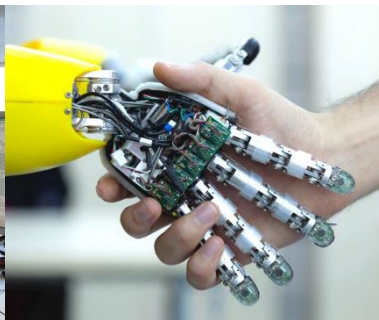




Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Recent and upcoming procedural changes

Platform Formalities Officers



Formalities Update - EPO

- Abolition of the option to waive the right to a further communication under Rule 71(3) EPC as of 01.07.2020
- Pilot project on notification by email during Examination proceedings 01.09.2020 – 31.08.2021
- Pilot project for oral proceedings by VICO in Opposition 15.04./15.09.2020 – 15.09.2021
- EPO-CNIPA pilot (EPO as ISA)

Abolition of the option to waive the right to a further communication under Rule 71(3) EPC As of 01.07.2020

*Notice from the European Patent Office dated 26 May 2020 concerning abolition of
the option to waive the right to a further communication under Rule 71(3) EPC
OJ EPO 2020, A73*

Abolition of waiver - Background

- When the European Patent Office (EPO) intends to grant a European patent, it first informs the applicant of the text intended for grant (Rule 71(3) EPC)
- If amendments or corrections are filed, and the Examining division gives consent, a further communication under Rule 71(3) EPC with a new time limit is issued
- Otherwise Examination proceedings are resumed

Abolition of waiver - Background

- As of 01.07.2015, the EPO had offered applicants the option of expressly waiving their right to receive a further communication under Rule 71(3) EPC
- The waiver option was introduced to increase procedural efficiency where the Examining division had no objection to the requested amendments and the necessary formal conditions for grant were fulfilled (see OJ EPO 2015, A52)
- However, the EPO has observed that, in practice, only a few applicants made use of this option

Abolition of waiver - Background

- In addition, once applicants complied with all requirements for the grant of a patent, the EPO immediately initiates the preparations for publication of the patent specification and, as soon as these are completed, issues the decision to grant
 - Following consultation with users, the EPO has therefore decided to abolish the waiver option and so always to establish approval of the text intended for grant in accordance with Rule 71(6) EPC
- **Waivers filed in response to a communication dated 01.07.2020 or later will not be processed!**

Possible replies to Rule 71 EPC

- **R.71(5) “approval of text”**
 - fee payment
 - claims translations
- **R.71(6) “disapproval”**
 - no payment
 - no claims translations
- **R.71(7) “deemed withdrawal”**
 - no/ late payment
 - no/late translation
 - no request for correction/ amendment

Rule 71(5) EPC (approval)

payment + claims translations

= **approval** of text + **verification** of bibliographic data

- Checking of text especially important in view of decision G 1/10 of 23.07.2012!

Rule 71(6) EPC (disapproval)

Applicant requests **reasoned amendments/corrections** to communicated text*, **no** payment + **no** claims translations

- new Rule 71(3) communication if examining division consents;
- otherwise resumption of examination**

***amendments/corrections of text** (description, claims, drawings),
not of bibliographic data (including title, classification)

** **resumption of examination** depending on history of application,
e.g. communication, summons to oral proceedings, refusal

Pilot project on notification by email during examination proceedings

01.09.2020 – 31.08.2021

Notice from the European Patent Office dated 23 July 2020 concerning the pilot project on notification by email during examination proceedings under the decision of the Vice-President Legal and International Affairs (Directorate-General 5) of the European Patent Office dated 23 July 2020, OJ EPO 2020, A89

Notification by email

- In order to communicate more effectively with applicants **in the period immediately before the oral proceedings**, and to
 - reduce paper consumption
 - the EPO has decided to launch a pilot project permitting Examining divisions to use email to notify important information about oral proceedings
- **The main objective of this pilot project is to test the suitability and reliability of using email instead of fax in such cases!**

Scope of the pilot project

- The pilot project will be limited to notices and other **communications without time limit**
- These notices or communications are usually issued to inform applicants of a decision to maintain, postpone or cancel oral proceedings and the reasons for that decision or of the preliminary assessment of any submissions received by the date set under Art. 116 EPC
- **Applicants similarly have the option of using email to reply to such notices and communications!**

Notification by email - framework

- The pilot project is conducted by Examining divisions assigned to directorates which have been selected to participate in the pilot
- The emails will be sent from a central email account created to that effect in each of those Directorates
- The pilot may be expanded to more directorates during its course if the findings are positive

