

Extension and validation system before the EUROPEAN PATENT OFFICE (EPO)

The European Patent Convention (EPC) allows applicants to obtain a single European patent application through the EPO. Once granted, however, the patent is not automatically valid across all member states. Instead, the applicant must validate the patent in each country where protection is desired, often by filing translations, paying fees, and complying with national requirements.

Beyond EPC contracting states, the EPO has agreements with extension states (e.g., Bosnia and Herzegovina, Montenegro) and validation states (e.g., Morocco, Moldova, Tunisia, Cambodia). This means a European patent application can also be extended or validated in those countries, giving protection similar to that in EPC states, provided the applicant requests it and pays the necessary fees during the application procedure.

INTRODUCTION

The EUROPEAN PATENT OFFICE has a number of agreements with other countries (referred to as “extension states” or “validation states”).

Under these agreements, the European patent application can be optionally “extended” to include one or more or all of those countries through payment of additional official fees (“extension fees” and “validation fees”).

After the European patent has been granted, the patent owner can decide to “nationally validate” the granted patent in one or more or all of the designated states. If, in addition the designation fee, the extension or validation fee for a country has been paid, then the patent owner can also decide to “nationally validate” the patent in that country (again, by filing any necessary translations and paying any necessary fees).

EXTENSION STATES

The extension states which are available depend on the filing date of the European

application, or the filing date of the underlying International (PCT) application for European regional phase applications.

Historically, there have been a number of different extension states, and many of them have “graduated” to become EPC member states.

For European applications filed from 1 October 2022, only one extension state is available:

Bosnia and Herzegovina (BA)

VALIDATION STATES

The validation states which are available depend on the filing date of the European application, or the filing date of the underlying International (PCT) application for European regional phase applications.

Currently there are six validation states:

Morocco (MA) from 1 March 2015

Republic of Moldova (MD) from 1 November 2015

Tunisia (TN) from 1 December 2017

Cambodia (KH) from 1 March 2018

Georgia (GE) from 15 January 2024

The Lao People's Democratic Republic (LA) from 1 April 2025

FEES FOR EXTENSION STATES

A separate extension fee must be paid for the only available extension state in an amount of EUR 102.

FEES FOR VALIDATION STATES

A separate validation fee must be paid for each (available) validation state that is wanted.

The individual validation fees vary from EUR 180 to EUR 240:

Morocco	EUR 240
Republic of Moldova	EUR 200
Tunisia	EUR 180
Cambodia	EUR 180
Georgia	EUR 200
The Lao People's Democratic Republic	EUR 180

REQUEST FOR EXTENSION / VALIDATION

For regional International applications (PCT):

International applications (PCT) entering the European phase may be extended to or validated in third countries for which an extension or validation agreement has entered into force (REQUIREMENT 1), provided that the EPO has been designated for a European patent (REQUIREMENT 2) and the extension or validation state has been

designated for a national patent in the international application (REQUIREMENT 3).

Moreover, the extension fee or validation fee, whichever is applicable, is to be paid within the prescribed time limit.

The time limits for paying extension and validation fees are governed by the national laws of the extension/validation states, according to which extension and validation fees are to be paid

- ✦ within 31 months from the date of filing (or the earliest priority date) or
- ✦ six months from the date of publication of the international search report, whichever is the later.

Usually, the time limit is defined by the 31 months due date from filing the PCT application or the respective priority date because the in almost all cases the international search report is published much earlier than six months before the 31 months due date.

If the extension or validation fee is not paid in due time, the request for extension or validation is deemed withdrawn.

If the extension or validation fee for an extension or validation state is not paid within the basic period, it is still possible to pay the fee, together with a 50% surcharge,

- (a) within two months of expiry of the basic period ("grace period")

→ meaning until 33 months after the filing date or priority date of the PCT application whatever is older,

or

- (b) along with further processing in respect of the designation fee: within

two months of notification of a communication of loss of rights under Rule 112(1) EPC following non-payment of the designation fee.

→ this possibility exists only in case the designation fee had not been paid by the 31 months due date for entering the regional phase and the EPO issues a communication for a loss of rights for not paying the designation fee and further processing is requested

For EP direct filings (also direct filings claiming a priority (Paris Convention Applications before the EPO):

For EP direct filings, the extension and validation fee must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

This time is the same as the due date for paying the designation fee and the examination fee.

WHAT HAPPENED IN CASE THE EXTENSION AND VALIDATION FEE ARE NOT PAID IN TIME?

If no loss of rights under Rule 39 EPC has occurred (i.e. the designation fee had been paid in time) and the extension or validation fee has not been paid within the applicable basic period, no notification under Rule 112(1) EPC is issued and the request for extension or validation is deemed withdrawn, with no possibility of late payment plus surcharge unless the grace period of two months as from the end of the basic period has not yet expired.

Re-establishment of rights under Article 122 and Rule 136 EPC is not available in

respect of payment of the extension or validation fee.

WHAT HAS TO BE DONE AFTER AN APPLICATION WITH EXTENSIONS AND / OR VALIDATIONS HAD BEEN GRANTED?

The extension and validation systems are based not on direct application of the EPC but solely on the relevant national law modelled on the EPC. Hence they are subject to the national extension/validation rules of the country concerned with different requirements for the extension or validation process.

You are kindly asked to let us know in case you need detailed information about the validation process for one or more extension or validation countries.



Dr. Dirk Bröcher, LL.M.
Dipl.-Chem.
Partner

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