

EPC Handbook

A practical guide and reference book for the EQE legal exams and EPAC

An Essential Tool for Excelling in EQE Legal Papers
Relevant for Paper D, Modules F, M2, M4, and EPAC

written and edited by

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First edition

Leseprobe

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Foreword to the First edition

Preparing for the European Qualifying Examination (EQE) often feels like navigating through a flood of legal texts and procedures. The EPC Handbook aims to streamline this challenge. Written in an exam-oriented bullet style based on past papers and recurring EQE questions, this comprehensive resource helps candidates maximize their scores in the legal components of the EQE, including Paper D of the “old” EQE format and Modules F, M2, and M4 of the new EQE, as well as the EPAC exams. By covering all critical topics for exam success, this handbook offers a practical, structured approach to mastering these essential areas of patent law.

This book was formerly known as “**D-I Guide (Part 1 of 2: EPC)**”, published last year in its third edition for the EQE 2025. Now, under the new title “**EPC Handbook**”, this first edition by Wolters Kluwer has been thoroughly updated for the EQE 2026. It reflects the relevant legal changes up to November 2025 and incorporates significant revisions and expansions that accommodate the evolving exam requirements. A restructured chapter layout offers improved clarity and usability, helping candidates efficiently navigate complex legal concepts and procedural steps.

About the author

It has been a long journey for me to become a tutor and finally reach this important milestone of authoring a book for Wolters Kluwer. My IP career began on the first of March 2019, when I made the pivotal decision to switch from an engineering role to the patent department at Schaeffler. While the choice was not an easy one, it set me on a path that shaped my professional development profoundly. The timing was equally significant: I entered the patent profession just in time to meet the two-year waiting period, enabling me to sit the pre-exam for the EQE on 1 March 2021 and eventually the main EQE Papers A, B, C, D in 2022.

I remain grateful to my former mentors at Schaeffler – Florian Maas, Winfried Helm, and Johannes Burkardt – who provided a solid foundation and laid the pillars of my current IP knowledge. After moving to Siemens Gamesa (now part of Siemens Energy), where I am currently employed, I continue to benefit from what I learned during my earlier years. My current colleagues at Siemens Gamesa, especially Philipp Rosenits, have also been tremendously supportive in my first steps at the company.

I extend my sincere thanks to all those who have supported me in drafting, reviewing, and refining my EQE preparation materials. In particular, Maria Claudia Souza has been a constant source of encouragement, and I am immensely grateful to the many candidates, tutors, and representatives whose feedback has shaped and enhanced these exam preparation books. Your input drives the continuous improvement of this work.

If you have suggestions for future editions or spot any errors, please do not hesitate to contact me at ignaciolobato93@gmail.com or connect with me on LinkedIn. Let us work together to support more candidates on their path to success in the EQE!

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Ignacio Lobato

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2 Legal remedies

- If **third persons are entrusted** with application by the applicant, these persons also need to satisfy the due care criterion
 - Non-EP representatives (such as US – or JP-patent lawyers) can be held responsible for meeting the obligations of any representative whose duty it is to care for his client's interests, irrespective of whether such representative is entitled to represent before EPO or any other patent office – [J25/96](#), [J4/07](#), [J5/18](#)
- Renewal fee payment **reminder** communication from EPO is courtesy service of EPO – [J23/87](#), [J12/84](#), [GL A-X 5.2.4](#)
 - No rights derivable from reminder to pay renewal fee – [A2\(1\).4 RFeesEPC](#)
 - All due care cannot be successfully argued based on omitted reminder to pay renewal fee

95 2.2.6 Outcome

96 2.2.6.1 RE allowable

- If RE allowable, deemed withdrawn will be deemed not to have ensued – [A122\(3\) EPC](#)
 - If the argumentation is successful, acts of EPO and of the applicant will be null and void – [J2/87](#), [J3/87](#), [J15/92](#)
- EPO will communicate decision to applicant – [R136\(4\) EPC](#)

97 2.2.6.2 RE not allowable/inadmissible

- Request for RE is inadmissible – [J12/84](#), [J1/89](#)
- The application is deemed withdrawn/refused and is irretrievably lost

98 2.2.7 Renewal fees

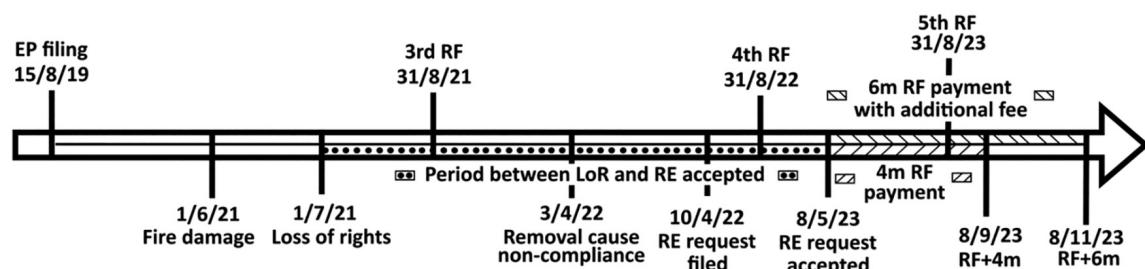
[R51\(4\) EPC](#) | RE for renewal fee

If EP application has been refused or deemed to be withdrawn as a result of non-observance of a time limit, and if the applicant's rights are re-established under [A122 EPC](#), a renewal fee

- which would have fallen due under [R51\(1\) EPC](#) in period starting on date on which loss of rights occurred, up to and including date of notification of RE decision, shall be due on that later date. This fee and any renewal fee due within **4m** from that latter date may still be paid within **4m** of that latter date without additional fee. [R51\(2\) EPC](#) shall apply
- which, on the date on which the loss of rights has occurred, was already due but the period provided for in [R51\(2\) EPC](#) has not yet expired, may still be paid within **6m** from the date of the notification of the RE decision, provided that the additional fee pursuant to [R51\(2\) EPC](#) is also paid within that period

