

**Supplement to the 2021 Edition of
Visser's Annotated European Patent Convention**

updated until 31.10.2021

Derk Visser
Laurence Lai
Peter de Lange
Andrew Rudge
Kaisa Suominen

Introduction

This supplement is primarily for EQE 2022 candidates, taking into account the legal status cut-off date of 31.10.2021 (OJ 2017 A88). This supplement provides an overview of significant updates made to Visser in view of OJ 2021/04 to OJ 2021/10 as well as Enlarged Board of Appeal decisions and opinions.

The online edition of Visser available on the Kluwer IP Law website - www.kluweriplaw.com - is regularly updated and includes full commentary on these updates as well as amendments in view of recent Technical Board of Appeal decisions and new information from the EPO website.

The next print edition of Visser will be published in Spring 2022. This will include commentary on the 2022 edition of the Guidelines for Examination in the EPO.

Art.97(2):1, pages 240-241 – G4/19 (Double Patenting)

The Enlarged Board of Appeal issued, on 22.06.2021, its decision in the case G4/19, concerning double patenting.

Insert a new note Art.97(2):2:

2 Double patenting as a ground for refusal

A European patent application is to be refused under **Art.97(2)** and **Art.125** if it claims the same subject-matter as a European patent which has been granted to the same applicant and which does not form part of the state of the art pursuant to **Art.54(2)** and **(3)** for the patent application under examination. In such cases the patent application is refused, on the ground of prohibited double patenting (**G4/19** hn.1, r.78). The existence of overlapping designated contracting states under **Art.79** is an additional condition for the prohibition to apply (**G4/19** r.5, 80). The Enlarged Board confirmed the established practice of the EPO regarding double patenting objections in **G4/19**. However, there is no established case law as to when the applicants are the same for the purposes of the prohibition of double patenting.

The application can be refused on the ground of double patenting if it has the same effective date (filing date or priority date) as the granted European patent, which can be the case e.g. if the application was filed on the same day as the European patent application leading to the already granted European patent, or claims the same priority date (G-IV,5.4). A patent application can therefore also be refused on this legal basis if it is related to the already granted patent application as parent and divisional patent application, or as priority-founding and priority-claiming patent application. Note that only European patent applications form prior rights under **Art.54(3)**, not granted patents; the first headnote of **G4/19** is imprecise and should refer to the application from which the patent is derived not forming part of the state of the art rather than the patent itself. Furthermore, the patent application should not be refused for double patenting if the application under examination forms part of the state of the art for the patent pursuant to **Art.54(2)** or **(3)**.

A patent application and a patent are not directed to the same subject-matter if they both have a single independent claim and these claims differ by at least one feature. In such a case the criteria for double patenting set out in **G4/19** are not fulfilled (**T943/17** r.3.2). If the claims of the applications are merely partially overlapping, there is no impermissible double patenting (**T877/06**). **G2/10** r.4.5.5 acknowledged that an applicant may have a legitimate interest in obtaining rapid protection for a preferred embodiment in a first application and then pursuing broader claims in a divisional application (G-IV,5.4).

Should two applications with the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist (G-IV,5.4).

Art.110:1, page 281 – New article 15a RPBA

The RPBA were amended by inserting the following Art.15a RPBA regarding videoconference oral proceedings, which entered into force on 01.04.2021 (OJ 2021 A19). The complete text of the amended RPBA2020 as in force from 01.04.2021 was published in OJ 2021 A35.

Article 15a - Oral proceedings by videoconference

- (1) The Board may decide to hold oral proceedings pursuant to Article 116 EPC by videoconference if the Board considers it appropriate to do so, either upon request by a party or of its own motion.
- (2) Where oral proceedings are scheduled to be held on the premises of the European Patent Office, a party, representative or accompanying person may, upon request, be allowed to attend by videoconference.
- (3) The Chair in the particular appeal and, with the agreement of that Chair, any other member of the Board in the particular appeal may participate in the oral proceedings by videoconference."

Thus, the second paragraph of **Art.110:1** must be updated:

The RPBA in force until 31.12.2019 are published in OJ 2007 p.536 ('RPBA2007'). The RPBA which entered into force on 01.01.2020 are published in OJ 2020 sp2 ('RPBA'). New Art.15a of RPBA entered into force on 01.04.2021 and the updated complete RPBA was published in OJ 2021 A35. For transitional provisions, see **R.12c(2):1**.

Art.112(3):3, page 294 – Pending referrals to the Enlarged Board of Appeal

As of 31.10.2021, the referrals pending before the Enlarged Board of Appeal are as follows:

~~**G4/19** Double patenting. See OJ 2020 A20 for the staying of proceedings due to the referral, and **Art.139(3):3**.~~

~~**G1/21** Video conference oral proceedings. See referring decision **T1807/15** and **Art.116:2**.~~

G2/21 Plausibility. See referring decision **T0116/18**.

