

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

Article 78(1) and Rules 41-43, 46-50 EPC

Topics	EPC	GL/EPO	Other references
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	
- Photographs		A-IX 1.2	
- Colour drawings		A-IX 7.1	
- 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 ' <i>ordre public</i> '	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	
- Irrelevant or unnecessary matter	Rule 48(1)(c)	F-II 7.4, A-IX 6	
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	Also see § 6.1.4
- Machine translations		G-IV 4.1	

6.1.2 Fees on filing the European patent application

Article 78(2) and Rules 38(1), (2), (3) and 45 EPC

Topics	EPC	GL/EPO	Other references
Fees on filing the application	Art. 78(2)	A-III 13	
Paying the filing fee and search fee	Rule 38(1)	A-III 13.1	RFees Art. 2(1) 1, 2
- Amount of the filing fee is dependent on the manner of filing	Rule 38(1)	A-III 13.1	RFees Art. 2(1) 1, 2(4)
- 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 Art. 14(1); see § 1.4.2
- Refund of the search fee		A-X 10.2.1	RFees Art. 9(1)
- Additional 'page' fee if application contains > 35 pages	Rule 38(2)- (3)	A-III 13.2	RFees Art. 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- Non-payment: application deemed to be withdrawn	Art. 78(2)	A-III 13.1, 16	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 Art. 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 Art. 2(1) 15
- Period for paying: depends on when first set of claims is 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	

6.1.3 The abstract

Article 85 EPC and Rules 47, 66 EPC

Topics	EPC	GL/EPO	Other references
Abstract:	Art. 85	A-III 10, F-II 2	Also see § 6.1.10
- 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(2)	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

6.1.4 Filing a European patent application; forwarding of European applications

Article 75 and Rule 35 EPC

Topics	EPC	GL/EPO	Other references
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 or mandatory)	Rule 35(2)-(4)	A-II 3	National Law II
National security	Art. 75(2)		National Law II

Article 77 and Rules 37, 155 EPC

Topics	EPC	GL/EPO	Other references
Forwarding of the application by national office to the EPO	Art. 77(1), Rule 37(1)	A-II 1.6	
- Period: 6 weeks of filing if not liable to secrecy	Rule 37(1)(a)	A-II 1.6	
- Period: 4 months of filing or 14 months of priority date where examination as to the liability to secrecy is required	Rule 37(1)(b)	A-II 1.6	
Application not forwarded if the subject-matter is liable to secrecy	Art. 77(2)		
If the application is not forwarded to the EPO in due time	Art. 77(3), Rule 37(2)	A-II 1.6, 3.2	
- Application deemed to be withdrawn	Art. 77(3), Rule 37(2)	A-II 1.6	
- All fees refunded	Rule 37(2)	A-X 10.2.4	
- No re-establishment of rights		A-II 1.6	
- Conversion into a national application	Art. 135(1)(a), (2), Rule 155	A-IV 6	See § 9.5.1

Rules 1, 2 and 50 EPC

Topics	EPC	GL/EPO	Other references
Requirements for written proceedings	Rule 1		
Filing of and formal requirements for documents	Rule 2	A-II 1	
- Delivery by hand or by postal services	Rule 2(1)	A-II 1.1	
- Automated mail-boxes		A-II 1.1	
- Hand in to the porter		A-II 1.1	
- By means of electronic communication	Rule 2(1)	A-II 1.2	
- By fax		A-II 1.2.1	
- EPO Online Filing (OLF)		A-II 1.2.2	
- EPO case management system (CMS)		A-II 1.2.2	
- Online Filing 2.0			OJ 2021 A21
- EPO Web Form Filing service		A-II 1.2.2	
- Safeguards in event of outages of means of electronic filing and other online services		E-VIII 1.6.2.1	
- Filing by other means (e.g., e-mail) is <i>not</i> allowed		A-II 1.3	
- Subsequent filing of documents	Rule 2(1), 50	A-II 1.4, A-VIII 2.5	

