

**Update of the 24<sup>th</sup> edition of  
the Annotated European Patent Convention  
from 15-11-2016 till 31-12-2016**

**Amendments in view of OJ 11 and 12 of 2016 and the EPO website**

**Convention**

Page 25, Art.15:1

Fifth paragraph, replace the first sentence by ‘The Boards of Appeal and the Enlarged Board of Appeal are since 01.07.2016 no longer part of Directorate-General 3 but part of the Boards of Appeal Unit (R.12a(1)), located in Munich.’

Page 69, Art.53:2.2

Add after the first paragraph on page 69: ‘The EU Council published a meeting report on 20.02.2017, in which it urges member states to advocate that the EPO aligns its practice with the note of the Commission.

The EPO will stay ex officio all examination and opposition proceedings in which the decision depends entirely on the patentability of a plant or animal obtained by an essentially biological process. The EPO will inform all parties concerned. (OJ 2016 A104).’

Page 224, Art.94(3):7

First paragraph, replace sentence ‘The pilot ... 2017’ by ‘The EPO will publish a notice if the pilot programme is terminated before 05.01.2020.’ In the next sentence, replace ‘OJ 2014 A8’ by ‘OJ 2016 A106’

Third paragraph, replace ‘OJ 2014 A8 pages 9-17’ by ‘OJ 2016 A106 Annex 1 and 2’.

Page 266, Art.108:4

Third paragraph, add after ‘(OJ 2015 A13).’ the following sentences:

‘In case R4/15, issued after G1/14, the EBoA decided that a petition for review was deemed not to have been filed under Art.112a(4), last sentence, because the fee was paid after the two-month period; consequently, the fee was refunded (r.11, 12). The EBoA did not give any other reasoning than a reference to the law. In view of the similarity of Art.112a(4); R.108(1) and Art.108; R.77(1), the board in case T1553/13 decided that the appeal was deemed not filed because the appeal fee was paid late and refunded the appeal fee.’

Page 283, Art.112(3):3

After ‘T437/14’ add ‘and OJ 2016 A96, A105’

Page 349, Art.134a(1):2

In the one but last paragraph, replace ‘OJ 2008, 143 and 146, §4.2’ by ‘OJ 2016 A108 II. §5.2’.

Insert before the last paragraph: ‘Candidates intending to enrol for the eqe for the first time must register immediately once they have commenced their training. The registration requires payment of a fee. The period of training after registration counts for the three-year period. (OJ 2016 A108 I.)’

End of section 2, replace ‘OJ 2015 A98’ by ‘OJ 2016 A93’.

## Implementing Regulations

Page 415, R.9:

Add the following sentence before 'Implementation': 'R.9(1) amended by decision of the Administrative Council of 30.06.2016, which entered into force on 01.07.2016 (OJ 2016 A100). The decision changes the BsoA and the EBA from a directorate-general into a separate organisational unit, defined in R.12a.'

Page 415, R.9(1)

Change text of law paragraph to 'The European Patent Office shall be divided administratively into Directorates-General, to which the departments specified in Article 15(a) to (e), and the services set up to deal with legal matters and the internal administration of the Office, shall be assigned.'

Page 418, R.12 and 13

Change the law text of R.12 and R.13 to the text of R.12a-d and R.13 as given in [OJ 2016 A100](#).

Page 490, R.51(1):3

Second paragraph. Change the second 'R.51(4)' to 'R.51(5)'

Page 490, R.51(2)

Change text of law paragraph to 'If a renewal fee is not paid on the due date under paragraph 1, the fee may still be paid within six months of the said date, provided that an additional fee is also paid within that period. The legal consequence laid down in Article 86, paragraph 1, shall ensue upon expiry of the six-month period.'

Page 490, R.51(2)

Add the following note between the law text and note number 1: 'Amended by decision of the Administrative Council of 14.12.2016, which entered into force on 01.01.2017 (OJ 2016 A102, A103). The amendment defines the date the sanction on non-payment takes effect, without changing the practice of the office. It removes the discrepancy noted in T1402/13 between the previous text of the law and the practice of the office.'

Page 492, R.51(2)

Add after R.51(2):3 the following section:

'Start of the six-month period

After the amendment of R.51(2) on 01.01.2017, the provision explicitly defines the period for payment with additional fee as six months of the due date stated in R.51(1), i.e. six months of the last day of the month containing the anniversary of the date of filing of the European patent application. The purpose of this amendment was to clarify that a renewal fee can still be paid with additional fee if the renewal fee has not been paid on the due date under R.51(1) (CA/99/16 §32).

Whereas the amendment is appropriate for the normal due dates defined in R.51(1), it does not take into account the deviant due dates in R.51(1):3. Under the previous provision the additional period for a deviant due date was six months from the deviant due date and not from the normal due date.

The Guidelines (November 2016) still apply the previous practice and determine the six-month period for deviant due dates from the deviant due date. Hence, the determination of these six-month periods does not take the amended R.51(2) into account and, as a consequence, does not have a legal basis anymore. The six-month periods for deviant due dates in this book are based on the Guidelines.'

Page 692, R.147:

Add after the first sentence: (OJ 2015 A83; OJ 2016 A90)

Page 693, R.147(2):1

Add at end of notes: ‘The five-year period does not apply to record copies of PCT applications filed with the EPO on paper and kept by the EPO on behalf of the International Bureau (OJ 2016 A90 §5).’

Page 731, R.162(2)

Change text of law paragraph to ‘If the claims fees are not paid in due time, they may still be paid within the period under Rule 161, paragraph 1 or paragraph 2, as the case may be. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims and shall be paid within this period.’

Page 731, R.162(2):

Add the following note between the law text and note number 1: ‘Amended by decision of the Administrative Council of 14.12.2016 which entered into force on 01.01.2017. The amended rule applies to Euro-PCT applications for which the R.161/162 communication has not been issued on 01.01.2017. (OJ 2016 A102)

The amendment is a response to J11/12 and clarifies the unchanged practice of the office.

R.161(1): Invitation to respond to written opinion where EPO was ISA

R.161(2): Invitation to amend application where EPO was not ISA’

## Case Law Table

Page 896, G1/14

Replace ‘2014 A84’ by ‘2016 A95’.

Page 896, G1/16

Add in third column ‘2016 A96’.

## Corrections

A software error has caused several inverted commas in the law text to disappear. An inverted comma should be inserted after the following phrases:

EPC	R. 43(6) of the drawings
R. 12(1) Presidium of the Boards of Appeal	R. 44(1) The expression “special technical
R. 26(2) Biotechnological inventions	features
R. 26(3) Biological material	R. 46(2)(j) water, steam, open, closed, AB
R. 26(4) Plant variety	R. 48(1)(a) ordre public
R. 26(6) Microbiological process	R. 132(1) to be specified
R. 33(1) the requester	R. 143(1)(h) and others
R. 33(2) compulsory licence	
R. 43(1)(b) characterised in that	Protocol on Recognition
R. 43(1)(b) characterised by	Art. 1(2) courts
R. 43(6) of the description	Art. 1(3) the term “Contracting State