

Client Advisory | January 2009

European Patent Office fee changes enter into force on 1 April 2009

A number of changes in the fees that fall due on patent applications filed in Europe are entering in to force on 1 April 2009¹. Details of these changes and how they might impact upon filing practice in Europe are outlined below.



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Which kinds of patent applications will be affected?

European patent applications (including divisional applications) and international applications entering Europe that are filed on or after 1 April 2009.

Which fees are going to change?

Three fees will be impacted by the changes:

1. Excess claims fees. These are the fees which become due when an application has more than 15 claims. The increase will impact those applications containing more than 50 claims.
2. Designation fees. These become due when one or more European contracting states are designated.
3. A printing fee. This will now be payable on filing for applications containing more than 35 pages (the figures are included in this page count).

Is there any way that we can avoid these increased fees?

Yes.

If the patent application is filed before 1 April 2009 then the increased fees will not have to be paid. It may therefore be appropriate to bring forward the filing of applications that fall due on or after 1 April 2009. Due consideration should also be given to filing divisional applications before 1 April 2009 since cost savings may also be made.

Are the fee increases really that significant?

This really depends on your current filing practice.

The most significant fee increase is in relation to the excess claims fees that will be payable on those applications containing more than 50 claims. If, for example, the patent application contains 60 claims then the excess claims fees will increase from about €9000 to about €12000. An application containing 80 claims will see an increase from about €13,000 to about €22,000 and an application containing 100 claims will see an increase from about €17,000 to about €32,000.

Our patent applications typically contain large numbers of claims. Will reducing the number of claims not limit the scope of protection that we can obtain in Europe?

Not necessarily.

There are a number of strategies that can be used in Europe in order to reduce the number of claims without necessarily limiting the scope of protection. For example, multiple claim dependencies or alternatives (eg. and/or) in a single claim may be used. Due consideration may also be given to focussing the claims on those commercially important and/or advantageous embodiments. Moreover, the availability of centralised post-grant limitation under EPC2000 makes the use of nested claims comprising limitations of a range less important.

We have heard that excess claims fees can also become due at grant. Do the fee changes also apply at grant?

Yes.

If an application is in order for grant and has more claims in it than originally filed then

¹ For each claim in addition to the 50th an excess claims fee of €500 will be payable. A single designation fee of €500 for all Contracting States will be payable. A fee of €12 for the 36th and each subsequent page will be payable on filing. Full details of the fee changes can be found at: <http://www.epo.org/patents/law/legal-texts/decisions/archive/14122007a.html>

excess claims fees will have to be paid for those extra claims. For the increased fees to apply the application that is in order for grant will need to contain more than 50 claims. The only way to avoid the increase is to pay the excess claims fees before 1 April 2009.

When filing patent applications in Europe, we prefer to designate less than seven European Contracting States. Can we continue to do this after 1 April 2009?

No.

A single designation fee of €500 for all European Contracting States will be payable. It will no longer be possible to pay for fewer states.

If your preferred filing strategy is to file and pay for less than seven Contracting

States then you will only be able to do this before 1 April 2009. It may therefore be desirable to bring forward the filing of those applications that you intend to file in less than seven states.

Does this mean that it is will cost us more to file in all the States, even though we are only interested in fewer than seven European Contracting States?

This depends.

There is actually a saving up to a point. To designate six Contracting States currently costs €510. Therefore, if you routinely designate six Contracting States then there is actually a small saving of €10 to be made. If you routinely designate five or less Contracting States then you will see an increase.

If the patent application is filed before 1 April 2009 then the increased fees will not have to be paid. It may therefore be appropriate to bring forward the filing of applications that fall due on or after 1 April 2009.

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