

# D-Book

*How to answer legal questions, draft legal opinions and pass Paper D of the European Qualifying Examination*

written and edited by

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# PART A – STRATEGY

## Chapter 1: Legal Questions

### 1.1 General comments

In the first part of paper D of the old EQE (up to and including 2026), the candidate must answer a series of short questions relating to aspects of substantive and procedural law under the EPC and PCT (Part I: Legal Questions; Art. 1(4) REQEPR 2009, r.26(1) IPREQE 2010). The number of marks allocated to this part of paper D will vary between 40 % and 60 % of the marks allocated to paper D as a whole (notice from the Examination Board dated 13 March 2019).

In the new EQE (from 2026 onwards) similar questions will be found in paper M2 (Art. (1)(5)(c) REQEPR 2025, r.24 IPREQE 2025).

The balance between EPC and PCT questions varies from year to year but generally about two thirds of the marks are allocated to questions relating to the EPC and one third of the marks are allocated to questions relating to the PCT.

In order to secure full marks in these short questions, the candidate needs to identify the legal provisions that are relevant and apply these provisions to the facts of the question in order to identify the appropriate consequences and outcomes. Both the citation of the legal basis and the reasoning relating to its application are necessary in order to secure any marks: a simple yes/no answer will not generally score any marks on its own.

The extent of the legal knowledge that can be tested in Paper D, and indeed in the EQE as a whole, is set out in the examination syllabus (Art. 13 REQEPR 2009 and r.22(1) IPREQE 2010). A thorough knowledge of the EPC and PCT is required. In terms of the EPC, the candidates must be particularly familiar with Arts. 1 to 25 and 52 to 153 of EPC2000 and the corresponding Implementing Regulations. A knowledge of those important provisions of EPC1973 which continue to apply, e.g. Art. 54(4) and r.23a EPC1973, and transitional rules relating to them is also necessary. Furthermore, where recent changes to the regulations have taken place since the introduction of EPC2000, candidates are also expected to know the transitional provisions that determine the coming into force of the changes and the situations under which the previous rule may continue to apply.

Knowledge of the Protocols on Centralisation and Recognition (particularly the latter), the Rules Relating to Fees, important case law, the ancillary regulations (notices from the EPO and decisions of the President, including arrangements for debiting deposit accounts), the national law book and the Guidelines for Examination is also required. The relevant Guidelines include both Guidelines for Examination in the EPO and Guidelines for Search and Examination at the EPO as PCT Authority. The most important case law is that cited in the Guidelines together with the decisions of the Enlarged Board of Appeal. Students also need to be familiar with the content of the latest edition white Case Law book (Case Law of the Board of Appeal of the European Patent Office), the annual updates published in special editions of the Official Journal between new editions and any case law published in the Official Journal in the year before the exam up until 31 October (r.2 IPREQE 2010).

In terms of the PCT, candidates must be particularly familiar with Arts. 1 to 49 and the corresponding implementing regulations. Knowledge of the main provisions of the Paris Convention (Articles 1 to 5 *quater* and 11), which is directly applied under the PCT, is also required. The syllabus further extends to a knowledge of the most significant provisions of Japanese and US patent law.

The legal texts to be used in the exam are those that are in force on 31 October of the year prior to the exam (r.2 and 22(1) IPREQE 2010). Any changes, e.g. amendments to the EPC regulations, coming into force between that date and the date of the exam are to be ignored. It is a basic but important point that candidates should use these up-to-date texts in preparation for the exam and in the exam itself! Sadly, the reports of the Examination Committee suggest that this is not always the case.

Although this is an open-book exam (Point I.4, ICEQE, Decision of the Examination Board dated 24.10.2011), time is short and the opportunity to search for answers is

severely limited. To ensure success, the candidate must be thoroughly familiar with the materials described above and know instantly where to locate the relevant information.

- 9 Apart from the guides to the EPC and PCT included in this publication (see below) and the sources they reference (EPC, PCT, Guidelines for Examination in the European Patent Office, ancillary regulations, case law), all of which you should be familiar with and have with you, several other reference works are useful in the exam. These include the PCT Applicant's Guide and a list of countries that are members of the EPC, PCT, Paris Convention and WTO (available from the WIPO website). In particular, an up to date copy of the PCT Applicant's Guide is virtually essential if you are to be able to answer fully many of the questions set on the PCT. It is also useful to have a pre-marked EPO calendar showing closed days for the year of the exam and the previous year and a copy of the EPO publication relating to aspects of national law.