99 ► EP application refused/deemed withdrawn due to non-observance of time limit and RE request successful

Case 1: [R51\(4\)\(a\) EPC](#) | Renewal fee under [R51\(1\) EPC](#) (without additional fee) fell between loss of rights and RE decision



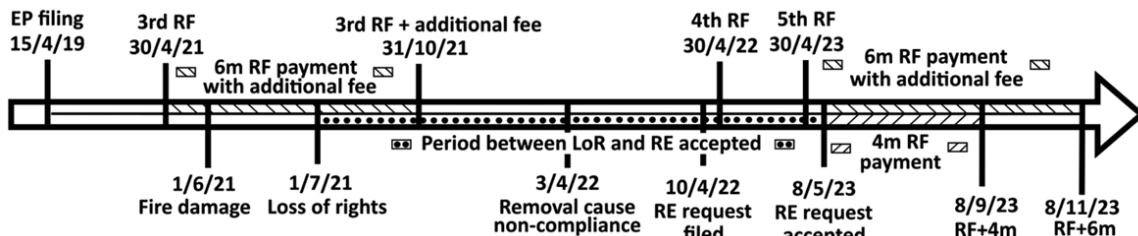
F-01 Renewal fee falls due between loss of rights and RE decision

- 15/8/19 – EP filing
- 1/6/21 – Fire damage
- 1/7/21 – Loss of rights due to unobserved time limit
- 31/8/21 – 3rd RF – Renewal fee for third year
- 3/4/22 – Files are reconstructed (removal of cause of non-compliance)
- 10/4/22 – Applicant files RE
- 31/8/22 – 4th RF – Renewal fee for fourth year
- 8/5/23 – RE request accepted by EPO (new due date for renewal fee)
- 31/8/23 – 5th RF – Renewal fee for fifth year

- A renewal fee under **R51(1) EPC** fell due within the date of loss of rights and the date of RE decision.
 - This is the case for 3rd RF and for 4th RF
- 3rd RF and 4th RF are due on date of RE decision (8/5/23) and can be paid within **4m** from date of RE decision – **R51(4)(a) EPC**
 - 8/5/23+**4m** [**R51(4)(a) EPC**, **R131(4) EPC**]→8/9/23 (last day of payment of renewal fee under **R51(1) EPC**)
 - No ultimo-ad-ultimo
- Under **R51(4)(a) EPC**, the due date of the renewal fee changes to the date of the RE decision and **R51(2) EPC** applies, so the renewal fee under **R51(1) EPC** can be paid with additional fee under **R51(2) EPC** of 50% of the renewal fee until **6m** from the date of the RE decision – **R51(2) EPC**, **A2(1).5 RFeesEPC**
 - 8/5/23+**6m** [**R51(4)(a) EPC**, **R51(2) EPC**, **R131(4) EPC**]→8/11/23 (last day of payment of renewal fee under **R51(1) EPC** with additional fee under **R51(2) EPC**)
 - No ultimo-ad-ultimo
- Hence, 3rd RF and 4th RF are due on 8/5/23 but can be paid without additional fee until 8/9/23 and with additional fee until 8/11/23
- 5th RF is due on 31/8/23 and can be paid until 31/8/23 without an additional fee (**R51(1) EPC**) and until 31/8/23+**6m** [**R51(2) EPC**, **J4/91**, **de ultimo ad ultimo**]→29/2/24 (Th) with additional fee (**R51(2) EPC**) (here **R51(4) EPC** does not apply)

Case 2: R51(4)(b) EPC | Renewal fee under **R51(1) EPC** fell before loss of rights date but could be paid with additional fee under **R51(2) EPC** at date of loss of rights

100



F-02 Renewal fee falls due before loss of rights and could be paid with additional fee at loss of rights

15/4/19 – EP filing

30/4/21 – 3rd RF – Renewal fee for third year

1/6/21 – Fire damage

1/7/21 – Loss of rights due to unobserved time limit (renewal fee could be paid at this date with additional fee)

31/10/21 – 3rd RF + additional fee – Renewal fee + additional fee for third year

3/4/22 – Files are reconstructed (removal of cause of non-compliance)

10/4/22 – Applicant files RE

30/4/22 – 4th RF – Renewal fee for fourth year

30/4/23 – 5th RF – Renewal fee for fifth year

8/5/23 – RE request accepted by EPO (new due date for renewal fee)

- A renewal fee under **R51(1) EPC** fell due before the date of loss of rights but could be paid with additional fee under **R51(2) EPC** at date of loss of rights
 - This is the case for 3rd RF
- This renewal fee under **R51(1) EPC** together with the additional fee under **R51(2) EPC** may still be paid within **6m** from the date of the notification of the RE decision, provided that the additional fee under **R51(2) EPC** of 50% of the renewal fee is also paid within that period – **R51(4)(b) EPC**
 - 8/5/23+**6m** [**R51(4)(b) EPC**, **R131(4) EPC**]→8/11/23 (last day of payment of renewal fee under **R51(1) EPC** with additional fee under **R51(2) EPC**)
 - No ultimo-ad-ultimo
 - Hence, 3rd RF can be paid with additional fee until 8/11/23 (due date already expired before loss of rights)
- A renewal fee under **R51(1) EPC** fell due within the date of loss of rights and the date of RE decision.
 - This is the case for 4th RF and for 5th RF
- 4th RF and 5th RF are due on date of RE decision (8/5/23) and can be paid within **4m** from date of RE decision – **R51(4)(a) EPC**
 - 8/5/23+**4m** [**R51(4)(a) EPC**, **R131(4) EPC**]→8/9/23 (last day of payment of renewal fee under **R51(1) EPC**)
 - No ultimo-ad-ultimo

