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SUBJECT: Draft Implementing Regulations under the EPC 2000

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains the draft Implementing Regulations under the EPC 2000 as well as the accompanying Explanatory remarks, **in English only**. The French and German versions will be posted on the Micado website as soon as they become available.

Delegations are encouraged to forward **advance written comments** to the International Legal Affairs Directorate, in order to simplify and speed up the Committee's proceedings.

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June 2002

Taskforce EPC Revision

**NEW IMPLEMENTING REGULATIONS
UNDER THE EPC 2000**

Draft Version

Present wording

PART I

IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

Chapter I

Languages of the European Patent Office

Rule 1

Derogations from the provisions
concerning the language of the
proceedings in written proceedings

- (1) In written proceedings before the European Patent Office any party may use any official language of the European Patent Office. The translation referred to in Article 14, paragraph 4, may be filed in any official language of the European Patent Office.
- (2) Amendments to a European patent application or European patent must be filed in the language of the proceedings.
- (3) Documents to be used for purposes of evidence before the European Patent Office, and particularly publications, may be filed in any language. The European Patent Office may, however, require that a translation be filed, within a given time limit of not less than one month, in one of its official languages.

Revised wording

PART I

IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

Chapter I

Languages of the European Patent Office

Rule 1

[...] Language [...] in
written proceedings

- (1) *Unchanged*
- (2) Amendments to a European patent application or European patent **shall** be filed in the language of the proceedings.
- (3) **Documentary [...]** evidence and, **in particular**, publications may be filed in any language. The European Patent Office may, however, require that a translation in one of its official languages be filed, within a **period to be specified [...]**. **If a required translation is not filed in due time, the EPO may disregard the document in question.**

Rule 2

Derogations from the provisions concerning the language of the proceedings in oral proceedings

(1) Any party to oral proceedings before the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office, on condition either that such party gives notice to the European Patent Office at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. Any party may likewise use one of the official languages of the Contracting States, on condition that he makes provision for interpretation into the language of the proceedings. The European Patent Office may permit derogations from the provisions of this paragraph.

(2) In the course of oral proceedings, the employees of the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office.

(3) In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in one of the official languages of the European Patent Office or the Contracting States may use another language. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express

Rule 2

[...] Language [...] in oral proceedings

(1) Any party to oral proceedings before the European Patent Office may **use any official language of the European Patent Office other than the language of the proceedings**, if such party gives notice to the European Patent Office at least one month before the date of such oral proceedings or **provides** for **interpretation** into the language of the proceedings. Any party may use **an** official language of a Contracting State, **if he provides** for interpretation into the language of the proceedings. The European Patent Office may permit derogations from [...] **these** provisions.

(2) In oral proceedings, employees of the European Patent Office may **use an official language of the European Patent Office other than the language of the proceedings**.

(3) **Where evidence is taken**, any party, witness or expert to be heard who is unable to express himself adequately in **an** official language of the European Patent Office or **of a** Contracting State may use another language. **Where evidence is taken [...]** upon request of a party to the proceedings, parties, witnesses or experts [...] **expressing** themselves in **a** language other than **an** official language of the

themselves in languages other than the official languages of the European Patent Office may be heard only if the party who made the request makes provision for interpretation into the language of the proceedings; the European Patent Office may, however, authorise interpretation into one of its other official languages.

(4) If the parties and the European Patent Office agree, any language may be used in oral proceedings.

(5) The European Patent Office shall, if necessary, make provision at its own expense for interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

(6) Statements by employees of the European Patent Office, by parties to the proceedings and by witnesses and experts, made in one of the official languages of the European Patent Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent shall be entered in the minutes in the language of the proceedings.

Rule 3
(deleted)

European Patent Office **shall** be heard only if the **requesting** party [...] **provides** for interpretation into the language of the proceedings. The European Patent Office may, however, **permit** interpretation into one of its other official languages.

(4) *Unchanged*

(5) The European Patent Office shall, if necessary, **provide** at its own expense interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless **such** interpretation is the responsibility of one of the parties to the proceedings.

(6) Statements by employees of the European Patent Office, parties to the proceedings, witnesses or experts, made in **an** official language of the European Patent Office [...], shall be entered in the minutes in **that** language. Statements made in any other language shall be entered in the official language into which they are translated. Amendments to [...] **a** European patent application or European patent shall be entered in the minutes in the language of the proceedings.

Rule 3
(deleted)

Rule 4

Language of a European
divisional application

.....

Rule 5

Certification of translations

When a translation of any document must be filed, the European Patent Office may require the filing of a certificate that the translation corresponds to the original text within a period to be determined by it. Failure to file the certificate in due time shall lead to the document being deemed not to have been received unless the Convention provides otherwise.

Rule 6

Time limits and reduction of fees

(1) The translation referred to in Article 14, paragraph 2, must be filed within three months after the filing of the European patent application, but no later than thirteen months after the date of priority. Nevertheless, if the translation concerns a European divisional application or a new European patent application under Article 61, paragraph 1(b), the translation may be filed at any time within one month of the filing of such application.

(2) The translation referred to in Article 14, paragraph 4, must be filed within one month of the filing of the document. Where the document is a notice of opposition or an appeal, this period shall be extended

Rule 4

Language of a European
divisional application

Deleted - substance moved to Rule 25

Rule 5

Certification of translations

Where the translation of a document is required, the European Patent Office may require [...] **that** a certificate that the translation corresponds to the original text **be filed within a period to be specified. If the certificate is not filed in due time, such document shall be deemed not to have been filed, unless [...] otherwise provided.**

Rule 6

Filing of translations and reduction of
fees

(1) **A translation under** Article 14, paragraph 2, [...] **shall** be filed within [...] **one month of** filing the European patent application [...].

(2) **A translation under** Article 14, paragraph 4, [...] **shall** be filed within one month of filing the document. Where the document is a notice of opposition or appeal, **the translation may be filed**

where appropriate to the end of the opposition period or appeal period.

(3) A reduction in the filing fee, examination fee, opposition fee or appeal fee shall be allowed an applicant, proprietor or opponent, as the case may be, who avails himself of the options provided in Article 14, paragraphs 2 and 4. The reduction shall be fixed in the Rules relating to Fees at a percentage of the total of the fees.

Rule 7

Legal authenticity of the translation of the European patent application

Saving proof to the contrary, the European Patent Office may, for the purposes of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the European patent application as filed, assume that the translation referred to in Article 14, paragraph 2, is in conformity with the original text of the application.

within the period for filing such a notice if that period expires later.

(3) The examination fee, opposition fee or appeal fee shall be **reduced in accordance with the Rules relating to Fees where a person avails** himself of the option **under** Article 14, paragraph 4. [...] **The same shall apply to the filing fee where a person referred to in Article 14, paragraph 4, files a European patent application in the language admitted therein.**

Rule 7

Legal authenticity of the translation of the European patent application

Unless evidence is provided [...] to the contrary, the European Patent Office **shall assume**, for the purpose of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the [...] application as filed, that the translation **filed under** Article 14, paragraph 2, is in conformity with the original text of the application.

