

epi-CEIPI STUDY GUIDE

**Structure of the epi-CEIPI Modules
with references and key topics relating to:**

- **the EPC, PCT and Paris Convention,**
- **the Unitary Patent Regulations and UPC Agreement**

April 2023



MODULES

| SUBSTANTIVE LAW | | | | |
|-------------------|--|--------------------|---|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| A | General Introduction | | | |
| A1 1h | Introduction to intellectual property law | | <ul style="list-style-type: none"> • Intellectual property rights <ul style="list-style-type: none"> - Copyrights - Trademarks - Patents - Industrial designs - Trade secrets • Economic growth | |
| A2 0.5h | The patent and other rights to protect inventions | | | |
| A3 1h | History of patent law | | <ul style="list-style-type: none"> • From Venetian patent ordinance to a unitary patent in the EU | |
| A4 0.5h | The international patent conventions | | <ul style="list-style-type: none"> • Paris Convention <ul style="list-style-type: none"> - National Treatment • 1963 Strasbourg Convention • European Patent Convention • TRIPs Agreement • Patent Law Treaty • UP Reg 1257, 1260 and UPCA *) | <ul style="list-style-type: none"> • Patent Cooperation Treaty |

*) Reg 1257 = Regulation (EU) No 1257/2012 of the European Parliament and of the Council implementing enhanced cooperation in the area of the creation of unitary patent protection (17 December 2012)

UPR = Rules relating to Unitary Patent Protection (15 December 2015)

RFees UPP = Rules relating to Fees (15 December 2015)

Reg 1260 = Council Regulation (EU) No 1260/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (17 December 2012)

UPCA = UPC Agreement = Agreement on a Unified Patent Court (19 February 2013)

| SUBSTANTIVE LAW | | | | |
|------------------------|--|---|---|--|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| B | Introduction to European Patent Law | | | |
| B1 1h | Introduction to the EPC | Preamble, Art. 1, 2, 3, 142(1), 164, 166, 172 EPC | <ul style="list-style-type: none"> • Relationship Paris > PCT > EPC > CPC > UP • EPC as a multilateral treaty • Autonomous legal system for granting European patents • Bundle of European patents • Accession to the EPC • Revision of the EPC (1991, 2000) <ul style="list-style-type: none"> – Transitional provisions • Overview from filing to grant • Overview post-grant proceedings • Unitary effect | |
| B2 1h | Introduction to the PCT | PCT Art. 1, 45, 64; Rules 81, 88, 89 | | <ul style="list-style-type: none"> • International applications • Regional patent treaties • Overview: filing, search, publication and preliminary examination • Overview: entry in national/regional phase • Amendment of the PCT <ul style="list-style-type: none"> – Modification of the PCT (2001): time limit in Art. 22(1) from 20 to 30 months – Reservations |
| B3 1h | Interpretation of provisions of the EPC and PCT | Preamble, Art. 150(2), 164, 177 EPC Vienna Convention Art. 31-32 PCT Art. 67(1) | <ul style="list-style-type: none"> • Rules for interpretation • Vienna Convention <ul style="list-style-type: none"> – Good faith • Languages of the Convention | Equally authentic texts of the Patent Cooperation Treaty |

| SUBSTANTIVE LAW | | | | |
|-----------------|--------------------------|---|---|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| B4 3h | Institutional provisions | Art. 4,13, 15-24, 25, 26-50, , 169, 170, 171,176, 178 EPC Rules 8-13 EPC Protocol on Centralisation Protocol on Privileges and Immunities Protocol on the Staff Complement <i>[PCT Art. 2, 16, 32, 53, 55, 58; Rule 2] *)</i> Art. 9(1) first sentence, 9(2) Reg 1257; Rules 2-4 UPR | <ul style="list-style-type: none"> • European Patent Organisation (EPOrg) <ul style="list-style-type: none"> - Administrative Council and its competence - European Patent Office (EPO) • Departments of the EPO and their responsibilities <ul style="list-style-type: none"> - Delegation to formalities officers - Technical opinion • Independence of the boards of appeal <ul style="list-style-type: none"> - Exclusion and objection - Partiality in departments of first instance • Financial provisions | <ul style="list-style-type: none"> • Union • Assembly • Definitions <ul style="list-style-type: none"> - Regional patent - Priority period - National Office - Receiving Office (rO) - International Bureau (IB) - International searching authority (ISA) - International preliminary examination authority (IPEA) - Designated/elected Office (dO/eO) |

*) References to the PCT in square brackets indicate crosslinks between the topic of the EPC module and the PCT. They can be used to put the topic in a broader context.

| SUBSTANTIVE LAW | | | | |
|------------------------|-----------------------------------|---|---|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| B5 3h | Languages and translations | Art. 14, 65, 70 EPC Rules 3-7, 36(2), 40(3) EPC <i>[PCT Rules 12, 19.4(a)(ii), 48.3]</i> Art. 9(1)(f)(g)(h) Reg 1257; Art. 2(b), 3(2), 5, 6(1)(2) Reg 1260; Rules 8-11 and 20 UPR | <ul style="list-style-type: none"> • Official languages of the EPO • Filing a European patent application and translation • Language of application filed by reference • Language of divisional application • Language of the proceedings • Filing further documents and translations • Fee reduction • Publications of the EPO • Entries in the European Patent Register • Languages in written and oral proceedings • Language of publication of the European patent application and patent • Authentic text of the application or patent <p>Unitary patent:</p> <ul style="list-style-type: none"> • Language provisions • Translation in transitional period • Compensation scheme <ul style="list-style-type: none"> – Comparison with filing fee reduction | Basic language provisions in the PCT <ul style="list-style-type: none"> • Filing the international application <ul style="list-style-type: none"> – Filing in language not accepted by rO • Languages of publication • Translation for international search • Translation for international publication |

