DIFFICULT EPO ACTIONS TO DOCKET
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2. SIGN UP FOR THE LINKEDIN GROUP
3. ENGAGE WITH IP EXPERTS

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Difficult EPO Docketing Items

• Presenters and panelists:
  o Ann McCrackin, President, Black Hills IP, LLC
  o 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**

**Rules 69 & 70 - Pay Exam & Designation Fees Continue? And Respond to Objections in EP Search Opinion**

- **Exam Fee Paid on Filing**
  - **Excess Claims Fee**
  - **File Voluntary Response**
  - **Do Not File Voluntary Response**
  - **File Search Report ESR Opinion Issues**
  - **Voluntary Amendment**

- **Exam Fee Not Paid on Filing**
  - **Excess Claims Fee**
  - **File Voluntary Response**
  - **Do Not File Voluntary Response**
  - **File Search Report ESR Opinion Issues**
  - **Voluntary Amendment**

**Minimum on Filing Requirements**
- **Filing Fee**
- **Search Fee**
- **Add Page Fee**

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*The right to receive 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 should be taken to ensure designations fees are also paid.*

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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.
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
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.
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, G-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 1820,00

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 15 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 of validation fees are also payable within the above-mentioned period.
EX-PCT EP FILING

RESPOND TO OBJECTIONS IN ISA WRITTEN OPINION (RULE 161) AND PAY EXCESS CLAIMS FEES (RULE 162)

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226CC
RESPOND 6 MONTHS PLUS 10 DAYS

15 OR LESS CLAIMS OR EXCESS CLAIMS FEE PAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226CC
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226CC
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226CC
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

RESPONSE TO -VE OPINION NOT FILED
EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT MANDATORY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226AA
RESPOND 6 MONTHS PLUS 10 DAYS

RESPONSE TO -VE OPINION NOT FILED

- AMENDMENT MANDATORY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226AA
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE

- AMENDMENT VOLUNTARY

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

RESPONSE TO -VE OPINION FILED
EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

RESPONSE TO -VE OPINION FILED

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

15 OR LESS CLAIMS OR EXCESS CLAIMS FEE PAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE UNPAID ON FILING

- AMENDMENT VOLUNTARY
- MANDATORY TO PAY EXCESS CLAIMS OR REDUCE TO 15 OR LESS

1226BB
RESPOND 6 MONTHS PLUS 10 DAYS

EXCESS CLAIMS FEE UNPAID ON FILING
EX-PCT EP FILING CONTD.

RULE 79 – CONTINUE? AND RESPOND TO OBJECTIONS IN EP SEARCH OPINION

SUPPLEMENTARY ESR
AND EP SEARCH OPINION

DEAL WITH OBJECTIONS & CONFIRM CONTINUE

1224

RESPOND 6 MONTHS PLUS 10 DAYS

MANDATORY TO CONFIRM PROCEED

DO NOT DEAL WITH OBJECTIONS & CONFIRM CONTINUE

1224

RESPOND 6 MONTHS PLUS 10 DAYS

AMENDMENT MANDATORY

DO NOTHING

1224

RESPOND 6 MONTHS PLUS 10 DAYS

AMENDMENT MANDATORY

AMENDMENT MANDATORY

MANDATORY TO CONFIRM PROCEED

PUBLICATION NOTICE

EXAMINATION REPORT
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 respond). This is indicated by the wording “you may comment....”.
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 respond).

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 65, 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 169(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.
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), 169(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 EPC, B-XI, 6).

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 rectify this deficiency (R. 137(4) EPC).

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

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 (EPO/OP/01/8) OMBEX
- 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
  o Please submit 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