Chapter II
Organisation of the
European Patent Office

Rule 8
Patent classification

- (1) The European Patent Office shall use:
- (a) the classification referred to in Article 1 of the European Convention on the International Classification of Patents for Invention of 19 December 1954 until the entry into force of the Strasbourg Agreement concerning the International Patent Classification of 24 March 1971;
- (b) the classification referred to in Article 1 of the aforementioned Strasbourg Agreement, after the entry into force of that Agreement.
- (2) The classification referred to in paragraph 1 is hereinafter referred to as the international classification.

Rule 12 EPC
Administrative structure
of the European Patent Office

- (1) The Examining Divisions and the Opposition Divisions shall be grouped together administratively so as to form Directorates, the number of which shall be laid down by the President of the European Patent Office.

Chapter II
Organisation of the
European Patent Office

Section 1
General matters

Rule 8
Patent classification

The European Patent Office shall use [...] the classification referred to in Article 1 of the **Strasbourg Agreement concerning the International Patent Classification of 24 March 1971** [...], hereinafter referred to as the international classification.

Rule 8a
Administrative structure
of the European Patent Office

- (1) *Deleted*

(2) The Directorates, the Legal Division, the Boards of Appeal and the Enlarged Board of Appeal, and the administrative services of the European Patent Office shall be grouped together administratively so as to form Directorates-General. The Receiving Section and the Search Divisions shall be grouped together administratively so as to form a Directorate-General.

(3) Each Directorate-General shall be directed by a Vice-President. The appointment of a Vice-President to a Directorate-General shall be decided upon by the Administrative Council, after the President of the European Patent Office has been consulted.

Rule 9

Allocation of duties to the departments of the first instance

(1) The President of the European Patent Office shall determine the number of Search Divisions, Examining Divisions and Opposition Divisions. He shall allocate duties to these departments by reference to the international classification and shall decide where necessary on the classification of a European patent application or a European patent in accordance with that classification.

(2) In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Receiving Section, Search Divisions,

(1) The European Patent Office shall be divided administratively into Directorates-General, to which the departments specified in Article 15, and the services set up to deal with legal matters and the internal administration of the Office, shall be assigned.

(2) Each Directorate-General shall be directed by a Vice-President. The assignment of a Vice-President to a Directorate-General shall be decided upon by the Administrative Council, after the President of the European Patent Office has been consulted.

Rule 9

Allocation of duties to the departments of [...] first instance

(1) The technically qualified examiners acting as members of Search [...], Examining [...] or Opposition Divisions shall be assigned to Directorates. The President of the European Patent Office shall allocate duties to these Directorates by reference to the international classification.

(2) In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Receiving Section, **the** Search [...],

Examining Divisions, Opposition Divisions and the Legal Division.

(3) The President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Divisions or Opposition Divisions and involving no technical or legal difficulties.

(4) The President of the European Patent Office may grant exclusive responsibilities to one of the registries of the Opposition Divisions for fixing the amount of costs as provided for in Article 104, paragraph 2.

Rule 10

Presidium of the Boards of Appeal

(1) The autonomous authority within the organisational unit comprising the Boards of Appeal (the "Presidium of the Boards of Appeal") shall consist of the Vice-President in charge of the Boards of Appeal, who shall act as chairman, and twelve members of the Boards of Appeal, six being Chairmen and six being other members.

Examining [...] **and** Opposition Divisions, and the Legal Division.

(3) The President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of [...] duties falling to the Examining [...] or Opposition Divisions and involving no technical or legal difficulties.

(4) *Deleted*

Section 2

Organisation of the Boards of Appeal and the Enlarged Board of Appeal

Rule 10

Presidium of the Boards of Appeal

(1) - (5) *Unchanged*

(2) All members of the Presidium shall be elected by the Chairmen and members of the Boards of Appeal for one working year. If the full composition of the Presidium cannot be reached, the vacancies shall be filled by designating the most senior Chairmen and members.

(3) The Presidium shall adopt the Rules of Procedure of the Boards of Appeal and the Rules of Procedure for the election and designation of its members. The Presidium shall further advise the Vice-President in charge of the Boards of Appeal with regard to matters concerning the functioning of the Boards of Appeal in general.

(4) Before the beginning of each working year the Presidium, extended to include all Chairmen, shall allocate duties to the Boards of Appeal. In the same composition, it shall decide on conflicts regarding the allocation of duties between two or more Boards of Appeal. The extended Presidium shall designate the regular and alternate members of the various Boards of Appeal. Any member of a Board of Appeal may be designated as a member of more than one Board of Appeal. These measures may, where necessary, be amended during the course of the working year in question.

(5) The Presidium may only take a decision if at least five of its members are present; these must include the

Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of two Boards of Appeal. Where the tasks mentioned in paragraph 4 are concerned, nine members must be present, including the Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of three Boards of Appeal. Decisions shall be taken by a majority vote; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

(6) The Administrative Council may allocate duties under Article 134, paragraph 8(c), to the Boards of Appeal.

Rule 11

Business distribution scheme for the Enlarged Board of Appeal and adoption of its Rules of Procedure

(1) Before the beginning of each working year, the members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall designate the regular and alternate members of the Enlarged Board of Appeal.

(2) The members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall adopt the Rules of Procedure of the Enlarged Board of Appeal.

(6) The Administrative Council may allocate duties under Article **134a**, **paragraph 1(c)**, to the Boards of Appeal.

Rule 11

Business distribution scheme for the Enlarged Board of Appeal and adoption of its Rules of Procedure

(1) Before the beginning of each working year, the members of the Enlarged Board of Appeal [...] appointed under Article **11**, **paragraph 3**, shall designate the regular and alternate members of the Enlarged Board of Appeal.

(2) The members of the Enlarged Board of Appeal [...] appointed under Article **11**, **paragraph 3**, shall adopt the Rules of Procedure of the Enlarged Board of Appeal.

(3) Decisions on matters mentioned in paragraphs 1 and 2 may only be taken if at least five members are present, including the Chairman of the Enlarged Board of Appeal or his deputy; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

Rule 12

Administrative structure of the European
Patent Office

(3) *Unchanged*

Rule 12

*Deleted - Substance transferred to new
Rule 8a EPC*

Present wording

PART II IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Chapter I

Procedure where the applicant or
proprietor is not entitled

Rule 13

Suspension of proceedings

(1) If a third party provides proof to the European Patent Office that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent, the European Patent Office shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the European Patent Office; it shall be irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application.

(2) Where proof is provided to the European Patent Office that a decision which has become final has been given in the proceedings concerning entitlement to the grant of the European patent, the European Patent Office shall communicate to the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication unless a new European

Revised wording

PART II IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Chapter I

Procedure where the applicant
[...] is not entitled

Rule 13

Stay of proceedings

(1) If a third party provides **evidence** [...] that he has **instituted** proceedings against the applicant [...] seeking a judgment that he is entitled to the grant of the European patent, the [...] proceedings for grant **shall be stayed** unless the third party **communicates to the European Patent Office in writing his** consent [...] to the continuation of such proceedings. Such consent [...] shall be irrevocable. However, proceedings for grant **shall** not be stayed before the publication of the European patent application.

(2) Where **evidence** is provided [...] that a **final** decision [...] **determining the** entitlement to the grant of a European patent **has been taken**, the European Patent Office shall **inform** the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication, unless a new European patent application **under** Article 61, paragraph 1(b), has been filed

patent application pursuant to Article 61, paragraph 1(b), has been filed for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.