Art.116:1.1, page 307 — New article 15a RPBA

The third paragraph of Art.116:1.1 must be updated:

Videoconference oral proceedings have also become available before the Boards of Appeal during the COVID-19 pandemic. ~~Subject to approval by the Administrative Council,~~ a New Art.15a RPBA ~~will~~ was entered into force on 01.04.2021, allowing boards to decide whether oral proceedings are held by videoconference or in person. The new provision was, however, applicable as of 01.01.2021, and allows boards to hold oral proceeding by videoconference without consent of the parties (BOAC/16/20).

Art.125(1):1, page 342 – G4/19 (Double Patenting)

The second paragraph of Art.125(1):1 must be updated:

The provision applies in principle only to procedural law, not to substantive patent law (J15/86 hn.IV). ~~Holes in the material law must always be closed by changed in the EPC or by further development of the EPC.~~ However, a provision falling under **Art.125** may well cover issues which touch upon substantive matters, such as the scope of claimed subject-matter (G4/19, r.27). The Enlarged Board found that a European patent application is to be refused in certain cases under **Art.97(2)** and **Art.125** on the ground of impermissible double patenting (G4/19; see **Art.97(2):2**).

Art.139(3):1, page 372 – G4/19 (Double Patenting)

Add a new last paragraph in Art.139(3):1:

Double patenting between a European patent application and a granted European patent is not covered by **Art.139(3)**. Instead, it is a ground for refusal of the European patent application by the EPO (**G4/19**, see **Art.97(2):2**).

Art.153(5):2, page 390 – Publication of PCT-applications fulfilling requirements of Art.153(5)

As of 25.08.2021, the Bulletin publishes PCT-applications that fulfil the requirements of Art.153(5), i.e. which have not duly entered into the European phase but which are taken into account as Art.54(3) documents (OJ 2021 A51).

The fifth paragraph of Art.153(5):2 must be updated:

When these two conditions have been complied with, a Euro-PCT application will be regarded as a European prior right. This means that a Euro-PCT application does not need to fulfil all conditions for entry into the European phase to be regarded as a European prior right. The EPO thereby continues its practice under the EPC 1973. Such applications are mentioned in the Bulletin as of 25.08.2021 (OJ 2021 A51).

R.2, pages 414-420 – Decision of the President on electronic filing

The Decision of the President dated 03.03.2021 concerning the electronic filing of documents was published in OJ 2021 A20. The mention “to be published in OJ” is thus to be replaced with “OJ 2021 A20”. The Notice from the EPO dated 03.03.2021 concerning the launch of EPO's new filing service Online Filing 2.0 was published in OJ 2021 A21. The mention “to be published in OJ” is thus to be replaced with “OJ 2021 A21”.

The third paragraph of R.2(1):3 must be updated:

The general rules for acknowledgement of receipt of documents sent to the EPO were provided in the now abolished Notice of the EPO (OJ 2005, 44 §6). These rules have been copied to Dec. Pres. OJ 2019 A18 Art.8 concerning ‘the filing of patent applications and other documents by facsimile’. Notwithstanding the restrictive title of the Decision, its rules for acknowledgement should be applicable to acknowledgement of receipt of documents sent to the EPO by any method, not only by facsimile, except where specific rules for acknowledgement are provided (see e.g. **R.35(2)** for filing a European patent application, Dec. Pres. 03.03.2021 Art. 12 (~~to be published in OJ 2021 A20~~) for electronic filing of documents with the EPO, and Dec. Pres. OJ 2007 se3 A.6 Art.5 for electronic filing of European patent applications with the German Patent and Trade Mark Office).

The first paragraph of R.2(1):7 must be updated:

Documents can be sent to the EPO using fax. Fax can be used in any procedure and for any type of document, except authorisations and priority documents (Dec. Pres. OJ 2019 A18 Art.3). Debit orders may not be filed by fax (ADA.5.1.3). Note that while Dec. Pres. 03.03.2021 (~~to be published in OJ 2021 A20~~) does not list fax as an electronic filing means, the EPO applies the same safeguards to fax transmissions as for electronic filing means in case of technical problems (OJ 2020 A120 §1, see **R.134(1):3.2**).

The first paragraph of R.2(1):8 must be updated:

Documents, including European patent applications, may be filed electronically with the EPO as set out in Dec. Pres. 03.03.2021 and Not. EPO 03.03.2021 (~~both to be published in OJ 2021 A20, A21~~). Detailed information on the different electronic filing methods is given on www.epoline.org. The EPO encourages online filing of applications by a reduced filing fee (see **Rfees2(1)1**).