Notification by email - framework

- The participation of applicants in the pilot is voluntary. They will be invited to consent to receiving the communications concerned by email in the annex to the summons to oral proceedings
- Where summons have been issued before 01.09.2020 and the oral proceedings are to take place on or after 01.11.2020, the invitation will be sent as stand-alone communication

Notification by email - framework

- Applicants will consent to their participation in the pilot by providing the email address to which they wish to receive the communications concerned
- The piloted procedures will be applied only in the participating directorates for the applications where the applicant gave consent
- The transmission by email of the communications covered by the pilot project will constitute a valid electronic notification under Rule 127 EPC. Therefore, no paper copies will be sent in parallel!

Practical information

- Besides the main email address, applicants may also provide a second email address, e.g. the email address of the employee or representative in charge of the application, to which the EPO will simultaneously forward a copy of any notice or communication as a courtesy service
- Any notice or communication notified by email will be sent from a central email account as an attachment in PDF format

Practical information

- If written submissions have been filed under Rule 116 EPC and the examining division considers it appropriate to inform the applicant ahead of the oral proceedings of its preliminary assessment of those submissions, including any information as to new relevant prior art, a copy of the documents concerned will also be attached to the email in PDF format
- The EPO will test whether the main email address provided by the applicant is functioning properly before sending any notices or communications by email under the pilot project

Notification by email

- Applicants will be required to **promptly acknowledge receipt of any notice or other communication** which the examining division has notified by email **by replying to that email**, confirming that they have received it
 - The functionality "request a delivery receipt" offered by most email applications is not considered reliable
 - If no acknowledgement of receipt is received within 24 hours of transmission of the email, the Examining division will contact the applicant
- **Receipt at a second email address is not verified!**

Legal Framework

- The transmission by email of any notice or other communication covered by the pilot project will have the effect of a notification by means of electronic communication under Rule 127 EPC
- No paper copies will be notified in parallel. For the purposes of settling a dispute within the meaning of Rule 127(2) EPC, second clause, the full content of the email, including the main email address, will be made available for inspection in the public file

Conditions applicable to submissions filed by email

- Written submissions filed by email in reply to any notice or other communication notified by the ED by email will have legal effect only if they are sent to the central email account
- The EPO will promptly issue an acknowledgement of receipt by email
- If applicants do not receive this acknowledgement of receipt within one working day, or if the submissions they filed by email have not been uploaded to the public file, they can contact the EPO's User Services

Conditions applicable to submissions filed by email

- The requirements applicable to the signature and format of documents filed by email laid down in the decision of the President of the European Patent Office dated 13 May 2020 concerning the filing of documents during telephone consultations and during interviews and oral proceedings held by videoconference (see OJ EPO 2020, A71) apply *mutatis mutandis*
- Where any attachments are illegible or incomplete, the EPO will promptly invite the applicant by email to remedy the deficiency!

Conditions applicable to submissions filed by email

- The EPO will endeavour to ensure that emails coming from the addresses specified by the applicant are intercepted by any spam or malware filters in place only if they are infected with a computer virus or contain any other malicious software.
- Any exchanges by email falling within the scope of the pilot project will be added as such to the file and made available for public inspection

Pilot project for oral proceedings by VICO in Opposition

14.04./15.09.2020 – 15.09.2021

Decision of the President of the European Patent Office dated 14 April 2020 concerning the pilot project for oral proceedings by VICO before ODs, OJ EPO 2020, A41)

Notice from the European Patent Office dated 14 April 2020 concerning the pilot project for oral proceedings by VICO before ODs OJ EPO 2020, A42, Decision of the President of the

European Patent Office dated 10 November 2020 concerning the modification and extension of the pilot project for oral proceedings by videoconference before opposition divisions, Notice from the European Patent Office dated 10 November 2020 concerning oral proceedings before examining and opposition divisions, and consultations, by videoconference

Introduction

The European Patent Office has offered the possibility of oral proceedings by VICO in examination since 1998. With a view to extending this option to other procedures, the EPO has launched a pilot project to assess its suitability in opposition

In view of the ongoing disruptions caused by the spread of COVID-19 the EPO has decided to postpone until further notice all oral proceedings in opposition and examination scheduled until 15.09.2021 which have not either already been confirmed to take place by VICO or will be held by VICO

