-compliant sequence listing is not filed on the date of filing. In such a case, the sequence listing is not part of the description and therefore not subject to examination under Article 123(2) EPC. This statement helps to ensure that the subsequently filed ST.26 sequence listing which is fed into the sequence listing database only contains information included in the original application documents. It therefore serves the purpose of legal certainty. Modifying the statement to take account of possible conversion issues does not appear to be legally sustainable.

Regarding the publication by the EPO of information allowing applicants to correct ST.26 sequence listings at any time during the grant procedure, allow me to refer you to the general principles applicable under Rules 139 and 137(2) EPC as set out in Part H of the Guidelines for Examination, which are based on the case law of the Boards of Appeal. Moreover, we consider the possibility to file the parent application's ST.25 sequence listing to be a sufficient safeguard.

Finally, the two-month time limit under Rule 30(3) EPC appears to be sufficient for providing a sequence listing compliant with ST.26, also considering that further processing may still be requested if that time limit is missed. The late furnishing fee compensates for the EPO's administrative burden in issuing the communication under Rule 30(3) and Rule 163(3) EPC. It does not fall due if the ST.26 sequence listing is provided before the invitation is sent. We also expect that users will become more and more familiar with ST.26 and WIPO's software for generating ST.26-compliant sequence listings, and so a rule change does not seem to be the appropriate measure to overcome initial difficulties.

We trust that the proposed measures sufficiently address the concerns of the user community. The epi Biotech Committee is welcome to provide the EPO's experts with further practical examples. This will allow us to supplement the technical guidance that we publish on our website.

Yours sincerely,

Christoph Ernst