

**Update of the 23rd edition of
the Annotated European Patent Convention
from 15-11-2015 till 31-12-2015**

Amendments in view of OJ 11 and 12 of 2015 and the EPO website

Convention

Page 164, Art.79(2):1.1, third paragraph, correct part sentence ‘The designation fee ... 5.2.1)’ to ‘The designation fee is due upon mention of the publication of the search report (A-X,5.2.2)’.

Page 208, Art.92:2, change title to ‘Start of the search’

Page 208, Art.92:2, delete last two paragraphs and replace with the following text:

‘The search can only start if the application documents on filing are complete enough for the search to be performed. Since the search must be based on the claims according to Art.92, the search can only start after the claims and any translation have been filed (see notes to R.57(c)). It should be noted that in certain cases the filing of the translation may be made up to about one month before publication of the application, making it difficult to publish the search report together with the application.

If the Search Division has despatched a communication R.62a</REFERENCE> (multiple independent claims), 63 (unsearchable subject-matter) or 64 (non-unity) the search can only proceed after receipt of the applicant's response or expiry of the period for response. (OJ 2015 A93 §10, 11)’

Page 210, Art.92:7, replace the entire section with the following text:

‘The EPO always performs an accelerated search for direct European patent applications; no PACE request is needed. The EPO strives to issue the search report within six months from the date of filing (OJ 2015 A93 §8). As a transitional provision, the search of a direct European application filed before 01.07.2014 and claiming priority will only be accelerated after a PACE request (OJ 2015 A93 §1-6, 9, valid as from 01.01.2016).

The search division will only be able to complete the search in due time if the workload of the search division is not too high and the start of the search is not delayed (see above section 2; OJ 2015 A93 §6, 10).’

Page 215, Art.94(1):4, replace the complete section with the following text:

‘The programme for accelerated prosecution of European patent applications (PACE) enables a faster processing of applications during search and examination (Not. EPO, OJ 2015 A93; valid as from 01.01.2016).

An applicant can apply for accelerated prosecution by filing a PACE request. The EPO may restrict the number of allowed requests depending on technical field and applicant. The PACE request for acceleration must be filed online on a special EPO form. The EPO will acknowledge receipt promptly. A request not filed online or not on the special EPO form will not be processed. The request must be filed for one application at a time. It will not be published and will be excluded from file inspection. (OJ 2015 A93 §1-3, 6)

It should be noted that the request is a ‘document’ in the sense of R.2 the filing of which is governed by the Decisions of the President taken under R.2. A Notice of the EPO limiting the ways of filing a PACE request to online only appears to violate R.2.

The search is always accelerated; there is no need for a PACE request (Art.92:7).

Accelerated examination can only be requested after the examining division has become responsible for the application according to R.10 (see R.70(1):1; R.70(2):1 and C-II,1). (OJ 2015 A93 §12).

When accelerated examination has been requested, the examining division strives to issue a communication within three months from receipt of the request or the applicant's response to a previous communication, whichever is latest (OJ 2015 A93 §14, 15). The applicant can enquire with the EPO customer services as to the status of an application for which a PACE request has been filed (OJ 2015 A93 §7).

The examination will no longer be accelerated if the applicant withdraws the PACE request or requests an extension of a period, or if the application has been refused, withdrawn or deemed withdrawn. Since a PACE request may be filed only once during each stage of the procedure, a removal from the PACE programme cannot be undone by refiling the PACE request. Hence, an allowed request for further processing will continue the proceedings but not the accelerated examination. (OJ 2015 A93 §2, 4)

Accelerated prosecution will be suspended in the event of failure to pay the renewal fee by the due date (OJ 2015 A92 §5). After payment, accelerated prosecution will be resumed.’

Page 262, Art.108:4 third paragraph, replace the sentence ‘The case has ... G1/14.’ by ‘The referred case, G1/14, was not admissible because the decision applied R.126(1) incorrectly.’

Page 279, Art.112(3):2, last paragraph, change ‘OJ 2013, 449 and OJ 2014 A87’ to ‘OJ 2015 A92’.

Page 279, Art.112(3):3, delete the sentence ‘G1/14 ... A64).’

Page 279, Art.112(3):3, add after ‘T557/13’ the text ‘and OJ 2015 A101’

Page 344, Art.134a(1):2, last paragraph, change ‘OJ 2014 A110’ to ‘OJ 2015 A98’.

Implementing Regulations

Page 395, R.2(1):2, 7.1 and R.2(2):1, change all occurrences of ‘OJ 2009, 182’ to ‘OJ 2015 A91’, without changing the article numbers of the Decision of the President.

Page 411, R.11(3):1, first paragraph, add after ‘OJ 2014 A32’ the text ‘; OJ 2015 A104’.

Page 718, R.161(1):3, add the following text after the last paragraph:

‘The examination can be further accelerated by filing a PACE request. The requirements for such a request are set out in Art.94(1):4. The request can be filed at any time during the European phase, for example together with the Form 1200 or with the response to the R.161(1) communication. (OJ 2015 A93 §13)

When accelerated examination has been requested, the examining division strives to issue a communication within three months of receipt of the request or receipt of the applicant’s response to a previous communication, whichever is latest (OJ 2015 A93 §14, 15).’

Page 719, R.161(2):2, add the following text after the last paragraph:

‘The EPO always accelerates the supplementary search; no PACE request is needed. The EPO strives to issue the supplementary search report within six months from expiry of the six-month period of R.161(2), or, if the R.161(2) and 162 communication has been waived, from entry into the European phase (OJ 2015 A93 §6, 10(iii)). As a transitional provision, the supplementary search of a Euro-PCT application that entered the European phase before 01.07.2014 and claiming priority will only be accelerated after a PACE request (OJ 2015 A93 §1-6, 9; valid as from 01.01.2016).

Acceleration of the examination requires filing of a PACE request. The requirements for such a request are set out in Art.94(1):4. The request can be filed at any time during examination proceedings, at the earliest together with the response to the R.70a(2) communication or, if this communication has been waived, together with the response to the first Art.94(3) communication. (OJ 2015 A93 §12 and R.70a(2):1).’

Notes to the PCT

Page 787, section 2, 2.3, 2.3.2 and 7.4.1, change all occurrences of ‘OJ 2009, 182’ to ‘OJ 2015 A91’, without changing the article numbers of the Decision of the President.

Tables

Page 890, Case law table

in the line starting with G1/14, add in the middle column ‘19.11.2015’

in the line starting with G3/14 replace ‘2014 A115’ by ‘2015 A102’

in the line starting with G1/15 add in the right column ‘2015 A101’