The second paragraph of R.2(1):8 must be updated:

European patent applications may be filed electronically also with national authorities of those contracting states which so permit (Dec. Pres. 03.03.2021 Art.2(3), ~~to be published in OJ 2021 A20~~). See e.g. Not. EPO OJ 2007 se3 A.6 for electronic filing of European patent applications with the German patent office.

The fourth paragraph of R.2(1):8 must be updated:

Where required, documents can be signed using a facsimile signature, i.e. an image of a handwritten signature, a text string between two forward slashes, or an enhanced

electronic signature, e.g. a smart card signature. (Dec. Pres. 03.03.2021 Art.11, ~~to be published in~~ OJ 2021 A20)

The sixth paragraph of R.2(1):8 must be updated:

Electronic filing, except Web-Form Filing, allows the filing of a pre-conversion archive in addition to the filed documents. The pre-conversion archive may contain original documents, i.e. before conversion into pdf or xml, in the format in which they were created, e.g. DOCX format. The original documents may be helpful in the event of quality issues and submission of colour documents. They will not become publicly available. (Dec. Pres. 03.03.2021 Art.10, ~~to be published in~~ OJ 2021 A20; OJ 2007 se3 A5 Art.3 and user guides)

The ninth paragraph of R.2(1):8 must be updated:

An electronic document that is illegible or incomplete, is infected, or has been filed using a method not allowing the filing of such a document (e.g. notice of opposition via Web-Form Filing) will be deemed not to have been received and the EPO will notify the sender without delay (Dec. Pres. 03.03.2021 Art.13, Art.3, ~~to be published in~~ OJ 2021 A20).

The tenth paragraph of R.2(1):8 must be updated:

The provisions for electronic filing apply not only to the filing of European patent applications and further documents but also to the filing of international applications and further documents filed with the EPO in the international phase (Dec. Pres. 03.03.2021 Art.2(1), ~~to be published in~~ OJ 2021 A20).

The first paragraph of R.2(1):8.1 must be updated:

Documents to be filed online with OLF are prepared, signed where required, packaged on a local computer and submitted by the sender in encrypted form to a secure server of the EPO (Dec. Pres. 03.03.2021 Art.8(1), ~~to be published in~~ OJ 2021 A20). The software to be used on the local computer can be downloaded free of charge from the EPO website, and regular software updates are made available to add functionality and update forms and fees. Currently, the earliest software version from which the EPO will accept filings is set out in OJ 2020 A105.

The third paragraph of R.2(1):8.1 must be updated:

OLF can be used for filing any type of document in all proceedings under the EPC, including opposition proceedings, limitation and revocation proceedings, appeal proceedings and proceedings for review under **Art.112a** (Dec. Pres. 03.03.2021 Art.2(1), ~~to be published in~~ OJ 2021 A20). OLF can be used for filing priority documents only if they have been digitally signed by the issuing authority and the EPO accepts the signature (OJ 202148 A93 A20 Art.44(1); see **R.53(1):2**). A filed priority document that is not duly signed is deemed not to have been received and the EPO will inform the sender without delay (Dec. Pres. 03.03.2021 Art.4, ~~to be published in~~ OJ 2021 A20).

The fourth paragraph of R.2(1):8.1 must be updated:

The format of the technical documents to be filed must be xml or pdf or, for sequence listings, a text-only format (Dec. Pres. 03.03.2021 Art.10(1), Art.5, ~~to be published in OJ 2021 A20~~, and user guide OLF). The EPO provides software to generate documents in xml format and to convert documents to pdf format with embedded fonts. The EPO will provide an acknowledgement of receipt within the submission session (Dec. Pres. 03.03.2021 Art.12(1)(a), ~~to be published in OJ 2021 A20~~).

The first paragraph of R.2(1):8.2 must be updated:

Documents can be filed electronically with the EPO using a data carrier (Dec. Pres. 03.03.2021 Art.1(2), ~~to be published in OJ 2021 A20~~). The data carrier can be used for filing documents in all proceedings under the EPC. The permitted types and formats of documents are the same as for the Online Filing using internet in the above section **7.1**. Before online filing was possible a data carrier was the only means filing a long sequence listing.

The third paragraph of R.2(1):8.2 must be updated:

The data carrier must be accompanied by a paper document stating the applicant and/or the representative, an address for correspondence and a listing of the files stored. (Dec. Pres. 03.03.2021 Art.8(2), ~~to be published in OJ 2021 A20~~)

The fourth paragraph of R.2(1):8.2 must be updated:

The data carrier and the document must be filed with the EPO by hand, delivery service or post (Dec. Pres. 03.03.2021 Art.12(5), ~~to be published in OJ 2021 A20~~).