Oral proceedings in opposition as VICO

- Oral proceedings scheduled until **31.12.2020** will be held as VICO with the parties' consent under the pilot project
- As of **04.01.2021** the consent is no longer necessary, and VICOs will be the default (in line with the practice in Examination)
- Oral proceedings may be held on the premises of the EPO, either at the request of a party or at the instigation of the opposition division if there are serious reasons against holding the oral proceedings by videoconference

Oral proceedings in opposition as VICO

- If a request to hold oral proceedings on the premises of the European Patent Office is refused, the parties will be informed of the reasons; such a refusal is not separately appealable
- Where there are serious reasons preventing the use of VICO in opposition, oral proceedings will be postponed until after 15 September 2021.
- The parties are informed about the postponement of oral proceedings in affected cases as soon as possible. They are invited to check the respective files online via the European Patent Register where the notice of postponement will be available shortly after its despatch

Oral proceedings in opposition as VICO

- The EPO intends to **maintain oral proceedings** in opposition which have been scheduled to take place **on the premises of the EPO on or after 15.09.2021**
- **As of May 2020** oral proceedings in opposition can be held as VICO in cases without interpretation via Skype for Business (SfB)
- **As of 15.09.2020** oral proceedings in opposition can be held as ViCo for cases with interpretation and/or multiparty (several opponents) via ZOOM
- The opposition **pilot will end on 15.09.2021** and based on the results, the President of the EPO will take decision

Agreement – until end of 2020

- Oral proceedings may be held until 31.12.2020 by VICO in opposition **if all parties** to be summoned to the oral proceedings **and the Opposition division agree**
- A formalities officer will contact the parties to explore whether they agree to hold the oral proceedings via VICO
- Parties should state as early as possible, preferably when filing a request for oral proceedings, whether they agree to the oral proceedings being held by VICO
- A request by a party for oral proceedings to be held by VICO will be considered an expression of agreement.
- **No appealable decision will be issued on such a request!**

Agreement – scenarios (until end of 2020)

- Where an **agreement on videoconferencing is reached before the summons to oral proceedings is issued**, the summons will indicate that the oral proceedings are to be held by VICO
- Where a summons has been issued to oral proceedings on the premises of the EPO and the parties express their agreement to **the oral proceedings being held by VICO only thereafter**, the parties will be informed that oral proceedings will be held by VICO on the date indicated in the summons

Agreement – scenarios (until end of 2020)

- **If there is no agreement by all parties**, the parties will be informed accordingly and will set up a new date together with a new summons
- Oral proceedings scheduled as of 04.01.2021 will take place as VICO per default unless there are serious reasons preventing the use of VICO

Location of participants

Parties and their representatives are allowed to connect to oral proceedings held by VICO from different locations. For the supporting systems see technical guidelines, published on the EPO website

The EPC does not require the parties to the proceedings to be physically in one of the member states in order to participate in oral proceedings by VICO

Admission of the public

- Any person may request to remotely attend oral proceedings held by videoconference in opposition proceedings
- The request is to be submitted via email to the EPO at support@epo.org at least three working days prior to the date indicated in the summons to oral proceedings
- A request submitted later may not be processed in time and consequently may be disregarded

Admission of the public

The request is to be filed by or on behalf of the member of the public wishing to attend the oral proceedings remotely (the requester) and should indicate:

- a) the application number
- b) the date of the oral proceedings
- c) the requester's name
- d) the requester's email address.

Admission of the public

- The EPO will send connection details for the oral proceedings to the requester at the email address indicated in their request
- In exceptional circumstances, access may be denied if the number of requests received exceeds the limit set and risks having an adverse impact on the conduct of the oral proceedings

Admission of the public - conditions

- Information about themselves to obtain connection details for remote access must be provided
- Participation is restricted to listening to the sound and watching the images transmitted during the videoconference.
- The member of the public must not switch on their microphone or camera, unless requested to do so by the chairperson; they are not entitled to speak or otherwise become involved in the videoconference, unless specifically invited to do so by the chairperson.

