



DELTA PATENTS

Training for Patent Professionals

BASIC LEGAL QUESTIONS FOR PRE-EXAM AND PAPER D

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Introduction and acknowledgement

This document comprises an update to the Study Guide and Questions and Answers as used in our Integrated Pre-Exam Courses in 2020, and to the 'Basic legal Questions for Pre-Exam and Paper D -book ("L-book", edition June 2020, EQE 2021):

- Publications in OJ EPO after the Book was printed (OJ June 2020 – 31 Oct 2020);
- Publications in PCT Newsletter after the Book was printed (PCT NL June 2020 – 31 Oct 2020);
- Corrections to the questions and answers.

We thank all who provided any comments and all candidates who participated in our legal training courses, as well as those that gave feedback on our material via email, for useful feedback. Any further comments are highly appreciated.

The latest version of this document is available on our website.

Also refer to our compilations of key parts of the EQE syllabus as in force on 31 October 2020 for EQE 2021, on <https://www.deltapatents.com/course-links.html>:

- EQE 2021 references - EQE
- EQE 2021 references - EPC
- EQE 2021 references - EPO and PCT
- EQE 2021 references - PCT

Roel van Woudenberg,
9 November 2020

EQE 2021 preparation courses

DeltaPatents organizes further training sessions for candidates preparing for Pre-Exam 2021 and for the Main Exam 2021 in the period from April 2020 until February 2021. Also, our Correction Papers programme for the EQE Main Exam papers will start after the summer and be active until late January.

Please check our website for course details, further announcements and enrolment:

<http://www.deltapatents.com/eqe.html>

<http://www.deltapatents.com/eqe-pre-exam.html>

<http://www.deltapatents.com/eqe-main-exam-paper-d.html>

<http://www.deltapatents.com/registration--cancellation.html>

or contact us via email at:

training@deltapatents.com .

1. Update of Study Guide

Notes on the references & Training Material and Sources – Law + Regulations

How to get.../ Guide for applicants / Euro-PCT Guide (HTG)

A new, 20th edition of "European Patent Guide - How to get a European patent (April 2020)", based on the information available on 1 April 2019, was published on 7 October 2020

- Numbering is (largely) unchanged.
- Please replace all references to "Guide for Applicants: How to get a European patent", 18th edition to "European Patent Guide: How to get a European patent", 19th edition.

Case Law (EPC)

(Advanced Topics): Case Law of the Boards of Appeal from www.epo.org

Add:

- "EPO Boards of Appeal Case Law 2018 and 2019" (Case Law supplement), OJ Suppl 4/2020

Training Material and Sources – Law + Regulations

EQE

1. EQE Regulation

Add:

- "EQE 2021 – Important information from the Supervisory Board", 23.07.2020 (EQE website)
- e-EQE FAQ on <https://www.epo.org/learning/eqe/faq.html>
- **Check EQE website for updates!** <https://www.epo.org/learning/eqe.html>

B5, Law + Regulations:

Add to OJ 2016, A6:

- Supplemented per 1/7/2020 with OJ 2020, A80 "R.20.8(c), 82ter.1(c) and (d) PCT items"

C4, Law + Regulations:

Add to Art.53(b):

- OJ 2020, A79 "Notice from the EPO dd 3 June 2020 concerning resumption of proceedings following G 3/19"

G2, Law + Regulations:

Add to OJ 2014, A6

- Supplemented per 1/1/2016 with OJ 2015, A104 (R.140 decisions, corr. of granted text)
- Supplemented per 1/7/2020 with OJ 2020, A80 (R.20.8(c), 82ter.1(c) and (d) PCT items)

Add to Advanced:

- OJ 2020, A80 "Decision of the President dd 14 June 2020 concerning the entrustment to non-examining staff of certain duties incumbent on the examining or opposition divisions": added item "23a, Examination, communications and decisions under Rule 20.8(c) PCT and Rule 82ter.1(c) and (d) PCT" per 1/7/2020



H4, Law + Regulations:

Add:

