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Newsletter- Spring 2020

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Our wishes for you:

We wanted to let you know that in these unprecedented times of the continuing battle against Covid-19 virus, our thoughts are with you, our clients, and colleagues and your teams, families and friends. We thank you with all our hearts, for the good wishes that you have sent to us as well as the offers to help, in a very touching way by sending us protective masks.

We are fully aware that the ongoing uncertainty of these challenging times is impacting everyone in their personal and professional lives.

At Hanna Moore + Curley, we are focusing on the health and safety of our community, while continuing to work together and assist our clients.

The situation has made us think even more about our colleagues and clients and has drawn us even closer together. We had planned for a variety of detailed back-up business plans and, following Government recommendations on March 12th, 2020, we commenced working from home. We are fully organized and ready for working from home with well-established IT structures and systems already in place for this situation so that we can continue to serve you with no interruption to our services for you and to the support that we wish to continue to provide to you.

We greatly value our relationship with you, and we wish everyone peace and good health during this difficult time.

Please do not hesitate to contact us at Hanna Moore + Curley if you require our assistance. Please feel free to contact Marie WALSH or Yan GUO on china@hmc-ip.com if you have any questions.



...promise of new growth

在全球与新冠持续斗争的特殊时期里，我们感谢所有瀚恒朋友及客户给予的信任和支持，并与您一同期待疫情尽快结束，重新恢复到正常的工作生活中去。

1. Exceptional extensions announced by EPO, EUIPO and UKIPO in response to disruption caused by Covid-19 and measures in place to prevent the spread of the virus:



Although we are planning on meeting all deadlines as normal, for information and as a back-up, we will summarise below, the exceptional extensions that are in place at the EPO, EUIPO and UKIPO for this time period, in response to the disruption caused by COVID-19:

The EPO announced that all “periods” are extended until **17 April 2020**. The announcement takes the form of a Notice in the Official Journal which can be read in full [here](#). [Rule 134\(2\) EPC](#) provides that if a deadline expires on “a day on which there is a general dislocation in the delivery or transmission of mail in a Contracting State, the period shall extend to the first day following the end of the internal of dislocation for parties which are resident in the State”. If the State (e.g. Germany or The Netherlands) is one in which the EPO is located, the provision applies to all parties and their representatives.

The EPO Notice acknowledges that Germany “is experiencing restrictions on the movement and circulation of persons as well as certain services, exchanges and public life in general, which can be qualified as general dislocation within the meaning of Rule 134(2) EPC”. Therefore, “periods expiring on or after the date of the publication of this notice are thus extended **for all parties and their representatives to 17 April 2020**”. The extension also applies to PCT applications handled by the EPO ([Article 150\(2\) EPC](#)).

The EPO notice therefore applies to all deadlines at the EPO (including those for 31-month deadline for entry to EPO Regional phase for international applications under the PCT) due after the date of the notice on 15 March 2020 until 17 April 2020.

More detailed analysis about EPO extensions due to Covid-19:

The notice from the EPO primarily refers to [Rule 134\(2\) EPC](#), which relates to the problems being experienced at the EPO itself. However, it also refers to [Rule 134\(5\) EPC](#) and [Rule 82quater.1 PCT](#), which relate to problems which might be experienced at the applicant’s or representative’s location.

The notice states that, under [Rule 134\(2\) EPC](#), and in view of the restrictions currently in place in Germany (where two of the EPO’s three filing offices are located; the other is in The Netherlands): “*Periods expiring on or after the date of the publication of this notice [15 March 2020] are thus **extended for all parties and their representatives to 17 April 2020.***” Indeed, the notice also states: “*The above period may be further extended by the publication of another Notice in case the dislocation extends beyond the aforementioned date*”.

While this is certainly a welcome development in these increasingly uncertain times, it should NOT be regarded as covering ALL deadlines at the EPO:

Accordingly, care is needed before deciding to rely on the EPO’s exceptional extension due to COVID-19. If in doubt, ask your European attorney at China@hmc-ip.com



EPO exceptional extension and relevant deadlines in more detail:

[Rule 134 EPC](#) refers to “extension of **periods**”, and, unfortunately, not all deadlines are covered by this reference to “periods”.

