

NEW EPO FEE STRUCTURE

New rules are coming into force at the EPO that will change the fees payable in respect of European patent applications filed from 1 April 2009, and international (PCT) patent applications entering the European regional phase from 1 April 2009.

The changes include the introduction of a flat designation fee, the introduction of new page fees as part of the filing fee, the introduction of a second tier for claim fees, a reduction of the window for early payment of renewal fees; and the elimination of page fees due at the grant stage.

Designation Fees

For European patent applications filed from 1 April 2009, and for international (PCT) patent applications entering the European regional phase from 1 April 2009, a single flat designation fee of 500 Euro is payable. Payment of the flat fee results in designation of all available member states, unless individual designations are expressly withdrawn.

For European patent applications filed before 1 April 2009, and for international (PCT) patent applications which have entered the European regional phase before 1 April 2009, the "old" fee structure still applies. For these cases, a designation fee of 85 Euro is payable for each designation, but payment of 7 designation fees (that is, 595 Euro) is deemed to be payment of all possible designation fees.

For cases where five or fewer designations are wanted, the "old" fee structure is cheaper; for these cases, European applications may be filed early, and international applications may be taken into the European regional phase early, before 1 April 2009, in order to take advantage of the "old" fee structure.

The deadline for paying the designation fee(s) (whether the flat designation fee or the individual designation fees) is unchanged: six months from publication of the European Search Report, or, for European regional phase applications, the later of six months from publication of the International Search Report, and 31 months from earliest priority.

Page Fees

For European patent applications filed from 1 April 2009, and for international (PCT) patent applications entering the European regional phase from 1 April 2009, new page fees are payable as part of the filing fee. The new page fees are 12 Euro per page, for each page of the application more than 35 pages.

European applications may be filed early, and international applications may be taken into the European regional phase early, before 1 April 2009, to avoid payment of the page fees.

Page Fees - "Direct" and "Divisional" Applications

For European "direct" and "divisional" applications filed from 1 April 2009, the new page fees are calculated on the basis of the pages of the description, claims, and any drawings, plus one page for the abstract.

If the application as filed includes, as a separate part, a sequence listing which is the format according to WIPO Standard ST 25, then page fees are not charged for the pages of the sequence listing.

In most cases, the page fees are payable within one month of filing the "direct" and "divisional" application.

Page Fee - "Regional Phase" Applications

For applications which enter the European regional phase from 1 April 2009, the new page fee is calculated on the basis of the pages of the international application as published, any amendments under Article 19 PCT, plus one page for the abstract. However, if the publication includes more than one page of bibliographic data, only the first page is counted.

The page fees are payable by the normal deadline of 31 months from earliest priority.

The pages of the latest set of any amended documents (e.g., amendments under Article 34 PCT, amendments filed upon entry into the European regional phase) are taken into account only if they are available to the EPO no later than payment of the page fees, and only if the page fees are paid by the normal deadline of 31 months from earliest priority.

Normally, when entering the European regional phase, the applicant indicates (typically on EPO Form 1200, or in an appended letter) which documents are to form the application documents. By correctly indicating this, it is possible to avoid paying fees for pages which have been superseded or deleted by subsequent amendments.

When entering the European regional phase, the applicant may wish to file amended claims in order to reduce the number of claims (and so reduce the claims fees) and/or the number of pages (and so reduce the page fees). Also, the applicant may wish to file amendments to the description/drawings, for example, to remove subject-matter that does not relate to the (amended) claims, in order to reduce the number of pages (and so reduce the page fees).

Changes to the number of pages that occur after the date of payment of the page fee are not taken into account. For example, amendments filed after entry into the European regional phase (e.g., under Rules 161 and 162 EPC) are not taken into account; no additional page fees are charged, and no page fees are refunded.

It seems that, if the international application as published includes, as a separate part, a sequence listing which is the format according to WIPO Standard ST 25, then page fees are not charged for the pages of the sequence listing.

Claim Fees

For European patent applications filed from 1 April 2009, and for international (PCT) patent applications entering the European regional phase from 1 April 2009, a new two-tier claim fee structure applies: (i) a fee of 200 Euro is payable for each claim from the 16th to the 50th, and (ii) a fee of 500 Euro is payable for the 51st and each subsequent claim.

For European patent applications filed before 1 April 2009, and for international (PCT) patent applications which have entered the European regional phase before 1 April 2009, the "old" one-tier claim fee structure still applies: a fee of 200 Euro is payable for the 16th and each subsequent claim.

European applications may be filed early, and international applications may be taken into the European regional phase early, before 1 April 2009, in order to avoid being subject to the new two-tier claim fee structure.

Our experience has been that the changes introduced in April 2008 (to increase claim fees from 45 Euro to 200 Euro for the 16th and each subsequent claim) has already discouraged applicants from pursuing large claim sets. We doubt, therefore, that the new two-tier claim fee structure will impact many applications in practice.

Note that, when bringing an international (PCT) application into the European regional phase, it is still possible to file amended claims in order to reduce the number of claims, and so reduce the impact of these punitive claims fees.

Renewal Fees

From 1 April 2009, for all European applications, irrespective of filing date or date of entry into the European regional phase, the EPO will accept payment of renewal fees only up to three months in advance of their due date. At present it is possible to pay renewal fees up to one year in advance of their due date.

Flat Fee for Grant and Publication

Concurrent with the introduction of the new page fees (due at filing), the page element of the printing fee (due at the grant stage), has been eliminated.

For European patent applications filed from 1 April 2009, and for international (PCT) patent applications entering the European regional phase from 1 April 2009, a new flat fee for grant and publication applies (currently 790 Euro).

For European patent applications filed before 1 April 2009, and for international (PCT) patent applications which have entered the European regional phase before 1 April 2009, the "old" grant and printing fee applies (currently 790 Euro plus 12 Euro for each page more than 35).

If you would like more information about the new rules, please contact your usual Mewburn contact or email us at mail@mewburn.com.

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