(3) When giving a decision on the suspension of proceedings or thereafter the European Patent Office may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings referred to in paragraph 1 opened against the applicant. The date is to be communicated to the third party, the applicant and any other party. If no proof has been provided by that date that a decision which has become final has been given, the European Patent Office may continue proceedings.

(4) If a third party provides proof to the European Patent Office during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the European Patent Office shall stay the opposition proceedings unless the third party consents to the continuation of such proceedings. Such comment must be communicated in writing to the European Patent Office; it shall be irrevocable.

for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed three months **after the decision has become** final, unless the third party requests the resumption. [...]

(3) **Upon staying the proceedings**, or thereafter, the European Patent Office may set a date on which it intends to continue the proceedings **for grant** regardless of the stage reached in the **national** proceedings [...] against the applicant **referred to in paragraph 1. It shall communicate this date [...]** to the third party, the applicant and any other party. If no **evidence** has been provided by that date that a **final** decision [...] has been **taken**, the European Patent Office may continue proceedings.

(4) *Deleted - Substance moved to new Rule 56a(1) EPC in Part V of the Implementing Regulations*

However, the suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. Paragraphs 2 and 3 shall apply mutatis mutandis.

(5) The time limits in force at the date of suspension other than time limits for payment of renewal fees shall be interrupted by such suspension. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings shall not be less than two months.

Rule 14

Limitation of the option to withdraw the European patent application

As from the time when a third party proves to the European Patent Office that he has initiated proceedings concerning entitlement and up to the date on which the European Patent Office resumes the proceedings for grant, neither the European patent application nor the designation of any Contracting State may be withdrawn.

[See Article 61(1) EPC 1973:

[...] that person may, within a period of three months after the decision has become final, provided that

(4) All periods [...] other than those for the payment of renewal fees, running at the date of the stay of proceedings, shall be interrupted by such stay. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed. **However, the time still to run after such resumption [...] shall not be less than two months.**

Rule 14

Limitation [...] on withdrawals

As from the **date on which** a third party **provides evidence [...]** that he has **instituted entitlement** proceedings [...], and up to the date on which [...] the proceedings for grant **are resumed**, neither the European patent application nor the designation of any Contracting State may be withdrawn.

Rule 14a

Procedure under Article 61, paragraph 1

(1) A person entitled to the grant of a European patent may only avail himself of the remedies under Article 61, paragraph 1, provided that:

(a) he does so no later than three months after the decision recognising his entitlement has become final, and

the European patent has not yet been granted,

in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention]

Rule 15

Filing of a new European patent application by the person entitled to apply

(1) Where the person adjudged by a final decision to be entitled to the grant of the European patent files a new European patent application pursuant to Article 61, paragraph 1(b), the original European patent application shall be deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised.

(2) The filing fee and search fee shall be payable in respect of the new European patent application within one month after the filing thereof.

The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new European patent application.

(b) the European patent has not yet been granted.

(2) Such remedies shall only apply in respect of Contracting States designated in the European patent application in which the decision has been taken or recognised or must be recognised on the basis of the Protocol on Recognition.

Rule 15

Filing of a new European patent application by the **entitled** person [...]

(1) Where the person adjudged by a final decision to be entitled to the grant of the European patent files a new European patent application **under** Article 61, paragraph 1(b), the original European patent application shall be deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised.

(2) The filing fee and search fee shall be **paid [...]** within one month **of** filing the new [...] application. **If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn.**

(3) The designation fees shall be **paid** within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new [...] application. **Where a designation**

(3) The time limits for forwarding European patent applications provided for in Article 77, paragraphs 3 and 5, shall, for the new European patent application, be four months as from the actual filing date of that application.

Rule 16

Partial transfer of right by virtue of a final decision

(1) If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Article 61 and Rule 15 shall apply mutatis mutandis to such part.

(2) Where appropriate, the original European patent application shall contain, for the designated Contracting States in which the decision was taken or recognised, claims, a description and drawings which are different from those for the other designated Contracting States.

(3) Where a third party has, in accordance with Article 99, paragraph 5, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may contain for these States claims, a description and drawings which are different from those for the other designated Contracting States.

fee is not paid in due time in respect of any designated state, the designation of that state shall be deemed to be withdrawn.

(3) *Deleted*

Rule 16

Partial transfer of right by virtue of a final decision

(1) If a final decision **determines** that a third party is entitled to the grant of a European patent in respect of only part of the **subject-matter contained** in the **original** European patent application, Article 61 and Rules **14a and 15** shall apply to such part.

(2) *Unchanged*

(3) *Deleted - Substance moved to new Rule 56a(2) EPC in Part V of the Implementing Regulations*

Chapter II

Mention of the inventor

Rule 17

Designation of the inventor

(1) The designation of the inventor shall be filed in the request for the grant of a European patent. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document; the designation must state the family name, given names and full address of the inventor and the statement referred to in Article 81 and shall bear the signature of the applicant or his representative.

(2) The European Patent Office shall not verify the accuracy of the designation of the inventor.

(3) If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall inform the designated inventor of the data in the document designating him and the further data mentioned in Article 128, paragraph 5.

(4) The applicant and the inventor may invoke neither the omission of the notification under paragraph 3 nor any errors contained therein.

Chapter II

Mention of the inventor

Rule 17

Designation of the inventor

(1) The request for grant of a European patent shall **contain** the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document. The designation **shall** state the family name, given names and full address of the inventor, **contain** the statement referred to in Article 81 and bear the signature of the applicant or his representative.

(2) *Unchanged*

(3) If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall inform the designated inventor of the data in the document designating him and the further data [...] **prescribed by the President of the European Patent Office.**

(4) The applicant and the inventor may invoke neither the omission of the **communication** under paragraph 3 nor any errors contained therein.

Rule 18

Publication of the mention of the inventor

(1) The person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification, unless the said person informs the European Patent Office in writing that he waives his right to be thus mentioned.

(2) In the event of a third party filing with the European Patent Office a final decision whereby the applicant for or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph 1 shall apply.

Rule 19

Rectification of the designation of an inventor

(1) An incorrect designation of an inventor may not be rectified save upon request, accompanied by the consent of the wrongly designated person and, in the event of such request not being filed by the applicant for or proprietor of the European patent, by the consent of that party. The provisions of Rule 17 shall apply *mutatis mutandis*.

(2) In the event of an incorrect mention of the inventor having been entered in the Register of European Patents or published in the European Patent Bulletin such entry or publication shall be corrected.

Rule 18

Publication of the mention of the inventor

(1) The [...] designated [...] inventor shall be mentioned [...] in the published European patent application and the European patent specification, unless **he [...] has waived** in writing his right to be thus mentioned.

(2) **Paragraph 1 shall apply where** a third party **files** with the European Patent Office a final decision **determining** that the applicant for or proprietor of a **European** patent is required to designate him as **an** inventor [...].

Rule 19

Rectification of the designation of an inventor

(1) An incorrect designation of an inventor **shall** be rectified upon request [...] **and only with** the consent of the wrongly designated person and, **where** such a request **is** filed by **a third party**, the **consent of** the applicant for or proprietor of the European patent [...]. [...] Rule 17 shall apply *mutatis mutandis*.

(2) **Where** an incorrect mention of the inventor **has** been **recorded** in the Register of European Patents or published in the European Patent Bulletin, **its rectification or cancellation shall also be recorded or published therein**.

