

# Decision of the Administrative Council of 13 October 1999 amending the Implementing Regulations to the European Patent Convention and the Rules relating to Fees

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention ("EPC"), and in particular Article 33(1)(b) and (2)(d) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

## **Article 1**

Article 1 The Implementing Regulations to the EPC shall be amended as follows:

1. Rule 15(2) shall be amended to read as follows:

"(2) The filing fee and search fee shall be payable in respect of the new European patent application within one month after the filing thereof. The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new European patent application."

2. Rule 18 shall be amended to read as follows:

"Rule 18

Publication of the mention of the inventor

(1) The person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification, unless the said person informs the European Patent Office in writing that he waives his right to be thus mentioned.

(2) In the event of a third party filing with the European Patent Office a final decision whereby the applicant for or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph 1 shall apply."

3. Rule 25(2) shall be amended to read as follows:

"(2) The filing fee and search fee shall be payable in respect of a European divisional application within one month after the filing thereof. The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application."

4. Rule 38(3) to (6) shall be amended to read as follows:

"(3) The copy of the previous application must be filed before the end of the sixteenth month after the date of priority. The copy must be certified as an exact copy of the previous application

by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application.

(4) The copy of the previous application shall be deemed duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions laid down by the President of the European Patent Office.

(5) The translation of the previous application required under Article 88, paragraph 1, must be filed within a time limit to be set by the European Patent Office but at the latest within the time limit under Rule 51, paragraph 6. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 4 shall apply *mutatis mutandis*.

(6) The particulars stated in the declaration of priority shall appear in the published European patent application and also on the European patent specification."

5. Rule 85a(1) shall be amended to read as follows:

"If the filing fee, the search fee, a designation fee or the national basic fee have not been paid within the time limits provided for in Article 78, paragraph 2, Article 79, paragraph 2, Rule 15, paragraph 2, Rule 25, paragraph 2, or Rule 107, paragraph 1(c), (d) and (e), they may still be validly paid within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid."

6. Rule 85b shall be amended to read as follows:

"If the request for examination has not been filed within the time limit provided for in Article 94, paragraph 2, or Rule 107, paragraph 1(f), it may still be validly filed within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid."

7. Rule 92(1)(g) shall be amended to read as follows:

"(g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 18, paragraph 1;"

8. Rule 93(c) shall be amended to read as follows:

"(c) the designation of the inventor, if he has waived his right to be mentioned under Rule 18, paragraph 1;"

9. The heading to Part VIII shall be amended to read as follows:

"PART VIII  
IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION".

10. After Rule 103, a new Part IX shall be added, containing Rules 104 to 112 and with the following heading:

"PART IX  
IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION".

11. Existing Rule 104a shall become Rule 105.

12. Existing Rules 104b to 106a shall be replaced by the following new Rules 106 to 112:

### *Rule 106*

#### The national fee

The national fee provided for in Article 158, paragraph 2, shall comprise the following fees:

- (a) a national basic fee equal to the filing fee provided for in Article 78, paragraph 2, and
- (b) the designation fees provided for in Article 79, paragraph 2.

### *Rule 107*

The European Patent Office as a designated or elected Office

(1) In the case of an international application as referred to in Article 150, paragraph 3, the applicant must perform the following acts within a period of twenty-one months, where Article 22, paragraphs 1 and 2, of the Cooperation Treaty apply, or thirty-one months where Article 39, paragraph 1(a), of the Cooperation Treaty applies, from the date of filing of the application, or, if priority has been claimed, from the priority date:

- (a) supply, where applicable, the translation of the international application required under Article 158, paragraph 2;
  - (b) specify the application documents, as originally filed or in amended form, on which the European grant procedure is to be based;
  - (c) pay the national basic fee provided for in Rule 106(a);
  - (d) pay the designation fees if the time limit specified in Article 79, paragraph 2, has expired earlier;
  - (e) pay the search fee provided for in Article 157, paragraph 2(b), where a supplementary European search report has to be drawn up;
  - (f) file the request for examination provided for in Article 94, if the time limit specified in Article 94, paragraph 2, has expired earlier;
  - (g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 37, paragraph 1;
  - (h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 23.
- (2) Where the European Patent Office has drawn up an international preliminary examination report the examination fee shall be reduced as laid down in the Rules relating to Fees. If the report was established on certain parts of the international application in accordance with Article 34, paragraph 3(c), of the Cooperation Treaty, the reduction shall be allowed only if examination is to be performed on the subject-matter covered by the report.