The fifth paragraph of R.2(1):8.2 must be updated:

The EPO will send an acknowledgement of receipt as set out in the above section **2**. Note, that the rules set out in Dec. Pres. 03.03.2021 Art.12(1) (~~to be published in OJ 2021 A20~~) apply only to methods of filing using the internet.

The second paragraph of R.2(1):8.3 must be updated:

Use of CMS requires a smart card registered for CMS and certificates issued by the EPO (Dec. Pres. 03.03.2021 Art.6(2), 7(2), ~~to be published in OJ 2021 A20~~).

The fourth paragraph of R.2(1):8.3 must be updated:

CMS can be used for filing any type of document in all proceedings under the EPC (Dec. Pres. 03.03.2021, ~~to be published in OJ 2021 A20~~; A-VIII,2.5). The EPO will provide an acknowledgement of receipt in the CMS (Dec. Pres. 03.03.2021 Art.12(1)(b), ~~to be published in OJ 2021 A20~~). Priority documents may only be filed using CMS if they are digitally signed by the issuing authority and the signature is accepted by the EPO (Dec. Pres. 03.03.2021 Art.4(1), ~~to be published in OJ 2021 A20~~). See also **R.53(1):2**.

The second paragraph of R.2(1):8.4 must be updated:

Web-Form Filing can be used for filing European and PCT applications and further documents relating to such applications. It cannot be used for filing authorisations, priority documents and documents relating to opposition proceedings, limitation and revocation proceedings, appeal proceedings, and proceedings for review under **Art.112a**. (Dec. Pres. 03.03.2021 Art.3(1), ~~to be published in~~ OJ 2021 A20)

The fifth paragraph of R.2(1):8.4 must be updated:

The EPO will provide an acknowledgement of receipt on the website once the files have been transferred. An e-mail acknowledgement will be sent on request. (Dec. Pres. 03.03.2021 Art.12(1)(c), ~~to be published in~~ OJ 2021 A20)

The first paragraph of R.2(1):8.5 must be updated:

A pilot project for Online Filing 2.0, the planned successor to OLF and CMS, started on 04.05.2020 for volunteer users (EPO website ‘Online Filing 2.0 – call for pilot users’). Online Filing 2.0 ~~will be~~ launched on 01.04.2021. Use of Online Filing 2.0 requires a smart card registered for Online Filing 2.0 and certificates issued by the EPO (Dec. Pres. 03.03.2021 Art.6(2), 7(2), ~~to be published in~~ OJ 2021 A20). Similar to CMS, Online Filing 2.0 is a secure web-based application which requires no local software, except for the smart card software. Online Filing 2.0 covers all procedures before the EPO, including procedures before the boards of appeal. Online Filing 2.0 also integrates WIPO’s ePCT service for filing and managing PCT applications. (Not. EPO 03.03.2021, ~~to be published in~~ OJ 2021 A21)

The second paragraph of R.2(2)1: must be updated:

R.2(2) defines the permitted forms of signature. Paper documents that must be signed require a handwritten signature (**R.2(2)**). The signature reproduced on a fax is an appropriate form of signing (OJ 2019 A18 Art.4). Documents filed in electronic form may have a text string signature or an enhanced electronic signature (when using OLF) or their authenticity may be confirmed by a facsimile signature (Dec. Pres. 03.03.2021, ~~to be published in~~ OJ 2021 A20; OJ 2016 A21; OJ 2007 se3 A.5 Art.1).

R.12c(2):1, page 436 – New article 15a RPBA

The third paragraph of R.12c(2):1 must be updated:

The Rules of Procedure of the Boards of Appeal in force until 31.12.2019 are published in OJ 2007 p.536 ('RPBA2007'). The RPBA which entered into force on 01.01.2020 are published in OJ 2020 sp2 ('RPBA'). The amendments and explanatory remarks leading to the RPBA are provided in OJ 2020 sp2 p.46. New Art.15a of RPBA entered into force on 01.04.2021 and the updated complete RPBA was published in OJ 2021 A35.

R.53(1):2, page 523 – filing of priority documents

The Decision of the President dated 03.03.2021 concerning the electronic filing of documents was published in OJ 2021 A20. The mention “to be published in OJ” is thus to be replaced with “OJ 2021 A20”, see R.53(1):2 on page 536, last but one line of the page.