- Under **R51(4)(a) EPC**, the due date of the renewal fee changes to the date of the **RE** decision and **R51(2) EPC** applies, so the renewal fee under **R51(1) EPC** can be paid with additional fee under **R51(2) EPC** of 50% of the renewal fee until **6m** from the date of the **RE** decision – **R51(2) EPC, A2(1).5 RFeesEPC**
 - 8/5/23+**6m** [**R51(4)(a) EPC, R51(2) EPC, R131(4) EPC**] → 8/11/23 (last day of payment of renewal fee under **R51(1) EPC** with additional fee under **R51(2) EPC**)
 - No **ultimo-ad-ultimo**
- Hence, **4th** RF and **5th** RF are due on 8/5/23 but can be paid without additional fee until 8/9/23 and with additional fee until 8/11/23

101 Legal remedies

- If renewal fee with additional fee not paid within the **6m** of **R51(4)(a) EPC** or the **6m** of **R51(4)(b) EPC** (see cases above to see which applies), application is deemed to be withdrawn – **A86(1) EPC**
 - Application is deemed withdrawn at end of **6m** additional period – **R51(2) EPC, R51(4) EPC**
- EPO will notify applicant of loss of rights – **R112(1) EPC**
 - This loss of rights ensues directly on expiry of applicable period – **J4/86 mut. mut., GL A-III 16.2**
- (-) FP excluded for period of **R51(4) EPC** – **A121 EPC, R135(2) EPC**
- RE is available if all due care can be proven – **A122 EPC, R136(3) EPC**
 - Example calculation/requirements for RE: See → **EPC Handbook: 2.2 A122 EPC – Re-establishment** | 80
- (-) RE in period of FP not possible, as FP excluded for period of **R51(4) EPC** – **A121 EPC, R135(2) EPC**
- Review of loss of rights communication (**R112(2) EPC**): Appeal can be filed if applicant applies for a **R112(2) EPC** decision within **2m** of **R112(1) EPC** communication – **A106(1) EPC, A108 EPC**
 - However, the appeal has to be based on valid grounds – **A108 EPC**
 - Example calculation/requirements for appeal against **R112(2) decision**: See → **EPC Handbook: 2.4 R112(2) EPC – Review of loss of rights communication** | 109

102 2.2.7.1 Divisionals

- See → **EPC Handbook: 12.9 Divisional application** | 1042
- Accrued renewal fees (**A2(1).4 RFeesEPC**) fall due on the filing date of the divisional – **A86(1) EPC, R51(3) EPC**
- Within **4m** of filing, accrued renewal fees may be paid without additional fee (**No de ultimo a ultimo**) – **A2(1).5 RFeesEPC**
 - 2/3/23+**4m** [**R51(3) EPC, R131(4) EPC**] → 2/7/23 (**Sun**) [**R134(1) EPC**] → 3/7/23
- If a renewal fee is due after filing divisional in **4m** period of filing, it can be paid without additional fee within same **4m**
- Within **6m** of filing the divisional, accrued renewal fees (**A2(1).4 RFeesEPC**) can be paid with an additional fee (**A2(1).5 RFeesEPC**) of 50% of the renewal fees paid late (**No de ultimo a ultimo**) – **R51(2) and (3) EPC**
 - 2/3/23+**6m** [**R51(2) and (3) EPC, R131(4) EPC**] → 2/9/23 (**Sat**) [**R134(1) EPC**] → 4/9/23
- If a renewal fee is due after filing the divisional, it can be paid after the **4m** period of **R51(3) EPC** with an additional fee of 50% until **6m** from the renewal fee due date (the date in which it falls due) – **R51(2) EPC, A2(1).5 RFeesEPC**

103 Legal remedies

- If renewal fee with additional fee not paid within the **6m** of **R51(2) EPC**, application is deemed to be withdrawn – **A86(1) EPC, R51(3) EPC**
 - Application is deemed withdrawn at end of **6m** additional period – **R51(2) EPC, R51(3) EPC**
- EPO will notify applicant of loss of rights – **R112(1) EPC**
 - This loss of rights ensues directly on expiry of applicable period – **J4/86 mut. mut., GL A-III 16.2**
- (-) FP excluded for period of **R51(2) EPC** – **A121 EPC, R135(2) EPC**
- RE is available if all due care can be proven – **A122 EPC, R136(3) EPC**
 - Example calculation/requirements for RE: See → **EPC Handbook: 2.2 A122 EPC – Re-establishment** | 80
- (-) RE in period of FP not possible, as FP excluded for period of **R51(2) EPC** – **A121 EPC, R135(2) EPC**
- Review of loss of rights communication (**R112(2) EPC**): Appeal can be filed if applicant applies for a **R112(2) EPC** decision within **2m** of **R112(1) EPC** communication – **A106(1) EPC, A108 EPC**
 - However, the appeal has to be based on valid grounds – **A108 EPC**
 - Example calculation/requirements for appeal against **R112(2) decision**: See → **EPC Handbook: 2.4 R112(2) EPC – Review of loss of rights communication** | 109

104 2.2.7.1.1 Applying R51(4) EPC for divisionals

- Examples above apply to divisionals taking into account the due date for renewal fee of divisional
 - Due date for renewal fee of a divisional:
 - Filing date of the divisional if it already fell due for parent application before filing date
 - Else: actual due date for renewal fee (same date as due date for parent application)

OJ2024 A8, 2003/361/EC | Definition of microenterprise

Within the SME category, a **microenterprise** is defined as an enterprise which employs fewer than 10 persons and whose annual turnover and/or annual balance sheet total does not exceed EUR 2 million