### *Rule 108*

#### Consequence of non-payment of the national fee

- (1) If the national basic fee is not paid in due time, the European patent application shall be deemed to be withdrawn.
- (2) The designation of any Contracting State in respect of which the designation fee has not been paid in due time shall be deemed to be withdrawn.

### *Rule 109*

## Amendment of the application

Without prejudice to Rule 86, paragraphs 2 to 4, the application may be amended once, within a non-extendable period of one month as from notification of a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 157, paragraph 2.

### *Rule 110*

#### Claims incurring fees

#### Consequence of non-payment

(1) If the application documents on which the European grant procedure is to be based comprise more than ten claims, a claims fee shall be payable for the eleventh and each subsequent claim within the period provided for in Rule 107, paragraph 1.

(2) Any claims fees not paid in due time may still be validly paid within a non-extendable period of grace of one month as from notification of a communication pointing out the failure to pay. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims.

(3) Any claims fees paid within the period provided for in paragraph 1 and which are in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned.

### *Rule 111*

#### Examination of certain formal requirements by the European Patent Office

(1) If the data concerning the inventor prescribed in Rule 17, paragraph 1, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the data within such period as it shall specify.

(2) Where the priority of an earlier application is claimed and the file number or copy provided for in Article 88, paragraph 1, and Rule 38, paragraphs 1 to 3, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the number or copy of the earlier application within such period as it shall specify. Rule 38, paragraph 4, shall apply.

(3) If at the expiry of the period provided for in Rule 107, paragraph 1, a sequence listing as prescribed in Rule 5.2 of the Regulations under the Cooperation Treaty is not available to the European Patent Office, or does not conform to the prescribed standard, or has not been filed on the prescribed data carrier, the applicant shall be invited to file a sequence listing conforming to the prescribed standard or on the prescribed data carrier within such period as the European Patent Office shall specify.

### *Rule 112*

#### Consideration of unity by the European Patent Office

If only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the

international application which have not been searched if a search fee is paid for each invention involved within a period specified by the European Patent Office which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up a European search report for those parts of the international application which relate to inventions in respect of which search fees have been paid. Rule 46, paragraph 2, shall apply mutatis mutandis."

## Article 2

1. Article 2, items 1, 2, 15, 19 and 21 of the Rules relating to Fees shall be amended to read as follows:

	<b>EUR</b>
"1. Filing fee (Article 78, paragraph 2); national basic fee (Rule 106(a))	127
2. Search fee in respect of	
- a European or supplementary European search (Article 78, paragraph 2, Rules 46, paragraph 1, and 112, Article 157, paragraph 2(b))	690
- an international search (Rule 16.1 PCT and Rule 105, paragraph 1)	945
15. Claims fee for the eleventh and each subsequent claim (Rules 31, paragraph 1, 51, paragraph 7, and 110, paragraph 1)	40
19. Fee for the preliminary examination of an international application (Rule 58 PCT and Rule 105, paragraph 2)	1533
21. Protest fee (Rules 40.2(e) and 68.3(e) PCT, Rule 105, paragraph 3)	1022".

2. In Article 12(2) of the Rules relating to Fees the reference to Rule 104b, paragraph 6, shall be replaced by a reference to Rule 107, paragraph 2.

## Article 3

The present decision shall enter into force on 1 March 2000.

## **Article 4**

The following transitional provisions shall apply:

1. Rules 15(2) and 25(2) as amended shall apply to all European patent applications in respect of which, on 1 March 2000, the designation fees have not been validly paid and the time limit under existing Rules 15(2) and 25(2) for paying them has not yet expired.
2. Rule 107(1)(d) shall apply to all international applications in respect of which, on 1 March 2000, the designation fees have not been validly paid and the time limit under Rule 104b(1)(b) (ii) for paying them has not yet expired.
3. Rules 109 and 110 shall apply to all international applications in respect of which, on 1 March 2000, all the acts provided for in Rule 104b(1) have not been performed and the period for doing so has not yet expired.

Done at Munich, 13 October 1999

For the Administrative Council  
The Chairman

*Sean FITZPATRICK*