- OJ 2019, A106 “PPH pilot programme between the IP5 Offices based on PCT and national work products”
- OJ 2019, A107 “PPH pilot programme EPO and Peru based on PCT and national work products”
- OJ 2020, A11 “PPH pilot programme EPO and ROSPATENT based on PCT and national work products”
- OJ 2020, A21 “PPH pilot programme EPO and Mexico based on PCT and national work products”
- OJ 2020, A82 “PPH pilot programme EPO and Malaysia based on PCT and national work products” (including corrigendum of OJ 2020, A92)
- OJ 2020, A83 “PPH pilot programme EPO and Philippines based on PCT and national work products”
- OJ 2020, A114: “PPH programme between the EPO and the Eurasian Patent Office (EAPO) based on PCT and national work” (replaces OJ 2017, A77)

H6, H8, Law + Regulations:

- OJ 2020, Axx (June 2020) “Decision of the President dd 13 May 2020 concerning the filing of documents during telephone consultations and during interviews and oral proceedings held by videoconference” was published as OJ 2020, A71
- OJ 2020, Axx (June 2020) “Notice from the EPO dated 13 May 2020 revising its Notices dated 1 April 2020...” was published as OJ 2020, A72
- OJ 2020, Axx (June 2020) “Notice from the EPO dated 26 May 2020 concerning abolition of the option to waive...” was published as OJ 2020, A73

H9, Law + Regulations:

Add:

- OJ 2020, A31 “Notice from the EPO dated 13 March 2020 concerning improved online file inspection in the European Patent Register of documents cited in opposition proceedings” (for oppositions filed per 1/7/2019)
- OJ 2020, A106 “Notice dd 28 August 2020 concerning the communication for information purposes of observations made by parties to opposition proceedings to the other parties to the proceedings” (per 1/10/20)
 - Consolidated list of opposition citations (patent documents, other documents filed during oppo)
 - No longer automatically transmission of documents which are available for inspection in the Register.
 - EPO still communicates notices of opposition & observations to the other parties for info (R.79).

Updates:

- OJ 2009, 434 was superseded by OJ 2020, A106 per 1/10/2020
- Update reference to OJ 2020, Axx (June 2020) by OJ 2020, A71 (2x)

H10, Law + Regulations:

Add:

- OJ 2020, A103 “Notice of the President of the Boards of Appeal dd 1 August 2020 concerning oral proceedings before the Boards in Haar and in the Isar building in Munich during the coronavirus (COVID-19) pandemic”

H11, Law + Regulations:

- OJ 2020, Axx (June 2020) “Notice dd 27 May 2020 concerning the disruptions due to the COVID-19 outbreak” was published as OJ 2020, A74
- OJ 2020, Axx (June 2020) “Decision of the Administrative Council of 28 May 2020 temporarily suspending the application of Rule 51(2) EPC with respect to the additional fee, as referred to in RFees 2(1).5 (CA/D 6/20)” was published as OJ 2020, A70
- OJ 2020, Axx (June 2020) “Notice from the EPO dd 29 May 2020 concerning temporary suspension of the application of Rule 51(2) with respect to an additional fee for belated payment of a renewal fee (RFees 2.1(5))” was published as OJ 2020, A75

Add:

- OJ 2020, A107 “Notice 14 September 2020 concerning the expansion of electronic notification via the Mailbox in opposition proceedings” (per 1/12/2020): all communications in opposition, except for the transmission of the patent certificate if the patent is maintained in amended form (R.87 jo R.74).
- OJ 2020, A89 “Decision of the Vice-President Legal and International Affairs (Directorate-General 5) of the EPO dd 23 July 2020 concerning the pilot project on notification by email during examination proceedings”
- OJ 2020, A90 “Notice from the EPO dd 23 July 2020 concerning the pilot project on notification by email during examination proceedings under the decision of the VP Legal and International Affairs (DG 5) dd 23 July 2020”
- OJ 2020, A103 “Notice of the President of the Boards of Appeal dd 1 August 2020 concerning oral proceedings before the Boards in Haar and in the Isar building in Munich during the coronavirus (COVID-19) pandemic”

