

CHAPTER 6 EPC PROCEDURAL LAW: FILING THE APPLICATION, DATE OF FILING AND FORMALITIES EXAMINATION; EUROPEAN SEARCH

6.1 The European patent application, examination on filing and formalities examination

6.1.1 The European patent application

Study Art. 78(1) EPC

Topics	EPC	GL/EPO	Case Law/other
Content of a European patent application:	Art. 78(1)	F-II	Also see § 2.7
- Request for grant	Art. 78(1)(a), Rule 41	A-III 4, F-II 3	
- Content of the description	Art. 78(1)(b), Rule 42	F-II 4	
- Content of the claims	Art. 78(1)(c), Rule 43	F-IV	
- Form of the drawings	Art. 78(1)(d), Rule 46	A-IX	
- Form and content of the abstract	Art. 78(1)(e), Rule 47	A-III 10, F-II 2	
Prohibited matter	Rule 48	A-III 8, F-II 4.4, 7	
- Morality or 'ordre public'	Art. 53(a), Rule 48(1)(a)	A-III 8.1	Also see § 2.2
- Disparaging statements	Rule 48(1)(b)	A-III 8.2	
Presentation of documents making up the European patent application	Rule 49	A-VIII 2	
Documents filed after filing the application	Rule 50	A-VIII 2.2, 2.5, 3.1	
- Machine translations		G-IV 4.1	

Study Art. 78(2) EPC

Topics	EPC	GL/EPO	Case Law/other
Fees on filing the application	Art. 78(2)	A-III 13	
Paying the filing and search fee	Rule 38(1)	A-III 13.1	RFees 2(1) 1, 2
- Amount of the filing fee is dependent on the manner of filing	Rule 38(1)		RFees 2(1) 1, 2(3); OJ 2018 A4
- Period: within 1 month of filing the application	Rule 38(1)	A-III 13.1	
- Reduction of the filing fee under the language arrangements	Rule 6(3), Art. 14(4)	A-X 9.2.2	RFees 14(1); see § 1.4.2
- Refund of the search fee		A-X 10.2.1	RFees 9(1)
- Additional fee if application contains > 35 pages	Rule 38(2)-(3)	A-III 13.2	RFees 2(1) 1a
- Non-payment: application deemed to be withdrawn	Art. 78(2)	A-III 13.1, 16	
- Further processing	Art. 121, Rule 135	A-III 13.1, 16.2	RFees 2(1) 12
Claims fees	Rule 45	A-III 9	Also see § 7.5.6
- For 16-50 claims and for the 51 st and each subsequent claim	Rule 45(1)	A-III 9	RFees 2(1) 15
- Period for paying - depends on when the claims are filed	Rule 45(2)	A-III 9	
- 1-month grace period	Rule 45(2)	A-III 9	(no surcharge)
- Non-payment	Rule 45(3)	A-III 9, B-III 3.4	

Study Art. 85 EPC

Topics	EPC	GL/EPO	Case Law/other
Abstract:	Art. 85	A-III 10, F-II 2	
- Serves the purpose of technical information only	Art. 85	F-II 2.1	
- May not be taken into account for any other purpose, in particular for applying Art. 54(3)	Art. 85 → Art. 54(3)	G-IV 5.1	
- Not part of the 'content of the application as filed' for the purpose of Art. 123	Art. 85 ↔ Art. 123	F-II 2.7	
Form and content of the abstract	Rule 47	F-II 2, B-X 7	
Definitive content of the abstract	Rule 66	A-III 10.2	See § 6.2.6

6.1.2 Filing of a European patent application

Study Art. 75 and Rule 35 EPC

Topics	EPC	GL/EPO	Case Law/other
Filing of the application	Art. 75(1)	A-II 1	EPO Form 1001: Request for grant form; Notes on the request for grant form
- Filing at EPO filing offices	Rule 35(1)	A-II 1	
- Filing at national offices (if allowed)	Rule 35(2)-(4)	A-II 3	Nat. Law Table II
National security	Art. 75(2)		
Forwarding of the application by national office to the EPO	Art. 77(1), Rule 37(1)	A-II 1.7	
- Onward transmission within 6 weeks	Rule 37(1)(a)	A-II 1.7	
- More time if liability to secrecy must be examined	Rule 37(1)(b)	A-II 1.7	
Application not forwarded if subject has been made secret	Art. 77(2)		
Failure to forward the application to EPO	Art. 77(3), Rule 37(2)	A-II 1.7, 3.2	
- Application deemed to be withdrawn	Art. 77(3), Rule 37(2)	A-II 1.7	
- All fees refunded	Rule 37(2)	A-X 10.2.6	
- Conversion into a national application	Art. 135(1)(a), (2), Rule 155	A-IV 6	See § 9.5.1