236

3.6.1 Reduction of filing and/or examination fee under R7a(1) and (2) EPC

237

3.6.1.1 Requirements

238

3.6.1.1.1 Applicant's requirements

239

- Applicant(s) is a person as defined in **A14(4) EPC**:
 - **Legal person** with principal place of business in CS having language other than **English/French/German** as an official language
 - Natural person
 - **Resident** in CS having language other than **English/French/German** as an official language
 - **National** of CS having language other than **English/French/German** as an official language who is resident abroad
- Applicant(s) is a person as defined in **A14(4) EPC**:
 - **✓ Legal person**: SME with principal place of business in Switzerland (**Italian** is official language)
 - **✓ Natural person**: **US national** resident in Greece (**Greek** is official language)
 - **✓ Natural person**: **Greek national** (**Greek** is official language) resident in US
- Nationality or residence of representative is irrelevant, **A14(4) EPC** provisions do not apply to representative – **T149/85**
- Joint applicants may use an admissible non-EPO language as soon as one of them is allowed to do so – **J4/18**
 - If joint applicants, all of them have to be persons under **R7a(2) EPC** – **R7a(5) EPC**
- **R7a(6) EPC** | **R7a(1)-(3) EPC** eligibility criteria shall be fulfilled on the date of the payment of fee concerned
- **R7a(2) EPC** | Reduction is only available for
 - (a) microenterprises;
 - (b) small and medium-sized enterprises;
 - (c) natural persons;
 - (d) non-profit organisations, universities or public research organisations.
- If joint applicants, all of them have to be persons under **R7a(2) EPC** – **R7a(5) EPC**
- Also different types of applicants (SME+university or natural person+non-profit organisations) are entitled to a fee reduction if all applicants are persons as defined under **R7a(2) EPC** – **J4/18, GL A-X 9.3.1**

3.6.1.1.2 Declaration

240

- A **declaration** has to be filed confirming that applicant is a person within the meaning of **R7a(2) or (3) EPC** at the latest when the first reduced payment is made – **R7b(1) EPC**

3.6.1.1.3 Language requirements

241

- Filed in an “admissible non-EPO language” as defined in **A14(4) EPC**

Language requirements for filing fee reduction

242

- Essential element is description, which has to be filed in an “admissible non-EPO language” – **G6/91, J4/88, GL A-X 9.3.2**
 - Claims are not required for language reduction, they can be filed after the filing date
- Filing description or reference to earlier application both allow applicant to be entitled to fee reduction – **R40(1)(c) EPC**
 - See → **EPC Handbook: 12.2.3 R40(1)(c) EPC** – A description or reference to a previously filed application | 892

Language requirements for examination fee reduction

243

- Examination requested in admissible non-EPO language

List of EPC CS having official language other than EN/FR/DE

244

[State]	[language]	[State]	[language]	[State]	[language]
Albania	Albanian	Austria	German	Belgium	French/Dutch/German
Bulgaria	Bulgarian	Croatia	Croatian	Cyprus	Greek
Czech Republic	Czech	Denmark	Danish	Estonia	Estonian
Finland	Finnish/Swedish	France	French	Germany	German
Greece	Greek	Hungary	Hungarian	Iceland	Icelandic

[State]	[language]	[State]	[language]	[State]	[language]
Ireland	English/Irish	Italy	Italian	Latvia	Latvian
Liechtenstein	German	Lithuania	Lithuanian	Luxembourg	French/German/Luxembourgish
Malta	English/Maltese	Monaco	French	Montenegro	Montenegrin
Netherlands	Dutch	North Macedonia	Macedonian	Norway	Norwegian/English
Poland	Polish	Portugal	Portuguese	Romania	Romanian
San Marino	Italian	Serbia	Serbian	Slovakia	Slovak
Slovenia	Slovenian	Spain	Spanish	Sweden	Swedish
Switzerland	French/Italian/ German	Turkey	Turkish	United Kingdom	English

T-05 List of EPC CS having official language other than EN/FR/DE – Nat Law Tab II

245 Filing EP application in a language different from official EPO languages

- Any person can file EP application in any language different from the official EPO languages – [A14\(2\) EPC](#)
- If application not filed in official EPO language, translation to [EPO language] shall be filed within **2m** of filing EP application – [A14\(2\) EPC](#), [R6\(1\) EPC](#)
 - 1/3/22+**2m** [[R6\(1\) EPC](#), [R131\(4\) EPC](#)]→1/5/22 (**Sun**) [[R134\(1\) EPC](#)]→2/5/22
- The translation may be brought into conformity with the original language throughout the proceedings – [A14\(2\) EPC](#)
- EPO will check if translation has been filed – [A90\(3\) EPC](#), [R57\(a\) EPC](#)
- If no translation is filed, EPO will invite to file a translation into one EPO official language within **2m** of notification – [R58 EPC](#)
 - 3/5/22+**2m** [[R58 EPC](#), [R131\(4\) EPC](#)]→3/7/22(**Sun**) [[R134\(1\) EPC](#)]→4/7/22
- If no translation filed before expiry of **2m** period of [R58 EPC](#) invitation, application is deemed withdrawn – [A90\(5\) EPC](#), [A14\(2\) EPC](#)
 - Application is deemed withdrawn at end of **2m** period of [R58 EPC](#) invitation
- EPO will notify applicant of loss of rights – [R112\(1\) EPC](#)
 - This loss of rights ensues directly on expiry of applicable period – [J4/86 mut. mut.](#), [GL A-III 16.2](#)
- (-) FP excluded for period of [R6\(1\) EPC](#) & [R58 EPC](#) – [A121 EPC](#), [R135\(2\) EPC](#)
- RE is available if all due care can be proven – [A122 EPC](#), [R136\(3\) EPC](#)
 - Example calculation/requirements for RE: See → [EPC Handbook: 2.2 A122 EPC – Re-establishment](#) | 80
- (-) RE in period of FP not possible, as FP excluded for period of [R6\(1\) EPC](#) & [R58 EPC](#) – [A121 EPC](#), [R135\(2\) EPC](#)
- Review of loss of rights communication ([R112\(2\) EPC](#)): Appeal can be filed if applicant applies for a [R112\(2\) EPC](#) decision within **2m** of [R112\(1\) EPC](#) communication – [A106\(1\) EPC](#), [A108 EPC](#)
 - However, the appeal has to be based on valid grounds – [A108 EPC](#)
 - Example calculation/requirements for appeal against [R112\(2\) EPC](#) decision: See → [EPC Handbook: 2.4 R112\(2\) EPC – Review of loss of rights communication](#) | 109
- Another option is filing a new application claiming priority ([A87\(1\) EPC](#)) at latest on:
 - 1/3/22+**12m** [[A87\(1\) EPC](#), [R131\(4\) EPC](#)]→1/3/23
 - A filing date was accorded to the filing in non-official EPO language, so priority can be claimed
- Conversion to a national application is possible in some EPC CS – [A135\(1\) EPC](#)
 - See → [EPC Handbook: 2.6.4 Convert application to national application](#) | 143
 - but not for Sweden and Norway – [Nat. Law Tab. VII col.1](#)
 - Conversion allowed if application deemed withdrawn under [A14\(2\) EPC](#) because no translation was filed in:
 - NL, BG, CH (if filed in **Italian**), CY, EE, ES, FI, GR, HR, HU, IT (if filed in **Italian**), LV, LT, MK, MT, PL, PT, RO, RS, SK, SI – [Nat. Law Tab. VII col.1](#)
 - Conversion allowed if application is withdrawn, deemed withdrawn or refused for any reason in:
 - EE (utility model only), ES (utility model only), FI (utility model only), IT, PL, SK – [Nat. Law Tab. VII col.1](#)