(3) Paragraph 2 shall apply mutatis mutandis to the cancellation of an incorrect designation of the inventor.

Chapter III

Registering transfers,
licences and other rights

Rule 20

Registering a transfer

(1) A transfer of a European patent application shall be recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the European Patent Office that the transfer has taken place.

(2) The request shall not be deemed to have been filed until such time as an administrative fee has been paid. It may be rejected only in the event of failure to comply with the conditions laid down in paragraph 1.

(3) A transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that the documents referred to in paragraph 1 have been produced.

(3) *Deleted*

Chapter III

Registration of transfers,
licences and other rights

Rule 20

Registration of transfers

(1) **The** transfer of a European patent application shall be recorded in the Register of European Patents at the request of an interested party, **upon** production of documents **providing evidence of such** transfer [...].

(2) The request shall not be deemed to have been filed until [...] an administrative fee has been paid. It may be rejected only **if** paragraph 1 **has not been complied with**.

(3) A transfer shall have effect vis-à-vis the European Patent Office only **at the date** when and to the extent that the documents referred to in paragraph 1 have been produced.

Rule 21

Registering of licences and other rights

(1) Rule 20, paragraphs 1 and 2, shall apply *mutatis mutandis* to the registration of the grant or transfer of a licence, the establishment or transfer of a right *in rem* in respect of a European patent application and any legal means of execution of such an application.

(2) The registration referred to in paragraph 1 shall be cancelled upon request, which shall not be deemed to have been filed until an administrative fee has been paid. Such request shall be supported either by documents establishing that the right has lapsed, or by a declaration whereby the proprietor of the right consents to the cancellation of the registration; it may be rejected only if these conditions are not fulfilled.

Rule 22

Special indications for the registration of a licence

(1) A licence in respect of a European patent application shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require.

(2) A licence in respect of a European patent application shall be recorded in the Register of European Patents as a sub-licence where it is granted by a licensee whose licence is recorded in the said Register.

Rule 21

Registration of licences and other rights

(1) Rule 20, paragraphs 1 and 2, shall apply *mutatis mutandis* to the registration of the grant or transfer of a licence, the establishment or transfer of a right *in rem* in respect of a European patent application and any legal means of execution **affecting** such an application.

(2) **A registration under** paragraph 1 shall be cancelled upon request, supported by documents **providing evidence** that the right has lapsed, or by **the written consent of** the proprietor of the right to the cancellation of the registration. **Rule 20, paragraph 2, shall apply.**

Rule 22

Special entries for licence registrations

A licence in respect of a European patent application shall be recorded

(a) as an exclusive licence if the applicant and the licensee so **request**;

(b) as a sub-licence where it is granted by a licensee whose licence is recorded in the Register **of European Patents.**

Chapter IV

Certification of exhibition

Rule 23

Certificate of exhibition

The applicant must, within four months of the filing of the European patent application, file the certificate referred to in Article 55, paragraph 2, issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, and stating that the invention was in fact exhibited there. This certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not coincide with the opening date of the exhibition, the date of the first disclosure. This certificate must be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

Chapter V

Prior European applications

Rule 23a

Prior application as state of the art

A European patent application shall be considered as comprised in the state of the art under Article 54, paragraphs 3 and 4, only if the designation fees under Article 79, paragraph 2, have been validly paid.

Chapter IV

Certification of exhibition

Rule 23

Certificate of exhibition

Within four months of filing the European patent application, **the applicant shall** file the certificate referred to in Article 55, paragraph 2, **which shall**:

- (a) **be** issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition;
- (b) **attest** that the invention was in fact **displayed** there;
- (c) state the opening date of the exhibition and, where the invention **was disclosed later than on that date**, the date **on which the invention was first disclosed**; and
- (d) be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

Deleted

Deleted

Chapter VI

Biotechnological inventions

Rule 23b

General and definitions

(1) For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the Convention shall be applied and interpreted in accordance with the provisions of this chapter. Directive 98/44/EC of 6 July 1998*** on the legal protection of biotechnological inventions shall be used as a supplementary means of interpretation.

(2) "Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used.

(3) "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

(4) "Plant variety" means any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right are fully met, can be:

(a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,

Chapter V

Biotechnological inventions

Rule 23b

General and definitions

Unchanged

(b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and

(c) considered as a unit with regard to its suitability for being propagated unchanged.

(5) A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.

(6) "Microbiological process" means any process involving or performed upon or resulting in microbiological material.

Rule 23c

Patentable biotechnological inventions

Biotechnological inventions shall also be patentable if they concern:

(a) biological material which is isolated from its natural environment or produced by means of a technical process even if it previously occurred in nature;

(b) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;

(c) a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.

Rule 23c

Patentable biotechnological inventions

Unchanged

Rule 23d

Exceptions to patentability

Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:

- (a) processes for cloning human beings;
- (b) processes for modifying the germ line genetic identity of human beings;
- (c) uses of human embryos for industrial or commercial purposes;
- (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

Rule 23e

The human body and its elements

- (1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.
- (2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

Rule 23d

Exceptions to patentability

Unchanged

Rule 23e

The human body and its elements

Unchanged

(3) The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

Rule 27a

Requirements of European patent applications relating to nucleotide and amino acid sequences

(1) If nucleotide or amino acid sequences are disclosed in the European patent application the description shall contain a sequence listing conforming to the rules laid down by the President of the European Patent Office for the standardised representation of nucleotide and amino acid sequences.

(2) The President of the European Patent Office may require that, in addition to the written application documents, a sequence listing in accordance with paragraph 1 be submitted on a data carrier prescribed by him accompanied by a statement that the information recorded on the data carrier is identical to the written sequence listing.

(3) If a sequence listing is filed or corrected after the date of filing, the applicant shall submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed.

(4) A sequence listing filed after the date of filing shall not form part of the description.

Rule 23f

Requirements of European patent applications relating to nucleotide and amino acid sequences

(1) *Unchanged*

Rule 28

Deposit of biological material

(1) If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Article 83 if:

(a) a sample of the biological material has been deposited with a recognised depositary institution not later than the date of filing of the application;

(b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material;

(c) the depositary institution and the accession number of the deposited biological material are stated in the application, and

(d) where the biological material has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is submitted satisfying the European Patent Office that the latter has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with this Rule.

Rule 23g

Deposit of biological material

Unchanged

(a) - (c) *Unchanged*

d) where the biological material has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is submitted satisfying the European Patent Office that the latter has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with [...] Rule **23i**.

(2) The information referred to in paragraph 1(c) and, where applicable, (d) may be submitted

(a) within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date, this time limit being deemed to have been met if the information is communicated before completion of the technical preparations for publication of the European patent application;

(b) up to the date of submission of a request for early publication of the application;

(c) within one month after the European Patent Office has communicated to the applicant that a right to inspect the files pursuant to Article 128, paragraph 2, exists.

The ruling period shall be the one which is the first to expire. The communication of this information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the deposited biological material being made available to the public in accordance with this Rule.

Rule 28

Deposit of biological material

(4) Until completion of the technical preparations for publication of the application, the applicant may inform the European Patent Office that

(2) *Unchanged*

(a) *Unchanged*

(b) up to the date of submission of a request **under Article 93, paragraph 1(b)**;

(c) within one month after the European Patent Office has communicated to the applicant that **the** right to inspect the files **under** Article 128, paragraph 2, exists.

