

Excess claims fees and excess page fees at the European Patent Office and the United Kingdom Patent Office

Excess claims and page fees are now payable at both the European Patent Office (EPO) and the United Kingdom Patent Office. In this article, we will explain what the fees are, when they are due and what the consequences of not paying them are.

What are the official claims fees?

At the European Patent Office, a charge is associated with the 16th and subsequent claims for all patent applications. For an application filed on or after 1 April 2009 the fee for the 16th and each subsequent claim up to the limit of 50 is EUR 235, for the 51st and each subsequent claim the fee is EUR 585.

Claims fees were introduced at the Intellectual Property Office of the United Kingdom (UKIPO) from 6 April 2018. The fee for the 26th and subsequent claim is GBP 20 per claim.

When are the claims fees payable?

For convention, non-convention, and divisional European applications filed at the EPO, the excess claims fees are due no later than one month from the filing date of the claim set under Rule 45 EPC. For European regional phase applications, the proprietor can either pay claims fees on filing or will be asked to pay them under Rule 161 EPC. This allows the applicant to amend the application so that it comprises 15 or fewer claims.

At the UK Patent Office, the excess claims fee is part of the search fee and applies to any request for a search under section 17(1) made on or after 6 April 2018. The claims fee is payable for each claim over 25 at the time the request for search is filed. If your application was filed before 6 April 2018 these fees are still payable if the request for search was filed on or after 6 April 2018. An application filed at the UK Patent Office cannot be amended as of right between filing and search, therefore these fees should be considered on filing. If you have requested a supplementary search under section 17(8), or a search of a further invention under section 17(6), then no further excess claims fees are payable.

What are the consequences of not paying the claims fees?

If the claims fees due under Rule 45 EPC have not been paid in due time, the EPO will issue a communication pointing out the failure to observe the time limit. The applicant may then validly pay the claims fee within one month of notification of this communication. If the claims fee is not paid in due time, the claim/claims concerned shall be deemed to be abandoned.

Features of a claim deemed to have been abandoned and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims.

If the excess claims fees payable under Rule 161 EPC are not paid those excess claims are deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1) EPC. Further processing can be requested within two months of this communication, with the payment of the excess claims fee and the further processing fee which is calculated at 50% of the unpaid fee.

If the excess claims fee is not paid on a UK patent application, the full search fee will be deemed unpaid. To pay the outstanding balance a Form 52 will need to be filed within 2 months of the deadline for requesting search. The claims fee needs to be paid as well as a fee of £135 for requesting a 2-month extension. The consequences at the UK Patent Office are more severe than those of the EPO because the excess claims fee is part of the search fee. Failure to pay the full search fee in time or with extension and surcharge results in withdrawal of the entire application.

Can more claims be added to the application later on?

Claims fees at the EPO will not be payable again until the intention to grant communication under Rule 71(3) EPC is issued. If the text for the European patent application serving as the basis for grant contains more than 15 claims, the applicant will be requested to pay the excess claims fees, unless they have already done so. If the text contains fewer claims, no refund of the claim fees will be made. If the claims fees are not paid in the time limit dictated by the communication the European patent application shall be deemed to be withdrawn.

For a UK patent application if the number of excess claims has increased above the number paid for as part of the search fee, a grant fee will apply. No refunds will be available where the number of claims has decreased. The applicant will be advised in the notification

of intention to grant if a grant fee is due and what fee is required. There will be a two-month period for payment of the grant fee, from the date of the notification of intention to grant. It will be possible to extend this period by two months by filing a Patents Form 52 and payment of £135. The consequence of non-payment or incomplete payment will be that the application does not proceed to grant.

Can you file a divisional patent application to protect the lost claims?

A divisional application may be filed for subject-matter which does not extend beyond the content of the parent application as filed. Therefore, all claims lost by non-payment of claims fees or otherwise can be protected in a divisional patent application as long as they were present at the time of filing. This is applicable at both the EPO and the UKIPO.

What are the official page fees?

At the EPO a charge is associated with the 36th and subsequent pages for all applications. For an application filed on or after 1 April 2009 the fee for the 36th and each subsequent page is EUR 15. The page count includes 1 page per abstract and does not include pages forming part of a sequence listing.

From 6 April 2018, the fee for substantive examination at the UK Patent Office will increase by GBP 10 for each page of description over 35. This is the excess pages fee. This new excess page fee will apply to any request for a substantive examination made on or after 6 April 2018. Where a sequence listing is filed separately to the description it does not form part of the description and so does not add to the excess page count.

When are the page fees payable?

The excess page fees are due one month from the filing date of a European patent application. If the application is filed without claims or by reference to a previously filed application the excess pages fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the referred application, whichever expires later.

At the UK Patent Office, the excess claims fee is part of the examination fee and applies to any request for examination made on or after 6 April 2018. The fee for substantive examination is calculated based on the number of pages of description present in the application at the time the Patents Form 10 (request for examination) is filed. If the applicant wishes to reduce the number of pages of description present in the application

prior to filing the Form 10, they may make amendments after issue of the search report in accordance with rule 31.

What are the consequences of not paying the claims fees?

If the fee for excess pages is not paid in the time limits mentioned in the previous section, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1) EPC. Further processing can be requested within two months of this communication, with the payment of the excess pages fee and the further processing fee which is calculated at 50% of the unpaid fee.

If the excess pages fee is not paid on a UK patent application, the full examination fee will be deemed unpaid. To pay the outstanding balance a Form 52 will need to be filed within 2 months of the deadline for requesting examination. You will need to pay the page fees as well as a fee of £135 for requesting a 2-month extension. Failure to pay the full examination fee in time or with extension and surcharge results in withdrawal of the application.

Can more pages be added to the application later on?

At the EPO pages of amendments filed after the date of payment of the excess pages fee are not included in the calculation of the page fees. If amendments are filed at this stage which reduce the number of pages already paid for, no refund will be made, and if they increase the number of pages, no extra fee is payable.

At the UK Patent Office, the number of excess pages present in the description are counted once the patent application has met all the requirements of the Act and Rules. If the number of excess pages has increased above the number paid for as part of the substantive examination fee, a grant fee will apply. No refunds will be available where the number of pages has decreased. The applicant will be advised in the notification of intention to grant if a grant fee is due and what fee is required. There will be a two-month period for payment of the grant fee, from the date of the notification of intention to grant. It will be possible to extend this period by two months by filing a Patents Form 52 and payment of £135. The consequence of non-payment or incomplete payment will be that the application does not proceed to grant.

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If you have any further questions about excess claims and page fees or anything else relating to patents, trade marks or designs, please contact one of our offices to speak with one of our Chartered or European patent attorneys.

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