246 3.6.1.2 Reduction

247 3.6.1.2.1 Filing fee and examination fee

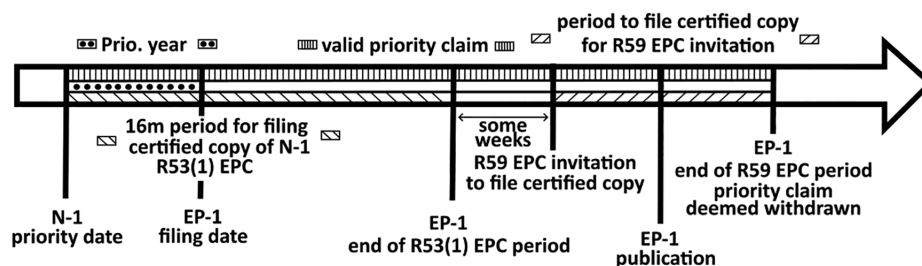
- 30% reduction of filing fee** including additional page fee – [R7a\(1\) EPC](#), [A2\(1\).1 and .1a RFeesEPC](#), [A14\(1\) RFeesEPC](#)
 - Reduction of filing fee is also applicable to **divisional applications** if parent application was filed in an admissible non-EPO language and the divisional application is filed in the same admissible non-EPO language as the earlier application – [GL A-X 9.3.2](#), [A2\(1\).1b RFeesEPC](#)
- 30% reduction of examination fee** if examination requested in **admissible non-EPO language** as defined in [A14\(4\) EPC](#) – [R7a\(1\) EPC](#), [A2\(1\).6 RFeesEPC](#), [A14\(1\) RFeesEPC](#)
 - For this, box 5 of Request for Grant Form (Form 1001) can be used

- N-1 is first application for A. EP-1 is first application for B – [A87\(1\) EPC](#)
 - Effective date of claim to A = filing date of N-1
 - Effective date of claim to B = filing date of EP-1
- Publication of N-1 is [A54\(2\) EPC](#) prior art for the part of claim of EP-1 which does not benefit from priority of N-1, i.e. for B
- Novelty
 - ✓ As N-1 does not disclose B, claim directed to B of EP-1 is new over N-1
- Inventive step
 - **Case 1: ✗ B is not inventive over A**
 - The difference between A and B lies in that ...
 - The effect of...
 - The objective technical problem is ...
 - A person skilled in the art knows that
 - Starting from N-1 and seeking to simplify by calling on his general knowledge, the person skilled in the art would obtain B of claim 1 without showing any inventive activity
 - As a sub-area of claim 1 does not involve inventive step, claim as a whole is not inventive – [A56 EPC](#)
 - The claim is thus not patentable
 - **Case 2: ✓ B is inventive over A**
 - As B provides an improvement over A, the claim to B is inventive – [A56 EPC](#)

4.6.2 Priority lost after publication

409

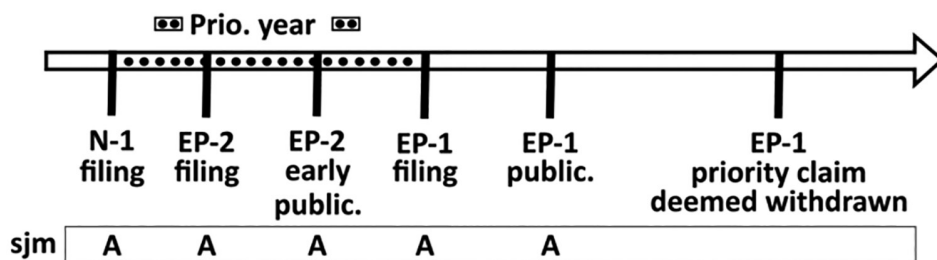
► Certified copy not filed



F-09 Priority lost after publication

- EP1 claims priority from N1
- Applicant did not file the certified copy of N1 on due time
 - Certified copy of priority documents must be filed within **16m** of earliest priority date – [A88\(1\) EPC](#), [R53\(1\) EPC](#)
 - If certified copy is not filed in due time, EPO invites applicant to provide it within period to be specified – [R59 EPC](#)
 - This period cannot be less than **2m** nor more than **4m** – [R132\(2\) EPC](#) – and is usually **2m** – [GL A-III 6.7](#)
- Hence, at EP1 publication (**18m** after priority date), the period to file the certified copy of the priority document set by the [R59 EPC](#) invitation did not expire yet, so **priority claim was valid at publication date**
 - (Procedural) changes taking effect **after the date of publication** of the prior right patent application do not affect the application of [A54\(3\) EPC](#) – [GL G-IV 5.1.1](#)
 - Examples of procedural changes
 - Withdrawal of a designation, non-payment of designation fee – [A2\(1\).3 RFeesEPC](#)
 - Withdrawal of the priority claim or loss of the priority right for other reasons