In almost all cases, “periods” (e.g., for taking action) are set by the European Patent Convention (EPC) or by the EPO itself (e.g., by way of a formal communication, e.g., an examination report); these “periods” are automatically extended by the EPO COVID-19 extension. This will apply to the vast majority of deadlines that you might have. However, some notable deadlines are NOT “periods”, and so, some deadlines are NOT covered by the COVID-19 extension.

The following are deadlines which are some exceptions for which [Rule 134\(2\) EPC](#), and the EPO’s COVID-19 extension, does NOT apply:

1. **Paying a renewal fee for a European patent application.** Under [Article 86 EPC](#), annual renewal fees in respect of the third year, and each subsequent year (as calculated from the application date) must be paid while a European patent application is pending. Under [Rule 51\(1\) EPC](#), the renewal fees are due, in advance, at the end of the month in which the anniversary of the application date falls. And so, the Year 3 renewal fee is due at the end of the month in which the 2nd anniversary of the application date falls. Famously, this is a “due date” and not a “period”, and so is not subject to [Rule 134 EPC](#) (instead, EPO Board of Appeal decision [J 4/91](#) provides legal basis for “extensions”; for example, if the “due date” falls on a “closed day”, e.g., a weekend, then action may be taken on the next “open day”). As a result, the COVID-19 Extension does NOT apply to “normal” renewal fees (i.e., the vast majority of them). Two exceptions, where the COVID-19 Extension DOES apply, are (a) “back” renewal fees and potentially the first “forward” renewal fee due in respect of a divisional application ([Rule 51\(3\) EPC](#)), and (b) the Year 3 renewal for a European regional phase application, if it was due before entry into the European regional phase ([Rule 159\(1\)\(g\) EPC](#)). Finally, and to make things even more complicated, if a renewal fee is not paid by the due date, it can be paid “late”, with 50% surcharge, within a six-month “additional period”, as provided in [Rule 51\(2\) EPC](#). This six-month “additional period” is a “period”, and so both Rule 134 EPC and the COVID-19 Extension DO apply. Ultimately, we strongly recommend careful consideration before relying on the COVID-19 Extension in respect of *any* renewal fee for a European patent application.
2. **Filing a divisional application.** A divisional application can only be filed while the parent application is still pending ([Rule 36 EPC](#)). Note that this is considered to be “a condition to be met” and so is not a deadline, let alone a period. For example, an application is no longer pending on the day it is granted, and so if a divisional is wanted, it must be filed no later than *the day before* the publication of mention of grant of the parent. At this moment, it appears that the EPO is still publishing the mention of grant on its usual timetable. And so, if a divisional is wanted and the parent is scheduled to be granted, the divisional must be timely filed, without relying on the COVID-19 extension.
3. **Filing a patent application not later than the date of a public disclosure.** [Rule 134\(2\) EPC](#) does not provide a “grace period”, i.e., an additional period of time for filing a patent application after the invention (or relevant disclosure) has been made available to the public. And so, if there is a planned public disclosure, and a corresponding patent application is wanted, it must be filed not later than the date of the public disclosure, without relying on the COVID-19 extension.
4. **Filing written submissions ahead of scheduled oral proceedings.** When oral proceedings are scheduled, a final date for filing written submissions is set under [Rule 116\(1\) EPC](#). It is by no means clear that this “final date” is a “period” for the purposes of [Rule 134\(2\) EPC](#). Our recommendation is to assume that these “final dates” are not “periods”, and so are not affected by the COVID-19 extension.
5. **Oral proceedings.** At this moment, oral proceedings before examining and opposition divisions are cancelled until 17 April 2020. Oral proceedings before the EPO Boards of Appeal will not be held up to 17 April 2020. Our recommendation is that *each* case where oral proceedings are scheduled to take place in the next few months be reviewed to determine the best course of action.