The third paragraph of R.53(1):2 must be updated:

Alternatively, the applicant may retrieve a copy of the priority document electronically from the issuing authority. The applicant may file the electronic copy with the EPO only using OLF, CMS or Online Filing 2.0 (see **R.2(1):8**). The copy must be in PDF format and digitally signed by the issuing authority using a signature accepted by the EPO (Dec. Pres. 03.03.2021, ~~to be published in~~ OJ 2021 A20). The signatures of the USPTO and Brazil's INPI are accepted by the EPO (Not. EPO OJ 2018 A94 §5). The EPO may accept other signatures but does not currently provide an exhaustive list of issuing authorities whose signatures are accepted.

R.57:8.3, page 542 – filing of priority documents

The first paragraph of R.57:8.3 must be updated:

Before expiry of 16 months from the earliest priority date, a certified copy of the priority document must be filed (R.53(1)), either on paper, electronically using OLF, ~~or~~ CMS, Online Filing 2.0, or on a data carrier, e.g. CD-R (A-III,6.7; see **R.53(1):2**). No copy need be filed if it is already available to the EPO, which will include a copy in the file free of charge (see **R.53(2):2**). The EPO also participates in the WIPO's digital access system (DAS) for exchanging certified priority documents (Dec. Pres. OJ 2020 A57; see **R.53(2):1**).

R.127(1), pages 668 – electronic notification

The third paragraph of R.127(1):1 must be updated:

As of 01.04.2021, almost all communications in examination and opposition proceedings ~~can be notified electronically (OJ 2021 A5)~~ as well as communications in appeal proceedings as of 01.06.2021, can be notified electronically (OJ 2021 A5, A37). A full list of communications which can be notified electronically via the Mailbox is available at <http://epo.org/mailbox-full-list>. The notification of an electronic document is governed by **R.127(2)**.

R.134(1), pages 682-684 – extension of periods

The first paragraph of R.134(1):3.1 must be updated:

The permitted means of electronic filing documents with the EPO are OLF, Online Filing 2.0, CMS, Web-Form Filing and fax (Not. EPO OJ 2020 A120 §1 which covers only outages of OLF, CMS and Web-Form Filing; see **R.134(1):3.2** below for outages of a fax server). The permitted means of electronic filing with the EPO as receiving Office under the PCT are given in **R.157(1):1**.

The third paragraph of R.134(1):3.1 must be updated:

For example, if a party wants to file a document on the last day of a period using OLF and notices that CMS is not available that day, the period will be extended, even though OLF, Online Filing 2.0 and Web-Form Filing are available. An extension due to an unavailable means of electronic filing probably does not give rise to an extension for other means of filing, such as filing by hand or post, as these means are not covered by **R.134(1)**, second sentence. Hence, a document submitted in an extension of a period due to an outage of electronic filing must probably be filed using electronic filing.

The first paragraph of R.134(1):3.3 must be updated:

The accepted means of making payment to the EPO electronically are CMS, Online Filing 2.0 and OLF for filing debit orders, the Online Fee Payment tool, and the EPO online service for making payments via credit card and bank transfers. Since methods of payment by deposit account are not part of the EPC procedures (**T170/83** r.8) and are therefore not covered by **R.134**, a legal basis for any extension of periods for filing debit orders is provided separately in ADA.5.5.

R.136(1):2.1, page 694 – date of removal of the cause of non-compliance

The third paragraph of R.136(1):2.1 must be updated by adding the following at the end of the paragraph:

In case of an applicant from a contracting state without representative, the date of removal of the cause of non-compliance is the date the applicant did become aware of the non-compliance, not when they ought to have become aware of it. Thus, the knowledge in patent law of the person responsible for the application vis-à-vis the EPO is also taken into account. (J1/20).

R.141(2):1, page 717 – automatic inclusion of priority search results

The third paragraph of R.141(2):1 must be updated:

The EPO will also include a copy of the search results of a priority application if that application was filed in AT, CH, CN, DK, ES, GB, JP, KR, SE or US (OJ 2021 A40 ~~Dec. Pres. OJ 2011 p.62; 2012 p.540, 2013 p.216; 2015 A2, A3, 2016 A18, A19; 2019 A55 and A56~~).

R.157(1):1, pages 745-746 – date of removal of the cause of non-compliance

The third paragraph of R.127(1):1 must be updated:

The permitted methods of filing an international application with the EPO are governed by provisions of the PCT, decisions of the President and the Guidelines (see E-IX,1; Euro-PCT Guide 2.2.001; and Not. EPO OJ 2014 A33). The EPO as rO accepts international applications filed electronically using EPO Online Filing (OLF) Software, Online Filing 2.0, EPO CMS Online Filing, or EPO Web-Form Filing (OJ ~~2018 A45~~ 2021 A20), or using ePCT (Dec. Pres. OJ 2014 A107). Web-Form Filing cannot be used for paying fees with a debit order. Filing by fax is possible and requires that a confirmation copy of the application including the request form is simultaneously sent by post (Dec. Pres. OJ 2019 A18 Art.2(2); A19 §12). The EPO as rO stopped accepting electronic filings using PCT-SAFE as of 01.07.2020 (OJ 2020 A59).