| SUBSTANTIVE LAW | | | | |
|-----------------|---|--|--|--|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| B6 3h | Representation before the EPO and under the PCT | Art. 133-134a EPC Rules 151-154, 130 EPC Regulation on the European qualifying examination for professional representatives, Art. 11 PCT Art. 27(7), 49, Rules 83.1, 90 R.20 UPR and application <i>mutatis mutandis</i> of Art. 133 and 134(1),(5),(8) and Rule 151-153 EPC; Art. 48 UPCA | <ul style="list-style-type: none"> • Actors before the EPO <ul style="list-style-type: none"> – Applicant/proprietor/opponent – Professional representative – Employee • Compulsory representation for non-resident applicants • Institute of Professional Representatives <ul style="list-style-type: none"> – Disciplinary power – Attorney evidentiary privilege • Appointment and authorisation of representative • Common representative • Accompanying persons in oral proceedings • Conditions for registration and enrolment for the EQE <p>Unitary patent:</p> <ul style="list-style-type: none"> • Representation for UP before the EPO • Representation by European patent attorneys before the UPC | <ul style="list-style-type: none"> • Actors in the PCT: <ul style="list-style-type: none"> – Applicant – Common representative – Agent • RO may require that applicant be represented by an agent • Who can represent before which authority • Appointment and authorisation |

| SUBSTANTIVE LAW | | | | |
|-----------------|---|---|---|--|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| C | Patentability | | | |
| C1 3h | Patentable and non-patentable inventions; industrial application | Art. 52, 57 EPC Rule 42(1)(f) EPC Art. 27 TRIPs Agreement [PCT Art. 33(4)] | <ul style="list-style-type: none"> • Patentable inventions • Definition of invention • Technical character <ul style="list-style-type: none"> - Contribution approach • Discoveries; aesthetic creations; presentations of information • Mathematical methods • Computer programs • Methods of doing business <ul style="list-style-type: none"> - Exclusion of subject-matter "as such" • Industrial application <ul style="list-style-type: none"> - Industry - Manufacturability - Gene sequences | Industrial application |
| C2 4h | State of the art | Art. 54(2), (3), 55, 89 EPC Rule 25 EPC Art. 153(3), (4), (5) EPC Rule 165 EPC [PCT Art. 15(2), Rules 33, 64] | <ul style="list-style-type: none"> • State of the art • Admissible prior art <ul style="list-style-type: none"> - Availability <ul style="list-style-type: none"> o Public o Secrecy - Means of disclosure - when available <ul style="list-style-type: none"> o Oral disclosure o Internet disclosure o Public prior use o Accessibility and analysability - Disclosure: explicit - implicit -enabling • European prior rights • Effect of priority date • Non-prejudicial disclosures <ul style="list-style-type: none"> - Evident abuse - International exhibition and certificate | <ul style="list-style-type: none"> • Prior art for: <ul style="list-style-type: none"> - International search • International application becoming Art. 54(3) EPC prior art in the regional phase before the EPO |

| SUBSTANTIVE LAW | | | | |
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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| C3 2h | Novelty | Art. 54(1) EPC <i>[PCT Art. 33(2); Rule 43bis.1(a)(i)]</i> | <ul style="list-style-type: none"> • Single disclosure • Conformance of all features • Multiple embodiments • Optional, use features • Genus - species • Selection inventions • Method versus use claims • Disclaimers | Written opinion of ISA: novelty |
| C4 3h | Exceptions to patentability; medical uses | Art. 53, 54(4), (5) EPC Rules 26-29 EPC <i>[PCT Rules 39, 67]</i> | <p>Exceptions to patentability</p> <ul style="list-style-type: none"> - Ordre public and morality - Plant and animal varieties - Methods for treatment of the human or animal body <ul style="list-style-type: none"> o Treatment by surgery o Treatment by therapy o Diagnostic methods - Disclaimers <ul style="list-style-type: none"> • First medical use • Second medical use • Biological processes and products thereof • Gene sequences | |
| C5 2×3h | Inventive step | Art. 56 EPC <i>[PCT Art. 33(3); Rule 43bis.1(a)(i)]</i> | <ul style="list-style-type: none"> • Person skilled in the art • Common general knowledge • Technical field • Problem-solution approach • Combining teachings • Secondary indications • Partial problems • Surprising effect • Non-technical feature • Chemical claims • Inventive step attack and defence | Written opinion of ISA: inventive step |

| SUBSTANTIVE LAW | | | | |
|-----------------|---------------------------|--|---|-----------------------------------|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| C6 2×3h | Unity; disclosure; claims | Art. 82-84 EPC Rules 30-34, 42-44 EPC <i>[PCT Art. 3(4)(iii), Rule 13]</i> | <ul style="list-style-type: none"> • Unity of invention <ul style="list-style-type: none"> - Special technical features - Markush grouping • Disclosure <ul style="list-style-type: none"> - Clear and complete disclosure - Sufficiency of disclosure - Functional formulation - Repeatability • Claims <ul style="list-style-type: none"> - Clear; concise; supported by description - Form of claims - Claim categories - Independent / dependent claims - Disclaimers - Product-by-process claims - Use features | Requirement of unity of invention |