6. **“Double deadlines” may be affected differently.** For example, a decision which is open to appeal under [Article 106 EPC](#) (e.g., a decision refusing a patent application in examination proceedings, a decision revoking a patent application in opposition proceedings) normally sets two deadlines (under [Article 108 EPC](#)): a first deadline (two months from notification of the decision) for filing a *Notice of Appeal*, and a second deadline (four months from notification of the decision) for filing the *Grounds of Appeal*. The COVID-19 extension might apply to the first one (because it falls in the relevant time window) but not the second one (because it does not fall into the relevant time window).
7. **Paris convention applications for jurisdictions other than the EPO.** Article 4 of the [Paris Convention](#) provides a 12-month “priority period”. These “priority” provisions are also included in the European Patent Convention, e.g., in [Article 87 EPC](#) (“a period of twelve months”). And so, the priority period will be extended by the COVID-19 extension *for European patent applications*. However, and most importantly, the priority period might *not* be extended by the COVID-19 extension for patent applications in *other jurisdictions*. For example, if an international (PCT) application is wanted, and it is to be filed at the EPO as Receiving Office, then it is *possible* that the COVID-19 extension will not apply to the priority period in respect of *all* PCT states (see, e.g., [Article 8\(2\)\(b\) PCT](#), where national law will apply). This is, admittedly, quite esoteric. Nonetheless, we recommend that, where an international (PCT) application is to be filed, the normal 12-month priority deadline be respected if possible, and great care be taken before relying on the COVID-19 extension.

2. EUIPO

The EUIPO has taken a similar measure. A decision of the Executive Director has been published extending “all time limits expiring between 9 March and 30 April, that affect all parties before the Office to 1 May 2020”. In practice, this means that time limits are extended until Monday 4 May, given that Friday 1 May is a public holiday in Spain.

Please note that extension at EUIPO does NOT apply to claiming priority under the Paris Convention for filing EU trade marks and/or Design applications.

3. UK Intellectual Property Office (UKIPO)

The UKIPO has declared 24 March, and subsequent days until further notice, to be interrupted days.

Any deadlines for patents, supplementary protection certificates, trade marks and designs, designs, and applications for them, which fall on an interrupted day will be extended until the UKIPO states that it will be ending the period of interrupted days.

This decision applies to all statutory time periods set out in UK legislation, and to all non-statutory periods set by the UKIPO. This decision does not apply to time periods set out under the various international IP treaties, for example, the Patent Cooperation Treaty, European Patent Convention, or the Madrid system, where the UKIPO may be acting as a receiving office.

The UKIPO has said it will provide a minimum of two-weeks' notice before ending the interrupted days period. The situation will be reviewed on 17 April 2020, at which point a decision will be made to either continue with the period of interruption or end the period after a further two weeks. In practice this means that UKIPO deadlines are extended for a minimum of five weeks.



4. Intellectual Property Office of Ireland (IPOI)



The IPOI has been closed to the public since Friday, 13 March 2020 and will remain closed until at least Sunday, 19th April 2020. So, if you have a deadline with the IPOI that falls between 13 March and 19th April 2020, that deadline is now Monday, 20th April 2020.

5. Official Fee increases by EPO from April 1st, 2020

The European Patent Office (EPO) usually increases its official fees every two years. The last increase took effect 01 April 2018 and by way of the Decision of the Administrative Council of 12 December 2019 (CA/D 12/19) (published in the January 2020 issue of [The Official Journal of the EPO](#)), **some of the EPO's official fees will increase from 1 April 2020.** The average increase is about 4%. One notable exception is the appeal fee, which will increase by 20% (to EUR 2705).

In almost all cases, EPO official fees are paid at the rate that applies at that time, and so, any fees paid to the EPO AFTER April 1st, 2020, will have to be paid at the new rate of official fees in place from April 1st onwards.

Renewal Fees

All of the annual renewal fees are increasing by about 4% on average (Years 3 to 20; EUR 490 to EUR 1640). Note that, as set out in [Rule 51\(1\) EPC](#), while the Year 3 renewal fee (due at the end of the month in which the second anniversary of the filing date falls) may be paid 6 months in advance, all subsequent renewal fees may only be paid 3 months in advance. In our experience, this rule is very strictly enforced by the EPO, and payment of the Renewal fee, too early, will almost certainly be rejected.

Filing Fees

All of the official fees normally paid when filing a European patent application (e.g., basic fee, page fee, claims fee, and search fee; as well as designation fee and examination fee for applications for Regional phase entry at the EPO) will increase by an average of about 4%.



We wish you all good health and we grow stronger together and we look forward to recovery together. **Please contact our colleagues Marie and Yan Guo on China@hmc-ip.com if you have any further questions on International patent strategy in particular, relating to the EPO and PCT-EPO applications.**