## 1.2 How to tackle the questions

### 1.2.1 Time management – understanding the question

- 10 Paper D in current format is six hours long. The legal questions are split into two independent parts with three questions in each part. A well-planned and disciplined approach to time-management is absolutely essential for success. The planning must involve the allocation of an amount of time to be spent on each question that is commensurate with the number of marks available, allowing some time at the end, if possible, for checking. Discipline must be shown in adhering to this schedule properly so that a disproportionate amount of time is not spent answering questions for which only a few marks are available. It is important that the whole paper is answered.
- 11 The number of marks allocated to each short question is clearly marked on the examination paper so it is possible to calculate how many minutes are available for each question. If some time is to be reserved for a final check of the written answer, as is highly advisable, then about 3 minutes per mark should be allocated. So, for example, a typical question for which 6 marks have been allocated should be answered in a maximum of 18 minutes. Candidates should make a note of the time available for each question and not exceed it. It is better to leave a question half-answered and move on to the next question rather than risk running out of time at the end and not answering part of the paper. This is because it is easier to accumulate the first 50 % of the marks for any given question than the second 50 % and hence better to have partially answered all of the questions rather than fully answered half of the questions.
- 12 The other important aspect of time management is the allocation of the time available to a particular question between analysis and writing. There is a temptation to start writing the answer as soon as possible in order to make good progress and be able to complete the paper on time. However, the truth is that once the question has been properly analysed and the answer deduced, it does not take much time to draft a clear and concise answer. If, on the other hand, an attempt is made to start writing the answer during the analysis phase it is likely that much crossing-out and rewriting will be necessary, which will waste precious moments and lead to a poorly laid-out and sometimes illegible script. It is therefore important not to panic and to resist the temptation to start writing immediately when some aspect of the question has been appreciated. Take a few minutes to properly understand the question from beginning to end and what is being asked, identify the relevant legal provisions and analyse their effects on the facts of the question and identify the consequences. Then write the answer.
- 13 Many marks are lost in the legal paper by candidates answering a different question from that which is being asked or simply writing everything they know, in a general sense, about the legal provisions relevant to the question. This point is made again and again in the reports published by the Examination Committee. See, for instance, the 2010 report: "As always, reading the questions carefully is crucial for formulating a correct and complete response". Taking the time to understand the question as a preliminary step is therefore essential for success. It is very important to clearly establish the limits of the question: it is obviously important not to underestimate the scope of the question and overlook issues that need to be addressed but it is equally important, in view of time pressure, not to overestimate the scope of the question and address issues for which no marks are available. One aspect of importance here is accepting the facts of the question

## Chapter 12: Allowance and Grant

### 12.1 Circumstances in which a patent is granted

- Art. 97(2) If the Examining Division is of the opinion that a European patent application and the invention to which it relates meet the requirements of the EPC, it will decide to grant a patent provided that the conditions laid down in the Implementing Regulations are fulfilled. 982