| SUBSTANTIVE LAW | | | | |
|---------------------------|---|--|--|--|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| <p>C7 2×3h</p> | <p>Priority: Paris Convention, EPC and PCT</p> | <p>Preamble, Art. 87-89 EPC</p> <p>Rules 52-54 EPC</p> <p>Paris Convention Art.4</p> <p>PCT Art. 8; Rules 4.10(a), 17, 21.2, 26bis, 49ter, 90bis.3</p> | <ul style="list-style-type: none"> • Paris Convention • Priority under the EPC <ul style="list-style-type: none"> – Duly filed application – Paris Convention State or WTO member – Person or his successor in title – Transfer of priority right – The same invention - disclosure test – "First" application – Outcome of priority application – Subsequent application becoming a first application • Claiming priority <ul style="list-style-type: none"> – Multiple priorities – Effective dates of claims – Disclosure in "previous application as a whole", specific disclosure • Declaration of priority <ul style="list-style-type: none"> – Addition and correction of priority claim • Priority document <ul style="list-style-type: none"> – Filing of the priority document – WIPO Digital Access Service – Translation of priority document • Re-establishment of rights in the priority period • Effect of priority right | <p>Priority under the PCT</p> <ul style="list-style-type: none"> • Reference to Paris Convention • Priority claim in or for WTO member • Claiming priority • Priority document <ul style="list-style-type: none"> – Request rO to transmit the priority document to the IB – WIPO Digital Access Service (DAS) • Correction or addition of priority claim • Restoration of right of priority by the rO and effect before dOs • Restoration of right of priority by the dO • Withdrawal of priority claim and effect |

| SUBSTANTIVE LAW | | | | |
|------------------------|---|---|--|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| D | Right to the European Patent | | | |
| D1 0.5h | Designation of the inventor | Art. 62, 81 EPC Rules 19-21 EPC <i>[PCT Art 4(1)(v), Rules 4.1(a)(iv), 4.6, 92bis.1(a)(ii)]</i> | <ul style="list-style-type: none"> • Right to be mentioned as inventor <ul style="list-style-type: none"> – Inventor is person with legal capacity • Rectification of designation inventor • Publication of mention inventor • Waiver of right to be mentioned | Designation of the inventor in the PCT <ul style="list-style-type: none"> • Rectification of designation inventor • <i>No</i> waiver of right to be mentioned |
| D2 1h | Right to file; entitlement to the patent | Art. 58-60 EPC <i>[PCT Art 9, Rules 18, 19]</i> | <ul style="list-style-type: none"> • Inventor and applicant <ul style="list-style-type: none"> – Multiple applicants • First-to-file principle | Right to file an international application <ul style="list-style-type: none"> • Who can file • Competent rO • Two or more applicants |
| D3 1.5h | Entitlement proceedings | Art. 61 EPC Rules 14-18, 78 EPC Protocol on Recognition | <ul style="list-style-type: none"> • Stay of proceedings • Recognition of entitlement decisions <ul style="list-style-type: none"> – Only for applicants – Final decision • Actions after decision of national court <ul style="list-style-type: none"> – Time limit (and means of redress) – Differences between Art. 61(1)(b) application and divisional application – Possible reasons for requesting refusal | <i>No</i> entitlement proceedings in the PCT |

| SUBSTANTIVE LAW | | | | |
|-----------------|---|---|--|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| E | Rights conferred by the European Patent and by the Application | | | |
| E1 1h | Rights conferred by the European Patent | Art. 2(2), 63-65, 68, 70 EPC London Agreement on the Application of Art.65 EPC Paris Convention Art. 5 <i>quater</i> Art. 3, 4(1), 5, 6, (7), 15 Reg 1257; Art. 3(1), 4 Reg 1260; Art. 24-30 UPCA | <ul style="list-style-type: none"> • European Patent <ul style="list-style-type: none"> - Term of the patent - Rights conferred by the patent <ul style="list-style-type: none"> ○ Protection of product directly obtained by process - London Agreement - Effect of revocation or limitation - Authentic text of patent - Effect of narrow translation • Unitary Patent <ul style="list-style-type: none"> - Reference to national law - Harmonisation through UPC Agreement] | |
| E2 1h | Protection conferred by the application | Art. 66, 67, 69(2), 70 EPC [PCT Art 11(4), 29; EPC Art. 152(2), (3), (4)] | <ul style="list-style-type: none"> • European filing with date of filing is equivalent to regular national filing • Provisional protection by publication of the application | <ul style="list-style-type: none"> • International application with international filing date is equivalent to regional national filing • Provisional protection after publication of international application |
| E3 0.5h | Interpretation of the patent (application) | Art. 69 EPC Protocol on the interpretation of Art.69 EPC Strasbourg Convention Art. 8(3) | <ul style="list-style-type: none"> • Extent of protection determined by the claims • Equivalents | |
| E4 0.5h | Infringement and sanctions | Art. 2(2), 64(3) EPC [TRIPS Part III] | <ul style="list-style-type: none"> • Infringement and sanctions <ul style="list-style-type: none"> - National law - Scope of protection | |

| SUBSTANTIVE LAW | | | | |
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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| F | The European Patent and Application as Object of Property | | | |
| F 3h | Transfer and constitution of rights; assignment and licences | Art. 71-74 EPC Rules 22-24, 85 EPC <i>[PCT Rule 92bis(a)(i); PCT AG-IP 11.102-108]</i> Art. 3(2) third §, 7, 8, 9(1)(c) Reg 1257; Rule 12 UPR and Rule 20 with application <i>mutatis mutandis</i> | <ul style="list-style-type: none"> • Registering a transfer of a European patent application • Assignment of patent application • Licenses <ul style="list-style-type: none"> – Exclusive licence – Sub-licence • Law applicable <ul style="list-style-type: none"> – European patent and application Unitary patent: <ul style="list-style-type: none"> • Applicable law • Registering transfers of unitary patents, licences and other rights | <ul style="list-style-type: none"> • Recording of changes in indication of the applicant • Licensing indications |
| G | Information from the EPO/WIPO | | | |
| G1 1h | Information to the public | Art. 128 EPC Rules 143-147 EPC <i>[PCT Art. 30, 38, 50; Rules 93,94]</i> | <ul style="list-style-type: none"> • File inspection <ul style="list-style-type: none"> – Parts not open for file inspection – Electronic file inspection – Espacenet | <ul style="list-style-type: none"> • Patentscope • Confidential nature of international application • Confidential nature of international examination • Access to files held by international authorities |
| G2 1h | Register of European patents | Art. 127, 14(8), 20 EPC Rule 143 EPC Art. 2(e), 9(b)(h) Reg 1257; Rules 15-16 UPR | <ul style="list-style-type: none"> • European Patent Register <ul style="list-style-type: none"> – Entries in the Register – Languages – Competence Legal Division – Unitary Patent Register | |

