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DIFFICULT EPO ACTIONS TO DOCKET



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Difficult EPO Docketing Items

- Presenters and panelists:
 - Ann McCrackin, President, Black Hills IP, LLC
 - Kristi Wheeler, Foreign Filing Paralegal, Schwegman, Lundberg & Woessner, P.A.

Topics

- EP Convention Filing
 - Partial EPO Search Report and Extended EPO Search Report
 - Rule 164 -- Form 1507US, 1507N, 1507W
 - Invitation to Proceed / Reports ESR Publication Date
 - Rule 70 - Form 1081, 1082 and 1083
- PCT EP Filing
 - Respond to Objections in Written Opinion
 - Rule 161(2) and 162 – Forms 1226AA, 1226BB and 1226CC
 - Supplemental EP Search Report
 - Rule 70 - Form 1224
- Publication forms
- EPO countries issuing new numbers on grant

EP Convention Filing

EP CONVENTION FILING

RULES 69 & 70 - PAY EXAM & DESIGNATION FEES CONTINUE? AND RESPOND TO OBJECTIONS IN EP SEARCH OPINION

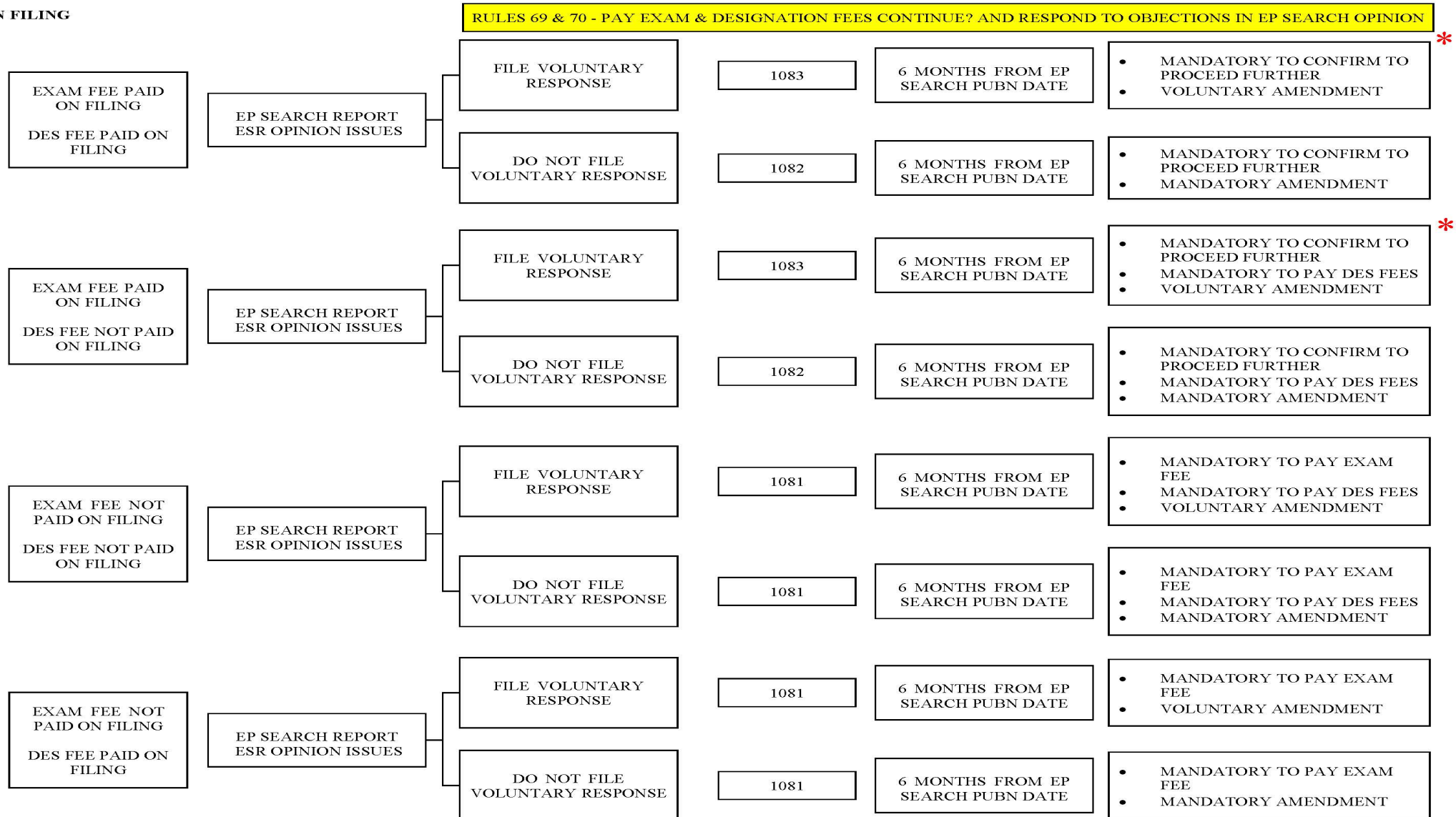
MINIMUM ON FILING REQUIREMENTS

FILING FEE

SEARCH FEE

ADD PAGE FEE

EXCESS CLAIMS FEE



* The right receive to Form 1083 can be waived on the Application form to speed up Examination. This will only apply if the exam fee is paid on filing AND a voluntary response is filed prior to issuance of Form 1083.. Care you should be taken to ensure designation fees are also paid

Search Report (form 1507)


- **There are 3 types**
 - **Partial EPO search**
 - Form 1507US
 - Can be issued for an EP or PCT (EP)
 - Applicant is informed only some claims have been searched and one or more further search fees can be paid
 - Deadline 2 months from notification (10 day rule applies)
 - A Form 1507N will follow if additional fees paid or if not.

Search Report (form 1507)

- **an extended ESR – form 1507N**
 - An opinion of the examiner is included and a Rule 70 letter will follow
- **an ESR – 1507W**
 - No opinion of the examiner is included and an exam report (Article 94(3) letter) or a Rule 71(3) allowance will follow.
 - Issued only if you request PACE and/or waive the Rule 70 communication.

Search Report (form 1507)

New Form 1507US

 Europäisches Patentamt European Patent Office Office européen des brevets	European Patent Office 80298 MUNICH GERMANY
Questions about this communication ? Contact Customer Services at www.epo.org/contact	
Formalities officer: Mr Rafael Cuevas Sáez	
Please specify the name of the formalities officer when contacting Customer Services by contact form or phone.	
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Form: F1507USE Tiger_Id: MARS-F1507US	Reference: GHS/P542685EPPC Application No./Patent No.: 11796426.2 - OD3 / 2582868 PCT/US2011040691 Applicant/Proprietor: Washington University