H12, Law + Regulations:

Add:

- OJ 2020, A76 “Notice from the EPO dd 29 May 2020 concerning implementation of amended Rule 142(2) EPC”

Update:

- Update reference to OJ 2020, Axx (June 2020) “Notice 27 May 2020” by OJ 2020, A74
- Update reference to OJ 2020, Axx (June 2020) “Decision 28 May 2020” by OJ 2020, A70
- Update reference to OJ 2020, Axx (June 2020) “Notice 29 May 2020” by OJ 2020, A75

H14, Law + Regulations:

- OJ 2020, Axx (June 2020) “Decision of the Administrative Council of 28 May 2020 temporarily suspending the application of Rule 51(2) EPC with respect to the additional fee, as referred to in RFees 2(1).5 (CA/D 6/20)” was published as OJ 2020, A70
- OJ 2020, Axx (June 2020) “Notice from the EPO dd 29 May 2020 concerning temporary suspension of the application of Rule 51(2) with respect to an additional fee for belated payment of a renewal fee (RFees 2.1(5))” was published as OJ 2020, A75

Add:

- OJ 2020, A77 “Decision of the President dd 4 June 2020 amending Annex A.1 to the Arrangements for deposit accounts (ADA) – Arrangements for the automatic debiting procedure (AAD) and Annex A.2 to the ADA – Information from the EPO concerning the automatic debiting procedure” (amended AAD 10.3 & 3.2; amended Point 10 AAD in Annex A.2 to the ADA) per 1 July 2020
- OJ 2020, A78 “Notice from the European Patent Office dated 4 June 2020 concerning changes to fee payment via the automatic debiting procedure”:
 - I. Ex officio revocation of all pending automatic debit orders upon closure of a deposit account
 - II. Additional search fee under R.40bis jo 20.5bis PCT in the event of correction of an erroneous filing
 - III. Abolition of the option to waive a further communication under Rule 71(3) EPC

L1, Law + Regulations:

Add to EPO-WIPO Agreement:

- - OJ 2020, A91 “Updated Annex D, Part II reduction of fees – revised lists of states”

L1, PCT Newsletter:

Add:

- PCT NL June 2020, Practical Advice “Entitlement to practice before the International Bureau as receiving Office (when an international application is assigned to an applicant from a different country)”



- PCT NL Jul-Aug 2020 “End of COVID-19-related RO/IB Extended Period for Considering PCT Applications as Withdrawn for Failure to Pay Fees”: RO/IB restarted on 1 July 2020 the issuance of Form PCT/RO/117 for failure to pay the required PCT fees

L1, Amendments to the PCT in the last few years:

- PCT NL Jul-Aug 2020 “ Excuse of Delay in Meeting Time Limits Due to Unavailability of Electronic Means of Communication (PCT Rule 82quater.2 per 1 July 2020)”:
 - IB as rO will use R.82quater if ePCT or PCT Contingency Upload Service was being used but was unavailable for a minimum of a continuous one-hour period on a specific working day at the IB
 - (does not apply to the priority period).

L2, PCT Newsletter:

Add:

- PCT NL Oct 2020, Practical Advice: “Access by third parties to the inventor’s address that was included in the request form upon filing, but is subsequently changed following a request under PCT Rule 92bis”
- PCT NL July/Aug 2020, Practical Advice “The furnishing of a correct element of an international application where the originally filed element was filed erroneously” (on R.20.5bis, 40bis.1 & 20.8, introduced per 1/7/20)

L2, Law + Regulations:

Add:

- OJ 2020, A81 “Notice of the EPO dated 14 June 2020 concerning new Rule 20.5bis PCT on the correction of erroneous filings in the procedures before the EPO” (per 1 July 2020)

L3, PCT Newsletter:

Add:

- PCT NL Sept 2020, Practical Advice “Access by third parties to information in the file of the international preliminary examination”

L3, Law + Regulations:

Add to OJ 2020, A4:

→ *republished with up-to-date list of states as OJ 2020, A91 “Notice from the EPO dd 10 July 2020 concerning the reduction of the fees for the international search and the international preliminary examination carried out on international applications in favour of nationals of certain states – revised list of states”*

Add:

- OJ 2020, A77 “Decision of the President dd 4 June 2020 amending Annex A.1 to the Arrangements for deposit accounts (ADA) – Arrangements for the automatic debiting procedure (AAD) and Annex A.2 to the ADA – Information from the EPO concerning the automatic debiting procedure” (amended AAD 10.3 & 3.2; amended Point 10 AAD in Annex A.2 to the ADA) per 1 July 2020
- OJ 2020, A78 “Notice from the European Patent Office dated 4 June 2020 concerning changes to fee payment via the automatic debiting procedure”:
 - I. Ex officio revocation of all pending automatic debit orders upon closure of a deposit account
 - II. Additional search fee under R.40bis jo 20.5bis PCT in the event of correction of an erroneous filing
 - III. Abolition of the option to waive a further communication under Rule 71(3) EPC

L4, Law + Regulations:

Add:

- OJ 2020, A81 “Notice of the EPO dated 14 June 2020 concerning new Rule 20.5bis PCT on the correction of erroneous filings in the procedures before the EPO” (per 1 July 2020)

Annex – Table of Contents OJ2016-SE4:

Update references:

- C.1, p.74: OJ 2014, A66 superseded by OJ 2020, A80 A80 “Decision of the President dd 14 June 2020 concerning the entrustment to non-examining staff of certain duties incumbent on the examining or opposition divisions”: added item “23a, Examination, communications and decisions under Rule 20.8(c) PCT and Rule 82ter.1(c) and (d) PCT" per 1/7/2020
- C.4, p.194: OJ 2015, A52 superseded by OH 2020, A73 for R.71(3) dated ≥ 1/7/2020



2. Update of Basic Legal Questions

QUESTIONS DEALING WITH LEGAL CHANGES OF 2020

- Notice disruptions due to COVID-19 outbreak:
 - OJ 2020, Axx (OJ June) (Notice 27/5: end of dislocation in DE) was published as OJ 2020, A74
 - OJ 2020, Axx (OJ June) (Decision 28/5 & Notice 29/5: R.51(2) was published as OJ 2020, A70 & A75
- Oral proceedings ...:
 - OJ 2020, Axx (OJ June) (Notice dd 13 May 2020 revising OJ 2020, A40/ A42) was published as OJ 2020, A72
- Pilot notification by email in examination proceedings H11-09
OJ 2020, A89 & A90 (pilot 1/9/2020-31/8/2021)
- PCT: EPO Notice of incompatibility R.20.8(a-bis)& (b-bis)
Add: OJ 2020, A81

C7-25

Replace “Today, 28 February 2017,” by “Shortly after filing the European patent application,”

H9-11

Add the underline parts to the Question:

A notice of opposition to a European patent is filed in Italian by an Italian representative acting for a French opponent resident in France. A translation of the notice of opposition in French is filed before the end of the opposition period, presented as a “traduction” (translation) of the notice filed in Italian. The opposition fee is paid on the last day of the opposition period.

Will the opposition be considered validly filed or not? Why (not)? What are the likely effects?

H14-02

In the first sentence, replace “5 March 2015,” by “5 March 2014”

H14-15

On the third line, replace “by fax” by “via Online Fee Payment in Online services”

L1-0

In (d), replace “Lithuania” by “Samoa”

L4-29

In the first sentence, replace “20 September 2017” by “20 September 2016.”