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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| G3 0.5h | Periodical publications | Art. 129, 14(7) EPC <i>[PCT Art. 55(4); Rule 86]</i> Rule 17 UPR | <ul style="list-style-type: none"> • European Patent Bulletin • Official Journal of the EPO | PCT Gazette |
| G4 0.5h | Exchanges of information between authorities | Art. 130, 131(1), 132 EPC Rules 148-149 EPC Art. 131(2) EPC Rule 150 EPC <i>[PCT Art. 13; Rule 87]</i> | <ul style="list-style-type: none"> • Exchange of information and publications between the EPO and central industrial property offices and inter-governmental organisations • Legal cooperation between the EPO and courts or national authorities | <ul style="list-style-type: none"> • Availability of copy of international application to dOs • Communication by IB of publications |

| PROCEDURAL LAW | | | | |
|-----------------|---|--|---|--|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H | Procedure | | | |
| H1 1h | General introduction to the procedure before the EPO and under the PCT | | <ul style="list-style-type: none"> • Substantive law versus procedural law • Overview EPC procedure • Overview of unitary patent procedure | Overview PCT procedure |
| H2 2h | The European patent application | Art. 78, 79, 85, 118 EPC Rules 41-43, 45-50 EPC <i>[PCT Art. 3-7; Rules 3, 5-8, 14-16]</i> | <ul style="list-style-type: none"> • Content European patent application • Filing, search and page fee • Request-for-grant (EPO Form 1001) • Claims fees • Drawings • Abstract • Prohibited matter | <ul style="list-style-type: none"> • Content international application • Transmittal fee, international filing fee and search fee • PCT Request (Form PCT/RO/101) |

| PROCEDURAL LAW | | | | |
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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H3 2x3h | Filing the application; accordance of a date of filing and formalities examination | Art. 75-77, 90(1), (2), (4) EPC Rules 1-2, 25, 31-34, 35-40, 55-57 EPC <i>[PCT Art. 3-7; Rules 3, 5-8, 14-16, 19.4(a)(i); PCT Art. 11; Rule 20]</i> | <ul style="list-style-type: none"> • Filing a European patent application <ul style="list-style-type: none"> - Where to file <ul style="list-style-type: none"> o EPO filing offices o National offices - Why/how to file - Filing a divisional application <ul style="list-style-type: none"> o Filing, search and 'divisional' fee • Accordance of date of filing <ul style="list-style-type: none"> - Invitation to correct deficiencies - Consequences • Missing parts of description or missing drawings <ul style="list-style-type: none"> - Re-dating of the application - Missing parts based on priority - Consequence of non-compliance | <ul style="list-style-type: none"> • Filing of international application <ul style="list-style-type: none"> - Filing at non-competent rO • Accordance of the international filing date <ul style="list-style-type: none"> - Filing missing parts and missing elements - Correction of erroneously filed elements and parts • No provision for filing divisional application in the international phase |
| | | Art. 80, 90(3), (4), (5) EPC Rules 57-60 EPC <i>[PCT Art. 14; Rule 26]</i> | <ul style="list-style-type: none"> • Examination as to formal requirements <ul style="list-style-type: none"> - Translation of the application - Request for grant - Claims - Abstract - Filing and search fee - Designation of inventor - Priority claim and documents - Representation - Drawings - Physical requirements - Sequence listing • When does loss of rights ensue? • Requirements for further documents | <ul style="list-style-type: none"> • Formalities examination by rO • Transmittal of the international application by the rO to the IB and ISA |

| PROCEDURAL LAW | | | | |
|----------------|---|---|--|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H4 2h | Search, search opinion and search report | Art. 92 EPC Rules 61-66 EPC <i>[PCT Art. 15-18; Rules 35-38, 40, 43, 43bis, 44, 44bis, 45]</i> | <ul style="list-style-type: none"> • Basis of the European search • Start of the search <ul style="list-style-type: none"> – Refund of the search fee • Extended European search report <ul style="list-style-type: none"> – European search report – Search opinion – Transmittal to applicant • Multiple independent claims during search • Incomplete search <ul style="list-style-type: none"> – Statement indicating subject-matter to be searched – Consequence of non-compliance • Lack of unity <ul style="list-style-type: none"> – Partial search report + search opinion – Invitation to pay further search fee • Definitive content of the abstract • Legal effect of publication of search report | International search <ul style="list-style-type: none"> • International Searching Authority (ISA) • Lack of unity of invention before ISA • Missing or defective title or abstract • International search report (ISR) • Written opinion of the ISA (WO-ISA) • Transmittal of ISR to IB and applicant • International Preliminary Report on Patentability (= IPRP (Chapter I)) • Translation of the ISR |
| H5 1h | Publication of the patent application | Art. 93, 115 EPC Rules 67-69, 114 EPC <i>[PCT Art. 21, 29; Rules 48, 90bis.1; PCT AG-IP 11.109-117]</i> | <ul style="list-style-type: none"> • When is the patent application published? <ul style="list-style-type: none"> – Content and form of publication – Types of publication – Technical preparations • Information about publication • Withdrawal of the application • Deferred publication • Invalid publication • Legal effect of publication • Third party observations | <ul style="list-style-type: none"> • International publication <ul style="list-style-type: none"> – Withdrawal of the international application – Technical preparations – Provisional protection after publication of the international application • Third party observations |