Rfees 2(1):17, page 806 – date of removal of the cause of non-compliance

The second paragraph of Rfees 2(1):17 must be updated:

The search fee for a (supplementary) international search under **Rfees2(1)2** and the fee for the preliminary examination of an international application under **Rfees2(1)19** will be reduced by 75% if each applicant is a natural person who is a national *and* resident of a state which is not party to the EPC and which is classified as a low-income or lower-middle-income economy (OJ 2020 A4, A35,~~A94~~; 2021 A58; Euro-PCT Guide 3.1.024). These states are listed in OJ 2021 A58 ~~2020 A94~~, Annex I. The reduction also applies if each applicant is a natural or legal person who is a national *and* resident of a state having a validation agreement with the EPO, irrespective of the state of the economy (OJ 2020 A4, A35,~~A94~~; 2021 A58).

Rfees5(1):17, pages 810-815 – new Central Fee Payment and payment by credit card

The EPO introduced Central Fee Payment as of 11.09.2021 as well as amended the ADA (OJ 2021 A26, A60) and published a new notice concerning payments by credit card. These have caused a number of changes in Rfees 5.

The note Rfees 5:1 must be updated:

As of 11.09.2021, the EPO provides an ~~Online~~ Central Fee Payment system service, accessible by smart card, which enables fees to be paid from a deposit account (see **Rfees5(2):2.1**), or with a username and password (without a possibility to pay from the deposit account). The Online Fee Payment system will continue to be available until all functionalities relating to fee payments and deposit accounts have been migrated to the Central Fee Payment, in 2022. Until then, for example deposit accounts can only be managed via the Online Fee Payment system.

~~The EPO also provides an online service for paying fees, accessible with a username and password. The online payment services is~~ are required to pay fees by bank transfer (see **Rfees5(1):1**), as well as by credit card (see **Rfees5(2):4**). The user selects the desired fees to be paid and indicates at the check-out stage whether the method of payment will be by deposit account, bank transfer or credit card. The check-out stage includes a validation functionality to automatically reject payment of fees that cannot be validly paid. (OJ ~~2020 A130~~ 2021 A61)

The first paragraph of Rfees 5(1):1 must be updated:

All payments to the EPO must be made to the EPO bank account in euro, without charge to the payee. See OJ ~~2020 A130~~ 2021 A61 for requirements for bank transfers and OJ 2016 sp2 p.32 for the details of the EPO bank account.

The second paragraph of Rfees 5(1):1 must be updated:

The EPO's online services can be used to make an order for payment by bank transfer for one or more applications. Once the order is confirmed, the online service provides an order confirmation with a payment reference. The payment reference is to be used in the bank transfer and allows the EPO to connect the payment with the relevant applications. The payment reference is usable once and is valid for two months. (OJ ~~2020 A130~~ 2021 A61)

The third paragraph of Rfees 5(1):1 must be updated:

A payment order cannot be cancelled or amended by user. In the event of an underpayment where the money reaching the EPO bank account is less than the total amount in the order, the fees will be paid in ascending order of the application numbers, with PCT preceding EP, and in ascending order of fee codes. Any underpaid and unpaid fees will be indicated in the payment confirmation in the online service. A new order for payment is required to redress the underpayment. (OJ ~~2020 A130~~ 2021 A61)

The first paragraph of Rfees 5(2):2 must be updated:

The payment of fees by debiting a deposit account is governed by the Arrangements for Deposit Accounts (ADA). The version valid as of 01.10.2019 is published in OJ 2019 sp4, amendments have been published in OJ 2020 A77, OJ 2021 A26 and A60. Instructions for online payment using a deposit account are given in the user guide ‘Online Fee Payment’. Since the ADA is an administrative regulation falling outside the EPC, certain provisions of the EPC do not apply, in particular Art.14 for languages and R.2 for filing methods.

The first paragraph of Rfees 5(2):2.1.1 must be updated:

The software for filing of debit orders prescribed in ADA.5.1.2 (amended by Dec. Pres. 18.03.2021, OJ 2021 A26 and Dec. Pres. 13.07.2021, OJ 2021 A60) ensures that debit orders include all information necessary for automatic processing, such as the application number, amount, and fee code. ~~According to the Guidelines and older case law, a debit order cannot be corrected (A-X,7.1.1). However, according to recent case law, a~~ debit order can be corrected under **R.139**, provided the requirements for correction as stated in the case law are met (**J8/19, T317/19, T1000/19**). Account holders may notify any errors to the EPO; the EPO checks the information and makes any corrections necessary, retroactively to the original decisive payment date (ADA.4.2). Moreover, the EPO may overlook small amounts lacking (**Rfees8**).