3. Update of Answers to Basic Legal Questions

B4-10

Add to answer:

- To benefit from the reduction, the party must file a declaration that he is an entity or natural person in the meaning of R.6(4) – R.6(6)

Add to answer to c) and correct the amounts:

- No fee reduction based on language privilege possible anymore since 1/4/2014
- However, a reduced appeal fee of € 1.955 applies for natural & R.6(4) persons (without a language or residence requirement) and a higher fee of € 2.705 for others – RFees 2.1(11) per 1/4/2020 (introduced per 1/4/2018 by OJ 2018, A4; OJ 2018, A5)
- If appellant consists of a plurality of persons, then each must be a R.6(4) person for the reduced fee to apply – OJ 2018, A5, item 5
- So:
 - Higher amount of € 2.705 to be paid for appeals by :
 - BIG (multinational is not a R.6(4) person), nor
 - BIG+UNI (BIG not a R.6(4) person) for EP-JOINT together.
 - Reduced amount of € 1.955 to be paid for appeals by:
 - NAT (natural person – R.6(4)(b)),
 - SML (SME – R.6(4)(a) & R.6(5); OJ 2018, A5, item 6),
 - VERT (non-profit – R.6(4)(c)), and/or
 - UNI (university – R.6(4)(c))
- To benefit from the reduced appeal fee, the appellant must expressly declare that he is a natural person or an entity covered by R.6(4), in notice of appeal or in a separate letter – OJ 2018, A5, item 3

H3-17

Correct the answer to (d) and the time limit calculation in the comment to:

- (c) F (1m from filing / first set of claims – R.38(3) gives 11/6/21 [EPO Munich closed Corpus Chriti: R.134(1)]
→ 14/6/21)

In (n)-(r) and (s): correct typo “23m” to “2m”

H4-09

Update OJ 2020, Axx (June 2020) (Notice 26 May) to OJ 2020, A73

H8-10

Update OJ 2020, Axx (June 2020) (Notice 26 May) to OJ 2020, A73

H9-11

Replace answer by:

Answer

- Notice of opposition must be filed in an official EPO language – R.76(1), R.3(1) -, so En, Fr or Ge – Art.14(1)
- Notice of opposition is a document to be filed within a time limit (9m – Art.99(1)), so Art.14(4) EPC applies.
- However, French opponent not entitled to use Italian language
 - because he is not an Art.14(4) person Italian
 - as Italian is not an official language of France
- Language of representative is irrelevant - T149/85

- so cannot use Italian based on the representative being an Italian
- So notice of opposition in Italian is deemed not filed - Art14(4), last sentence
- Even though French translation was filed within the opposition period, it cannot be considered to be the notice itself:
- A translation cannot become the original; whatever the date on which it is filed it remains a translation – G 6/91, r.10; T 1152/05, r.2.4-2.5.
- So, as the French translation was expressly presented as a “traduction” (translation)” of the notice of opposition:
 - its legal effect depends on said notice filed in Italian and
 - it cannot be considered as such to be the proper notice of opposition – T 41/09, r.2.2 mut.mut..
- Nor can the document presented as a French translation be considered as the notice of opposition by way of correction under R.139 by deleting the term "traduction" [=translation],
 - as the word "traduction" in the French document is perfectly in accordance with the earlier filing of the original notice of opposition in Italian,
 - so can only be considered as expressing the true intention at that time of the person on behalf of which it has been filed, and is thus not a mistake that allows to be corrected – J 8/80; T 1152/05, r.2.11
- So, notice of opposition in Italian is deemed not filed.
- The opposition fee has thus been paid without reason/ without legal basis
- so will be refunded – T 1225/05, r.2.13; GL (2019) A-X, 10.1.1; GL (2019) D-IV, 1.4.1. jo GL (2019) D-IV, 1.2.1(v)
- The Italian and French documents will form part of the file and will thus be available for inspection - Art. 128(4).
- They will be regarded as observations by third parties under Art. 115; GL (2019) D-IV, 1.4.1
 - May be examined by the opposition division of its own motion – R.81(1); GL (2019) D-V, 2.2
- If a further admissible opposition is pending, the proceedings are continued in respect of it.