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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H6 3h | Designation of States; Request for examination and substantive examination | Art. 79, 94, 124 EPC Rules 39, 70-70b, 71(1)-(2), 141 EPC <i>[PCT Art. 4(1)(ii), 4(2); Rules 4.9, 27.1; PCT Art. 31-37; Rules 53-55, 57-61, 66, 68.1, 68.2, 68.3(a)(b), 69, 70, 71-73]</i> | <ul style="list-style-type: none"> • Designation of States <ul style="list-style-type: none"> - How to designate - Withdrawal of designations - Designation fee - Extension fees - Validation fees • Request for examination <ul style="list-style-type: none"> - When to file the request for examination - Examination fee - Effect of non-payment - Refund of the examination fee • Response to search opinion <ul style="list-style-type: none"> - Compulsory response - Consequence of non-compliance • Invitation to provide information on: <ul style="list-style-type: none"> - Search results of priority application - Prior art • PACE • Enquiry as to the processing of the file • Substantive examination <ul style="list-style-type: none"> - Reasoned objections examiner - Response from applicant - Auxiliary requests | <ul style="list-style-type: none"> • Designation of States <ul style="list-style-type: none"> - 'Designation fee' has been incorporated in the international filing fee • International preliminary examination <ul style="list-style-type: none"> - Demand - Payment of handling fee and preliminary examination fee - International preliminary examining authority (IPEA) - Lack of unity of invention before IPEA - Written opinion of the IPEA - International Preliminary Report on Patentability (= IPRP (Chapter II)) - Transmittal of the Report to IB and applicant - Translation of the Report |
| H7 3h | Amendments and correction of errors | Art. 123 EPC Rules 137, 139-140 EPC <i>[PCT Art. 19, Rule 46; PCT Art. 34(2)(b); Rule 66.1(b); PCT Art. 28; Rules 52, 78, 91]</i> | <ul style="list-style-type: none"> • Amendments <ul style="list-style-type: none"> - Opportunity - Own volition - Indication of basis of amendment - Lack of unity - No extension of subject-matter - Admissibility, allowability - Disclaimers - Amendment during opposition • Corrections <ul style="list-style-type: none"> - Rule 139, first sentence <ul style="list-style-type: none"> o Late correction of priority claim - Rule 139, second sentence <ul style="list-style-type: none"> o Immediately evident - Errors in decisions | <ul style="list-style-type: none"> • Filing of: <ul style="list-style-type: none"> - amended claims before the IB after receiving ISR - amendments before the IPEA - amendments before dOs or eO • Rectification of obvious mistakes in documents |

| PROCEDURAL LAW | | | | |
|----------------|---|--|--|---------------------------|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H8 3h | Decision to grant the European patent or to refuse the patent application | Art. 97, 98 EPC Rules 71(3)-(7), 71a-74 EPC | <ul style="list-style-type: none"> • Grant <ul style="list-style-type: none"> - Approval of the text - Bibliographic data - Amendments or corrections <ul style="list-style-type: none"> o Amendments by examining division o Adaptation of description to claims - Crediting of fees - Technical preparations and form of publication - Mention of grant - Patent specification - Effects of grant - Double patenting • Refusal of the patent application <ul style="list-style-type: none"> - Reasoned decision - Possibility of filing appeal | No grant of patent in PCT |

| PROCEDURAL LAW | | | | |
|----------------|---|--|--|--------------------|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H9 2x3h | Opposition; request for limitation or revocation | Art. 99-105, 105a-105c, 123(3) EPC Rules 75, 76-87, 88, 89, 90-96 EPC | <ul style="list-style-type: none"> • Notice of opposition <ul style="list-style-type: none"> - Who may file? - Where to file? - Language - Payment opposition fee <ul style="list-style-type: none"> o Refund of opposition fee - Parties to opposition proceedings <ul style="list-style-type: none"> o <i>Inter-partes</i> proceedings • Extent of opposition • Grounds for opposition <ul style="list-style-type: none"> - Separate grounds • Indication of facts and evidence • Transfer of status as opponent • Early certainty from opposition • Examination of opposition <ul style="list-style-type: none"> - Notice of opposition deemed to have been filed - Admissibility of opposition - Substantive examination of opposition • Decision in opposition proceedings <ul style="list-style-type: none"> - Rejection of the opposition - Revocation of the patent - Patent maintained in amended form - Interlocutory decision • Continuation of own motion • New specification • Apportionment of costs | |
| | | | <ul style="list-style-type: none"> • Intervention <ul style="list-style-type: none"> - Payment opposition fee - Treated as opposition - In appeal proceedings | |