Study Rules 1, 2 EPC

Topics	EPC	GL/EPO	Case Law/other
Requirements for written proceedings	Rule 1		
Filing of and formal requirements for documents	Rule 2	A-II 1	
- Filing of applications by delivery by hand or by postal services	Rule 2(1)	A-II 1.1	
- Automated mail-boxes	Rule 2(1)	A-II 1.1	
- Filing of applications by fax	Rule 2(1)	A-II 1.2	
- Filing of applications by means of electronic communication	Rule 2(1)	A-II 1.3	
- Filing by other means (e.g. e-mail) is not allowed		A-II 1.4	

6.1.3 Filing of a divisional application

Study Art. 76 and Rule 36 EPC

Topics	EPC	GL/EPO	Case Law/other
Filing of divisional application	Art. 76(1)	A-IV 1, C-IX 1	
- No extension of subject-matter	Art. 76(1)	C-IX 1.4	G 1/05
- Same date of filing/priority as the parent	Art. 76(1)	C-IX 1.1	
Pendency of earlier application	Rule 36(1)	A-IV 1, C-IX 1	G 1/09
Language requirements	Rule 36(2)	A-IV 1.3.3	
Divisional filed 'by reference' to the parent application	Rule 40(1)(c), (2), (3)	A-IV 1.3.1, A-II 4.1.3.1	
Payment of the filing and search fee	Rule 36(3)	A-IV 1.4.1	RFees 2(1) 1, 2
- Period: within 1 month of filing the divisional	Rule 36(3)	A-IV 1.4.1	
- If the fees are not paid in due time: divisional deemed to be withdrawn	Rule 36(3)	A-IV 1.4.1	
- Full/partial refund of the search fee depending on the extent to the EPO benefits from the search report of the parent application			RFees 9(2)
Additional fee for divisional of second or subsequent generations	Rule 38(4)	A-IV 1.4.1.1	RFees 2(1) 1b
Renewal fees for divisional applications	Rule 51(3)	A-IV 1.4.3	See § 9.4.5
Payment of the designation fee	Rule 36(4), Art. 79(2)	A-IV 1.4.1	RFees 2(1) 3
- Period: within 6 months of date mention of the search report in the European Patent Bulletin	Rule 36(3)	A-IV 1.4.1	
The divisional is bound by States designated in the parent	Art. 76(2)	A-IV 1.3.4	G 4/98
Extension and validation States		A-IV 1.3.5	
Payment of the examination fee	Rule 70		Same period as for designation fee
Response to the search opinion	Rule 70a		See § 6.2.7
Filing of a divisional following lack of unity objection during substantive examination	Art. 76, Rule 36	F-V 11	See § 4.1
The parent and divisional applications may not claim the same subject-matter		C-IX 1.6	Also see "Double patenting" in § 9.5.3

6.1.4 Date of filing

Study Art. 80 and Rule 40 EPC

Topics	EPC	GL/EPO	Case Law/other
Date of filing	Art. 80, Rule 40	A-II 4, A-II 4.1.5	
Requirements for according a date of filing	Rule 40(1)	A-II 4	
- Indication that a European patent is sought	Rule 40(1)(a)	A-II 4.1(i), 4.1.4	
- Information identifying the applicant or allowing the applicant to be contacted	Rule 40(1)(b)	A-II 4.1(ii), 4.1.4	
- Description or reference to a previously filed application	Rule 40(1)(c), (2), (3)	A-II 4.1(iii), 4.1.3.1, 4.1.4, A-III 3.2.1	
- Reference filing: certified copy of previously filed application: 2 months of filing the application	Rule 40(3)	A-II 4.1.3.1, A-III 3.2.1	
- Conditions where the previously filed application is already available to the EPO	Rule 40(3), 53(2)	A-II 4.1.3.1	only for Euro-direct application or an international application filed at EPO as receiving Office
Language is not relevant for accordance of date of filing	not mentioned in Rule 40	A-VII 1.1	
Claims are not required for accordance of date of filing	not mentioned in Rule 40	A-II 4.1	
- However, claims are essential for the application	Art. 78(1)(c), Art. 92	A-III 15, B-XI 2.2, C-III 1.1.2	
- Set of claims can be filed of own volition		A-III 15	
- If not, the EPO issues an invitation	Rule 57(c), 58	A-III 15	See § 6.1.8
- Late filed claims are regarded as an amendment	Art. 123(2)	A-III 15, B-XI 2.2, C-III 1.1.2	See § 7.7.1
- This is indicated when the application is published	Rule 68(4) 1 st sentence	A-VI 1.3	See § 7.1
Legal effect of date of filing:			
- Equivalent with national filing	Art. 66		Art. 4A(2),(3) PC
- Right of priority	Art. 87		Art. 4A(1) PC

