

Changes in EPO Fees from 1st April 2009

The European Patent Office (EPO) has announced a number of structural changes to the fees payable on European Patent Applications and on International (PCT) Patent Applications entering the EPO regional phase. The changes came into force on 1 April 2009. This note sets out the changes and discusses their potential effect on practice from the applicant's viewpoint.

To which applications do the new fees apply?

Except for the advance payment of annuities (see below), the new fees apply to all European patent applications (including divisional applications) filed on or after 1 April 2009, and to international patent applications entering the EPO regional phase ("Euro-PCT applications") on or after that date.

European applications that were filed and international applications that validly entered the EPO regional phase before 1 April 2009 will remain subject to the former fee structure as in force until 31 March 2009.

Each of the new fees is now discussed in turn.

Additional page fee

The EPO claims that the length of patent applications has been increasing over recent years, and would like to reverse that trend. The EPO has therefore decided to introduce a new fee of €12 for the 36th and each subsequent page of the application, to be paid on filing. For a regular European application, the pages to be counted for this purpose are those making up the description, claims, any drawings and one page only for the abstract. Not counted in the total are the Application Form (EPO Form 1001), or pages that are part of a separate sequence listing that complies with the relevant WIPO Standard (currently ST. 25).

Under EPC 2000 (in force since 13 December 2007), a European patent application can be filed initially without claims (in which case the fee is calculated based on the first set of claims filed), or by reference to a previously filed application (in which case the fee is based on the number of pages of the certified copy, not including the certification and any bibliographic data).

For Euro-PCT applications, the pages to be counted are those making up the international application as published, any amendments under Article 19 PCT and one page only for the abstract. Again, the Application Form (EPO Form 1200) or pages that are part of a separate sequence listing that complies with the relevant WIPO Standard are not counted in the total. However, if replacement pages are filed on entering the EPO regional phase within the 31-month period allowed after the priority date (and if the additional fee is paid by that date), then these will be used as the basis of the calculation instead.

We recommend to clients that they now routinely send to us an electronic copy of the application text (if we do not already have it), thereby allowing us to minimise the new page fees by reformatting the text in compliance with EPC Rules.

Claims fees – new two-tier system

Since 1 April 2008, an excess claim fee of €200 has been levied by the EPO for the 16th and each additional claim, compared with the former fee of €45 for the 11th and each additional claim. This large increase was an attempt by the EPO to discourage applicants from including large numbers of claims, which were considered to create a significant administrative burden. This claims fee will continue; however, under the new system, the fee for the 51st and each subsequent claim increases to the punitive amount of €500.



In our experience, most clients have adjusted to the increased claims fees introduced in 2008 by routinely reducing the number of claims at the EPO to 15 or fewer, so this change will not have a major impact.

Flat designation fee

Under the former fee structure, the EPO levied a fee of €85 for each designated contracting state; however, if seven designation fees (€595) were paid, all available contracting states were considered as designated.

The system has been simplified by introducing a flat fee of €500 irrespective of the number of contracting states designated. The new flat fee applies to all European patent applications (including divisional applications) filed on or after 1 April 2009, and to international patent applications entering the EPO regional phase on or after that date. Unless the applicant indicates otherwise, all available EPC contracting states will be designated. Because the designation fee for European patent applications is due not on filing but only within six months of the publication of the search report, for European patent applications filed prior to 1 April 2009 the existing designation fee system will operate in parallel with the new one for some time into the future.

For the 'extension states', the requirement to pay a separate fee (currently €102 per state) will continue.

Fee for grant

Under the former fee structure, the EPO levied a page fee for the 36th and subsequent pages at the grant stage. This is now being abolished in view of the introduction of the additional page fee at the filing stage (see above). Instead, a flat fee (€790) will apply for grant and publication of the patent. However, the old system will continue to apply to European applications filed and international applications that validly entered the EPO regional phase before 1 April 2009.

Limitation on advance payment of annuities

Formerly, renewal fees could validly be paid to the EPO up to 12 months before their due date. Under the new rules, this is reduced to 3 months before the due date. This change applies to all applications as from 1 April 2009, irrespective of their filing date.

For practical reasons, any renewal fees paid during the month preceding the new 3-month permitted period will be retained by the EPO but not applied to the application until the first day allowed under the new rules; however, any attempt to pay a renewal fee more than 4 months before it is due will be rejected.

Further information

For further information on the above changes, please contact Philip Towler or your usual contact using the details below.

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