| PROCEDURAL LAW | | | | |
|----------------|---------------------------------------|--|---|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| | | | <ul style="list-style-type: none"> • Limitation/revocation procedure <ul style="list-style-type: none"> – Subject of proceedings – Competence of the examining division – Requirements of the request for limitation or revocation – Precedence of opposition proceedings – Decision on the request for limitation or revocation – Publication of the amended specification of the European patent | |
| H10 3h | Appeal and petition for Review | Art. 21, 22, 23, 106-112, 112a EPC Rules 97-103, 104-110 EPC Rules of Procedure of the Boards of Appeal, Art. 12-15 <i>[PCT Rules 40.2(c) to I and 68.3(c) I(e); GL/PCT-EPO B-VII 7]</i> Art. 9(3) Reg 1257: Art. 32(1)(i) UPCA | <ul style="list-style-type: none"> • Appealable decisions • Suspensive effect • Who is entitled to appeal? <ul style="list-style-type: none"> – Adversely affected party – Parties to appeal proceedings • Prohibition of <i>reformatio in peius</i> • Termination of appeal • Notice of appeal <ul style="list-style-type: none"> – What to file – Where to file – Appeal fee • Statement setting out grounds for appeal • Interlocutory revision • Assessment of appeal <ul style="list-style-type: none"> – Notice of appeal deemed to have been filed – Admissibility of appeal – Substantive examination of appeal • Decision of board of appeal <ul style="list-style-type: none"> – Binding nature • Reimbursement of the appeal fee <ul style="list-style-type: none"> – Appeal deemed not to have been filed – Substantial procedural violation – Withdrawal of the appeal • Rules of Procedure of the Boards of Appeal • How to appeal decisions of the EPO relating to unitary patent protection | Protest against non-unity finding of ISA <ul style="list-style-type: none"> • Payment of protest fee <ul style="list-style-type: none"> – Protest fee refunded if protest entirely successful • Review body constituted in framework of ISA <ul style="list-style-type: none"> – EPO: three-member Review Panel |

| PROCEDURAL LAW | | | | |
|----------------|--|--|---|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| | | | <ul style="list-style-type: none"> • Enlarged Board of Appeal <ul style="list-style-type: none"> - Referral by board of appeal: Decision <ul style="list-style-type: none"> ○ Binding nature - Referral by EPO President: Opinion • Petition for Review by the Enlarged Board of Appeal <ul style="list-style-type: none"> - Fundamental procedural defects - Obligation to raise objections during appeal proceedings - Contents of the petition for review - Examination of the petition - Procedure - Reimbursement of the fee for petition | |
| H11 3h | Common provisions governing procedure | Art. 113-119, 125 EPC Rules 4, 111, 113, 114, 115-116, 117-124, 125-130 EPC <i>[PCT Rule 80.6]</i> | <ul style="list-style-type: none"> • Decisions <ul style="list-style-type: none"> - Right to be heard - Text agreed by applicant/proprietor • Examination by the EPO of its own motion • Observations by third parties • Oral proceedings <ul style="list-style-type: none"> - Video conference - Handwritten amendments • Taking of evidence • Unity of application/patent • Notification (10-day rule → 7-day rule) <ul style="list-style-type: none"> - Postal services - Means of electronic communication • Reference to general principles | 7-day rule for late delivery of documents |
| H12 3h | Periods | Art. 120, 51(2) EPC Rules 131-134, 78(1), 142 EPC J 4/91 <i>[PCT Art. 47, 48(1); Rules 79-80, 82, 82quater]</i> | <ul style="list-style-type: none"> • Periods <ul style="list-style-type: none"> - Calculation of periods • Periods specified by the EPO <ul style="list-style-type: none"> - Extension upon request • Late receipt of documents • Extension of periods • Interruption of periods <ul style="list-style-type: none"> - Interruption of proceedings - Comparison with stay of proceedings | <ul style="list-style-type: none"> • Calculating time limits • Extension of time limits • Delay in meeting time limits <ul style="list-style-type: none"> - Irregularities in the mail service - Excuse of delay in meeting time limits |

| PROCEDURAL LAW | | | | |
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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| H13 3h | Further processing and re-establishment of rights | Art. 121, 122 EPC Rules 112, 135, 136 EPC <i>[PCT Art. 25, 48(2), Rules 49.6, 51, 82bis, 82ter]</i> R. 22 UPR | <ul style="list-style-type: none"> • Loss of rights communication <ul style="list-style-type: none"> – Application for decision • Further processing <ul style="list-style-type: none"> – Requirements – Periods exempt from further processing • Re-establishment of rights <ul style="list-style-type: none"> – Requirements – Cause of non-compliance and its removal – All due care – Periods exempt from re-establishment of rights – Application in unitary patent proceedings | <ul style="list-style-type: none"> • No remedies like further processing in international phase • Review by dOs • Excuse of delay in meeting time limits by dOs or eOs • Provisions for reinstatement of rights |
| H14 3h | Fees | Art. 14(4), 33(2)(d), 39(1), 51, 78(2), 79(2), 86, 99(1), 105a(1), 108, 112a(4), 135(3), 141 EPC Rules 6(3)-(7), 36(3)-(4), 37(2), 38-39, 45, 51, 64(2), 71, 71a(6), 82(2), 88(3), 89(2), 103, 135(1), 136(1), 162(3) EPC Rules relating to Fees Arrangements for Deposit Accounts (ADA) Arrangements for the Automatic Debiting Procedure (AAD) <i>[PCT Rule 96; Schedule of Fees]</i> Art. 9(1)(e), 11(1) Reg 1257]; Rule 13 UpR; RFees relating to UPP | <ul style="list-style-type: none"> • Fees for applications • Renewal fees <ul style="list-style-type: none"> – Computing patent years – Renewal fee for 3rd year – Courtesy service regarding renewal fees – Divisional and Art. 61(1)(b) applications – Interface European/national renewal fees • Rules relating to Fees <ul style="list-style-type: none"> – Effecting payment – Fail-safe arrangement – Insufficient payment – Refund of fees – Reduction of fees • Deposit accounts <ul style="list-style-type: none"> – Replenishment / effective date • Automatic debiting <ul style="list-style-type: none"> – Excluded fees • Renewal fees for unitary patents <ul style="list-style-type: none"> – First renewal fee | <ul style="list-style-type: none"> • Schedule of Fees <ul style="list-style-type: none"> – Reduction of fees |