The ruling period shall be the one which is the first to expire. The communication of this information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the deposited biological material being made available to the public in accordance with [...] Rule **23i**.

Rule 23h

Expert solution

(1) Until completion of the technical preparations for publication of the **European patent** application, the applicant may inform the European Patent Office that,

(a) until the publication of the mention of the grant of the European patent or, where applicable,

(b) for twenty years from the date of filing if the application has been refused or withdrawn or deemed to be withdrawn, the availability referred to in paragraph 3 shall be effected only by the issue of a sample to an expert nominated by the requester.

(5) The following may be nominated as an expert:

(a) any natural person provided that the requester furnishes evidence, when filing the request, that the nomination has the approval of the applicant;

(b) any natural person recognised as an expert by the President of the European Patent Office.

The nomination shall be accompanied by a declaration from the expert vis-à-vis the applicant in which he enters into the undertaking given pursuant to paragraph 3 until either the date on which the patent expires in all the designated States or, where the application has been refused, withdrawn or deemed to be withdrawn, until the date referred to in paragraph 4(b), the requester being regarded as a third party.

(a) until the publication of the mention of the grant of the European patent or, where applicable,

(b) for twenty years from the date of filing, if the application has been refused or withdrawn or deemed to be withdrawn, the availability referred to in Rule **23i** shall be effected only by the issue of a sample to an expert nominated by the requester.

(2) The following may be nominated as an expert:

(a) any natural person provided that the requester furnishes evidence, when filing the request, that the nomination has the approval of the applicant;

(b) any natural person recognised as an expert by the President of the European Patent Office.

The nomination shall be accompanied by a declaration from the expert vis-à-vis the applicant in which he enters into the undertaking given **under Rule 23i** until either the date on which the patent expires in all the designated States or, where the application has been refused, withdrawn or deemed to be withdrawn, until the date referred to in paragraph **1(b)**.

Rule 28

Deposit of biological material

(3) The deposited biological material shall be available upon request to any person from the date of publication of the European patent application and to any person having the right to inspect the files pursuant to Article 128, paragraph 2, prior to that date. Subject to paragraph 4, such availability shall be effected by the issue of a sample of the biological material to the person making the request (hereinafter referred to as "the requester").

Said issue shall be made only if the requester has undertaken vis-à-vis the applicant for or proprietor of the patent not to make the biological material or any biological material derived therefrom available to any third party and to use that material for experimental purposes only, until such time as the patent application is refused or withdrawn or deemed to be withdrawn, or before the expiry of the patent in the designated State in which it last expires, unless the applicant for or proprietor of the patent expressly waives such an undertaking.

The undertaking to use the biological material for experimental purposes only shall not apply in so far as the requester is using that material under a compulsory licence. The term "compulsory licence" shall be construed as including ex officio licences and the right to use patented inventions in the public interest.

Rule 23i

Availability of biological material

(1) [...] Biological material **deposited in accordance with Rule 23g** shall be available upon request to any person from the date of publication of the European patent application and to any person having the right to inspect the files **under** Article 128, paragraph 2, prior to that date. Subject to **Rule 23h**, such availability shall be effected by the issue of a sample of the biological material to the person making the request (hereinafter referred to as "the requester").

(2) *Unchanged*

(6) For the purposes of paragraph 3, derived biological material shall mean any material which still exhibits those characteristics of the deposited material which are essential to carrying out the invention. The undertaking referred to in paragraph 3 shall not impede any deposit of derived biological material necessary for the purpose of patent procedure.

(7) The request provided for in paragraph 3 shall be submitted to the European Patent Office on a form recognised by that Office. The European Patent Office shall certify on the form that a European patent application referring to the deposit of the biological material has been filed, and that the requester or the expert nominated by him is entitled to the issue of a sample of that material. After grant of the European patent, the request shall also be submitted to the European Patent Office.

(8) The European Patent Office shall transmit a copy of the request, with the certification provided for in paragraph 7, to the depositary institution as well as to the applicant for or the proprietor of the patent.

(9) The President of the European Patent Office shall publish in the Official Journal of the European Patent Office the list of depositary institutions and experts recognised for the purpose of this Rule.

(3) For the purposes of paragraph 2, derived biological material shall mean any material which still exhibits those characteristics of the deposited material which are essential to carrying out the invention. The undertaking **under** paragraph 2 shall not impede any deposit of derived biological material necessary for the purpose of patent procedure.

(4) The request **referred to** in paragraph 1 shall be submitted to the European Patent Office on a form recognised by that Office. The European Patent Office shall certify on the form that a European patent application referring to the deposit of the biological material has been filed, and that the requester or the expert nominated by him **under Rule 23h** is entitled to the issue of a sample of that material. After grant of the European patent, the request shall also be submitted to the European Patent Office.

(5) The European Patent Office shall transmit a copy of the request, with the certification provided for in paragraph 4, to the depositary institution as well as to the applicant for or the proprietor of the patent.

(6) The [...] European Patent Office shall publish in **its** Official Journal [...] the list of depositary institutions and experts recognised for the purpose of [...] Rules **23g to 23i**.

Rule 28a

New deposit of biological material

- (1) If biological material deposited in accordance with Rule 28, paragraph 1, ceases to be available from the institution with which it was deposited because:
- (a) the biological material is no longer viable, or
- (b) for any other reason the depositary institution is unable to supply samples, and if no sample of the biological material has been transferred to another depositary institution recognised for the purposes of Rule 28, from which it continues to be available, an interruption in availability shall be deemed not to have occurred if a new deposit of the biological material originally deposited is made within a period of three months from the date on which the depositor was notified of the interruption by the depositary institution and if a copy of the receipt of the deposit issued by the institution is forwarded to the European Patent Office within four months from the date of the new deposit stating the number of the application or of the European patent.
- (2) In the case provided for in paragraph 1(a), the new deposit shall be made with the depositary institution with which the original deposit was made; in the cases provided for in paragraph 1(b), it may be made with another depositary institution recognised for the purposes of Rule 28.

Rule 23j

New deposit of biological material

- (1) If biological material deposited in accordance with Rule **23g** ceases to be available from the **recognised depositary** institution, **a new deposit may be made in accordance with the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977.**
- (2) *Deleted*

(3) Where the institution with which the original deposit was made ceases to be recognised for the purposes of Rule 28, either entirely or for the kind of biological material to which the deposited sample belongs, or where that institution discontinues, temporarily or definitively, the performance of its functions as regards deposited biological material, and the notification referred to in paragraph 1 from the depositary institution is not received within six months from the date of such event, the three-month period referred to in paragraph 1 shall begin on the date on which this event is announced in the Official Journal of the European Patent Office.

(4) Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited.

(5) If the new deposit has been made under the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977, the provisions of that Treaty shall prevail.

(3) *Deleted*

(2) *Unchanged*

(5) *Deleted*

Present wording

PART III IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

Chapter I Filing of the European patent application

Rule 24 General provisions

(1) European patent applications may be filed in writing with the authorities referred to in Article 75 either directly or by post.