VAR_KEY_VALUE: 0000	Communication pursuant to Rule 164(1) EPC The partial supplementary European search report Rule 164(1) EPC is enclosed. The applicant is informed that if the supplementary European search report is also to cover inventions other than the invention(s) already searched and for which a meaningful search can be carried out, a further search fee must be paid for each of these inventions, in the present instance 1 search fee(s) within two months after notification of this communication. The amount payable for each further search is EUR 1285,00. Note to users of the automatic debiting procedure Unless the EPO receives prior instructions to the contrary, a search fee for (each of) the identified invention(s) will be debited on the last day of the period for payment. See the Arrangements for the automatic debiting procedure (Supplementary publication 4 - OJ EPO 2014). If applicable, a European search opinion covering those invention(s) for which a search fee has been paid will then be sent together with the supplementary European search report. Copies of documents cited in the supplementary European search report are attached. <input checked="" type="checkbox"/> 0 additional set(s) of copies of such documents is (are) enclosed as well.

Rule 70 - Form 1081, 1082 and 1083

- **These forms are issued for EP applications.**
- The 1081 form is a combined reporting of the publication date of the ESR which sets the exam fee deadline and the deadline for paying the designation fees and responding to the ESR opinion
- The 1082 form is for when the exam fee was paid earlier e.g. on filing. The form invites the applicant to confirm that the application is to continue and respond to the ESR opinion. A designation fee reminder is included in case not already paid.
- **DEADLINE IS 6 MONTHS FROM THE PUBLICATION DATE — NO 10 DAYS ADDED TO DEADLINE**

Rule 70 - Form 1081, 1082 and 1083

- The 1083 form is for when the exam fee was paid earlier e.g. on filing and when a response has already been filed to the search opinion. The form simply informs the applicant of the publication date of the search. A designation fee reminder is included in case not already paid.

Form 1081

Communication pursuant to Rule 69 EPC - reminder concerning payment of the designation fee (Art. 79(2) EPC) and of the examination fee (Art. 94(1) EPC) - and invitation pursuant to Rule 70a(1) EPC

The date on which the European Patent Bulletin mentions the publication of the European search report for the above-mentioned European patent application is: 04.11.15.

