

EPO Forms 1226AA, 1226BB and 1226CC - Amending an International Patent Application European regional phase before the European patent office under rules 161 / 162 EPC

Under Article 41 of the Patent Cooperation Treaty, when an international patent application enters the European regional phase at the European Patent Office, the applicant has the opportunity to amend the claims, description and drawings within the prescribed time limit.

Patent Cooperation Treaty (PCT)

Article 41

Amendment of the Claims, the Description, and the Drawings, Before Elected Offices

- (1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each elected Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.*

Pursuant to EPC Rules 161 and 162, the time limit set in the communication from the European Patent Office is six months. This time limit cannot be extended.

Rule 161

Amendment of the application

- (1) If the European patent office has acted as the International searching authority and, where a demand under article 31 PCT was filed, also as the International Preliminary Examining Authority for a Euro-PCT application, it shall give the applicant the opportunity to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination report and to amend the description, claims and drawings within a period of six months from the respective communication. If the European Patent Office has drawn up a supplementary International Search Report, an invitation in accordance with the first sentence shall be issued in respect of the explanations given in accordance with rule 45bis .7(e) PCT. If the applicant does not comply with or comment on an invitation in accordance with the first or second sentence, the application shall be deemed withdrawn.*
- (2) Where the European patent office draws up supplementary European search report on a Euro-PCT application, the application may be amended once within a period of six months from a communication informing the applicant accordingly. The application as amended shall serve as the basis for the supplementary European search.*

Rule 162 relates to the payment of extra claims fees due within the same six-month response period.

Rule 162

Claims incurring fees

- (1) If the application documents on which the European grant procedure is to be based comprise more than 15 claims, claims fees shall be paid for the 16th and each subsequent claim as laid down in the rules relating to fees within the period under rule 159, paragraph 1.*

- (2) *If the claims fees are not paid in due time, they may still be paid within the period under rule 161, paragraph 1 or paragraph 2, as the case may be. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims and shall be paid within this period.*
- (3) *Any claims fees paid within the period under paragraph 1 and in excess of those due under paragraph 2, second sentence, shall be refunded.*
- (4) *Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned.*

Practice Before the European Patent Office

The European Patent Organisation deals with this opportunity to amend the specification under the European Patent Convention under Rules 161 and 162 by issuing Form 1226 which has three variations AA, BB and CC.

Depending upon the history of the international phase, the applicant may:

- be required to file (**mandatory**) amendments to, or comments on their application within the six month time limit set (Form 1226 AA); or
- have the opportunity but not the obligation (**non-mandatory**) to file amendments to or comments on their application within the six-month time limit (Form 1226 BB & Form 1226 CC).

Form 1226 AA

Form 1226 AA requires a mandatory response under Rule 161(1) EPC, and the penalty for not responding within the six-month time period is withdrawal of the European patent application.

There are two separate deadlines in the form 1226 AA Communication being (1) a response deadline for amendment of the description, claims and drawings, and (2) a deadline for payment of additional claims fees. Both periods are non-extendable.

Form 1226 AA issues where the European Patent Office as International Searching Authority (ISA) has drawn up a Written Opinion on the application, or the European Patent Office as supplementary International Searching Authority has issued explanations concerning the Supplementary International Search Report. There is already some level of examination by the European Patent Office acting as either International Searching Authority, or International Preliminary Examining authority.

There are outstanding deficiencies, and the European Patent Office invites the applicant to correct any deficiencies noted in the Written Opinion of the ISA or in the International Preliminary Examination Report, or in the explanations to the supplementary International Search Report and to amend the description, claims and drawings within the non-extendable period of six-months from the date of the communication. This is indicated by the wording "You are invited to correct any deficiencies...."

Failure to comply with or comment on the invitation within the time limit results in the application being deemed withdrawn according to Rule 161(1) EPC.