The President of the European Patent Office may permit European patent applications to be filed by other means of communication and lay down conditions governing their use. He may, in particular, require that within such period as the European Patent Office shall specify written confirmation be supplied reproducing the contents of applications so filed and complying with the requirements of these Implementing Regulations.

(2) The authority with which the European patent application is filed shall mark the documents making up the application with the date of their receipt. It shall issue without delay a receipt to the applicant which shall include at least the application number, the nature and number of the documents and the date of their receipt.

Revised wording

PART III IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

Chapter I Filing of the European patent application

Rule 24 General provisions

(1) European patent applications may be filed in writing with **the European Patent Office in Munich, the Hague or Berlin, or** the authorities referred to in Article 75, **paragraph 1(b)**, either directly or by post.

(2) The President of the European Patent Office may **determine the means of communication and conditions under which** European patent applications **may** be filed **other than directly or by post [...]**.

(3) The authority with which the European patent application is filed shall mark the documents making up the application with the date of their receipt **and** issue without delay a receipt to the applicant **including** at least the application number **and** the nature, number and date of receipt **of the documents**.

(3) If the European patent application is filed with an authority mentioned in Article 75, paragraph 1(b), it shall without delay inform the European Patent Office of receipt of the documents making up the application. It shall inform the European Patent Office of the nature and date of receipt of the documents, the application number and any priority date claimed.

(4) When the European Patent Office has received a European patent application which has been forwarded by a central industrial property office of a Contracting State, it shall inform the applicant accordingly, indicating the date of its receipt at the European Patent Office.

Rule 25

Provisions for European divisional applications

(1) The applicant may file a divisional application relating to any pending earlier European patent application.

[See Article 76 EPC 1973:

(1) A European divisional application must be filed directly with the European Patent Office at Munich or its branch at The Hague.]

See Rule 4 EPC:

European divisional applications or, in the case referred to in Article 14, paragraph 2, the translations thereof, must be filed in the language of the proceedings for the earlier European patent application.

(4) If the European patent application is filed with an authority **referred to** in Article 75, paragraph 1(b), **such authority** shall without delay inform the European Patent Office of **the** receipt of the [...] application, **and, in particular, of** the nature and date of receipt of the documents, the application number and any priority date claimed.

(5) **Upon receipt of** a European patent application [...] forwarded by **the** central industrial property office of a Contracting State, **the European Patent Office** shall inform the applicant accordingly, indicating the date of its receipt [...].

Rule 25

Provisions for European divisional applications

(1) *Unchanged*

(2) **A divisional application shall be in the language of the proceedings for the earlier application.**

(2) The filing fee and search fee shall be payable in respect of a European divisional application within one month after the filing thereof.

The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application.

[See Article 77 EPC 1973:

(1) [...] in the shortest time compatible with the application of national law concerning the secrecy of inventions in the interests of the State [...]

(2) The Contracting States shall take all appropriate steps to ensure that European patent applications, the subject of which is obviously not liable to secrecy by virtue of the law referred to in paragraph 1, shall be forwarded to the European Patent Office within six weeks after filing.

(3) European patent applications which require further examination as to their liability to secrecy shall be forwarded in

(3) The filing fee and search fee shall be paid within one month of filing the divisional application. If the filing fee or the search fee is not paid in due time, the application shall be deemed to be withdrawn.

(4) The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application. Where a designation fee is not paid in due time in respect of any designated state, the designation of that state shall be deemed to be withdrawn.

Rule 25a

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State shall forward European patent applications to the European Patent Office in the shortest time compatible with its national law relating to the secrecy of inventions in the interests of the State, and shall take all appropriate steps to ensure such forwarding within:

(a) six weeks of filing, where the subject of the application is evidently not liable to secrecy under the national law; or

(b) four months of filing or, if priority has been claimed, fourteen months of the date of priority, where the

such manner as to reach the European Patent Office within four months after filing, or, where priority has been claimed, fourteen months after the date of priority.

(5) [...] before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority [...] The filing, search and designation fees shall be refunded.]

[See Article 78 EPC 1973:

(2) A European patent application shall be subject to the payment of the filing fee and the search fee within one month after the filing of the application.]

[See Article 79 EPC 1973:

(2) [...] Designation fees shall be paid within 6 months of the date on which the European Patent Bulletin mentions the publication of the European search report.]

[See Article 91 EPC 1973:

(4) Where, in the case referred to in paragraph 1 (e), the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.]

[See Article 79 EPC 1973:

(3) Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application.]

application requires further examination as to its liability to secrecy.

(2) A European patent application failing to reach the European Patent Office before the end of the fourteenth month of filing or, if priority has been claimed, of the date of priority, shall be deemed to be withdrawn. The filing, search, designation and claims fees shall be refunded.

Rule 25b

Filing fee and search fee

The filing fee and the search fee shall be paid within one month of filing the European patent application.

Rule 25c

Designation fees

(1) Designation fees shall be paid within 6 months of the date on which the European Patent Bulletin mentions the publication of the European search report.

(2) Where the designation fee is not paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.

(3) Where no designation fee is paid in due time or the designations of all the Contracting States are withdrawn, the European patent application shall be deemed to be withdrawn.

[See Article 80 EPC 1973:

The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:

(a) an indication that a European patent is sought; [...]

(c) information identifying the applicant;

(d) a description]

Rule 25d
Date of filing

(1) The date of filing of a European patent application shall be the date on which the documents filed by the applicant contain:

(a) an indication that a European patent is sought;

(b) information identifying the applicant or allowing the applicant to be contacted; and

(c) a description or reference to a previously filed application.

(2) A reference to a previously filed application under paragraph 1(c) shall state the filing date and number of that application and the Office with which it was filed, and shall indicate that it replaces the description and any drawings.

(3) Where the application contains a reference under paragraph 2, a copy of the previously filed application shall be filed within two months of filing the application. Where the previously filed application is not in an official language of the European Patent Office, a translation thereof in one of these languages shall be filed within the same period. Rule 38a, paragraph 2, shall apply *mutatis mutandis*.

Chapter II

Provisions governing the application

Rule 26

Request for grant

- (1) The request for the grant of a European patent shall be filed on a form drawn up by the European Patent Office. Printed forms shall be made available to applicants free of charge by the authorities referred to in Article 75, paragraph 1.
- (2) The request shall contain:
- (a) a petition for the grant of a European patent;
- (b) the title of the invention, which shall clearly and concisely state the technical designation of the invention and shall exclude all fancy names;
- (c) the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, shall be indicated by their official designations. Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They shall in any case comprise all the relevant

Chapter II

Provisions governing the application

Rule 26

Request for grant

- (1) The request for grant of a European patent shall be filed on a form drawn up by the European Patent Office. [...]
- (2) The request shall contain:
- (a) *Unchanged*
- (b) *Unchanged*
- (c) the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Names of natural persons shall be indicated by the person's family name, **followed by his** given name(s). Names of legal **persons**, as well as [...] **of bodies equivalent to legal persons under the law governing them**, shall be indicated by their official designations. Addresses shall be indicated in **accordance with applicable** customary requirements for prompt postal delivery **and** shall comprise all the relevant administrative units, including the house number, if any. It is recommended that the [...] **fax** and

administrative units, including the house number, if any. It is recommended that the telegraphic and telex address and telephone number be indicated;

(d) if the applicant has appointed a representative, his name and the address of his place of business under the conditions contained in sub-paragraph (c);