### 12.2 Approval of the text for grant, payment of fees and filing of claim translations

#### 12.2.1 Communication from the Examining Division under r.71(3)

- r.71(3)(4) Before deciding to grant a patent, the Examining Division: 983
- (a) informs the applicant of the text which it intends to grant and related bibliographic data; and invites the applicant to:
  - (b) pay the fee for grant and publishing;
  - (c) file translations of the claims into the two official languages of the EPO other than the language of proceedings; and
  - (e) pay claims fees for every claim over 15 for which a fee has not already been paid under r.45 or r.162;
- within a period of four months.
- RRF Art. 2(2)(7) For European patent applications filed before April 1, 2009, and international applications which entered the regional phase before that date, the fee for grant, including the fee for printing the European patent specification, is a combination of a fixed fee of € 1080 and an additional charge of € 18 for each page more than 35.
- RRF Art. 2(1)(7) For applications filed on or after April 1, 2009, the fee for grant, including the fee for publication of the European patent specification is a flat fee of € 1080 since the variable fee for pages more than 35 is now part of the filing fee.
- RRF Art. 2(2)(15) Each claims fee is € 275 for European patent applications filed before April 1, 2009 and international applications entering the regional phase before that date.
- RRF Art. 2(1)(15) Each claims fee is € 275 for claims in the range 16–50 and € 685 for the 51st and each subsequent claim for applications filed on or after April 1, 2009.
- Guidelines The grant and printing fee and any additional claims fees fall due on the notification of the r.71(3) communication (A-X, 5.2.3). See also C-V, 1.4 – claims fees are not refunded if the number of claims is reduced during prosecution.
- T1255/04 If, during examination proceedings, a main and a subsidiary request have been filed and one of the subsidiary requests is allowable, the communication pursuant to r.71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable and must expressly mention the applicant's right to maintain the main request and thus obtain an appealable decision (see below). See also T1181/04 and Guidelines H-III, 3.3.4 and C-V, 1.1.
- T646/20 Once a response has been filed approving the text proposed for grant, the Examining Division can issue a decision to grant at any time without waiting for the 4 month period of r.71(3) to expire.
- Guidelines See H-VI, 5 – mistakes in claim translations cannot be corrected after a decision to grant has been taken under r.140 since they do not form part of that decision. They are not part of the authentic text of the patent and are provided for information only. A corrected version will, however, be published as part of the B publication if received in time. They can also be corrected if the patent is later upheld in amended form in opposition or limitation proceedings.

- OJ See Notice from the EPO dated 13 December 2011 ([2012] O.J. 52). The text proposed for grant by the EPO may contain amendments/corrections made by the Examining Division which the applicant can reasonably be expected to accept (see also Guidelines C-V, 1.1 for examples of such amendments).
- r.50(1) Rule 49(2) (governing the presentation of the application documents) applies to the translation of the claims referred to in r.71 (translation of the allowed claims).
- Guidelines See C-IV,7.2 – the results of a search for prior national rights is also attached to the r.71(3) communication in order to help the applicant decide whether a request for unitary effect is appropriate or not (a single prior national right in a state to which unitary effect applies may be novelty-destroying to the unitary patent).

### 12.2.2 *Reduction of the grant fee if the applicant is a micro-entity*

- 984 r.7a(3) Where a microenterprise, natural person, non-profit organisation, university or public research organisation files a European patent application, the following fees shall be reduced in accordance with the Rules relating to Fees:  
(e) fee for grant.
- OJ The terms “non-profit organisation”, “university” and “public research organisation” are defined in the Notice from the EPO dated 25 January 2024 ([2024] O.J. A8). The definition of “microenterprise” is taken from Art. 2 of EU Commission Recommendation 2003/361/EC of 06 May 2003.
- r.7a(4) The reduction of fees referred to in r.7a(3) shall not be available where the same person has filed five or more European patent applications or Euro-PCT applications within a period of five years preceding
- the date of filing of the European patent application concerned or
  - the date of entry into the European phase of the Euro-PCT application concerned.
- The relevant date for previous applications shall be the date of filing in the case of a European patent application or the date of entry into the European phase in the case of a Euro-PCT application.
- r.7a(5) In the case of multiple persons filing a European patent application, the reduction under r.7a(3) shall be available only if each applicant fulfils the applicable eligibility criteria.
- r.7a(6) The eligibility criteria laid down in r.7a(3) shall be fulfilled on the date of the payment of the fee concerned.
- r.7b(1) Applicants wishing to benefit from a reduction of fees under r.7a(3) shall declare themselves to be a person within the meaning of r.7a(3) at the latest when the first reduced payment is made.
- r.7b(2) Applicants shall inform the European Patent Office of any change of status affecting eligibility for a reduction of fees at the latest when the fee concerned is paid.
- r.7b(3) In the event of reasonable doubt as to the veracity of the declaration within the meaning of r.7b(1) or, subsequently, as to the applicant’s eligibility for a reduction of fees, the EPO may request evidence.
- r.7b(4) Should it become apparent that an incorrect declaration has been filed or the EPO has not been informed of a change of status in accordance with r.7b(2) and a reduced payment is made, the fee shall be deemed not to have been paid and the application shall be deemed to be withdrawn.

