

Article 121**Further processing of the European patent application**

Notification of loss of rights without decision – **Rule 112 (1)**

Further processing – **Rule 135**

Article 87 (1) – 12-month priority period

Article 108 – 2-month period for filing notice of appeal and 4-month period for filing grounds of appeal

Article 112a (4) – 2-month period for filing petition for review

(1) If an applicant fails to observe a time limit vis à vis the European Patent Office, he may request further processing of the European patent application.

(2) The European Patent Office shall grant the request, provided that the requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.

(3) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.

(4) Further processing shall be ruled out in respect of the time limits in Article 87, paragraph 1, Article 108 and Article 112a, paragraph 4, as well as the time limits for requesting further processing or re-establishment of rights. The Implementing Regulations may Rule out further processing for other time limits.

Related Rule**Rule 135****Further processing****Previously Articles 121 (2) and (3)**

Article 121 – Further processing

Rule 6 (1) – 2-month period for filing translation of new application

Rule 16 (1)(a) – 3-month period for filing replacement application, taking over prosecution of existing application or requesting that existing application be refused following court decision on entitlement

Rule 31 (2) – Time limit for submitting biological material

Rule 40 (3) – 2-month time limit for filing certified copy and translation in support of application based on reference

Rule 51 (2) – (5) – Time limits for paying renewal fees

Rules 55, 56, 58 – 2-month time limit for remedying deficiencies in application

Rule 59 – Time limit for remedying deficiencies in priority claim

Rule 64 – Time limit for paying extra search fees following partial search

Rule 112 (2) – 2-month period for requesting decision following notification of loss of rights

(1) Further processing under Article 121, paragraph 1, shall be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act shall be completed within the period for making the request.

(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1 (a), Rule 31, paragraph 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 64 and Rule 112, paragraph 2.

(3) The department competent to decide on the omitted act shall decide on the request for further processing.

Other Relevant Rules

Rule 6	Filing of translations and reduction of fees	See Article 14, page 8
Rule 16	Procedure under Article 61, paragraph 1	See Article 61, page 38
Rule 31	Deposit of biological material	See Article 83, page 69
Rule 40	Date of filing	See Article 80, page 63
Rule 51	Payment of renewal fees	See Article 86, page 77
Rule 55	Examination on filing	See Article 90, page 85
Rule 56	Missing parts of the description or missing drawings	See Article 90, page 85
Rule 58	Correction of deficiencies in the application documents	See Article 90, page 87

Other Relevant Rules (continued)

Rule 59	Deficiencies in claiming priority	See Article 90, page 87
Rule 64	European search report where the invention lacks unity	See Article 92, page 91
Rule 112	Noting of loss of rights	See Article 113, page 131

Comment:

The amendments to Article 121 EPC considerably broaden the scope of further processing. It is now the standard legal remedy whenever a deadline is missed during prosecution of a European patent application.

In contrast to the position under old Article 121 EPC, further processing may now be used to extend the time limits for payment of filing, search and designation fees, as well as the national basic fee and the examination fee. It may also be used to extend the time limit for filing a request for examination. Further processing is not, however, available in post-grant proceedings such as limitation, opposition or revocation proceedings, since Article 121 (1) EPC expressly limits its use to time limits missed by an “applicant”.

Rule 135 (1) EPC provides that in order to obtain further processing, a fee must be paid and the omitted act must be completed within 2 months of notification of loss of rights or failure to observe a time limit. The fee is set by Article 2 (12) of the Rules Relating to Fees and is currently either €210 in the case of an omitted act or 50% of a relevant omitted fee. The sole exception is where further processing is sought in respect of the 4-month deadline for filing claims translations or for the payment of grant and printing fees, in which case the fee for further processing is fixed at €210, regardless of the level of the printing and grant fees.

Article 121 (4) and Rule 135 (2) EPC exclude further processing in respect of the following time limits:

- the 12-month priority period under Article 87 (1) EPC;
- the time limits for filing a notice and grounds of appeal under Article 108 EPC;
- the time limit in Article 112a (4) EPC for filing a petition for review;
- the time limit for further processing itself;
- the time limit for re-establishment of rights under Article 122 EPC;
- the 2-month period under Rule 6 (1) EPC for filing a translation of a new application not filed in English, French or German;
- the 3-month period under Rule 16 (1) EPC for filing a replacement application or taking over prosecution of an existing patent application following a court decision on entitlement;
- the time limit under Rule 31 (2) EPC for depositing biological material;
- the 2-month time limit under Rule 40 (3) EPC for filing a certified copy and translation in support of an application based on a reference to an earlier application;
- the time limits under Rules 51 (2) – (5) EPC for paying renewal fees;

- the 2-month time limits under Rules 55, 56 and 58 EPC for correcting formal deficiencies in documents forming a patent application and for dealing with missing drawings or sections of description;
- the time limits under Rule 59 EPC for correcting deficiencies in priority claims;
- the time limit for paying extra search fees under Rule 64 EPC following a partial search; and
- the 2-month period under Rule 112 (2) EPC for requesting a decision following notification of loss of rights.

Case law relating to further processing may be found in the *Case Law of the Boards of Appeal of the European Patent Office*, section VI – D.2.2, pages 352 – 353. Further processing is also discussed in the *Guidelines for Examination in the European Patent Office*, Part E, Chapter VIII, section 2.1.

Article 122

Re-establishment of rights

Request must be made within 2 months of removal of cause of non-compliance and within 1 year of missed deadline. Reduced to 2 months in case of missed priority year or missed deadline for petition for review – **Rule 136 (1)**

Request must state grounds, and omitted act must be completed within period for filing request – **Rule 136 (2)**

Must pay renewal fees falling due since lapse – **Rule 51 (4)**

No re-establishment of rights if further processing available – **Rule 136 (3)**

(1) An applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis à vis the European Patent Office shall have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the refusal of the European patent application or of a request, or the deeming of the application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) The European Patent Office shall grant the request, provided that the conditions of paragraph 1 and any other requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.

(3) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.

(4) Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights. The Implementing Regulations may rule out re-establishment for other time limits.

(5) Any person who, in a designated Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the period between the loss of rights referred to in paragraph 1 and publication in the European Patent Bulletin of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(6) Nothing in this Articles shall limit the right of a Contracting State to grant re-establishment of rights in respect of time limits provided for in this Convention and to be observed vis à vis the authorities of such State.