(e) where appropriate, indication that the application constitutes a European divisional application and the number of the earlier European patent application;

(f) in cases covered by Article 61, paragraph 1(b), the number of the original European patent application;

(g) where applicable, a declaration claiming the priority of an earlier application and indicating the date on which and the country in or for which the earlier application was filed;

(h) designation of the Contracting State or States in which protection of the invention is desired;

(i) the signature of the applicant or his representative;

(j) a list of the documents accompanying the request. This list shall also indicate the number of sheets of the description, claims, drawings and abstract filed with the request;

(k) the designation of the inventor where the applicant is the inventor.

telephone numbers be indicated;

(d) if the applicant has appointed a representative, his name and the address of his place of business **as prescribed in letter (c)**;

(e) where appropriate, **an** indication that the application constitutes a divisional application and the number of the earlier European patent application;

(f) *Unchanged*

(g) *Unchanged*

(h) **the** designation of the Contracting [...] States in which protection [...] is **sought**;

(i) *Unchanged*

(j) *Unchanged*

(k) *Unchanged*

(3) If there is more than one applicant, the request shall preferably contain the appointment of one applicant or representative as common representative.

Rule 27

Content of the description

(1) The description shall:

(a) specify the technical field to which the invention relates;

(b) indicate the background art which, as far as known to the applicant, can be regarded as useful for understanding the invention, for drawing up the European search report and for the examination, and, preferably, cite the documents reflecting such art;

(c) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;

(d) briefly describe the figures in the drawings, if any;

(e) describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any;

(f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry.

(3) *Unchanged*

Rule 27

Content of the description

(1) The description shall:

(a) *Unchanged*

(b) indicate the background art which, as far as **is** known to the applicant, can be regarded as useful **to understand** the invention, **draw** up the European search report and **examine the European patent application**, and, preferably, cite the documents reflecting such art;

(c) *Unchanged*

(d) *Unchanged*

(e) *Unchanged*

(f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention **is industrially applicable**.

(2) The description shall be presented in the manner and order specified in paragraph 1, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

Rule 27a

Requirements of European patent applications relating to nucleotide and amino acid sequences

.....

Rule 28

Deposit of biological material

.....

Rule 28a

New deposit of biological material

Rule 29

Form and content of claims

(1) The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate claims shall contain:

(a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;

(2) The description shall be presented in the manner and order specified in paragraph 1, unless, **owing** to the nature of the invention, a different **presentation** would afford a better understanding and be more concise.

Rule 27a

Requirements of European patent applications relating to nucleotide and amino acid sequences

Deleted - substance moved to new Rule 23f

Rule 28

Deposit of biological material

Deleted - substance moved to new Rules 23g to i

Rule 28a

New deposit of biological material

Deleted - substance moved to new Rule 23j.

Rule 29

Form and content of claims

(1) *Unchanged*

(a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, **form** part of the prior art;

(b) a characterising portion - preceded by the expression "characterised in that" or "characterised by" - stating the technical features which, in combination with the features stated in sub-paragraph (a), it is desired to protect.

(2) Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

(a) a plurality of inter-related products;

(b) different uses of a product or apparatus;

(c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim.

(3) Any claim stating the essential features of an invention may be followed by one or more claims concerning particular embodiments of that invention.

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features which it is desired to protect. A dependent claim shall also be admissible where the claim it directly refers to is itself a dependent claim. All dependent claims referring back to a single previous claim, and all dependent claims referring back to

(b) a characterising portion, **beginning with** the expression "characterised in that" or "characterised by" **and specifying** the technical features **for** which, in combination with the features stated **under letter (a), protection is sought**.

(2) *Unchanged*

(a) *Unchanged*

(b) *Unchanged*

(c) alternative solutions to a particular problem, where it is **inappropriate** to cover these alternatives by a single claim.

(3) *Unchanged*

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features [...]. A dependent claim [...] directly **referring to another [...]** dependent claim **shall also be admissible**. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped

several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

(5) The number of the claims shall be reasonable in consideration of the nature of the invention claimed. If there are several claims, they shall be numbered consecutively in Arabic numerals.

(6) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: "as described in part ... of the description", or "as illustrated in figure ... of the drawings".

(7) If the European patent application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to these features and placed between parentheses. These reference signs shall not be construed as limiting the claim.

Rule 30

Unity of invention

(1) Where a group of inventions is claimed in one and the same European patent application, the requirement of unity of invention referred to in Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

together to the extent and in the most appropriate way possible.

(5) The number of claims shall be reasonable **with regard to** the nature of the invention claimed. If there are several claims, they shall be numbered consecutively in Arabic numerals.

(6) **Except where absolutely necessary**, claims shall not rely on references to the description or drawings in **specifying** the technical features of the invention. In particular, they shall not **contain such expressions as**: "as described in part ... of the description", or "as illustrated in figure ... of the drawings".

(7) **Where** the European patent application contains drawings **including reference signs**, the technical features **specified** in the claims shall preferably [...] be followed by **such** reference signs relating to these features, placed **in** parentheses, if the intelligibility of the claim can thereby be increased. These reference signs shall not be construed as limiting the claim.

Rule 30

Unity of invention

(1) Where a group of inventions is claimed in [...] **a** European patent application, the requirement of unity of invention referred to in Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

(2) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Rule 31

Claims incurring fees

(1) Any European patent application comprising more than ten claims at the time of filing shall, in respect of each claim over and above that number, incur payment of a claims fee. The claims fee shall be payable within one month after the filing of the application. If the claims fees have not been paid in due time they may still be validly paid within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit.

(2) If a claims fee is not paid within the period referred to in paragraph 1, the claim concerned shall be deemed to be abandoned. Any claims fee duly paid shall be refunded only in the case referred to in Article 77, paragraph 5.

The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

(2) *Unchanged*

Rule 31

Claims incurring fees

(1) Any European patent application comprising more than ten claims [...] shall, in respect of **the eleventh and** each **subsequent** claim [...], incur payment of a claims fee.

(2) The claims fees shall be **paid** within one month **of** filing the **claims**. [...] If the claims fees have not been paid in due time they may still be [...] paid within [...] one month of [...] a communication [...] **concerning** the failure to observe the time limit.

(3) If a claims fee is not paid **in due time**, the claim concerned shall be deemed to be abandoned. [...]

Rule 32

Form of the drawings

(1) On sheets containing drawings, the usable surface area shall not exceed 26.2 cm x 17 cm. These sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows:

top	2.5 cm
left side	2.5 cm
right side	1.5 cm
bottom	1 cm

(2) Drawings shall be executed as follows:

(a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colourings.

(b) Cross-sections shall be indicated by hatching which should not impede the clear reading of the reference signs and leading lines.

(c) The scale of the drawings and the distinctness of their graphical execution shall be such that reproduction, obtained electronically or photographically, with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically.

(d) All numbers, letters, and reference signs, appearing on the drawings, shall be simple and clear. Brackets, circles or

Rule 32

Form of the drawings

(1) On sheets containing drawings, the usable surface area shall not exceed 26.2 cm x 17 cm. **The usable or used surface shall not be surrounded by frames.** The minimum margins shall be as follows:

top	2.5 cm
left side	2.5 cm
right side	1.5 cm
bottom	1 cm

(2) Drawings shall be executed as follows:

(a) Drawings shall be executed **without colourings** in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes.