- OJ See Notice from the EPO dated 25 January 2024 ([2024] O.J. A8). The declaration can be made in the Request form or separately on Form 1011. No fee reduction is possible in the absence of a declaration. Changes in status of an organisation will not retrospectively affect a reduction already taken advantage of – the status of the applicant at the time of paying the grant fee is determinative. If the EPO becomes aware that a fee should have been paid in full since the applicant did not have the necessary status, the fee will be deemed not to have been paid, the application will be deemed withdrawn and further processing will be necessary.
- OJ In relation to the cap of r.7a(4), see also Notice from the EPO dated 25 January 2024 ([2024] O.J. A8). The cap applies also in the case of the filing of a divisional application. Previously-filed applications count regardless of their status (e.g. withdrawn, deemed withdrawn etc). If two applications are filed on the same day, they are considered for eligibility in order of their filing numbers. Where an application is transferred from one applicant to another, it counts towards the cap for the new applicant from the date of registration of the transfer (reductions already applied are not affected). The new applicant may need to file a new declaration. If a reduction is mistakenly applied in spite of the cap being reached, there is no immediate loss of rights – the EPO will invite the applicant to pay the missing amount of the fee or fees within a period of two months.
- RRF Art. 14(1) The reduction is 30 % of the grant fee.

*12.2.3 Consequences of not responding fully to the r.71(3) communication*

- r.71(7) If the fee for grant and publishing or any due claims fees are not paid in due time or if the translations of the claims are not filed in due time, the application is deemed to be withdrawn. 985
- Guidelines See C-V, 3 and C-V, 4.9. Deemed withdrawal is only possible in the absence of any indication from the applicant that he does not approve the text proposed for grant.
- Art. 121 Further processing is available.
- Guidelines See C-V, 3 and C-V, 8 – the omitted act could be payment of the fee for grant and publishing, payment of claims fees, filing of claim translations, filing of proposed amendments, rejection of amendments proposed by the Examining Division or the maintenance of a high-ranking request. See also Notice from the EPO dated 13 December 2011 ([2012] O.J. 52).
- RRF Art. 2(1)(12) The further processing fee is € 300 in respect of the acts to be performed under r.71(3) (filing of claim translations and payment of the fee for grant and publishing), whether one or both of these acts are omitted, plus an additional 50 % of any unpaid claims fees and € 300 in other cases.
- Guidelines See E-VIII, 2 where examples are given.
- Art. 122 Re-establishment is available in respect of the time limit for further processing if it was missed in spite of all due care being shown.

*12.2.4 Implicit approval of the text by payment of fees and filing of translations*

- r.71(5) If the applicant pays the grant and printing fees and, if necessary, the claims fees and files the translations within the period set then they will be deemed to have approved the text intended for grant and verified the bibliographic data. 986

*12.2.5 Procedure where the proposed text is not acceptable to the applicant*

- 987 r.71(6) If the applicant responds within the period set under r.71(3) by requesting reasoned amendments or corrections to the text proposed for grant, or by maintaining the latest text proposed by them, the Examining Division will either issue a new communication under r.71(3) if it gives its consent or will resume examination proceedings.
- r.137(2) Though it does not follow from the wording of r.137, point 7.2 of the notice from the EPO of 15 October 2009 ([2009] O.J. 533) indicates that where no search opinion is issued and the first communication from the Examining Division is under r.71(3), the applicant has the right to introduce amendments of their own volition. This is confirmed by Guidelines H-II, 2.5.3 and C-V, 4.4.
- Guidelines See C-V, 4 and H-II, 2.5. The applicant may request new amendments, request the reversal of amendments proposed by the Examining Division or, where the r.71(3) communication was based on an auxiliary request, maintain a higher-ranking request. Examination must be resumed if either the amendments are not admitted into the procedure or the amendments are admitted into the procedure but found to be unallowable. Amendments should be reasoned – if they are not reasoned, it is more likely that examination will be reopened. Examination may be reopened in some cases with an invitation to oral proceedings or the refusal of the application (Guidelines C-V, 4.7.1).
- OJ See Notice from the EPO dated 13 December 2011 ([2012] O.J. 52). Where the applicant responds according to r.71(6), he does not need to pay any fees or file any translations (see also Guidelines C-V, 4.1). The applicant may, however, voluntarily pay the fees and the amount will be credited if a further r.71(3) communication is issued (r.71a(5), Guidelines A-X, 11, C-V, 4.2, C-V, 4.8) or refunded in other cases. Any additional amount due a fee increase in the meantime must still be paid.
- T2558/18 The applicant has no right to amend further under r.71(6) when a board of appeal has taken a decision indicating an allowable text for the grant of a patent and remitted the matter back to the examining division to implement the grant procedure. The decision taken is binding on the examining division under Art. 111(2) EPC and only the correction of errors pursuant to r.139 EPC is possible.