Admission of the public - conditions

- If so requested by the chairperson, the member of the public must temporarily switch on their camera to allow the videoconference participants to ascertain their identity (as if they were taking part in person on the premises of the EPO)
- It is prohibited for the member of the public attending oral proceedings remotely, or any other person, to make or retransmit video and/or sound recordings of any part of the videoconference, or to share/distribute the connection details to other persons

Submissions and their transmission

Decision of the President of the European Patent Office dated 13 May 2020 concerning the filing of documents during telephone consultations and during interviews and oral proceedings held by videoconference (OJ EPO, 2020, A71, A72)

Submissions and their transmission during OP

- Submissions are to be made by email and have to be attached in pdf format
- On the day of the oral proceedings, and before opening the oral proceedings officially, the opposition division (OD) will provide the parties with the email addresses of all members of the OD to be used during the oral proceedings for filing submissions
- Submissions made by one of the parties are to be always addressed to the complete OD. The OD will the submissions to the other parties via separate emails (data protection)

Admissibility of filing by email

- Each party must communicate to the EPO prior to the oral proceedings the email address it wishes to use for receiving copies of such submissions
- Documents filed subsequently as referred to in Rule 50 EPC, including authorisations, must be filed by email

Signature

- Where the filed documents require signature, this signature may be applied to the attached document or to the text of the accompanying email
- The signature may take the form of a string of characters or a facsimile signature
 - The string of characters selected by the signatory to provide evidence of their identity and their intent to authenticate the message in question must clearly indicate the person's name and position
 - A facsimile signature is the facsimile reproduction of a person's signature

Amended patent documents

- Amended patent documents must be filed as attachments in PDF format complying with the WIPO Standard for Filing and Processing in Electronic Form (Annex F)
- If an attachment does not comply with the above or is illegible or incomplete, the EPO will inform the party immediately

Supported systems – Skype for Business

- **The EPO supports the following technologies for connecting to oral proceedings held as a VICO:**
- Microsoft Skype for Business (SfB) Clients and SfB Room Systems
- Browser based Web Meeting via Skype for Business Web App
- SIP/H.323 video-conferencing systems

Supported systems - Zoom

- The EPO supports the following technologies for connecting to oral proceedings held as a VICO:
- Zoom desktop client installation on Windows, Mac OS (version 4.5.3261.0825 or higher)
- Zoom mobile App for iOS (version 4.5.0 [3261.0825] or higher) or Android (version 4.5.3261.0825 or higher)
- Due to its limited functionality, the Zoom Web client is not suitable to attend oral proceedings in opposition requiring simultaneous interpretation. It is thus not possible to use the Zoom Web client

Test call- Skype for Business and/or Zoom

- Users are strongly advised to perform a **test call** in good time prior to the date of the oral proceedings, i.e. **at least 10 working days in advance**
- The EPO offers the possibility for test calls on Mondays to Fridays (except days on closed days) from 13:00 to 16:00 hours CET
- A test call can be **arranged by contacting the EPO Serviceline** on Mondays to Fridays (except closed days) from 07:30 to 18:00 hours CET by telephone +31 70 340 4444 or by email (service@epo.org)

Test call

- EPO Serviceline will schedule a 30 minutes test session and send an invitation with the connection details for the call
- Goals that need to be met in the test are:
 - A stable connection, both audio and video should be of adequate quality
 - Presentation of content should be possible in both directions

Practical details

- The cameras of the participating parties (patent proprietor, opponent(s) and their accompanying persons) should be switched on at the beginning of the VICO in order to allow for the identities of the participants to be checked, and remain switched on
- The participants are invited to mute their microphones
- The cameras of the complete OD will remain active during the complete oral proceedings

Practical details

- In order to avoid background noise, the microphones of all participants other than the chairperson should normally be muted during the oral proceedings, except for the participant to which the chairperson is giving the word
- Delays in activation of the microphone will be taken into account

Practical details

- As in oral face to face proceedings, participants can let the chairperson know if they need a break
 - The chairperson will announce a break of the oral proceedings and the complete OD will change to their non-public deliberation room
 - All other participants will remain in the virtual oral proceedings room and are invited to mute their microphones and to switch off their cameras
- **The video conference link should not be disconnected!**

Technical issues during the VICO

- Prior to the oral proceedings parties are asked to provide a telephone number to be used during the VICO and in case technical issues arise
- The chairperson will provide a telephone number for contacting the OD at the beginning of the oral proceedings
- If the connection/reconnection fails, the OD will contact the party concerned by phone. Alternatively, the party can contact the OD

Technical issues during the VICO

- Technical support will be on hand
- Where technical problems prevent the oral proceedings by VICO from being conducted, a new summons to oral proceedings will be issued
- As a rule, such new oral proceedings will be held by VICO, unless there are serious reasons for not doing so!