Add to comment:

T 1152/05:

- *2.1 As indicated above in Section V, Notice of Appeal was filed in the Dutch language on 12 September 2005 by the Patent Proprietor, then Solvay Engineered Polymers. A translation in French of the Notice of Appeal was filed **on the same day.***
- *2.2 Since, however, Solvay Engineered Polymers is a company having its principal place of business at the following address: "1201 Avenue H. East Grand Prairie, TX, 75050 US", i.e. not within a Contracting State having a language other than English, French or German as an official language, it cannot benefit from the provisions of Article 14(4) EPC.*
- *2.3 Since the Notice of Appeal filed on 12 September 2005 by the Patent Proprietor was **not in one of the official language of the EPO, this document is, in accordance with Article 14(4) EPC, deemed not to have been filed.***
- *2.4 **Nor could it, in the Board's view, be considered that a Notice of Appeal had been filed in French before the end of the appeal period set out in Article 108 EPC in view of the document filed on 12 September 2005 and presented as a translation** of the Notice of Appeal filed in Dutch on the same day.*
- *2.5 This is because, in view of the considerations made in the decision G 6/91 (OJ EPO 1992, 491; Reasons point 10), where the translation is filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. As further stated in G 6/91 "**a translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original.**"*
- *2.6 Consequently, in accordance with Article 108 EPC, the Board comes to the conclusion that the appeal of the Patent Proprietor is deemed not to have been filed.*
- *[...]*
- *2.11 **Nor can** the further argument of the Patent Proprietor that the document presented as a French translation of the Notice of Appeal **be considered as the Notice of Appeal by way of correction under Rule 88 EPC1973 [Rule 139 EPC2000], i.e. by deleting the term "traduction" [=translation] from that document be accepted for the following reasons:[...]***

T 41/09 (cites T 1252/05):

- *2. Notice of appeal dated 19 December 2008*
- *2.1 Notice of appeal in Dutch*
It is not challenged by the appellant that under Article 14(4) EPC the notice of appeal filed in Dutch is in a non admissible non-EPO official language for a patent proprietor having its principal place of business in Spain. The

residence or principal place of business of the professional representative used is of no relevance in that matter (T 149/85, OJ EPO 1986, 103, point 6 of the Reasons). Therefore, in accordance with Article 108 EPC, the corresponding appeal is deemed not to have been filed.

○ 2.2 Translation in English

The letter in English, also dated 19 December 2008, **expressly indicates that it is "a translation of the notice of appeal" of the same date filed in Dutch.** Therefore, its legal effect depends on said notice of appeal filed in Dutch and it cannot be considered as such to be the proper notice of appeal.

The Board is of the opinion that G 6/91 (OJ EPO 1992, 491, point 10 of the Reasons) and T 1152/05 (of 8 April 2008, not published in OJ EPO, points 2.4 to 2.6 of the Reasons), have to be followed in the present case. These decisions indicate in the clearest possible way that a "translation cannot become the original".

Point 12 of the Reasons of G 6/91 (supra), cited by the appellant, is directed to the question of a possible confusion between the "translation" and the original document, when the "translation" is filed earlier than the original. The present case clearly distinguishes itself from such a situation, **since the translation was expressly qualified as such, making absent any possible confusion,** and filed together with the original notice of appeal. Therefore, in the present case, the Board does not see point 12 as more relevant than point 10, nor even simply relevant.

G 6/91:

○ Facts/Summary of Proceedings

II. In the case at issue, the appellant (opponent), a company constituted under Dutch law, had filed an appeal in the form of a letter drawn up in Dutch accompanied by a translation into English, at the same paying a reduced appeal fee and invoking Article 14(4) and Rule 6(3) EPC and Article 12 Rules relating to Fees.

○ Reasons

10. **Nor can the Enlarged Board follow Board 3.4.1's suggestion that where the translation [of the notice of appeal] is filed at the same time as the original the EPO could take it as the "official" notice of appeal and ignore the original as superfluous. A translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original.** For the documents comprising the European patent application, this possibility is expressly provided for in Article 14(2) EPC; for items filed later it results from application of Rule 88 EPC1973 [=Rule 139 EPC2000].

