

# Kluwer Patent Blog

## Communications under Rules 161 and 162 EPC

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EPO communications under Rule 161(1) and Rule 162 EPC are among those legal changes which entered into force on April 1, 2010 and are intended for realigning the European patent grant procedure. However, these communications and their legal framework seem to require considerable realignment, for several reasons.

In an actual case, the EPO issues a communication under Rule 161(1) and Rule 162 EPC stamped “for the Examining Division” and indicating telephone number +31(0)70 340 4500, i.e. the EPO user support, for enquiries, the communication inviting the applicant to correct the deficiencies noted in the written opinion of the International Searching Authority. The applicant’s patent attorney thoroughly and with all due care studies the written opinion and finds no deficiency, in particular finds no objection as to lack of unity, and an indication of the allowability of the claims. The patent attorney calls the telephone number (a long distance call) and asks why an invitation was issued if no deficiencies are discernable. Less than two hours later, an EPO examiner calls back and after a discussion of the situation he indicates that a communication will be issued stating that no deficiencies exist and that no reaction is required. The patent attorney asks when the latter communication may be expected to arrive since the term of one month triggered by the first communication is running and is advised, that the communication will be issued in about a week, well before the term expires. The expected communication arrives, signed “for the Examining Division” and indicating a formalities officer.

This seems to indicate that the communication under Rules 161(1) and 162 EPC was issued as a standard letter by a formalities officer acting for the Examining Division, without any previous examination – performed by an examiner – if the written opinion of the ISA indicates any deficiency or not. Applicants might ask why they paid an examination fee if the Examining Division does not perform any real examination at this stage of the proceedings. Applicants might also ask if it is fair to them if the EPO, by issuing standard letters without an examination of the factual basis of each particular case, imposes onto them efforts and corresponding costs for noting and monitoring terms, consultations with the EPO, legal analysis, and related matters.

The case happened in May 2010 and gets even more obscure by the EPO President’s decision of May 11, 2010 appearing on the EPO website on May 25 and entering into force on June 1. The decision concerns the entrustment to non-examining staff of certain duties, i.e. invitations under Rules 161(1) and 162 EPC. This would mean that any invitations issued by non-examining staff prior to June 1 might be considered null and void (and would have to be issued again in order to have legal effect).

However, this is not where the obscurities end, since the President's decision seems to be in conflict with the pertinent Rule of the EPC (Rule 161 according to CA/D 20/09, and not CA/D 3/09, of the Administrative Council). According to Rule 161(1), 1st sentence EPC, there is a "communication" which triggers a term of one month, and according to Rule 161(1), 3rd sentence EPC, there is an "invitation" which may cause that the European patent application is deemed to be withdrawn if the applicant fails to react. In the three official languages DE, EN, FR of the EPC the following terms are used, in the 1st sentence of Rule 161(1): DE Mitteilung; EN communication; FR notification; and in the 3rd sentence of that provision: DE Aufforderung; EN invitation; FR invitation.

Now, as a result of the President's decision, the non-examining staff are entrusted with the following duties: DE Mitteilungen; EN invitations; FR notifications. Based on the DE and FR versions and contrary to the EN version this would mean that non-examining staff would only be entrusted with issuing a communication under Rule 161(1), 1st sentence EPC, but not an invitation under Rule 161(1), 3rd sentence. In other words, such invitations would be null and void, and no terms concerning such invitations would have to be noted and monitored. It seems highly questionable if this result was intended by the lawmakers.

A further obscurity concerns Articles 36(1) and 94(3) and Rules 71, 161, 162 EPC. Although according to point I(a), 2nd paragraph of the Notice from the EPO dated Aug. 20, 2009 (OJ EPO 10/2009, 481) the "Examining Division's first communication" (under Rule 36(1) EPC) is a communication under Article 94(3) and Rule 71(1), (2) EPC or, where appropriate, Rule 71(3) EPC, the EPO Notice provides no legal basis for this opinion. In particular, it remains an open question why the communication under Rule 161(1) and Rule 162 EPC should not be regarded as a 1st communication under Rule 36(1) EPC, although it is issued by the Examining Division.

The obscurities outlined above lead to a vast area of legal uncertainties for applicants and legal practitioners in respect of determining terms to be observed under the EPC. It is to be expected that these legal uncertainties will remain for a considerable amount of time, i.e. until a clarification due to a decision of the Board of Appeal or, as the case may be, of the Enlarged Board of Appeal. This situation is unsatisfactory, to say the least, and should be remedied by appropriate measures as soon as possible.

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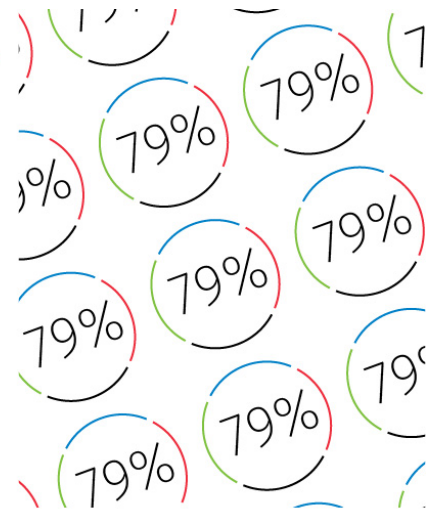
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