

NEW EPO FEES STRUCTURE AS OF 1 APRIL 2009

As foreshadowed in our website notice of 4 January 2008, the EPO has introduced a new fee structure due to come into force on 1 April 2009. A Notice from the EPO dated 26 January 2009 sets out the implementation of the new fee structure.

The Notice from the EPO is published at:

<http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090126.html>

As of 1st April 2009, applicants that file applications with a large number of pages and/or a large number of claims will be heavily penalised by the EPO. The new fee structure applies to all European patent applications, including divisional applications, filed on or after 1 April 2009 and to all international applications entering the European regional phase on or after that date. It may be possible to file applications that will be affected by the new fees structure before 1 April 2009 in order to avoid some of the new fees, as explained below.

European patent applications filed and international applications entering the European regional phase before 1 April 2009 will remain subject to the current fee structure.

Changes introduced by the new fee structure

Two-tier claims fees

Since 1 April 2008, an excess claims fee of EUR 200 has been payable for the 16th and each subsequent claim in an application. For European patent applications with a filing date or date of entry into the European regional phase of 1 April 2009 or later, a two-tier excess claims fee structure will apply:

For each claim from the 16th to the 50th: EUR 200

For the 51st and each subsequent claim: EUR 500

We do not anticipate that the new claims fees for claim 51 and above will affect many applicants, since most are already reducing the number of claims when filing a European application or entering the European regional phase in view of the current EUR 200 fee for claims in excess of 15. However, if you do wish to file a claim set having **more than 50 claims**, we would recommend filing the application **before 1 April 2009**.

Additional fee for excess pages

The EPO has brought forward the fee that is currently payable at the time of grant for the 36th and each subsequent page of a European application.

As of 1 April 2009, this fee will be payable at the time of paying the filing fee for a European patent application or upon entry into the European regional phase of an international application. The fee is set at EUR 12 for the 36th and each subsequent page of the application.

For European patent applications, the amount of the additional fee payable is calculated according to the number of pages over 35, on the basis of the description, claims, any drawings plus one page for the abstract. Pages forming part of a sequence listing that complies with WIPO Standard ST. 25 and that is presented as a separate part of the description are excluded from the calculation.

For international applications entering the European regional phase, the following rules for calculation will apply:

Where no amendments are made to the description or claims at the time of entry into the European regional phase, the calculation will be based on the number of pages of the international application as published, plus any amendments made under Article 19 PCT and one page for the abstract.

Where the international application is to enter the European regional phase with amendments made under Article 34 PCT or with amendments filed on entry, the applicant can specify that the new pages are intended to **replace** the corresponding original pages and/or corresponding pages filed under Article 19 PCT, such that the old pages are excluded from the calculation.

For any application that is **over 35 pages long**, we would recommend considering filing **before 1 April 2009** to avoid paying the excess page fees on filing. However, it is worth noting that if such an application proceeds to grant, the excess page fees will be due on grant.

For any application that has **35 pages or fewer**, the filing fee will be the same whether the application is filed **on, before or after 1 April 2009**.

If there are any parts of the description or drawings that do not relate to the claimed subject matter (for example if a lack of unity has been found), it may be worth considering deleting such pages from the application to reduce any page fees. Of course, the saving on fees needs to be balanced with the implications of deleting subject matter from the application – this should be discussed with your Kilburn & Strode advisor.

Flat fee for grant

As a consequence of the additional fee for excess pages being payable at the time of filing, excess page fees cease to be payable at the time of grant. The grant fee for European patent applications filed or entering the European regional phase on or after 1 April 2009 will therefore be a flat fee of EUR 790.

Any application that is filed **on or after 1 April 2009** and which proceeds to grant will be subject to the new flat grant fee; no page fees will need to be paid at grant.

Flat designation fee

For European patent applications filed or entering the European regional phase on or after 1 April 2009, a single flat designation fee of EUR 500 will secure the designation of **all** available EPC contracting states, unless individual designations are expressly withdrawn.

However, for European patent applications, including European divisional applications filed **before 1 April 2009** and for international applications entering the European regional phase prior to that date, the current system of paying individual designation fees up to a maximum of seven fees continues to apply, where payment of seven designation fees (totalling EUR 595) secures the designation of all available EPC contracting states.

For Applicants wishing to designate **six or more contracting states**, a cost saving will be made by filing **on or after 1 April 2009**. For applications where five or fewer states are required, we would recommend filing such applications **before 1 April 2009** to benefit from the one fee per state rule, which will still be applicable at that time.

Three month period for advance payment of renewal fees

Under the current fee structure, renewal fees for European patent applications can be validly paid up to one year before their due date. However, as of 1 April 2009, this period is being reduced to three months before the due date. This change applies to all European patent applications,

irrespective of the date of filing or of the date of entering the European regional phase.

Consequently, we will no longer be able to pay renewal fees more than 3 months before the due date. If you manage your own renewals, please note this new shortened period and update your docket accordingly.

What to do now

As the **new fee structure will apply** to any applications that are filed **on or after 1 April 2009**, we recommend that applicants that could be adversely affected by the new fees consider taking action before this date. For example, an international application having a deadline for entering the European regional phase of 1 April 2009 or later may be filed at the European Patent Office **prior to 1 April 2009** in order to avoid these additional fees. Likewise, if an applicant is considering filing a divisional application, we would suggest filing prior to 1 April 2009 if any of the above fees would adversely affect such an application.

Please note that due to the increase in fees, we anticipate that we will be filing a high volume of applications prior to 1 April 2009. Therefore, it is essential that we receive instructions for early filing as soon as possible.

If you are unsure about any of the fee changes and how they may affect you, please contact your usual Kilburn & Strode advisor.