

# Updates to the EPO Guidelines

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# Updates

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- Published in “preview mode” Feb 2023
- Effective 1 March 2023
- A public user consultation on the 2023 edition ran until 4 April 2023

# EPO Updates

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- Montenegro became 39th EPC Contracting State on 1 October 2022
- Guidelines A-III 12.1 updated

## E-VII 5 – Accelerated opposition

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- In cases where an infringement action in respect of a European patent is pending before the Unified Patent Court or a national court of a contracting state, a party to the opposition proceedings may request accelerated processing

## C-IV 7.2 – National Prior Rights

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- In view of the importance of national prior rights (see B-VI, 4.2) for applicants in proceedings before the Unified Patent Court, the examiner expands the top-up search scope at the grant stage (see C-IV, 7.1) to include national applications and patents of the contracting states, in so far as they are present in the EPO's databases.
- The division informs the applicant about the outcome of the top-up search for national prior rights. Those that are prima facie relevant for the application are communicated to the applicant.

## C-IV 7.2 – National Prior Rights

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National prior rights within the meaning of Article 139(2) EPC are not a bar to the grant of a European patent in proceedings before the EPO. Therefore, the EPO is not required to search for and assess such rights (GL, H-III, 4.4). Applicants may, however, consider the procedural option under Rule 138 EPC in view of the effects of such rights in national proceedings and/or before the Unified Patent Court (Article 3 Regulation (EU) No 1257/2012). As a support service free of charge for the applicant in this context, the applicant is hereby offered non-binding information on a search for and prima facie relevance assessment of national prior rights by the examining division. It is the applicant's responsibility to assess such national prior rights and any use of the procedural option under Rule 138 EPC (GL, H-III, 4.4). The applicant is informed that no prima facie relevant national prior rights were found.

## C-III 5 – Summons as first action

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In addition, in examination of a **divisional application**, the examining division may **exceptionally** issue a summons to oral proceedings as the first action if:

- the parent application was refused or withdrawn and there is no prospect of a grant for the divisional application, even taking into account the applicant's reply to the search opinion;
- the content of the claims on file is substantially the same as or broader than the subject-matter of claims which were examined for the refused or withdrawn parent application, or which served as a basis for the search of the divisional application, **and**
- one or more of the objections which are crucial to the outcome of the examination procedure and which were raised in the search opinion established for the divisional application, in the refusal of the parent or in a communication issued for the withdrawn parent still apply.

# EPO updates – New Rule 56a EPC

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- Applies to all applications filed on or after 1 Nov 2022
- New sections of the Guidelines A-II
- **Erroneously filed** application documents or parts
- Corresponds to existing Rule 56 EPC “Missing parts”
- Rule 56 EPC:
  - (1) If the examination under Article 90, paragraph 1, reveals that parts of the description or drawings, referred to in the description or in the claims, **appear to be missing**, the European Patent Office shall invite the applicant to **file the missing parts within two months**



# EPO updates – New Rule 56a EPC

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- Rule 56a EPC: Erroneously filed application documents

(1) If the examination under Article 90, paragraph 1, reveals that the **description, claims or drawings**, or parts of those application documents, **appear to have been erroneously filed**, the European Patent Office shall invite the applicant to file the **correct application documents** or parts **within two months**. The applicant may not invoke the omission of such a communication.

(2) If **correct application documents** or parts referred to in paragraph 1 **are filed on or before the date of filing so as to correct the application**, those correct application documents or parts shall be included in the application and the erroneously filed application documents or parts shall be deemed not to have been filed...

# EPO updates – New Rule 56a EPC

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- (3) Re-dating

If **correct application documents** or parts referred to in paragraph 1 are filed later than the date of filing, but **within two months of the date of filing** or, if a communication is issued under paragraph 1 or under **Rule 56, paragraph 1, within two months of that communication**, the application shall be **re-dated** to the **date on which the correct application documents or parts were filed...**

# EPO updates – New Rule 56a EPC

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- Rule 56a(4) EPC
  - You may correct erroneous parts based on a priority filing
  - Corresponds to existing R. 56(3) EPC
- Rule 56a(5) EPC
  - withdrawal of corrected parts, or failure to comply
  - Corresponds to existing R. 56(4) EPC
- Rule 56a(6) EPC
  - Effect of non-compliance with Rule 56a(4)
  - Corresponds to existing R. 56(5) EPC

# EPO updates – New Rule 56a EPC

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- Rule 56a(7) EPC
  - You may withdraw a correction
  - Corresponds to existing R. 56(6) EPC
- Rule 56a(8) EPC
  - If the applicant files correct application documents or parts under paragraph 3 or 4 after the European Patent Office has begun to draw up the search report, **the European Patent Office shall invite the applicant to pay a further search fee within one month.** If the search fee is not paid in due time, the application shall be **deemed to be withdrawn.**
- There is a risk that the EPO start their work, and make you pay – so respond quickly if you receive a Rule 56a communication!

# Internet Citations

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- Guidelines B-X 11.6 (*Nov 2018*)
  - Video and/or audio media fragments available on the internet are converted into a non-patent literature citation
  - The bibliographic data contains the **URL** of the original location on the internet.
  - Fragments should be cited as a **screenshot** of the first page of the internet citation.

# T 3000/19 – evidence in video form

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- Examining Division found a lack of inventive step over D4:

*D4 "Mac OS X Leopard Overview: Mac OS X Leopard Dictionary", YouTube, 9 July 2008, retrieved from <https://www.youtube.com/watch?v=JskACcyZbMs>.*

- The Examining Division provided the link, a screenshot (timestamped 0:00/1:21), and YouTube's own information about the video.
- The decision referred to video frames at "0:00", "0:56", "1:02" and "1:11" and video frame sequences "0:29-0:52" and "0:59-1:02".

# T 3000/19 – evidence in video form

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  - The bibliographic data contains the URL of the original location on the internet.
  - Fragments should be cited as a screenshot of the first page of the internet citation.
- The examining division had thus followed the indications in the Guidelines.

# T 3000/19 – evidence in video form

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- On appeal, the video was no longer available on YouTube
- Examining Divisions should make sure that an internet disclosure used as state of the art is reliable in terms of the publication date (see decision T 1066/13, Reasons 4 to 4.3; see also the Guidelines for Examination in the EPO, G-IV, 7.5.1)
- Continued accessibility to its content in the version made publicly accessible on that date must also be ensured (see decision T 3071/19, Reasons 5; see also T 0013/20, Reasons 4).
- Due account should be taken of the rights of third parties and the public to inspect the file under Article 128 EPC.



# T 3000/19 – evidence in video form

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- Although the measures in Guidelines B-X 11.6 were followed, they are not sufficient.
- Board: “a number of screenshots taken from a video, let alone a single screenshot, fail to preserve in its original format the necessary video content”
- The decision under appeal is not sufficiently reasoned.
  - Substantial procedural violation
  - Remitted back to examining division

# T 3000/19 – what is the solution?

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- The **Council of Europe** has published guidelines on using **electronic evidence in civil and administrative proceedings** (30 January 2019).
  - “...electronic evidence should be collected, structured and managed in a manner that facilitates its forwarding to other courts, in particular appellate courts.”
  - “...electronic evidence should be stored with standardised metadata so that the context of its creation is clear and the integrity of the evidence is preserved.

## B-X 11.6 – Internet Citations

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- Video and/or audio media fragments available on the internet are converted into a non-patent literature citation.
- The bibliographic data contain the URL of the original location on the internet.
- If these cited disclosures cease to be available on the internet, a copy will be made available to the applicant on request (see [G-IV, 7.5.6](#)).

# Questions/Discussion?

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