Your attention is drawn to Article 79(2) and Rule 39(1) EPC as well as Article 94(1), Rule 70(1) and Rule 70a(1) EPC, according to which within **six months** of the above-mentioned publication date of the search report

- the designation fee must be paid,
- the request for examination must be filed and the examination fee must be paid,
- comments on the objections raised in the opinion accompanying the European search report and/or any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion must be filed (R. 70a(1), 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

1. Payment of the designation fee and of the examination fee

The current designation fee for one or more Contracting States designated is: EUR 580,00

The current examination fee is: EUR 1620,00

If the written request for examination is filed in an admissible non-EPO language in accordance with Article 14(4) EPC, a reduction of the examination fee according to Rule 6(3) EPC applies.

For European patent applications filed on or after 01.04.2014, the reduction applies only if the applicant(s) has (have) declared to be an entity or a natural person within the meaning of Rule 6(4) EPC (Decision of the Administrative Council of 13 December 2013, OJ EPO 2014, A4).

If the designation fee and the examination fee are not paid within the period laid down in Rule 39(1) and Rule 70(1) EPC, the application **will be deemed to be withdrawn** (R. 39(2) and Art. 94(2) EPC).

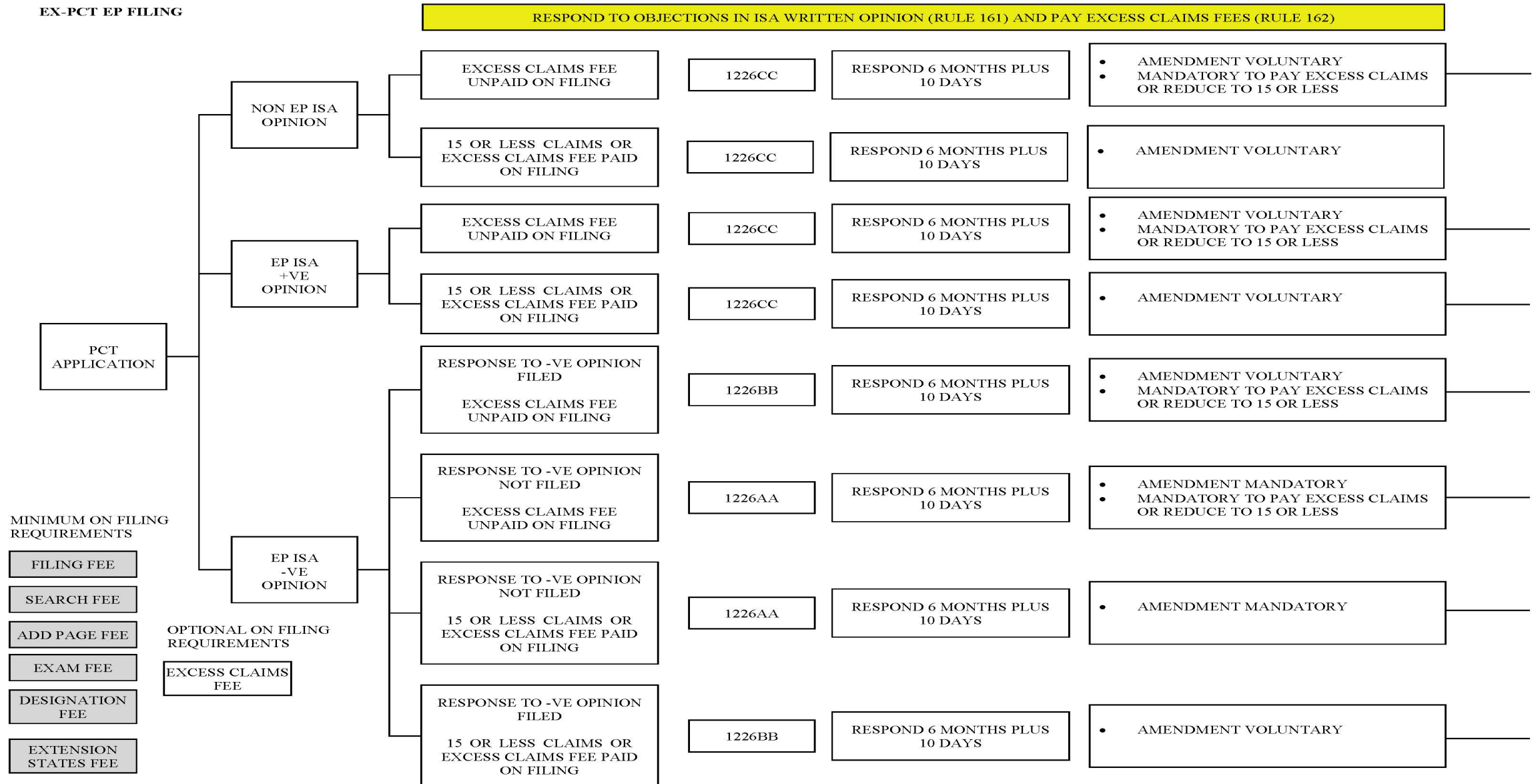
Any extension or validation fees are also payable within the above-mentioned period.