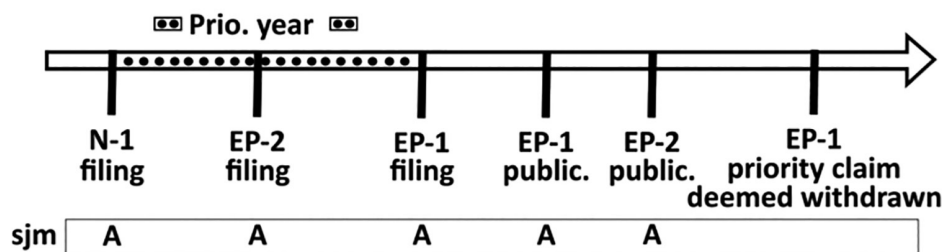
410 ► **Case 1** | EP2 filed and early published within the priority year prior to EP1 filing date



F-10 EP2 filed and early published within the priority year prior to EP1 filing date

- EP2 was filed and early published within the priority year of N1 but before the filing of EP1
 - EP1 is [A54\(3\) EPC](#) prior art against EP2 as at publication date, the priority of EP1 was valid
 - EP1 is novelty destroying against EP2
- After EP1 publication and due to missing the period set by the [R59 EPC](#) invitation to provide a certified copy of the priority document, N1 priority claim is lost
 - Hence, effective date of EP1 is filing date of EP1
 - EP2 was early published before EP1 filing and is therefore [A54\(2\) EPC](#) prior art against EP1 and novelty destroying for EP1
- So EP1 is [A54\(3\) EPC](#) prior art against EP2 and also novelty destroying against EP2 and the early publication of EP2 is [A54\(2\) EPC](#) prior art against EP1 and also novelty destroying against EP1

411 ► **Case 2** | EP2 filed in the priority year but published after EP1 filing date



F-11 EP2 filed in the priority year but published after EP1 filing date

- EP2 was filed within the priority year of N1 but before EP1 and published after EP1's filing date
- When EP1 was filed, EP2 was no prior art against EP1, because the priority was valid
- After EP1 publication and due to missing the period set by the [R59 EPC](#) invitation to provide a certified copy of the priority document, N1 priority claim is lost
 - Hence, when the priority is lost, the effective date of EP1 is filing date of EP1
 - After this point, EP2 becomes [A54\(3\) EPC](#) prior art against EP1, as it was filed before EP1 but published thereafter
 - EP2 is novelty destroying against EP1
- So when the priority is lost, EP1 is [A54\(3\) EPC](#) prior art against EP2 and also novelty destroying against EP2 and EP2 is [A54\(3\) EPC](#) prior art against EP1 and also novelty destroying against EP1

6.2.3 A61(1) EPC – Entitlement proceedings	498
6.2.3.1 R16 EPC – Conditions for applying A61 EPC	499
6.2.3.1.1 EP-UA not yet granted	500
- EP patent has not yet been granted – R16(1)(b) EPC - An application is still pending until day before date of publication of mention of grant of the patent – G1/09	
Case: R71(3) EPC communication:	501
- Time for UA to respond to R71(3) EPC communication 1/3/23+4m [R71(3) EPC, R131(4) EPC]→1/7/23 (Sat) [R134(1) EPC]→3/7/23 - However, UA can fulfil requirements (file translation of claims, pay fee for grant (A2(1).7 RFeesEPC) earlier → earlier grant - Start entitlement proceedings as soon as possible to avoid grant of EP-UA - EP-UA must be pending for applying A61 EPC	
6.2.3.1.2 A61(1) EPC applied within 3m	502
- A person entitled to the grant of EP patent may only avail himself of the remedies under A61 EPC, if he does so no later than 3m after the decision recognising his entitlement has become final – R16(1)(a) EPC 1/4/23+3m [R16(1)(a) EPC, R131(4) EPC]→1/7/23 (Sat) [R134(1) EPC]→3/7/23 - If period missed, entitled person cannot start entitlement proceedings at EPO – R16(1)(a) EPC (-) FP excluded for period of R16(1)(a) EPC – A121 EPC, R135(2) EPC - RE is available if all due care can be proven – A122 EPC, R136(3) EPC - Example calculation/requirements for RE: See → EPC Handbook: 2.2 A122 EPC – Re-establishment 80 (-) RE in period of FP not possible, as FP excluded for period of R16(1)(a) EPC – A121 EPC, R135(2) EPC	
6.2.3.2 How to start entitlement proceedings	503
1. Open court proceedings in the national court of the CS where UA has PoB – A61 EPC, PoR A2 - Evidence is sufficient for following cases to result in a favourable decision for ENT - Document has been stolen - EP-UA has the same description as DE-0 filed before EP-UA by ENT - UA was abusive because the meeting of ENT and UA on [date] clearly indicated confidentiality of the information concerning new process invented by ENT – T830/90 - We can prove that UA received information from ENT - Comparing the contents of the information received and the contents of EP-UA shows this - UA is not inventor of the new process, so UA has no right to a patent based on EP-UA – A60(1) EPC - ENT is the true inventor of [invention X], because [reasons] 2*.a) If EP-UA published and pending: - ENT should notify and send proof to EPO of opening court proceedings and request stay of EP-UA grant proceedings – R14(1) EPC - This is only possible after publication of EP-UA, which was/ which will be as soon as possible after: 1/2/22+18m [A93(1)(a) EPC, R131(4) EPC]→1/8/23 - Publication is on Wed, so first possible day of publication is 2/8/23 Wed) - Send proof: evidence and letters from ENT to UA - Sending proof to EPO of court proceedings is interpreted by EPO as a request to stay proceedings, even if not expressly requested. EPO will stay proceedings ex officio – R14(1) EPC - Alternatively, ENT can request under R14(1) EPC that proceedings are not stayed even if evidence is sent of opening court proceedings – with risk that UA can withdraw application - Only affected 3rd-party (ENT) can ask for suspension by instituting entitlement proceedings against UA – A61(1) EPC, R14(1) EPC - UA cannot ask for suspension of proceedings - Stay of proceedings - Stay of proceedings will prevent UA from withdrawing application or designation of any CS – R15 EPC - Stay of proceedings interrupt the period for [replying to the R71(3) EPC communication] – R14(4) EPC - Pay renewal fees – R14(4) EPC, A2(1).4 RFeesEPC - All periods other than payment of renewal fees, running at date of stay of proceedings, shall be interrupted by such stay - Renewal fees continue to fall due during the period of stay	504