6.1.5 Filing a divisional application

Art. 76 and Rule 36 EPC

Topics	EPC	GL/EPO	Other references
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 parent application	Art. 76(1)	C-IX 1.1	
Pendency of the earlier application	Rule 36(1)	A-IV 1, C-IX 1	
- After deemed withdrawal of the parent application		A-IV 1.1.1	
- After refusal of the parent application		A-IV 1.1.1	G 1/09
Sequence of divisional applications		A-IV 1.1.2	G 1/05, G 1/06
Persons entitled to file a divisional application		A-IV 1.1.3	
Date of filing of divisional application	[Art. 80, Rule 40]	A-IV 1.2.1	
- Priority claim of divisional application		A-IV 1.2.2	
Where and how to file a divisional application	Rule 36(2), Rule 41(2)(e)	A-IV 1.3.1, 1.3.2	EPO Form 1001: Box 27
- Divisional application can be filed 'by reference' to the parent application	[Rule 40(1)(c), 40(2), 40(3)]	A-IV 1.3.1, A-II 4.1.3.1	EPO Form 1001: Box 26
- Language requirements	Rule 36(2)	A-IV 1.3.3	Also see § 1.4.1
Filing of a divisional application following lack of unity objection during substantive examination	Art. 76, Rule 36	F-V 7	See § 4.1
Proceedings for grant of divisional application are separate and independent from proceedings concerning parent application		C-IX 1.1	G 4/98
Parent and divisional applications may not claim the same subject-matter		C-IX 1.6	Also see "Double patenting" in § 9.5.3

Art. 76 and Rules 36, 38(4), 51(3) EPC

Topics	EPC	GL/EPO	Other references
Payment of filing and search fee	Rule 36(3)	A-IV 1.4.1	RFees Art. 2(1) 1, 2
- 1 month of filing divisional	Rule 36(3)	A-IV 1.4.1	
- Consequence if fees are not paid in due time	Rule 36(3)	A-IV 1.4.1	
- Full/partial refund of search fee depending on extent that EPO benefits from search report of parent application			RFees Art. 9(2)
Additional fee for divisional of second or subsequent generations	Rule 38(4)	A-IV 1.4.1.1	RFees Art. 2(1) 1b
Renewal fees for divisional	Rule 51(3)	A-IV 1.4.3	See § 9.4.5
Payment of the designation fee	Rule 36(4)	A-IV 1.4.1	RFees Art. 2(1) 3
- Period: within 6 months of date mention of the search report in the European Patent Bulletin	Rule 36(4)	A-IV 1.4.1	
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 search opinion	Rule 70a		See § 6.2.7

6.1.6 Date of filing

Article 80 and Rule 40 EPC

Topics	EPC	GL/EPO	Other references
Date of filing	Art. 80, Rule 40	A-II 4, 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	E.g.: name/address representative; fax number; PO box number; phone number
- Description or reference to a previously filed application	Rule 40(1)(c), 40(2), 40(3)	A-II 4.1(iii), 4.1.3.1, 4.1.4, A-III 3.2.1	
- Reference filing: certified copy of the previously filed application: two 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 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	
- Providing a translation of the previously filed application is not required for the accordance of a date of filing	[Rule 57(a), 58]	A-II 4.1.4	
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, EPO informs applicant and invites him to correct deficiencies (2 months)	Rule 57(c), 58	A-III 15	See § 6.1.10
- 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
- Indicated in application as published	Rule 68(4) 1 st sentence	A-VI 1.3	See § 7.1

Article 80 and Rule 40 EPC

Topics	EPC	GL/EPO	Other references
Legal effect of accordance of date of filing:			
- Determination of state of the art	Art. 54		
- First-to-file principle	Art. 60(2)		
- Application is equivalent with regular national filing	Art. 66		Art. 4A(2),(3) PC
- Application can be claimed as priority	Art. 87(1)		Art. 4A(1) PC

6.1.7 The Receiving section

Article 16 and Rule 10 EPC

Topics	EPC	GL/EPO	Other references
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(2)	A-III 3.2, A-VI 2.4	Also see § 7.5.1
- If the request for examination is filed before the European search report has been transmitted to the applicant, the examining division is responsible from the time when the EPO receives the indication under Rule 70(2)	Rule 10(3), 70(2)	A-VI 2.3	
- Categorical request for examination	Rule 10(4)	A-VI 2.3	

