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Newsletter
Recent developments at the European Patent Office

Fees for European patent applications are changing from 1 April 2024. These include reductions for small companies, natural persons, non-profit organisations, universities and public research organisations also located outside Europe.

Moreover, the EPO announced that the latest version of the Guidelines are now in effect superseding the previous Guidelines implemented in March 2023.

1. Fees at the EPO

The Administrative Council agreed on several important fee changes coming into force on 1 April 2024: The European Patent Office will increase most official fees by around 4 %. However, the first two renewal fees, in respect of the third and fourth years, will see significant rises of 30 % to offset revenue lost as a result of the EPO reducing application pendency time.

In parallel with these increases, a new fee reduction system for some applicants will be implemented. Micro-enterprises, natural persons, non-profit organisations, universities and public research organisations will benefit from a 30% reduction in all main fees in the patent grant procedure, provided they have filed fewer than five applications in the last five years. This new fee reduction system will supplement the already existing practise available so far only to those types of entities which are based in an EPO member state and use a language other than English, French or German for the specification and/or request for examination. The EPO has confirmed that it is possible to combine the various fee reduction schemes with reductions on the same fee for the same application to be calculated sequentially.

As a consequence, the following fees will be reduced by 30% for such applicants:

- the filing fee, including any additional fees part of the filing fee;
- the fee for a European search and the fee for a supplementary European search in the case of a Euro-PCT application searched by an International Searching Authority (ISA) other than the EPO;
- the examination fee, and in addition, if applicable, the previously paid international search fee where the EPO acted as ISA;
- the designation fee;
- the fee for grant; and
- the renewal fees for the European patent application.

According to the definition by the European Commission, on which the EPO bases its own definition, a ‘micro enterprise’ is as a company with “fewer than ten employees and an annual turnover or balance sheet below € 2 million”.

The following table gives an overview about the official fees for patent applications before and after April 1, 2024:

Fee	Before 1 April	After 1 April
Filing fee	135,00 €	135,00 €
Search fee	1460,00 €	1520,00 €
Designation fee	660,00 €	685,00 €
Examination fee	1840,00 €	1915,00 €
Claim fee (16th – 50th claims)	265,00 €	275,00 €
3rd annuity	530,00 €	690,00 €
4th annuity	660,00 €	845,00 €

Since all annuities can be paid already three months before the respective due date except for the 3rd annuity which can be even paid 6 months in advance, one can make considerable savings if the annuities are paid prior to 1 April 2024.

The same applies for regional phase entries of pending PCT applications, where the applicant can save up to 310,00 € for a regional phase entry before 1 April 2024.

Further support measures will also enter into force on 1 April 2024:

All users of MyEPO Portfolio will benefit from fee reductions to zero to further incentivise their use of this secure, web-based online service. These reductions include, for instance, the fee for registration of transfers of rights for a European patent application or patent, i.e. change of ownership, in the European Patent Register.

Finally, the fee system is simplified by abolishing five rarely used fees.

2. EPO Guidelines 2024

The annual updated version of the Guidelines for Examination at the EPO entered into force on 1 March 2024. The updates are intended to reflect recent changes to the EPO's practice and some of the more significant changes are set out below.

Entitlement to claim priority

In response to the decisions handed down under G 1/22 and G 2/22, the Guidelines have been updated to clarify practice with respect to the transfer of a priority right.

According to the new Guidelines, the transfer of the priority right is distinct from the possible transfer of the priority application and must be assessed under the EPC, regardless of any national laws. The Guidelines make clear that the burden of proof that entitlement is missing lies with the party challenging an applicant's entitlement to priority meaning that in the absence of any substantiated indication to the contrary, there is a strong presumption under the EPC that an applicant or joint applicants claiming priority are entitled to the claimed priority (A-III, 6.1).

Claims directed to antibodies

The Guidelines list several specific approaches by which antibodies may be defined in patent claims and discuss the specific requirements for each of these various approaches to claiming antibodies based on structure, function, target, and/or method of production.

In the 2024 Guidelines, the section relating to defining antibodies on the basis of an epitope has been combined with the section relating to defining antibodies using a combination of the target antigen and a further functional feature. As a result of this amendment, specific requirements relating to the definition of linear and discontinuous epitopes have been removed entirely from the Guidelines, potentially providing more flexibility for applicants.

The amendments to the Guidelines explicitly place the burden of proof on the applicant for demonstrating the novelty of antibodies defined on the basis of their epitope and/or other functional features.

Plausibility

The decision G 2/21 left plenty of scope for interpretation regarding the plausibility of technical effects on which applicants and patentees rely. In G 2/21, it was concluded that a patentee "may rely upon a technical effect for inventive step if the skilled person, having the common general knowledge in mind, and based on the application as originally filed, would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention" (Headnote II, G 2/21). The Guidelines have now been updated to reflect this decision but provide no further guidance on how it should be interpreted.

Request for unitary effect

In respect of Unitary Patents, the Guidelines explicitly set out that a request for unitary effect can be filed no later than one month after the date of publication of the mention of the grant in the European Patent Bulletin. Whilst the EPO allows a request to be filed early, prior to the date of publication, the Guidelines state that such requests will not be processed prior to the date of publication and that the request will only appear in the Register for unitary patent protection from that date (General Part, 5; C-V, 2.1).

Patentability of AI inventions

The amended guidelines clarify the assessment of technical effects stemming from algorithms in AI inventions for the assessment of inventive step. The new Guidelines make it clear that any features of the training data set that are necessary for reproducing the purported technical effect must be disclosed in the application as filed. However, this is only required if these features cannot be derived by the skilled person, without undue burden, using their common general knowledge. The Guidelines do not require the disclosure of the specific training data set itself. However, such disclosure would likely satisfy these requirements where necessary. There is a balance to be struck by applicants here, in disclosing enough information regarding the training data set such that a skilled person can reproduce the invention (and technical effect) across the breadth of the claim, and protecting commercially sensitive information, as the data sets themselves can be very valuable.

If you're looking for some guidance or assistance with your EPO applications, get in touch with our specialist patent attorneys at GILLE HRABAL.