Registered letter

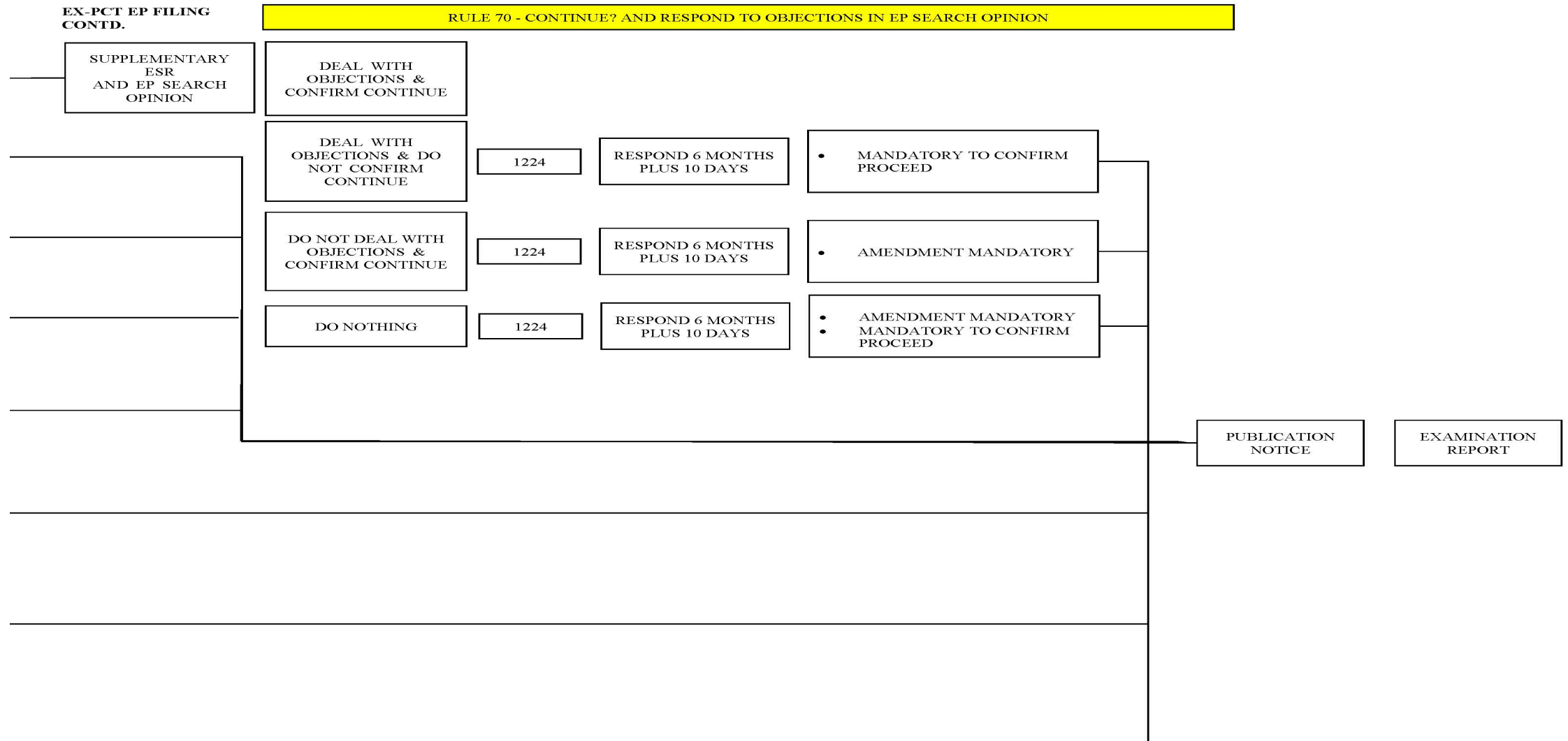
EPO Form 1081 06.15 (NFS/RTB/ESOP01=N)

PCT EP Filing

EX-PCT EP FILING



PCT EP FILING cont.