6. Right to EP

- Period for payment of renewal fee with an additional fee (A2(1).5 RFeesEPC) provided for in R51(2) EPC is not interrupted
- Renewal fees may be paid by a third party, so ENT can pay the renewal fees
- If UA did not pay renewal fees, ENT should make sure renewal fees are paid
- o Other fees (i.e. examination and designation fees) can be paid later, at resumption of proceedings – R14(4) EPC
- 505 • **2*.b) If EP-UA unpublished and pending:**
 - o Since the proceedings are not stayed before the publication (R14(1) EPC) an automatic withdrawal may still occur. Third party may have to pay filing (A2(1).1 RFeesEPC), search (A2(1).2 RFeesEPC) and claims fee (A2(1).15 RFeesEPC) (any person may pay)
 - o If a A14(2) EPC translation is required, a court injunction may be required to force applicant to file a translation
 - o To prevent UA from withdrawing the application, request an injunction preventing withdrawal of the application before the national court
 - However, even after withdrawal or deemed withdrawal, A61(1)(b) EPC (File new application EP-NEW) is still available for ENT – G3/92
 - o ENT can also wait for publication and follow the proceeding of 2*.a). However, there is the risk that UA withdraws the application. If done on time, the publication is prevented and so it will never be published
- 506 • **2*.c) If EP-UA not pending (e.g. withdrawn/refused before opening court proceedings):**
 - o Not possible to stay proceedings, as the application is not pending anymore
 - o However, ENT can continue with Step 3. (without resuming proceedings) and then file a new application under A61(1)(b) EPC
- 507 • **3. Send final decision of [State where UA has PoB] court to EPO – R14(2) EPC, then apply one of the A61(1) EPC options**
 - o Final decision by [State where UA has PoB] court must be recognised in all other CS – PoR A9
 - If UA has PoB in IT: Decision will be automatically recognized in IT – Protocol on Recognition (PoR)
 - For ENT = DE client: After grant of EP-1, ENT will be able to stop Company X1 from exploiting [invention X] in DE or IT
 - o Once a final decision in favour of ENT has been taken, then ENT has to provide evidence to that effect to resume the proceedings to grant – R14(2) EPC
 - o Evidence has to be provided within 3m after the final decision recognising his entitlement – R16(1)(a) EPC
 - 1/4/23+3m [R16(1)(a) EPC, R131(4) EPC] → 1/7/23 (Sat) [R134(1) EPC] → 3/7/23
 - o If period missed, entitled person cannot start entitlement proceedings at EPO – R16(1)(a) EPC
 - o (-) FP excluded for period of R16(1)(a) EPC – A121 EPC, R135(2) EPC
 - o RE is available if all due care can be proven – A122 EPC, R136(3) EPC
 - Example calculation/requirements for RE: See → EPC Handbook: 2.2 A122 EPC – Re-establishment | 80
 - o (-) RE in period of FP not possible, as FP excluded for period of R16(1)(a) EPC – A121 EPC, R135(2) EPC
- 508 **6.2.3.3 Cases and outcome of application of A61(1) EPC**
 - **Case: Full entitlement**
 - o ENT entitled to invention A
 - **Case: Partial entitlement**
 - o ENT entitled to invention A, ENT not entitled to invention B, as ENT did not invent B
 - o ✓ A61(1) EPC, R16 EP, R17 EPC apply only to invention A, to which ENT is entitled (not to invention B also disclosed in EP-UA) – R18(1) EPC
 - **Case: Part of subject-matter removed**
 - o ENT entitled to invention A and invention B. However, sjm B was removed during proceedings (e.g. translation to lang. of proceedings, removed from Druckexemplar...)
 - **Case: Non-unity/not patentable subject-matter**
 - o ENT entitled to invention A and invention B. However, sjm A does not have unity with sjm B or sjm B is not patentable
- 509 **6.2.3.3.1 Application of A61(1) EPC**
 - ENT has to inform EPO that he wants to do the following option:
 - o 1) A61(1)(a) EPC – Continue prosecution of EP-UA
 - o 2) A61(1)(b) EPC – File new application EP-NEW
 - o 3) A61(1)(c) EPC – Request refusal of EP-UA
- 510 **1) A61(1)(a) EPC – Continue prosecution of EP-UA**
 - (!) Not possible if EP-UA is no longer pending (withdrawn, deemed withdrawn...)
 - ✓ Applies to cases:
 - o Full entitlement / Part of sjm removed / Non-unity, not patentable sjm