*12.2.6 Refund of grant and publishing fee*

- 988 r.71a(6) If the European patent application is refused or withdrawn prior to the notification of the decision on the grant of a European patent or, at that time, deemed to be withdrawn, the fee for grant and publishing will be refunded.
- Guidelines See A-X, 10.2.5 – the fee for grant and publishing is refunded but claims fees are not refunded (unless they were paid when requesting amendments in response to a r.71(3) communication and were hence not due (C-V, 4.2)).

**12.3 Between approval of the text and a decision to grant**

- 989 r.71a(2) Until the decision to grant the European patent, the Examining Division may resume the examination proceedings at any time.
- Guidelines See C-V, 6.1. Resumption may be necessary where third party observations are filed, the Examining Division becomes otherwise aware of deficiencies which have been overlooked or the applicant files amendments that are admitted into the procedure (see below).

- r.71a(5) If, in response to an invitation under r.71(3), the applicant has already paid the fee for grant and publishing, or claims fees, the paid amount will be credited if a further such invitation is issued (Guidelines A-X, 11, C-V, 4.2, C-V, 4.8).
- G7/93 Headnote (1): An approval of the text submitted by an applicant pursuant to r.51(4) EPC (now r.71(3) EPC2000) does not become binding once a communication in accordance with r.51(6) (now part of r.71(3) EPC2000) has been issued. Following issue of such a communication under r.51(6) EPC and until issue of a decision to grant the patent, the Examining Division has a discretion under r.86(3) (now r.137(3) EPC2000), second sentence, EPC, whether or not to allow amendment of the application.
- Comment This decision (G7/93) was taken under the old law where the grant procedure was considerably different but the principles established are still important. The Enlarged Board decided that Art. 113(2) (EPO to decide only on text approved by applicant) did not give the applicant a right to amend. Any amendment under r.137(3) had to be made with the consent of the Examining Division. Equally, the Examining Division is not bound in any way by the text as approved and can authorise amendments prior to the issue of a decision to grant. Discretion will only be exercised in favour of the applicant as an exception rather than a rule at such a late stage of the grant procedure. The Examining Division must balance the applicant's interest in obtaining a valid patent against the EPO's interest in bringing grant proceedings to a close. Typically, amendments should be allowed which do not involve reopening of substantive examination.
- T556/95 A request for oral proceedings must be honoured at any time while proceedings are pending, i.e. up to the decision to grant or refuse.
- Guidelines See H-II, 2.6. Further requests for amendment after approval of the text are only admitted in exceptional circumstances, e.g. to take into account prior national rights, or if they are minor changes which will not delay grant appreciably.

#### 12.4 Decision to grant

- r.71a(1) If all fees have been paid, translations of the claims in the two official languages of the EPO other than the language of the proceedings have been filed and the applicant has approved the text proposed for grant, a decision to grant the patent will be issued. 990
- r.71a(1) The decision to grant the patent will state the text of the application which forms the basis for the decision.
- J7/96 Between the decision to grant and the grant taking effect there are only certain things that may be done in relation to the application. Linguistic errors, errors of transcription and obvious mistakes in the decision may be corrected under r.140, the application may be withdrawn or transferred or a designation may be withdrawn.
- Case law Where a patent is granted with a text not approved by the applicant there is a right of appeal since the applicant is adversely affected by the decision (J12/83). Some decisions have also allowed an appeal where the applicant approved the text but that text was clearly not what either the Examining Division or the applicant intended, for example where it did not include drawings which the applicant had not withdrawn (see, for example, T408/21, T1003/19 and T2081/16 as well as diverging decision T265/20 which did not allow such an appeal).

- J28/03 When the mention of grant has been published in the bulletin, the fact that an appeal has been filed against the decision to grant does not mean that a divisional application can once more be filed – the suspensive effect on its own is not enough in this case (unlike the case where an appeal is filed against a decision to refuse). Only if the appeal is allowed does the application become pending again for the purposes of r.36(1).
- Guidelines See C-V, 2, H-II, 2.6 and H-VI, 2.1. After a decision to grant has been taken (it is effective at the moment the decision is handed to the EPO's internal postal system or, very rarely, when announced in oral proceedings), neither amendment under Art. 123(1) nor correction under r.139 are possible. Only correction of the decision under r.140 is possible (and this cannot be used to change the text of the specification, G1/10). It would be possible, for example, to correct the bibliographic data in the decision under r.140 (H-VI, 3.2).