| PROCEDURAL LAW | | | | |
|----------------|---|--|--|---|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| I/J | Revocation and national rights | | | |
| I 0.8h | National revocation | Art. 2(2), 138, 139 EPC | <ul style="list-style-type: none"> • Grounds for revocation • Proceedings for revocation • Partial revocation | |
| J1 0.4h | National Offices | Art. 75(2), 77(2),(3) EPC Rule 37(1),(2) EPC PCT Art. 27(8), Rule 22.1 | <ul style="list-style-type: none"> • Mandatory filing at national Offices <ul style="list-style-type: none"> – European application and national law relating to the secrecy of inventions – Secret applications abroad using the NATO and other agreements | <ul style="list-style-type: none"> • International application not treated as such due to national security prescriptions <ul style="list-style-type: none"> – IA not transmitted by receiving Office (rO) to International Bureau (IB) – If IA is filed at IB/RO, IB does not check compliance |
| J2 0.8h | Relations European and national patents | Art. 139, 140 EPC Rule 138 EPC | <ul style="list-style-type: none"> • Rights of earlier date or the same date <ul style="list-style-type: none"> – National prior rights – Different claims, description and drawings for different States • National utility models and utility certificates | |
| J3 0.8h | Conversion to national application | Art. 135, 137 EPC Rules 155-156 EPC <i>[PCT Art. 23(1), Rule 47.4; PCT Art. 40(2), Rule 61.2(d)]</i> | <ul style="list-style-type: none"> • Conditions conversion • Procedure conversion | <ul style="list-style-type: none"> • Early entry into national/regional phase on express request of the applicant (see L4/L5) |
| J4 0.2h | Territorial effect of application | Art. 168 | <ul style="list-style-type: none"> • Territorial extent <ul style="list-style-type: none"> – Special cases (DK, FR, GB, NL) • Unitary patent <ul style="list-style-type: none"> – Territorial effect – Special cases (DK, FR, NL) | |

| PROCEDURAL LAW | | | | |
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| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| K | Unitary Patent Regulations and other agreements | | | |
| K1 0.5h | Special agreements | Art. 142-149a EPC | <ul style="list-style-type: none"> • Unitary patent in Switzerland and Liechtenstein | |
| K2 3.5h | Unitary Patent Regulations | Unitary Patent Regulations (Reg 1257 and 1260) and implementing regulations (In particular UPR) Art. 3, 31-32 UPCA National measures relating to the Unitary Patent (available at EPO) | <ul style="list-style-type: none"> • Entry into force and application • Accession of further EU States • Request for unitary effect <ul style="list-style-type: none"> – Time limit – Requirements – Request for compensation – Examination of request(s) by the EPO • Uniform protection • No simultaneous protection with the same European patent validated nationally • Licences as of right <ul style="list-style-type: none"> – Reduction of renewal fees • Common provisions • Actions against decisions of the EPO regarding unitary patents | |

| PROCEDURAL LAW | | | | |
|----------------|--|--------------------|---|--------------------|
| | Subject | Articles and Rules | Key Topics | PCT-related topics |
| K3 2h | Aspects of patent laws of the other four IP5 Patent Offices relevant to European practitioners | — | <p>United States Patent and Trademark Office (USPTO)</p> <ul style="list-style-type: none"> • First inventor to file • Provisional/utility application • Continuation / continuation-in-part / divisional • Claiming priority from US application • Prior art in US <ul style="list-style-type: none"> – Grace period + mandatory declaration – Intervening disclosure – Anti-self-collision • Claim amendment • Request for continued examination • Methods of treatment <p>Japan Patent Office (JPO)</p> <ul style="list-style-type: none"> • First to file • Grace period • Utility model • Claim amendment <p>Korean Intellectual Property Office (KIPO)</p> <ul style="list-style-type: none"> • First to file • Grace period • Utility model • Claim amendment <p>China National Intellectual Property Administration (CNIPA)</p> <ul style="list-style-type: none"> • First to file • Grace period • Utility model • Claim amendment | |

| PATENT COOPERATION TREATY | | | |
|---------------------------|---|---|--|
| | Subject | Articles and Rules | Key Topics |
| L | The Patent Cooperation Treaty | | |
| L1 3h | Introduction PCT and common provisions | PCT Art. 1, 2, 9, 10, 27(7), 43-45, 49, 53, 55, 58 PCT Rules 2, 79-82, 82 <i>quater</i> , 83, 90, 90 <i>bis</i> , 91, 92, 94 | <ul style="list-style-type: none"> • Structure of the PCT • International phase / national phase • General articles and rules <ul style="list-style-type: none"> - Definition of application - Definition of priority date - Definition of national Office - Applicant - Receiving Office (RO) - Seeking certain kinds of protection - Seeking two kinds of protection - Regional patent treaties <ul style="list-style-type: none"> o Closing national route - Right to practice before international authorities - Assembly - International Bureau (IB) - Time limits <ul style="list-style-type: none"> o 7-day rule for late delivered documents o Extension of time limits o Excuse of delay in meeting time limits - Irregularities in the mail service - Agents and common representatives - Obvious mistakes in documents - Correspondence - Withdrawals - Access to files |