6.1.8 Examination on filing; accordance of date of filing

Article 90(1), (2), (4) and Rule 55 EPC

Topics	EPC	GL/EPO	Other references
Receiving section checks requirements for accordance of date of filing	Art. 90(1), (2); Rule 55 referring to: Rule 40(1)(a),(c), 40(2), 40(3), 1 st sentence	A-II 4	Note that Rule 55 does not refer to Rule 40(3), 2 nd sentence: see Rule 57(a)
Invitation to correct deficiencies	Art. 90(4), Rule 55	A-II 4.1.4, 4.1.5	
- No invitation for deficiency under Rule 40(1)(b): applicant can identify himself within two months of the date of receipt of the original documents	Rule 55 does <i>not</i> refer to Rule 40(1)(b)	A-II 4.1.4	
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	

6.1.9 Missing parts of the description or missing drawings

Rule 56 EPC

Topics	EPC	GL/EPO	Other references
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	Rule 56(3)	A-II 5.4	
- Missing parts are filed within the applicable time limit	Rule 56(3) → Rule 56(2)	A-II 5.4(ii), A-II 5.1, 5.2	
- Application claims priority	Rule 56(3)	A-II 5.4(ii), 5.4.1	
- Applicant requests that the late-filed parts be based on the claimed priority in order to avoid a change in the date of filing	Rule 56(3)	A-II 5.4(iii), 5.4.1	
- The late-filed parts of the description, or drawings, are 'completely contained' in the priority application	Rule 56(3)	A-II 5.4(iv), 5.4.2, B-XI 2.1, C-III 1.1.1	
- Applicant files copy of the priority application, unless available to the EPO	Rule 56(3)(a)	A-II 5.4(v), 5.4.3	
- Where required, the applicant files a translation of the priority application	Rule 56(3)(b)	A-II 5.4(vi), 5.4.4	
- Applicant indicates 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	
Review of requirement 'completely contained'	Rule 56(4), (5), (6)	A-II 5.4.2 → C-III 1	
- Search division checks: if requirements not fulfilled, search opinion contains warning		B-XI 2.1	Also see § 6.2.5
- Examining division may raise objection under Rule 56		C-III 1.1.1	Also see § 7.5.2
Withdrawal of late-filed missing parts	Rule 56(6) → Rule 56(2), (5)	A-II 5.5, C-III 1.1.1	
- This may also happen before the examining division		C-III 1.1.1	
Sufficiency of disclosure and Rule 56	[Art. 83]	F-III 10, C-III 1.1.1	See § 4.2

6.1.10 Examination of formal requirements

Article 90(3), (4) and Rules 57-60 EPC

Topics	EPC	GL/EPO	Other references
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), Rules 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 fee 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	
- Sequence listing	Rule 57(j), 30	A-IV 5	See § 6.1.12

6.1.11 Consequences if the deficiencies are not rectified in due time

Article 90(5) and Rules 57-58 EPC

Topics	EPC	GL/EPO	Other references
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	

Articles 90(5), 14(2) and Rules 57-58 EPC

Topics	EPC	GL/EPO	Other references
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	

Article 90(5) and Rule 59 EPC

Topics	EPC	GL/EPO	Other references
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	

Article 90(5) and Rule 60 EPC

Topics	EPC	GL/EPO	Other references
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	A-III 5.5	

Article 78(2) and Rules 45, 57 EPC

Topics	EPC	GL/EPO	Other references
Non-payment of the filing fee or the search fee	Art. 78(2), Rule 57(e)	A-III 13, 16.2(ix)	
- Remedy: further processing	Art. 121, Rule 135	A-III 13.1, 16.2	
Non-payment of claims fees	Rule 45	A-III 9, 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, 16.2	
Claims fees at grant of patent	Rule 71(4)	C-V 1.4	See § 7.5.6

6.1.12 Applications relating to nucleotide and amino acid sequences

Rule 30 EPC

Topics	EPC	GL/EPO	Other references
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 57(j), 30(3)	A-IV 5	
- Period: two months	Rule 30(3)	A-IV 5	
- Pay the late furnishing fee	Rule 30(3)	A-IV 5	RFees Art. 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	

6.1.13 Applications relating to biological material

Rules 26(3), 31-34 EPC

Topics	EPC	GL/EPO	Other references
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	
- Budapest Treaty		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 deposited biological material to expert only	Rule 33	A-IV 4.3	
- Requests for samples of biological material	Rule 33	A-IV 4.4	