### 12.5 The decision to grant takes effect on publication of the mention of grant in the Bulletin

- 991 Art. 97(3) The decision to grant a European patent takes effect on the date on which the mention of grant is published in the European Patent Bulletin.

### 12.6 No publication of the mention of grant until designation or renewal fees have been paid

- 992 r.71a(3) If the designation fee becomes due after the communication under r.71(3), the mention of the grant of the European patent will not be published until the designation fee has been paid. The applicant will be informed accordingly.
- r.71a(4) If a renewal fee becomes due after the communication under r.71(3) and before the next possible date for publication of the mention of grant of the European patent, the mention will not be published until the renewal fee has been paid. The applicant will be informed accordingly.

### 12.7 Publication of the specification of the granted patent

- 993 Art. 98 The European Patent Office will publish the specification of the European patent as soon as possible after the mention of grant of the European patent has been published in the European Patent Bulletin.
- r.73(1) The specification of the European patent includes the description, the claims and any drawings. It also indicates the period for opposing the European patent.
- r.73(2) The President of the EPO determines the form of the publication of the specification and the data to be included.
- r.73(3) The designated Contracting States are indicated in the specification.
- Art. 14(6) The specification of the European patent is published in the language of the proceedings and includes a translation of the claims in the two other official languages of the European Patent Office.
- r.52(5) The particulars in the declaration of priority are published with the granted patent.
- OJ The European patent as granted or amended is published in electronic form by means of a publication server from which it may be downloaded (since April 1, 2005) – see Decision of the President dated 12 July 2007, [2007] O.J. Special Edition No. D3.
- r.20(1) The designated inventor will be mentioned in the European patent specification unless the inventor informs the EPO in writing that they have waived their right to be thus mentioned.

- r.20(2) In the event of a third party filing with the EPO a final decision determining that the applicant for or proprietor of a European patent is required to designate them as an inventor, the provisions of r.20(1) apply.
- OJ A copy of the patent can be requested to accompany the certificate ([2007] O.J. Special Edition No. 3, p. 95). Where technical information has been included in the file wrapper during prosecution, the granted patent will contain a reference to such material ([1981] O.J. 74 and Guidelines C-V, 1.5). The title of the invention is only shown on the title page and not as a heading to the description ([1984] O.J. 88). The published specification is not legally authentic (the text agreed for grant is) and any mistakes in it may readily be corrected ([1990] O.J. 260, T150/89 – see also Guidelines H-VI, 4 and C-V, 10). A list of any art cited by the applicant in the description pursuant to r.27(i)(b) is listed separately at the end of the published specification (see Decision of the President dated 12 July 2007, [2007] O.J. Special Edition No. 3 D4). A sequence listing filed with the application is published as part of the description (see Decision of the President dated 28 April 2011, [2011] O.J. 372).
- Guidelines See C-V, 11 – the patent specification is not published where the application is withdrawn before termination of the technical preparations for publication.

### 12.8 Grant to different applicants

- r.72 Where different persons are recorded in the European Patent Register as applicants in respect of different Contracting States, the EPO will grant the European patent for each Contracting State accordingly. 994

### 12.9 Issue of a certificate

- r.74 As soon as the specification of the European patent has been published, the EPO issues to the proprietor of the patent a certificate for a European patent. The President of the EPO prescribes the content, form and means of communication of the certificate and determines the circumstances in which an administrative fee is due. 995
- OJ The certificate is supplied as a digital file for download where the proprietor/representative has an activated Mailbox and in paper form in other cases. The certificate is issued to each proprietor where there is more than one. The supply of any additional certified copies of the certificate with the patent attached is subject to an administrative fee. The certificate must state the patent number and certify that the patent has been granted, in respect of the invention described and the States designated in the patent specification, to the persons named in the certificate. It also states the title of the invention, the date of grant and the name and address of the proprietor(s). A new certificate is issued when a patent is maintained in amended or limited form. See Decision of the President dated 17 December 2021, [2021] O.J. A94.
- RRF Art. 3(1) The amount of the administrative fee is fixed by the President of the EPO.
- OJ There is no fee if the certificate is requested using MyEPO. Otherwise, the amount is € 120 (see decision of the President dated 25 January 2024, [2024] O.J. A5).

