



## EPO: Minor Text Changes to Patent Application Need Not Slow Grant Process

The European Patent Office's ("EPO") quest to increase procedural efficiency has led to a revision of the final steps in the patent grant procedure. Now that a communication under Rule 71(3) EPC—Intention to Grant has issued, applicants may waive their right to issuance of a further Intention to Grant after requesting relatively minor amendments to the text intended for grant. Effectively, the revision brings us back to the prior practice before Rule 71 EPC was amended in April 2012, but without the requirement to expressly waive the right for a further Intention to Grant communication.

The new "old" practice will expedite the granting procedure when changes in the application are sought at this stage of the proceedings. As ever, applicants should carefully check the text intended for grant prior to approving it, since after grant, any changes to the patent text are no longer possible.

### Rule 71(3) EPC: Background and Present Practice

When the EPO intends to grant a patent, it issues a Communication pursuant to Rule 71(3) EPC—Intention to Grant informing the applicant of the text proposed for grant, also known as "*Druckexemplar*," to give the applicant the opportunity to review the text before

a patent is granted. Before July 1, 2015, there were three possibilities for applicants to respond to this Communication. Applicants could (i) approve the text intended for grant; (ii) disapprove the text intended for grant; or (iii) disapprove the text intended for grant and file amendments or corrections to the text.

The procedure under the third option was revised in April 2012, and since then, when the Examining Division does not have any objection to the requested amendments or corrections, it issues a second Intention to Grant to give applicants a further opportunity to check the text based on an unambiguously defined single document. If the Examining Division has objections to the amendments or corrections, it will resume the examination proceedings (see Rule 71(6) EPC).

The issuance of a further Intention to Grant triggers new deadlines for meeting the requirements under Rule 71(3) EPC (i.e., approval of text intended for grant, filing translations of claims, and payment of fees for grant and publishing/printing), which results in a delay of the granting procedure. The EPO realized that the issuance of a further Intention to Grant communication is not always efficient and thus decided to introduce a new option for applicants in responding to the Intention to Grant.

## New Option for Responding to Rule 71(3) EPC

Since July 1, 2015, applicants have the option to expressly waive their right to issuance of a further Intention to Grant under Rule 71(3) EPC. This new option is intended to speed up the granting procedure in cases where applicants request relatively minor amendments or corrections to the *Druckexemplar*, in response to a Rule 71(3) EPC Communication, that would not lead to resumption of examination proceedings.

If the applicant decides to waive its right to a further Intention to Grant, the applicant must meet all requirements under Rule 71(3) EPC within the term for responding to the Communication, i.e., by indicating the amendments/corrections requested, filing translations of the (amended) claims, and paying the fees for grant and publishing/printing. Based on this waiver, the Examining Division can immediately consent to the amendments/corrections without issuing a new Rule 71(3) EPC Communication. In fact, if the Examining Division agrees to the amendments/corrections and the other requirements are met, the waiver is deemed to be consented to. The Examining Division will publish a new EPO Form 2004W in the European Patent Register informing the applicant and the public of the allowance of the amendments/corrections. The next step will then be the issuance of a Decision to Grant. If the Examining Division does not agree with the requested amendments/corrections, the waiver is not consented to, and either examination proceedings will be resumed or a further Intention to Grant will be issued with a *Druckexemplar* that the Examining Division considers allowable.

### Conditions for the Waiver

Applicants who want to waive their right to a further Communication under Rule 71(3) EPC have to fulfill some conditions within the nonextendable four-month period for responding to the Communication.

The waiver has to be express and in writing. There is no special form for this, and thus it can be stated in a sentence in the response to the Intention to Grant. The requested amendments/corrections have to be identified and, where applicable, their basis must be indicated in the application as filed.

In addition, the respective pages of the *Druckexemplar* containing the amendments and corrections must be submitted. Further, a translation of the claims into the two EPO official languages other than the language of the proceedings has to be filed, and if the requested amendments/corrections concern the claims, those must be included in the translations. Finally, the fees for grant and publishing and, if applicable, claim fees for claims above 15 have to be paid.

Given that the purpose of the waiver is to expedite granting proceedings, the fees are not payable through the automatic debiting system, since with this system, fees are not debited until the last day of the payment period. Thus, the fees due with the response to the Intention to Grant including a waiver must be paid separately by another means of payment allowed under the Rules of Fees, and the fees will not be debited automatically.

The Examining Division will consent to the waiver only if all formal requirements are met and the requested amendments/corrections are allowable, i.e., they concern only minor or simple changes in the application documents without requiring substantive examination (e.g., misspelled words, incorrect use of words, incorrect reference to drawings, etc.). If the applicant's request for amendments corresponds to maintaining a higher ranking request, while the pending Intention to Grant was based on an auxiliary request, the Examining Division will not consent to the waiver, and either substantive examination will be resumed or a further Intention to Grant will be issued.

Also important to note is that applicants are given the ability to retract their waiver, which can be done up to the moment the Decision to Grant is handed over to the EPO's internal postal service. Thus, if a waiver needs to be retracted, we recommend contacting the EPO to confirm that the Decision to Grant has not been handed over.

### Practical Advice

The revision of Rule 71(3) EPC is a positive and welcome option given to applicants, since more often than not, mistakes or errors generally are not noticed until a final, thorough

review of the text intended for grant or preparation of claim translations has been performed. However, we recommend that this new procedure be used only when relatively simple amendments or corrections, which can be expected to be acceptable to the Examining Division, are requested. Still, emphasis is placed on the importance of carefully checking the text intended for grant prior to its approval, since once the Decision to Grant has issued, amendments or corrections to the application text as approved are no longer possible.

## Lawyer Contacts

For further information, please contact your principal Firm representative or one of the lawyers listed below. General email messages may be sent using our “Contact Us” form, which can be found at [www.jonesday.com/contactus/](http://www.jonesday.com/contactus/).

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