The first paragraph of Rfees 5(2):3 must be updated:

An applicant or proprietor may file an automatic debit order according to the Arrangements for the Automatic Debiting procedure (AAD). The version of the AAD in force as of 01.07.2020 is published in OJ 2019 sp4 Annex A1, with amendments published in OJ 2020 A77 and OJ 2021 A26. Explanations regarding the automatic debiting procedure are published in OJ 2019 sp4 Annex A2 and OJ 2020 A78.

The fourth paragraph of Rfees 5(2):3 must be updated:

The automatic debit order must be filed in XML in Online Filing, Online Filing 2.0 or CMS using one of the prescribed forms or via Online Fee Payment. Automatic debit orders relating to PCT applications for fees to be paid to the EPO must be filed using Online Filing, Online Filing 2.0, Online Fee Payment, CMS, PCT-SAFE or ePCT, using the PCT fee calculation and payment feature. (AAD.1.2, amended by Dec. Pres. 18.03.2021, OJ 2021 A26) Automatic debit orders cannot yet be filed with the Central Fee Payment (OJ 2021 A61).

The second paragraph of Rfees 5(2):4 must be updated:

Credit card payments can be made via the online services using American Express, Mastercard or Visa. The EPO will bear any transaction charges. (Not. EPO OJ 2021 A73 OJ 2020 A62)

Rfees 6(1):2. page 816 – purpose of payment

The note Rfees 6(1):2 must be updated:

For the efficient processing of payments made by bank transfer, the payer must give the application number and the fee code(s) in the payment-reference field of the (electronic) bank transfer, or a payment reference generated by the online service for payment for several applications, see **Rfees5(1):1** (OJ ~~2020 A13~~ 2021 A61). See **Rfees6(2)** for unclear or incomplete payment details.

Rfees 9:2. page 821 – refund of search fees

The second paragraph pf Rfees 9:2 must be updated:

Refund instructions must be filed in an electronically processable format via OLF, Online Filing 2.0, CMS or ePCT using one of the prescribed forms (ADA.8.2; OJ 2019 A82, amended by Dec. Pres. 18.03.2021, OJ 2021 A26).

Errata and Corrigenda

Art.75(1):2, page 162 – Filing

In the last paragraph, fourth line, reference to “note to AAD.5” should be “note to AAD.4”:

The national authorities accept (automatic) debit orders for deposit accounts according to ADA.5.6.1-5.6.3, notes to AAD.5 4 in ADA Annex A.2 and A-II,1.6.

Art.79(2):2.1, page 176 – Designation

In the last paragraph, last line, reference to “AAD.3.2(r) and notes thereto” should be “ADA Annex A.2, §I.11”:

Under the automatic debiting system only extension fees will only be debited for extension states for which the Request for Grant form indicates an intention to pay the extension fee (~~AAD.3.2(r) and notes thereto~~ ADA Annex A.2, §I.11).

Art.97(1):4, page 239 – Grant or refusal

In the last but one line of the second paragraph, the legal basis should be “Dec. Pres. OJ 2013 p.416” and a copy is only provided if requested and paid for:

~~The A certified copy of the certificate with the patent specification attached is sent only supplied if it has been duly requested upon request and payment of an administrative fee (Dec. Pres. OJ 2007 2013 se3-D:2 p.416; C-V,12).~~

Art.134a(1):1, page 361 – epi

In the second paragraph, reference to “ADA.8” should be to “ADA.9”:

Membership requires payment of an annual fee (Regulation, Art.6(1)), which may be paid through standard banking procedure or by direct debiting mandate (see ~~ADA.8~~ ADA.9).

R.13, page 438 – Enlarged BoA

The title of the rule should read “Business distribution scheme for the Enlarged Board of Appeal”.

R.30, pages 460-461 – Nucleotide and amino acid sequences

In R.30:1, second paragraph on page 460, second phrase should read:

See A-IV,5.1 for sequence listings inserted as a missing part under **R.56**, and A-IV,~~5.3~~ 5.2 for sequence listings filed by reference to a previous application under **R.40(1)(c)**.

R.30(3):1, last but one paragraph, last line, reference to the GL should be to A-IV,5.1:

Where a sequence listing can be included part under **R.56**, it will be considered as integral part of the description on the date of filing (which may or may not have changed because of the inclusion) (A-IV, ~~5-2~~ 5.1).

