

SINGLE DESIGNATION FEE AT THE EPO FROM 1 APRIL 2009

On 1 April 2009, a rule change requires that a **single designation fee**, effective to designate all available EPC countries, must be paid on each European patent application. The new rule applies to all European applications with filing date on or after 1 April 2009 and to all PCT applications which enter the EPO on or after 1 April 2009. The official fee will be €500 (compare the present fee of €595 for designation of all countries).

On a PCT application entering the EPO, this fee is normally due when the application enters the EPO. On a direct (non-PCT) European application, the fee is due at the same time as the examination fee, at 6 months after publication of the EPO search report. Because the designation fee is not refunded if the application is abandoned, **we strongly recommend** that it is not paid earlier than necessary.

Mewburn Ellis LLP will not charge a specific docket fee for paying the designation fee, when the fee is paid on filing or on entry of a PCT application to the EPO or simultaneously with the examination fee.

The present system

Individual designation fees are paid for each country up to a total of six. Payment of seven designation fees has the effect that all available EPC countries are designated.

Most applicants pay seven fees to obtain all countries, but some have been in the habit of paying fewer than seven fees, because they have no wish to designate many countries.

Some applicants have withdrawn unwanted countries before grant of the patent. Mainly, all designations have remained to grant.

For an application filed after 13 December 2007, when EPC 2000 came into force, the effect of the content of the application as 'prior art' under EPC Article 54(3) has not been dependent on the number of designation fees paid.

How does the present system change?

The only actual change is that from 1 April 2009, the applicant has no choice. The single designation fee must be paid in every application. All available EPC countries are designated in each application. The countries obtained are those that are EPC member states at the date of filing of the application (which is the international filing date for a PCT application).

The time limit for payment of the designation fee is not changed. It is 6 months after publication of the EPO search report for a direct (non-PCT) application, and 31 months from first priority date (normally) for a PCT application. This is the same time limit as for payment of the examination fee.

In effect, the designation fee becomes a non-refundable part of the examination fee.

As before, applicants can withdraw countries by letter to the EPO at any time after payment of the designation fee. Such withdrawal is final. Unless such withdrawal is made, the European patent will be granted for all possible countries.

To which applications does the new rule apply?

It applies to all direct (non-PCT) European applications having a filing date on or after 1 April 2009. It applies also to a divisional application filed on or after 1 April 2009, even if the divisional has an effective filing date before 1 April 2009.

It applies to all PCT applications which enter the EPO on or after 1 April 2009. If the first priority date is more than 31 months before 1 April 2009, the new rule does not apply. If the 31-month date from first priority is on or after 1 April 2009, the new rule applies unless all steps necessary to enter the EPO are performed before 1 April 2009. **If you wish an application to enter the EPO before 1 April 2009, please let us know well in advance.**

Our recommendations for payment of the designation fee

Since the designation fee, once paid, will not be refunded by the EPO if the applicant withdraws the application, we strongly recommend that it is paid shortly before it is due, at six months after the publication by the EPO of the EPO search report.

This time limit is the same as that for the examination fee. We also recommend that the examination fee is paid at the same time. The examination fee is refunded by the EPO if the applicant withdraws the application before the EPO begins examination.

Withdrawal of countries

The applicant can withdraw unwanted countries, by means of a letter to the EPO, at any time up to grant of the patent. Such withdrawal is irrevocable and therefore not normally recommended.

However in some special cases the applicant may wish to withdraw a country before grant. Particularly important is the case of withdrawal to avoid a conflict between the European patent and a parallel national patent.

If the patent is granted with unwanted countries, the patentee can allow the patent to lapse in these countries, either by failure to take the action necessary in each country to validate the patent after grant or by failure to pay the first annual renewal fee due in the country. A minor effect may be that the patentee will receive a letter from a national patent office about the lapse of the patent.

Divisional applications

A European divisional application receives, as its effective filing date, the filing date of its parent application. However, the application of the new rule on a single designation fee depends on the actual filing date of the divisional, not the filing date of the parent. On any divisional actually filed on or after 1 April 2009, the single designation fee must be paid, regardless of the number of countries which can be designated.

Normally a divisional application can designate only the same countries as those for which designation fees have been paid in the parent application. However in the special case where a divisional application is filed before the time limit for paying the designation fee(s) on the parent application, all countries which are available for designation in the parent may be designated in the divisional (even if the designation fee is not paid for all such countries in the parent).

Extension countries

The system for extension of a European patent to a few small countries is not affected by this rule change. For each such country (there are three at present), an extension fee must be paid to the EPO within the same time limit as for the designation fee on the application. Then the patentee can take steps to obtain the patent right in the extension country at the time of grant of the European patent.

Mewburn Ellis LLP's fees

In recent years we have charged our clients a single fixed fee for entry of a PCT application into the EPO, at the start of the regional processing at the EPO. This fixed fee covers many actions, including payment of the designation fees to the EPO.

From 1 April 2009, we will not charge a specific docket fee for payment of the single designation fee to the EPO, when the designation fee is paid on filing or on entry of PCT application to the EPO.

Since we expect that, on direct applications, all our clients will pay the single designation fee to the EPO at the same time as paying the examination fee, the docket fee for payment of the examination fee will cover also payment of the designation fee.

Another fee change on 1 April 2009

The EPO will charge a fee per page of the application from 1 April 2009, on all European applications with a filing date on or after 1 April 2009 and all PCT applications which enter the EPO on or after 1 April 2009. We have published a separate note entitled "New EPO Fee Structure" which is available on our website.

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