| PATENT COOPERATION TREATY | | | |
|---------------------------|--|---|---|
| | Subject | Articles and Rules | Key Topics |
| L2 3h | International application, international filing date and formalities examination, EPO as rO | PCT Art. 3-14 PCT Rules 3-11, 12-13ter, 14-16bis, 17, 18, 19-23, 24-26, 26bis, 26ter, 27-32, 40bis, 92bis Art. 150, 151 EPC Rule 157 EPC | <ul style="list-style-type: none"> • Filing an international application <ul style="list-style-type: none"> - Request - Applicant - Where to file <ul style="list-style-type: none"> o Filing at non-competent rO - Languages <ul style="list-style-type: none"> o Filing in language not accepted by rO - Agent and representative - Inventor - Signature - Fees - Designation of States - Priority • International filing date <ul style="list-style-type: none"> - Right to file the international application - Procedure for correction - Filing missing elements or missing parts - Erroneously filed elements and parts <ul style="list-style-type: none"> o Invitation from ISA to pay additional fee - Effect of the international filing date • Defects in the international application <ul style="list-style-type: none"> - Procedure for correction • EPO as rO <ul style="list-style-type: none"> - Application of the PCT to the EPC - Fees when filing an international application - Correction of erroneously filed elements and parts |

| PATENT COOPERATION TREATY | | | |
|---------------------------|---|---|--|
| | Subject | Articles and Rules | Key Topics |
| L3 3h | <p>International search, EPO as ISA; supplementary international search, EPO as SISA; international publication and international preliminary examination, EPO as IPEA</p> | <p>PCT Art. 15-19, 20-30, 31-38</p> <p>PCT Rules 33-45, 45<i>bis</i>, 46, 48, 53-78, 94</p> <p>Art. 152 EPC</p> <p>Rule 158 EPC</p> | <ul style="list-style-type: none"> • International search <ul style="list-style-type: none"> - Competent ISA - Subject-matter not searched - Relevant prior art <ul style="list-style-type: none"> o Oral disclosure - Lack of unity and protest procedure - International search report (ISR) - Written opinion of ISA (WO-ISA) - Filing amendments of the claims - IPRP (Chapter I) • EPO as ISA <ul style="list-style-type: none"> - PCT Direct service - Subject-matter not searched - Lack of unity and protest procedure - Refund of search fee <hr/> <ul style="list-style-type: none"> • International publication <ul style="list-style-type: none"> - Languages of publication - Contents publication - PCT Gazette - Patentscope - Preventing/postponing publication - Technical preparations - Provisional protection • International publication - EPO as dO/eO <ul style="list-style-type: none"> - Provisional protection |

| PATENT COOPERATION TREATY | | | |
|---------------------------|---------|--------------------|---|
| | Subject | Articles and Rules | Key Topics |
| | | | <ul style="list-style-type: none"> • Supplementary international search <ul style="list-style-type: none"> - Supplementary search request - Supplementary search handling fee - Supplementary search fee - Correction of defects - Start, basis and scope - Unity of invention <ul style="list-style-type: none"> o Review of opinion of SISA - Supplementary international search report <ul style="list-style-type: none"> o Explanations PCT R.45bis.7(e) o Transmittal to applicant - ISA competent to carry out supplementary international search (SISA) • EPO as SISA <ul style="list-style-type: none"> - Refund of supplementary search fee - Subject-matter not searched - Non-unity and review |
| | | | <ul style="list-style-type: none"> • International preliminary examination <ul style="list-style-type: none"> - Filing demand and fee payment - Competent IPEA - Written opinion of IPEA - Response to written opinion - Amendment - Lack of unity and protest procedure - Subject-matter not searched - IPER = IPRP (Chapter II) • EPO as IPEA <ul style="list-style-type: none"> - Subject-matter not searched - Non-unity and protest procedure - Filing amendments - Consultation by telephone |

| PATENT COOPERATION TREATY | | | |
|---------------------------|----------------|---|---|
| | Subject | Articles and Rules | Key Topics |
| L4 2h | National phase | PCT Art. 22-25, 27, 28, 39-41, 45(1), 48 PCT Rules 47, 49-50, 51-52, 74, 76, 82 <i>bis</i> | <ul style="list-style-type: none"> • National requirements • Processing prohibition <ul style="list-style-type: none"> – Early processing on express request of applicant • Patent Prosecution Highway (PPH) • Amendment of the international application before dOs/eOs • Communication to dOs/eOs • Acts for entry into national phase <ul style="list-style-type: none"> – Period for entry – Translation international application – Fee payment – Indication of inventor – Priority documents – Representation • Inspection of files • Reinstatement of rights after failure to duly enter the national phase • Review and excuse procedure <ul style="list-style-type: none"> – EPO: examining division competent to take decisions |

| PATENT COOPERATION TREATY | | | |
|---------------------------|---|--|--|
| | Subject | Articles and Rules | Key Topics |
| L5 4h | Regional entry before the EPO as dO/eO and Euro-PCT application | Art. 150, 153 EPC Rules 159-165 EPC PCT Art. 26, Rule 49.6 | <ul style="list-style-type: none"> • EPO as dO/eO <ul style="list-style-type: none"> - Predominance of the PCT over the EPC - Early processing of the Euro-PCT application - Effect of international publication of the Euro-PCT application and translation - Euro-PCT application as Art. 54(3) EPC prior art - Equivalence between international search report and European search report - Supplementary European search <ul style="list-style-type: none"> o Fee reductions - Acts for entry into EP regional phase <ul style="list-style-type: none"> o Translation o Filing and page fee o Designation fee o Search fee for supplementary European search o Request for examination o Renewal fees - Means of redress after failure to perform the acts - Claims fees - Examination of certain formal requirements by the EPO <ul style="list-style-type: none"> o Designation of inventor o Priority claim and document o Sequence listing o Address/nationality of applicant o Representation - Response to the written opinion prepared by the EPO as ISA or to explanations given by the EPO as SISA or to the IPER prepared by the EPO as IPE8A - Amendment of the Euro-PCT application where the EPO did not act as ISA or SISA - Accelerated processing of the Euro-PCT application - Further searches and unity of invention where the EPO did not act as ISA or SISA - Unity of invention and further searches where the EPO acted as ISA or SISA - Substantive examination of the Euro-PCT application |