6.1.5 The Receiving Section

Study Art. 16 EPC

Topics	EPC	GL/EPO	Case Law/other
Receiving Section is responsible for the examination on filing and the examination as to formal requirements of European patent applications	Art. 16, 90	A-II 4, A-III 1	Also see § 1.3.2
- Receiving Section is responsible until Examining Division becomes responsible	Rule 10(1)	A-I 2	
- Receiving Section is composed entirely of formalities officers		A-I 2	G 1/02
- At the search stage, the responsibility for the application lies with the Receiving Section	Art. 16	B-XI 3.9	
Transfer of the responsibility of the Receiving Section to an Examining Division	Art. 16, 18(1), Rule 10	A-III 3.2, A-VI 2.4	Also see § 7.5.1

6.1.6 Examination on filing; accordance of date of filing

Study Art. 90(1), (2) and (4) EPC

Topics	EPC	GL/EPO	Case Law/other
Receiving Section checks requirements for accordance of date of filing	Art. 90(1), (2), Rule 40(1)(a), (c), 40(2), 40(3), 1 st sentence	A-II 4	
Invitation to correct deficiencies	Art. 90(4), Rule 55	A-II 4.1.4, 4.1.5	
No date of filing accorded	Art. 90(2), Rule 55	A-II 4.1.4	
- Application not dealt with as a European patent application	Art. 90(2), Rule 55	A-II 4.1.4	
- Re-establishment of rights may be requested (all due care)	Rule 112(1), Art. 122, Rule 136	A-II 4.1.4	
Date of filing accorded to the application if requirements are met		A-II 4.1.5	

6.1.7 Missing parts of the description or missing drawings

Study Rule 56 EPC

Topics	EPC	GL/EPO	Case Law/other
Late filing of missing drawings or missing parts of the description			
- with invitation	Rule 56(1), (2), (4)(a)	A-II 5.1, 5.3	
- without invitation	Rule 56(2), (4)(a)	A-II 5.2, 5.3	
Missing parts based on priority: no change in date of filing	Rule 56(3)	A-II 5.4	
Missing parts based on priority: priority claim	Rule 56(3)	A-II 5.4	
- Checking on requirement 'completely contained'	Rule 56(3)	A-II 5.4.2, B-XI 2.1, C-III 1.1.1	
- Copy of the earlier application, unless available to the EPO	Rule 56(3)(a)	A-II 5.4(v)	
- Where required, a translation of the earlier application	Rule 56(3)(b)	A-II 5.4(vi), 5.4.4	
- Indication where the missing parts or missing drawings are completely contained	Rule 56(3)(c)	A-II 5.4(vii), 5.4.2, 5.4.4	
Decision on requirement 'completely contained'	Rule 56(4), (5), (6)	A-II 5.4.2, B-XI 2.1, C-III 1.1.1	
Withdrawal of late-filed missing parts	Rule 56(6) → Rule 56(2), (5)	A-II 5.5, C-III 1.1.1	
- Sufficiency of disclosure and Rule 56	[Art. 83]	F-III 10, C-III 1.1.1	See § 4.2

6.1.8 Examination of formal requirements

Study Art. 90(3), (4) and Rules 57, 58, 59, 60 EPC

Topics	EPC	GL/EPO	Case Law/other
Examination as to formal requirements	Art. 90(3), Rule 57	A-III	EPO Form 1034: Important deadlines when filing a European patent application
Invitation to correct deficiencies	Art. 90(4), Rule 57-60	A-II 4.1.4, 4.1.5	
- Translation	Rule 57(a), 58	A-III 14, 16	
- Request for grant	Rule 57(b), 58	A-III 4, 16	
- Presence of at least one claim	Rule 57(c), 58	A-III 15, 16	
- Abstract	Rule 57(d), 58	A-III 14, 16	
- Filing and/or search fee paid	Rule 57(e)	A-III 13.1	
- Designation of the inventor	Rule 57(f), 60	A-III 5, 16	See § 5.3
- Priority claim	Rule 57(g), 52(3), 59	A-III 6.5.3, 6.7, 16	See § 4.4.2
- Representation	Rule 57(h), 58	A-III 2, 16	
- Physical requirements	Rule 57(i), 58	A-III 3, 16	