### 12.10 Validation in contracting States

- See Chapter 18 (The application and patent in the Contracting States). 996

**12.11 Registration of the granted patent**

- 997 OJ A European patent (UK) may be registered in Hong Kong – a request must be filed within six months of publication of the application ([1997] O.J. 429 and [2009] O.J. 546). A European patent (UK) may also be registered in several overseas territories after grant ([2018] O.J. A97).

**12.12 Validation in non-contracting States**

- 998 NatLaw Note that for the extension of a European patent to one of the extension states or the validation of a European patent in a validation state to be valid, various acts in these states are necessary following the grant of the European patent (see Table IV).

## Chapter 13: European Patent with Unitary Effect

### 13.1 Abbreviations

	For the purposes of Chapter 13, the following abbreviations apply:	999
EU1257	Articles (Art.) and Recitals (Rec.) of Regulation (EU) No EU1257/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection ([2013] O.J. 111)	
EU1260	Articles (Art.) and Recitals (Rec.) of Regulation (EU) No EU1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements ([2013] O.J. 132)	
UPCA	Articles (Art.) and Rules of Procedure (r.) of the Agreement on a Unified Patent Court ([2013] O.J. 287), as amended	
UP Guidelines	Unitary Patent Guidelines published by the EPO	
UPR	Rules relating to Unitary Patent Protection adopted by Decision of the Select Committee of the Administrative Council of 15 December 2015 ([2016] O.J. A39), as amended	
UPRRF	Rules relating to Fees for Unitary Patent Protection adopted by the Decision of the Select Committee of the Administrative Council of 15 December 2015 ([2016] O.J. A40), as amended	

### 13.2 Status of the Unitary Patent Regulation in relation to the PC, PCT and EPC

EU1257 Art. 1(2)	This Regulation constitutes a special agreement within the meaning of Art. 142 EPC.	1000
EPC Art. 142(1)	Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of those States.	
EU1257 Rec.(6)	The Regulation also constitutes a regional patent treaty within the meaning of Art. 45(1) PCT and a special agreement within the meaning of Art. 19 PC.	

### 13.3 New institutions

#### 13.3.1 Select Committee of the Administrative Council

Art. 145(1) EPC	The group of Contracting States may set up a Select Committee of the Administrative Council for the purpose of supervising the activities of the special departments set up under Art. 143(2); the EPO will place at its disposal such staff, premises and equipment as may be necessary for the performance of its duties. The President of the EPO will be responsible for the activities of the special departments to the select committee of the Administrative Council.	1001
EU1257 Art. 9(2)	The participating Member States shall ensure compliance with this Regulation in fulfilling their international obligations undertaken in the EPC and shall cooperate to that end. In their capacity as Contracting States to the EPC, the participating Member States shall ensure that the governance and supervision of the activities related to the tasks referred to in EU1257 Art. 9(1) and shall ensure the setting of the level of renewal fees in accordance with EU1257 Art. 12 and the setting of the share of distribution of the renewal fees in accordance with EU1257 Art. 13 of this Regulation.	

To that end they shall set up a select committee of the Administrative Council of the European Patent Organisation (hereinafter ‘Select Committee’) within the meaning of Art. 145 EPC.

The Select Committee shall consist of representatives of the participating Member States and a representative of the Commission as an observer, as well as alternates who will represent them in their absence. The members of the Select Committee may be assisted by advisors or experts.

Decisions of the Select Committee shall be taken with due regard for the position of the Commission and in accordance with the rules laid down in Art. 35(2) EPC.

EPC Art. 35(2) A majority of 75 % of the votes of the Contracting States represented and voting is required for decisions that the Select Committee of the Administrative Council is empowered to take.

r.2(1) UPR The Select Committee of the Administrative Council shall be competent to amend

- (a) the present Rules (i.e. Rules relating to Unitary Patent Protection);
- (b) the Rules relating to Fees for Unitary Patent Protection;
- (c) other rules or decisions of a financial or budgetary nature;
- (d) its Rules of Procedure.

r.2(2) UPR The Select Committee of the Administrative Council shall ensure the governance and supervision of the activities related to the tasks entrusted to the EPO in accordance with r.1(1) UPR (i.e. the tasks entrusted to the EPO relating to the Unitary patent set out in EU1257 Art. 9(1)).