Deliberate breaking of connection, interfering of public

- The pilot will explore the technical possibilities available for ensuring that the public is not able to interfere with the proceedings. As in oral face-to-face proceedings, ensuring the proper conduct of the oral proceedings is the task of the chairperson

Further information

- A test environment has been set up. See update on [oral proceedings and the technical guidelines on the EPO website](#)
- [E-learning centre of the EPO](#)
- <https://e-courses.epo.org/course/view.php?id=196>
- **FAQ:**
<https://www.epo.org/service-support/faq/procedure-law/oral-proceedings-by-VICO.html>

EPO-CNIPA pilot (EPO as ISA)

*Joint communiqué EPO-CNIPA dated 20 October 2020, pilot starts on
01 December, 2020*

CNIPA-EPO Pilot for ISA Files

- A **historic agreement** was reached in November 2019 between the Heads of Office of the EPO and the CNIPA to enhance their bilateral cooperation in the framework of the PCT
- The EPO will become the **first foreign Office** to be designated as ISA and IPEA by the CNIPA
- As of **1 December 2020**, in the framework of a 2-year **pilot**, nationals and residents of P.R. China filing a PCT application **in English** with the receiving Office of CNIPA or the IB will be able to **select the EPO as their ISA**

Background

The CNIPA-EPO pilot aims to give Chinese nationals or residents of the P.R. China the option of selecting the EPO as their International Searching Authority (ISA) and as their International Preliminary Examining Authority (IPEA) when filing international patent applications under the PCT for which either the CNIPA or the International Bureau (IB) of WIPO acts as receiving Office.

The pilot will start on **1 December 2020**

Background

- EPO will become the first foreign patent office to be designated as ISA for Chinese applicants
- The pilot will have a duration of two years for a maximum of 5,500 applications (2,500 in the first year and 3,000 in the second year)
- The pilot will include applications received at CNIPA and the International Bureau
- EPO will also be designated as International Preliminary Examining Authority (IPEA)/PCT Chapter II for this pilot

Requirements

- The applications must be filed in English with either RO/CN or RO/IB
- The international search fee will be paid directly by the applicants to the EPO if applicants choose CNIPA as Receiving office. It is planned to soon enable applicants participating in the pilot to pay this fee to the CNIPA in renminbi (CNY) on filing their application.
- The applications are accepted during the pilot phase on a first come, first served basis

Conditions for participating in the CNIPA-EPO pilot

- The CNIPA-EPO pilot is open to nationals and residents of P.R. China
- The international application must be filed with either CNIPA or the IB acting as receiving Office, Chinese nationals or residents cannot file the international application at the EPO as RO
- The international application must be filed in English. Applications filed with RO CNIPA or IB which are filed in Chinese with an English translation will not be accepted by the Receiving Office. Applicants filing such applications will be able to select the CNIPA as their ISA instead

Fees

- There is no additional fee for participating in the pilot
- The usual fees falling due on filing of an international application, i.e.:
 - transmittal fee (for applications filed with the IB)
 - the international filing fee, collected by the receiving Office on behalf of the IB
 - the international search fee
- If later a demand for international preliminary examination is filed, the preliminary examination fee and a handling fee need to be paid

The international search fee

- If the **application is filed with CNIPA**, until further notice, the international search fee must be paid directly to the EPO in EUR
- Payment can be made by credit card (Visa, Mastercard, Amex). SC holders with a deposit account with the EPO can also make payments via OLF or CMS
- OFP cannot be used for the International search fee, but for subsequent payments (e.g. non-unity search fee, International Examination fee). During the pilot it is not possible to pay by bank transfer
- If the **application is filed with the IB**, the search fee can be paid directly to the IB in EUR, CHF or USD

Filing a demand for international preliminary examination

- The demand should be filed together with any further document relating to this PCT Chapter II procedure, directly to the EPO as IPEA
- The handling fee and the preliminary examination fee have to be paid directly to the EPO in EUR by bank transfer, from a deposit account held at the EPO, or by credit card (Mastercard, Visa and Amex)

Information about the EPO as ISA and IPEA

- Details of the procedure before the EPO as ISA can be found in Chapter 3 of the GL for applicants: PCT procedure before the EPO (Euro-PCT Guide)
- Details on the procedure before the EPO as IPEA can be found in Chapter 4 of the Euro-PCT Guide

Where to find more information on the Pilot?

- Frequently Asked Questions (FAQ) on the EPO website
- Guidance for applicants on the CNIPA website
- Or contact the EPO
at support@epo.org and/or CNIPA
at PCTaffair@cnipa.gov.cn, by
mentioning CNIPA-ISA Pilot in the title of
your query



Thank you for your attention!