R.70, pages 570-572 – Request for examination

R.70(1):1, page 570, second paragraph, the reference to “AAD.3.2(f), 6.1(a)” should be to “AAD.5.1(a), the reference to “AAD.6.1(b)” should be to “AAD.5.1(c) and legal reference to the PACE programme should be to OJ 2015 A93:

If the applicant has filed an automatic debit order, the examination fee will be debited on the last day of the six-month period (~~AAD.3.2(f), 6.1(a)~~ AAD.5.1(a)). According to ~~AAD.5.1(e)~~ AAD.6.1(b), on early payment of the examination fee under the automatic debiting procedure, the examination fee will be deemed to have been paid on the day of receipt of the waiver for the invitation under **R.70(2)**, which may be ticked in the Request for Grant form, and on the day of receipt of the request for accelerated examination under the PACE programme (see ~~OJ 2007 se3 F4~~ 2015 A93).

In R.70(2):3, page 572, last line, the reference should be to Rfees11(b) and not to Rfees11.

R.70a(2), page 574 – Response to EESR

In the law text of R.70a(2), the last word of the law text is missing, and should read “application”.

R.78(1), page 601 – Entitlement

In the law text of R.78(1), the last sentence of the law text should not be part of the law text (“Art.61(1) European patent application filed by non-entitled person”).

R.152(1):1, pages 735-736 – Authorisations

The refence to the Decision of the President on authorisations should be corrected to read “OJ 2007 se3 L1”, which is the original publication of this decision. The publication in OJ 2014 sp1 p.82 is a re-publication of the same decision.

In the first paragraph, first phrase should thus read:

The President has determined the cases where an authorisation is to be filed (~~OJ 2014 sp1 p.82~~ OJ 2007 se3 L1).

The second phrase of second paragraph should read:

An original authorisation and one copy must be filed (~~OJ 2014 sp1 p.82~~ OJ 2007 se3 L1; T267/08 r.5).

In R.152(1):1, sub-point 1, the last phrase should read:

The EPO sends the previous representative a copy of the individual authorisation or notifies them of the number of the general authorisation and the name of the new representatives, and informs them that the subsequent proceedings will be conducted with the new representative. (~~OJ 2014 sp1 p.82~~ OJ 2007 se3 L1 Art.1(2))

R.152(1):1, sub-point 2, should read:

The EPO also requires an authorisation if the circumstances of a specific case necessitate this, particularly in case of doubt as to the professional representative's entitlement to act. (~~OJ 2014 sp1 p.82~~ OJ 2007 se3 L1 Art.1(3))

In R.152(1):1, sub-point 3, the last phrase should read:

If not filed together with their appointment, the EPO will request the practitioner or the employee, respectively, to file an authorisation within a period to be specified by it. (~~OJ 2014 sp1 p.82~~ OJ 2007 se3 L1 Art.2, 3; A-VIII,1.6)

R.154:1, page 741 – List of EPA's

The reference should be to ADA.9 for the payment of epi subscription, not to ADA.8:

See ~~ADA.8~~ ADA.9 for the possibility to pay the subscription by debiting a deposit account of the EPO by direct debiting mandate.

R.158, page 748 – EPO as ISA or IPEA

In R.158(1):1, page 748, third paragraph, reference to Euro-PCT Guide should be to 3.3.013:

The non-unity procedure before the EPO as ISA is given in Euro-PCT Guide ~~3.3.7~~ 3.3.013.

In R.158(2):1, page 748, third paragraph, reference to Euro-PCT Guide should be to 4.2.041:

The non-unity procedure before the EPO as IPEA is given in Euro-PCT Guide ~~4.2.12~~ 4.2.041.

In R.158(3):1, page 748, last phrase, reference to Euro-PCT Guide should be to 3.3.020:

See Euro-PCT Guide ~~3.3.8~~ 3.3.020 for the protest procedure before the EPO as ISA (OJ 2010 p.316 §7 and p.322 §11-12).

R.159, pages 756-764 – EPO as dO or eO

R.159(1):2.1, page 756, first phrase of fourth paragraph, reference to Euro-PCT Guide should be to 5.5.010 - 5.5.015:

An overview of which parts of the application the translation must include is given in E-IX,2.1.3 (see also Euro-PCT Guide 5.5.010 – 5.5.015).

R.159(1):4.1, page 758, end of last but one paragraph, reference to Rfees should be to Rfees2(1):4:

The page fee is calculated as set out in **Rfees2(1):4.1**.

R.159(1):10, page 764, second paragraph, add the second reference to the phrase:

The EPO as designated Office generally recognises decisions of the rO taken under R.26bis.3 PCT to grant the restoration of priority based on the ‘due care’ criterion (R.49ter.1(a) PCT; Not. EPO OJ 2007 p.694).