### 13.3.2 *Unitary Patent Protection Division of the EPO*

1002 Art. 143(1) EPC The group of Contracting States may give additional tasks to the EPO.

Art. 143(2) EPC Special departments common to the Contracting States in the group may be set up within the EPO in order to carry out the additional tasks. The President of the EPO will direct such special departments; Art. 10, paras 2 and 3 apply mutatis mutandis (President’s powers and functions).

r.3 UPR The Unitary Patent Protection Division referred to in r.4 UPR shall be managed by the President of the EPO, who shall be responsible for its activities to the Select Committee of the Administrative Council. To this end, Art. 10(2) and (3) EPC shall apply mutatis mutandis (functions and powers of the President of the EPO).

r.4(1) UPR A Unitary Patent Protection Division is hereby established within the EPO as a special department within the meaning of Art. 143(2) EPC.

r.4(2) UPR The tasks entrusted to the EPO in accordance with r.1(1) UPR shall be carried out under the responsibility of the Unitary Patent Protection Division.

r.4(3) UPR Decisions of the Unitary Patent Protection Division shall be taken by one legally qualified member.

r.4(4) UPR The President of the EPO may entrust to employees who are not legally qualified members the execution of duties falling to the Unitary Patent Protection Division and involving no legal difficulties.

EU1257 Art. 10 The expenses incurred by the EPO in carrying out the additional tasks given to it, within the meaning of Art. 143 EPC, by the participating Member States shall be covered by the fees generated by the European patents with unitary effect.

OJ See Decision of the President dated 30 May 2022 ([2022] O.J. A69). The tasks carried out by the Unitary Patent Protection Division are allocated to the Legal Division, those tasks involving no legal difficulties being delegated to a formalities officer.

### 13.4 A Unitary Patent may only be granted for participating EU states in which the Unified Patent Court has jurisdiction

- EU1257 Art. 3(1) A European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection. 1003
- EU1257 Art. 18(2) Furthermore, a European patent for which unitary effect is registered in the Register for unitary patent protection shall have unitary effect only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.
- EU1257 Art. 2(a) “Participating Member State” means a Member State that participates in enhanced co-operation in the area of the creation of unitary patent protection by virtue of Decision 2011/167/EU or by virtue of a decision adopted in accordance with the second or third subparagraph of Art. 331(1) of the TFEU (Treaty on the Functioning of the EU), at the time the request for unitary effect as referred to in Art. 9 is made.
- Guidelines See UP Guidelines 1.5.1 – 1.5.2. Different Unitary Patents may therefore have a different geographical scope depending on the number of eligible states when the unitary effect is registered. The European patent may be validated as usual in participating Member States which has not yet ratified the UPCA and in non-participating EPC states.

EU state	Participating Member State?	UPCA status	Entry into force
Austria	YES	Signed and ratified	01 June 2023
Belgium	YES	Signed and ratified	01 June 2023
Bulgaria	YES	Signed and ratified	01 June 2023
Croatia	NO		
Cyprus	YES	Signed	
Czech Republic	YES	Signed	
Denmark	YES	Signed and ratified	01 June 2023
Estonia	YES	Signed and ratified	01 June 2023
Finland	YES	Signed and ratified	01 June 2023
France	YES	Signed and ratified	01 June 2023
Germany	YES	Signed and ratified	01 June 2023
Greece	YES	Signed	
Hungary	YES	Signed	
Ireland	YES	Signed	
Italy	YES	Signed and ratified	01 June 2023
Latvia	YES	Signed and ratified	01 June 2023
Lithuania	YES	Signed and ratified	01 June 2023
Luxembourg	YES	Signed and ratified	01 June 2023
Malta	YES	Signed and ratified	01 June 2023
Netherlands	YES	Signed and ratified	01 June 2023
Poland	YES		
Portugal	YES	Signed and ratified	01 June 2023
Romania	YES	Signed and ratified	01 September 2024
Slovakia	YES	Signed	
Slovenia	YES	Signed and ratified	01 June 2023
Spain	NO		
Sweden	YES	Signed and ratified	01 June 2023