Rule 161(2) and 162

- **These forms are for PCT (EP) applications**
- **EPO Form 1226AA** is issued if there has been a negative opinion by the EPO in the ISR and no amendments or comments have been filed on regional phase entry. A response to this form within **6 months is mandatory** (i.e. or else the application is deemed withdrawn) and your attention is drawn to this on the form.
- (Rule 161(1))

Rule 161(2) and 162

- **EPO Form 1226BB** is issued if there has been a negative opinion by the EPO in the ISR and amendments or comments have been filed on regional phase entry. A response to this form within 6 months is voluntary (i.e. the application is NOT withdrawn if you do not response). This is indicated by the wording “you may comment....”.

Rule 161(2) and 162

- **EPO Form 1226CC** is issued in other cases (e.g. non-EPO ISA, or positive ISR opinion). A response to this form within 6 months is voluntary (i.e. the application is NOT withdrawn if you do not response).
- Rule 161(2) – response to search opinion + Rule 162 – claims fees
- Note the communications have two independent deadlines that must be complied with in the response: Rule 161(2) and Rule 162
- **DEADLINE IS FROM THE DATE OF NOTIFICATION -10 DAY RULE APPLIES**

Rule 161(2) and 162

Communication pursuant to Rules 161(2) and 162 EPC

1. Amendment of the application (R. 161(2) EPC)

The above-mentioned international (Euro-PCT) application has entered the European phase.

Under Articles 28, 41 PCT and Rules 52, 78 PCT the application may be amended before a designated or elected Office.

In accordance with Rule 161(2) EPC, you may amend your application once within a **non-extendable period of six months** after notification of the present communication.

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

The claims applicable on expiry of this period, i.e. those filed on entry into the European phase or in response to the present communication, will form the basis for the calculation of any claims fee to be paid (see page 2).

2 Claims fees under Rule 162 EPC

If the application documents on which the European grant procedure is to be based comprise more than fifteen claims, a claims fee shall be payable for the sixteenth and each subsequent claim within the period provided for in Rule 159(1) EPC.

- ☐ Based on the application documents currently on file, all necessary claims fees have already been paid (or the documents do not comprise more than 15 claims).
- ☐ All necessary fees will be debited automatically according to the automatic debit order.
- ☒ The claims fees due for the claims 16 to 21 were not paid within the above-mentioned period.

Rule 70 - Form 1224

- **This form is issued to PCT (EP) applications after supplementary ESR**
- 6 month mandatory deadline from the date of notification (10 day rule applies)
- Must confirm the application is to proceed and respond to the supplementary ESR opinion
- Note the communication has two independent deadlines that must be complied with in the response: Rule 70(1) and Rule 70a(2)
- **DEADLINE IS FROM THE DATE OF NOTIFICATION -10 DAY RULE APPLIES**

Rule 70 - Form 1224

Communication pursuant to Rules 70(2) and 70a(2) EPC

A supplementary European search report has been drawn up concerning the above-identified European patent application (publication number:).

Since the request for examination has been filed (R. 70(1), 159(1)(f), Art. 94(1) EPC) prior to the transmission of the supplementary European search report, you are hereby invited to indicate within

six months

of notification of this communication whether you wish to proceed further with the European patent application.

If you do not indicate in due time that you wish to proceed further with the European patent application, it **will be deemed to be withdrawn** (R. 70(3) EPC).

You are invited, within the above-mentioned six-month period, to comment on the objections raised in the opinion accompanying the European search report and/or to file any amendments to the description, claims and drawings correcting any deficiencies noted in the opinion (R. 70a(2), R. 137(2) EPC; Guidelines for Examination in the EPO, B-XI, 8).

If filing amendments, you must identify them and indicate the basis for them in the application as filed. Failure to meet either requirement may lead to a communication from the Examining Division requesting that you correct this deficiency (R. 137(4) EPC).

Should the reply to the invitation pursuant to Rule 70a(2) EPC be filed in an admissible non-EPO language, a translation is to be submitted within one month of its filing (R. 6(2) EPC).

Should you not comply with this invitation within the time limit, the application **will be deemed to be withdrawn** in accordance with Rule 70a(3) EPC.

Receiving Section



Registered letter

EPO Form 1224 11.12 (RTB/ESQP01=N) DMEX

EPO Publication

- Form 1133 – Publication of an EP
- Form 1203 – Publication of the translation of a PCT (EP)
- Form 1219 – Publication of only the bibliographic data for a PCT(EP)
– no translation of the PCT required

Countries that issue new # for EPO granted patents

- Germany
- Spain
- Austria
- Italy

Questions

- Questions on Today's Program
 - Please submitted your questions using the Q&A button on the control bar on your screen.
- If you have questions regarding Black Hills IP's services or processes, please contact:
Jim Brophy
Ph. 612-867-4018
jbrophy@blackhillsip.com