○ 11. Lastly, and as is clear from the "travaux préparatoires" to the Convention cited by the President of the EPO (cf. point XIV above), Article 14(2) and (4) and Rule 6(1) and (2) EPC were drafted to compensate at least in part for the disadvantages to nationals of Contracting States with non-EPO official languages of having to provide translations into an EPO official language. The main aim of Article 14 and Rule 6 EPC is thus to enable such parties to benefit from all EPC time limits for filing applications and subsequent items, and to allow them at least one month for translation purposes. The possibility of correcting any translation errors is also guaranteed.

○ 12. **The translation must however be filed as such, with no possibility of its being confused with the original, or taking its place.** Since a translation is only recognisable as such if the original is available when it is received, translations reaching the EPO before the original cannot in the Enlarged Board's view be considered validly filed within the meaning of Article 14(2) and (4) and Rule 6(1) and (2) EPC. Parties wishing to avail themselves of these provisions must file the "translation" no earlier than simultaneously with the original. Otherwise the document first filed must be considered the original, with the ensuing legal consequences - notably as regards the fee amounts payable.


H11-07

OJ 2020, Axx (Decision President 13 May 2020) and OJ 2020, Axx (Notice 13 May 2020) OJ JA71 (Decision) and OJ 2020, A72 (Notice); per 14/5/2020 were published as OJ 2020, A71 and OJ 2020, A72

H11-09

Add to the answer to (c):

- in pilot project on notification by email during examination proceedings: by email (per 1/9/20) – OJ 2020, A89 & A89:
 - any notice or other communication issued by examining divisions in relation to scheduled oral proceedings may be notified by email.
 - but limited to notices and other communications from which no time limit is reckoned and which is issued between the final date for making written submissions fixed under R. 116(1) and the date of the scheduled oral proceedings

- 
- (a) i.e., usually issued to inform applicants of a decision of the examining division to maintain, postpone or cancel oral proceedings and the reasons for that decision or of its preliminary assessment of any submissions received by the date set under R.116(1). Examining divisions participating in the pilot project will therefore invite applicants to give their consent either in the annex to the summons to oral proceedings or in a stand-alone communication.

H11-11

Add to the Comments:

- Also see OJ 2020, A107 “Notice from the European Patent Office dated 14 September 2020 concerning the expansion of electronic notification via the Mailbox in opposition proceedings”

H11-15

OJ 2020, Axx (June 2020) (Notice 27 May) was published as OJ 2020, A73

H12-05

OJ 2020, Axx (to be published in OJ June 2020) “Notice from the EPO dated 27 May 2020 concerning the disruptions due to the COVID-19 outbreak” was published as OJ 2020, A74

H12-09

Correct the time limit calculations in the Comments to:

- Notification of the written decision:
24/1/18 + 10 days [R.126(2)] → 3/2/18
- Notice of appeal and payment of appeal fee by [Art.108, 1st sentence and R.99(1)]:
3/2/18 + 2m [R.131(4)] → 3/4/18 (Tue).
- Filing written statement setting out the grounds of appeal by [Art.108, last sentence and R.99(2)]:
3/2/18+ 4m [Art.108; R.131(4)] → 3/6/18 (Sun) → 4/6/18 (Mon).

H12-11

As the Guidelines no longer refer to CEPT, but to “Europe”, change first bullet in the answer to b) to

- Andorra is not an EPC state but is inside Europe – OJ 2015, A29; GL (2019) E VIII, 1.7

Add to the Comments:

- Until and including the 2018-edition of the Guidelines, E-VIII, 1.7 showed a list of non-Contracting States belonging to the CEPT. The reference to CEPT as well as this list has been deleted from the GL since the 2019 edition – the Guidelines now merely refers to inside/outside “Europe”, and the earlier clarification that, in this context, that wwa to be interpreted as all CEPT states has been deleted.
The former GL indicated: “Within the meaning of Rule 133, a document is deemed to have been posted or delivered to a delivery service within Europe if it was despatched in one of the states belonging to the European Conference of Postal and Telecommunications Administrations (CEPT) (in addition to the EPC contracting states these are the states listed below) or in a state which is generally understood to be part of Europe. At the request of the EPO, confirmation of registration by the post office or of receipt by the delivery service must be provided as evidence that the document was posted in due time. Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received.
The following non-contracting states belong to the CEPT (updated 1 November 2012): Andorra, Azerbaijan, Belarus, Bosnia and Herzegovina, Georgia, Moldova, Montenegro, Russian Federation, Ukraine and Vatican.”
<https://www.cept.org/cept/background>: “With its 48 members CEPT now covers almost the entire geographical area of Europe” (<https://www.cept.org/cept/cept-country-codes>). (Acc. <https://en.wikipedia.org/wiki/Europe> Europe has 50 states: all CEPT states plus Armenia and Kazakhstan)
GL (2019) E-VIII, 1.7 & OJ 2015, A29: “Recognised postal service providers are the designated operators within the meaning of Art.1 of the Universal Postal Convention as well as Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS and Transworld (see the Decision of the President dd 11 March 2015, OJ 2015, A29). The document must have been sent as a registered letter or equivalent and, if posted outside Europe, by airmail. At the request of

the EPO, confirmation of receipt by the postal service provider must be provided as evidence that the document was delivered in due time."

H13-12

Update the GL reference to:

- GL (2019) E-VIII, 1.9.3:

H14-01

- In the answer to (c), replace "6m before [R.51(1), last sentence]" by "3m before [R.51(1), last sentence]"

H14-04

Correct last bullet of the answer to (a) to:

- GL (2019) E-VIII, 1.9.3: The last day for payment of the renewal fee in respect of the fourth year with additional fee [R.51(2)]:
30/9/16 (= due date) + 6m [J4/91: "de ultimo ad ultimo"] → 31/3/17 (Fri)

L2a-05

Add OJ 2020, A81 to legal basis at last bullet of answer to (c), together with PCT NL April 2020:

Add to Comment:

- OJ 2020, A81 "Notice from the EPO dd 14 June 2020 concerning the applicability of new Rule 20.5bis PCT on the correction of erroneous filings in proceedings before the EPO"
"1. On 1 July 2020, new Rule 20.5bis PCT, which allows applicants to correct an erroneously filed element (description or claims) or part of the description, claims or drawings (including all drawings) contained in an international application, will enter into force. The EPO has notified WIPO that this provision is partially incompatible with the current legal framework under the EPC and will therefore not be fully applicable in proceedings before the EPO as receiving and designated/elected Office (Rule 20.8(a-bis) and (b-bis) PCT)"
"2. This notice gives information about the applicability of Rule 20.5bis PCT in proceedings before the EPO. The annexed diagrams give an overview of the possible procedural scenarios. The notice does not cover the procedure under existing Rule 20.5 PCT as there has been no change in practice at the EPO and that provision continues to apply only to cases where a part of the description, claims or drawings (including all drawings) is truly missing from the international application."
3-4 of the Notice describe the Procedure before the EPO as receiving Office
5-6 of the Notice describe the Procedure before the EPO as ISA
7 of the Notice describes the Procedure before the EPO as IPEA
8-19 of the Notice describe the Procedure before EPO as dO/eO (incl Abridged procedure & Early entry)
20-22 of the Notice describes Examples of processing in the European phase
An Annex to the Notice presents Diagrams illustrating possible scenarios (EPO as rO, ISA, dO/eO)

L2a-16

Add OJ 2020, A81 to legal basis at last bullet of answer to (c) (incompatibility provision)

Add to comment:

- OJ 2020, A81 "Notice from the EPO dd 14 June 2020 concerning the applicability of new Rule 20.5bis PCT on the correction of erroneous filings in proceedings before the EPO": Procedure before EPO as rO, ISA, IPEA, dO/eO & examples

L4-29

Correct typo in time limit calculation:

- 20/9/16 + 31m [R.159(1); R.131(4)] → 20/4/19 (Sat) [R.134(1)] → 23/4/19