Concerning the claims fees, if there are more than 15 claims, additional claims fees are due for the 16th and subsequent claim. If these claims fees are not paid by the non-extendable six-month deadline from the date of the form 1226 AA Communication, the European Patent Office bases the examination on the set of claims 1 to 15 currently on

file, or if amended claims of been filed in response to the form 1226 AA, on the amended claims filed pursuant to Rule 161 EPC. Unless the additional claims fees are paid, the 16th and subsequent claims are deemed to be abandoned (Rule 162(4) EPC).

If excess claims fees have been paid in respect of some but not all of the 16th and subsequent claims, then the applicant can indicate for which claims it is intended the additional claim fees apply to. Any excess claims for which additional claims fees have not been paid in due time are deemed abandoned (Rule 162(4) EPC).

The supplementary search carried out by the European Patent Office will relate only to the last set of claims applicable on expiry of the six-month period and will be confined to those fee incurring claims for which fees have been paid in due time.

Form 1226 BB

Form 1226 BB has a voluntary response under Rule 161(2) EPC, and the application is not withdrawn if no response is filed.

Form 1226 BB issues if there has been a negative Written Opinion by the European Patent Office appended to the International Search Report, and where amendments and comments have been filed on entry into the European regional phase.

At this stage, the previous set of comments filed on entry into the European regional phase of not yet been examined, but there is still the opportunity not the obligation to file further amendments to the description, claims and drawings. This is indicated in the wording “you may comment ...” appearing in the form 1226 BB.

Concerning the claims fees, if there are more than 15 claims, additional claims fees are due for the 16th and subsequent claim. If these claims fees are not paid by the non-extendable six-month deadline from the date of the form 1226 BB communication, the European Patent Office bases the examination on the set of claims 1 to 15 currently on file, or if amended claims have been filed in response to the form 1226 BB, on the amended claims filed pursuant to rule 161 EPC. Unless the additional claims fees are paid, the 16th and subsequent claims are deemed to be abandoned (Rule 162(4) EPC).

If excess claims fees have been paid in respect of some but not all of the 16th and subsequent claims, then the applicant can indicate for which claims it is intended the additional claim fees apply to. Any excess claims for which additional claims fees have not been paid in due time are deemed abandoned (Rule 162 (4) EPC).

The supplementary search carried out by the European Patent Office will relate only to the last set of claims applicable on expiry of the six-month period and will be confined to those fee incurring claims for which fees have been paid in due time.

Form 1226 CC

Form 1226 CC has a voluntary response under Rule 161(2) EPC and the application is not withdrawn and continues through to examination if no response is filed.

Form 1226 CC issues when the International Search Authority is not the European Patent Office, or if there is a positive International Search Report with Written Opinion indicating novelty and inventive step for all claims.

There are two separate deadlines in the form 1226 CC communication being (1) a response deadline for amendment of the description, claims and drawings, and (2) a deadline for payment of additional claims fees. Both periods are non-extendable.

Amendment of the description, claims and drawings is optional. This is indicated by the wording "...you may amend your application once within the non-extendable period of six months.."

If the applicant chooses not to amend the description, claims or drawings then the application is not withdrawn, and subsequent examination will be based upon the description claims and drawings in their current condition.

If any additional claims fees are due, for the 16th and subsequent claims, and these are not paid by the deadline, the European Patent Office bases the examination on the claims 1 to 15 as presented on entry to the European regional phase, and the remaining claims are deemed to be abandoned (Rule 162(4) EPC).

The supplementary search carried out by the European Patent Office will relate only to the last set of claims applicable on expiry of the six-month period and will be confined to those fee incurring claims for which fees have been paid in due time.

Summary

- EPO form 1226 AA - a substantive response including amendments to the description claims and drawings is required within a non-extendable six months of the date of the communication. Failure to respond results in termination of the European patent application.
- EPO form 1226 BB - a substantive response including amendments to the description, claims and drawings can be voluntarily filed within a non-extendable six months of the date of the communication. Failure to respond does not result in termination of the European patent application.
- EPO form 1226 CC - a substantive response including amendments to the description, claims and drawings can be voluntarily filed within a non-extendable six months of the date of the communication. Failure to respond does not result in termination of the European patent application.

For any specific queries on entry into the European regional phase from an international patent application, please contact:

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