6.1.9 Consequences if the deficiencies are not rectified in due time

Study Art. 90(5) and Rule 58 EPC

Topics	EPC	GL/EPO	Case Law/other
Application refused	Art. 90(5)		
- Request for grant not filed or not corrected	Rule 57(b), 58, Art. 90(5)	A-III 16.2(iii)	
- No claims filed	Rule 57(c), 58, Art. 90(5)	A-III 16.2(vi)	
- Abstract not filed	Rule 57(d), 58, Art. 90(5)	A-III 16.2(iv)	
- Non-appointment of compulsory representative	Rule 57(h), 58, Art. 90(5)	A-III 16.2(i)	
- Non-compliance with the physical requirements	Rule 57(i), 58, Art. 90(5)	A-III 16.2(ii)	
No further processing	Art. 121, Rule 135(2)	A-III 14, 16, E-VIII 2	
- Re-establishment of rights possible (all due care)	Art. 122, Rule 136	E-VIII 3.1.1	

Study Art. 90(5) and Rule 58 EPC

Topics	EPC	GL/EPO	Case Law/other
Application deemed to be withdrawn	Art. 90(5) 'different legal consequence'		
- Translation not filed	Rule 57(a), 58, Art. 90(5), Art. 14(2) last sentence	A-III 16.2(v)	
No further processing	Art. 121, Rule 135(2)	A-III 14, 16, E-VIII 2	
- Re-establishment of rights possible (all due care)	Art. 122, Rule 136	E-VIII 3.1.1	

Study Art. 90(5) and Rule 59 EPC

Topics	EPC	GL/EPO	Case Law/other
Right of priority lost	Rule 57(g), 59, Art. 90(5) last sentence	A-III 16.2(viii)	
No further processing	Art. 121, Rule 135(2)	A-III 14, 16, E-VIII 2	
- Re-establishment of rights possible (all due care)	Art. 122, Rule 136	E-VIII 3.1.1	

Study Art. 90(5) and Rule 60 EPC

Topics	EPC	GL/EPO	Case Law/other
Application refused	Art. 90(5)		Also see § 5.3
- Designation of the inventor not made or not corrected in due time	Rule 60, Art. 90(5)	A-III 5.5	
Remedy: further processing	Art. 121, Rule 135(2)	A-III 5.5	

Study Art. 78(2) and Rule 45 EPC

Topics	EPC	GL/EPO	Case Law/other
Non-payment of the filing and search fee	Art. 78(2), Rule 57(e)	A-III 13, A-III 16.2(ix)	
- Remedy: further processing	Art. 121, Rule 135	A-III 13.1, A-III 16.2	
Non-payment of claims fees	Rule 45	A-III 9, A-III 16.2(vii)	
- If a claims fee is not paid in due time, the claim concerned is deemed to be abandoned	Rule 45(2)	A-III 9, A-III 16.2	
Claims fees at grant of patent	[Rule 71(4)]	C-V 1.4	See § 7.5.6

6.1.10 Applications relating to nucleotide and amino acid sequences

Study Rule 30 EPC

Topics	EPC	GL/EPO	Case Law/other
Sequence listing	Rule 30(1)	A-IV 5	
- Not part of description	Rule 30(2)	A-IV 5	
Invitation to correct deficiencies	Art. 90(3), Rule 30(3)	A-IV 5	
- Period: 2 months	Rule 30(3)	A-IV 5	
- Pay the late furnishing fee	Rule 30(3)	A-IV 5	RFees 2(1) 14a
- If not complied with: application will be refused	Rule 30(3)	A-IV 5	
- Remedy: further processing	Art. 121, Rule 135	A-IV 5	

6.1.11 Applications relating to biological material

Study Rules 31-34 EPC

Topics	EPC	GL/EPO	Case Law/other
Biological material	Rule 26(3)	A-IV 4.1	
Deposit of biological material	Rule 31	A-IV 4.1	
- New deposit	Rule 34	A-IV 4.1.1	
Missing information; notification	Rule 31(2)	A-IV 4.2, F-III 6.3(ii)	G 2/93
Availability of deposit to expert only	Rule 32	A-IV 4.3	