- 1350 14. Validation
- 1351 14.1 Translation
- 1352 14.1.1 Minimum time limit for validation
- For validation, the time limit is determined by national law. **A65(1) EPC** guarantees a minimum of **3m**
 - 12/3/23+**3m**[**A65(1) EPC**, **R131(4) EPC**]→12/6/23
 - Some states allow for a longer period if a fee is paid
- 1353 Legal remedies
- If translation is not filed, the patent will be deemed void ab initio in the state – **A65(3) EPC**
 - National remedies might be available
- 1354 14.1.2 Validation states – Time limit, translation requirements and special fee
- EPC CS having ratified **London Agreement** undertake to waive, entirely or largely, requirement for EP patent translations
 - A state which has an official language in common with one of the official languages of EPO shall dispense entirely with the translation requirements provided for in **A65(1) EPC – A1(1), (2) and (3) London Agreement**
- 1355 14.1.2.1 Case 1. States not party to London Agreement
- [State] is **not** party to the London Agreement on the application of **A65 EPC**
- 1356 14.1.2.1.1 Case 1.a | **3m** period for filing translation
- A translation of **patent specification** into [language] must be supplied within **3m** from mention of grant in EP Bulletin – **A65(1) EPC**, **Nat. Law Tab. IV col 1&2**
 - or within **3m** of the decision to maintain the patent as amended or limited is published in EP Bulletin
 - In addition, a national fee for publication of [fee] (special fee under **Nat. Law Tab. IV col 5**) has to be paid
 - Except Malta – **no publication fee** due for Malta
 - Representation: Must a national professional representative be appointed?**
 - Yes:** Applicants with neither residence nor principal place of business in [State] must appoint a professional representative resident in [State]
 - Yes, except EU residence/PPB¹:** However, natural persons or legal persons having their residence or place in business in an EU member state or in an EEA state are not required to appoint a professional representative under certain conditions
 - Residence/address for correspondence in [State] might be required
 - See **Nat. Law Tab. IV** for further conditions of representation
 - No:** no professional representation required
 - Residence/address for correspondence in [State] might be required
 - See **Nat. Law Tab. IV** for further conditions of representation

[State]	[Language]	[fee]	Remedies/extension of time limit	Representation
Austria	German	186€ & each page > 15 pages: 135€		Yes, except EU residence/PPB ¹
Bulgaria	Bulgarian	Mention of translation: BGN 45; Translation: BGN 80 & each page > 10 pages: BGN 10		Yes, except EU residence/PPB ¹
Cyprus	Greek	100€		Yes
Czech Republic	Czech	CZK 2'000	Extension: additional 3m with fee (CZK 3'000)	Yes, except EU residence/PPB ¹
Estonia	Estonian	45€	Extension: additional 2m with fee (32€)	No
Greece	Greek	400€		Yes
Italy	Italian	40€ (paper by post/through chamber of commerce), 43€ and 16 € in stamps (certified copy)	FP possible within 2m of expiry of time limit for filing translation with FP fee	No
Malta	English	no publication fee!		Yes, except EU residence/PPB ¹
Montenegro	Montenegrin	Yes (no amount given)		Yes

[State]	[Language]	[fee]	Remedies/extension of time limit	Representation
Poland	Polish	PLN 90; & each page > 10 pages: PLN 10		Yes, except EU residence/PPB ¹
Portugal	Portuguese	58.97€ (online), 117.94€ (paper)	Extension: additional 1m with fee (50% surcharge of prescribed fee)	No
Romania	Romanian	100€ or RON 497 and & each page > 20 pages: 5€ or RON 25	Extension: additional 3m with fee (200€ or RON 995 and & each page > 20 pages: 5€ or RON 25)	Yes
Serbia	Serbian	Yes (no amount given)		Yes
Slovakia	Slovak	116€	Extension: additional 3m with fee (232€)	Yes
Spain	Spanish	327.38€ plus 13.16€ (paper) & each page > 22 pages, or 278.28€ plus 11.19€ (electronic form)	Extension: additional 2m RE possible within 2m of removal of obstacle if request is filed within 12m from expiry date of time limit.	Yes, except EU residence/PPB ¹
Turkey	Turkish	(a)(i) TRY 14'360 normal and TRY 5'980 for amended patent specification (opposition, limitation)	Extension: additional 3m with fee paid in advanced (TR 8'120)	Yes

T-09 Case 1.a | States not party to London Agreement – **3m** period –
Nat. Law Tab. IV

1357

14.1.2.1.2 Case 1.b | **6m** period for filing translation

1358

- A translation of **patent specification** into [language] must be supplied within **6m** from mention of grant in EP Bulletin – **A65(1) EPC**, **Nat. Law Tab. IV col 1&2**
 - or within **6m** of the decision to maintain the patent as amended or limited is published in EP Bulletin
- In addition, a national fee for publication of [fee] (special fee under **Nat. Law Tab. IV col 5**) has to be paid
- Representation: Must a national professional representative be appointed?**
 - Yes:** Applicants with neither residence nor principal place of business in [State] must appoint a professional representative resident in [State]
 - Yes, except EU residence/PPB¹:** However, natural persons or legal persons having their residence or place in business in an EU member state or in an EEA state are not required to appoint a professional representative under certain conditions
 - Residence/address for correspondence in [State] might be required
 - See **Nat. Law Tab. IV** for further conditions of representation
 - No:** no professional representation required
 - Residence/address for correspondence in [State] might be required
 - See **Nat. Law Tab. IV** for further conditions of representation

[State]	[Language]	[fee]	Remedies/extension of time limit	Representation
San Marino	Italian	100€ p& each page > 20 pages: 10€		Yes

T-10 Case 1.b | States not party to London Agreement – **6m** period –
Nat. Law Tab. IV

1359

14.1.2.2 Case 2. States party to London Agreement – no official language in common with EPO languages

1360

- [State] is party to the London Agreement on the application of **A65 EPC**
- [State] has no official language in common with one of the official languages of EPO

14.1.2.2.1 Case 2a. | States party to London Agreement – translation of claims

1361

- A translation of the **claims** into [language] must be supplied within **3m** from mention of grant in EP Bulletin – **A65(1) EPC**, **A1(3) London Agreement**, **Nat. Law Tab. IV col 1&2**
 - If patent maintained in amended form, translation of amended claims into [language] must be filed within **3m** from mention of grant in EP Bulletin – **A65(1) EPC**, **A1(3) London Agreement**, **Nat. Law Tab. IV col 1&2**
- In addition, a national fee for publication of [fee] (special fee under **Nat. Law Tab. IV col 5**) has to be paid
- Representation: Must a national professional representative be appointed?**
 - Yes:** Applicants with neither residence nor principal place of business in [State] must appoint a professional representative resident in [State]