(b) *Unchanged*

(c) The scale of the drawings and [...] their graphical execution shall be such that **electronic or photographic** reproduction [...] with a linear reduction in size to two-thirds **will allow** all details to be distinguished without difficulty. If, **exceptionally**, the scale is given on a drawing, it shall be represented graphically.

(d) All numbers, letters, and reference signs appearing on the drawings shall be simple and clear. Brackets, circles or

inverted commas shall not be used in association with numbers and letters.

(e) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.

(f) Elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure.

(g) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.

(h) The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

(i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. The same

inverted commas shall not be used in association with numbers and letters.

(e) **Generally, all** lines in the drawings shall [...] be drawn with the aid of drafting instruments.

(f) Elements of the same figure shall be **proportional to one another**, unless a difference in proportion is indispensable for the clarity of the figure.

(g) *Unchanged*

(h) The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form **a single** figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

(i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. [...]

features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs.

(j) The drawings shall not contain text matter, except, when absolutely indispensable, a single word or words such as "water", "steam", "open", "closed", "section on AB", and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords indispensable for understanding. Any such words shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings.

(3) Flow sheets and diagrams are considered drawings.

Rule 33

Form and content of the abstract

(1) The abstract shall indicate the title of the invention.

(2) The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterises the

Reference signs **to features** shall be **consistent** throughout the application [...].

(j) The drawings shall not contain text matter. **Where [...]** indispensable **to understand the drawings, a few short keywords**, such as "water", "steam", "open", "closed", "section on AB", **may be included**. Any such words shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings.

(3) Flow sheets and diagrams **shall be deemed to be** drawings.

Rule 33

Form and content of the abstract

(1) *Unchanged*

(2) The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings. The summary shall indicate the technical field to which the invention pertains and shall be drafted in a **manner allowing** the clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterises the invention. It shall

invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(3) The abstract shall preferably not contain more than one hundred and fifty words.

(4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when the abstract is published. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign, placed between parentheses.

(5) The abstract shall be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field particularly by making it possible to assess whether there is a need for consulting the European patent application itself.

Rule 34
Prohibited matter

(1) The European patent application shall not contain:

(a) statements or other matter contrary to "ordre public" or morality;

not contain statements on the alleged merits or value of the invention or on speculative applications **thereof**.

(3) *Unchanged*

(4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which [...] should **be published with the abstract**. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed **in** parentheses.

(5) The abstract shall be drafted **in such a manner as to** constitute an efficient instrument for **the** purpose of searching in the particular technical field. **In particular, it shall** make it possible to assess whether consultation of the European patent application itself **is necessary**.

Rule 34
Prohibited matter

(1) The European patent application shall not contain:

(a) *Unchanged*

(b) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person. Mere comparisons with the prior art shall not be considered disparaging *per se*;

(c) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

(2) If a European patent application contains prohibited matter within the meaning of paragraph 1(a), the European Patent Office shall omit it when publishing the application, indicating the place and number of words or drawings omitted.

(3) If a European patent application contains statements within the meaning of paragraph 1(b), the European Patent Office may omit them when publishing the application. It shall indicate the place and number of words omitted, and shall furnish, upon request, a copy of the passages omitted.

Rule 35

General provisions governing
the presentation of the
application documents

(1) Translations mentioned in Article 14, paragraph 2, shall be considered to be included in the term "documents making up the European patent application".

(b) statements disparaging the products or processes of any **third party [...]** or the merits or validity of **the** applications or patents of any such **party**. Mere comparisons with the prior art shall not be considered disparaging *per se*;

(c) *Unchanged*

(2) If **the** application contains matter prohibited **under** paragraph 1(a), **such matter may be omitted from the application as published and** the place and number of words or drawings omitted **shall be indicated**.

(3) If **the** application contains statements **referred to in** paragraph 1(b), **they may be omitted from the application as published**. The place and number of words omitted **shall be indicated and, upon request, the** European Patent Office shall furnish a copy of the passages omitted.

Rule 35

General provisions governing
the presentation of the
application documents

(1) **Any translation referred to** in Article 14, paragraph 2, shall be **deemed** to be a **[...]** "document making up the European patent application".

(2) The documents making up the European patent application shall be filed in three copies. The President of the European Patent Office may, however, determine that the documents shall be filed in fewer than three copies.

(3) The documents making up the European patent application shall be so presented as to admit of electronic as well as of direct reproduction, in particular by scanning, photography, electrostatic processes, photo offset and micro filming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used.

(4) The documents making up the European patent application shall be on A 4 paper (29.7 cm 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Subject to the provisions of Rule 32, paragraph 2(h), and paragraph 11 of this Rule, each sheet shall be used with its short sides at the top and bottom (upright position).

(5) Each of the documents making up the European patent application (request, description, claims, drawings and abstract) shall commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(2) *Deleted*

(2) The documents making up the application shall be [...] presented **so** as to **allow** electronic and direct reproduction, in particular by scanning, photography, electrostatic processes, photo offset and microfilming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used.

(3) The documents making up the [...] application shall be on A 4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Subject to **paragraph 11 and** Rule 32, paragraph 2(h), each sheet shall be used with its short sides at the top and bottom (upright position).

(4) Each of the documents making up the [...] application (request, description, claims, drawings and abstract) shall commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(6) Subject to Rule 32, paragraph 1, the minimum margins shall be as follows:

top: 2 cm
left side: 2.5 cm
right side: 2 cm
bottom: 2 cm

The recommended maximum for the margins quoted above is as follows:

top: 4 cm
left side: 4 cm
right side: 3 cm
bottom: 3 cm

(7) The margins of the documents making up the European patent application, when submitted, must be completely blank.

(8) All the sheets contained in the European patent application shall be numbered in consecutive Arabic numerals. These shall be placed at the top of the sheet, in the middle, but not in the top margin.

(9) The lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin.

(10) The request for the grant of a European patent, the description, the claims and the abstract shall be typed or printed. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be written by hand or drawn. The typing shall be 1 ½ spaced. All text matter shall be in

(5) *Unchanged*

(6) **Upon filing**, the margins of the documents making up the [...] application **shall** be completely blank.

(7) All the sheets contained in the [...] application shall be numbered in consecutive Arabic numerals. These shall be **centred** at the top of the sheet, [...] but not **placed** in the top margin.

(8) *Unchanged*

(9) The request for grant of a European patent, the description, the claims and the abstract shall be typed or printed. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be **drawn or** written by hand. The typing shall be 1 ½ spaced. All text matter shall be in characters, the capital

characters, the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible colour.

(11) The request for the grant of a European patent, the description, the claims and the abstract shall not contain drawings. The description, the claims and the abstract may contain chemical or mathematical formulae. The description and the abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable. Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

(12) Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in the units recognised in international practice. For mathematical formulae the symbols in general use shall be employed. For chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

(13) The terminology and the signs shall be consistent throughout the European patent application.

letters of which are not less than 0.21 cm high, and shall be in a dark, indelible colour.

(10) The request for grant of a European patent, the description, the claims and the abstract shall not contain drawings. The description, [...] claims and [...] abstract may contain chemical or mathematical formulae. The description and [...] abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable. Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position [...]. [...] Tables or chemical or mathematical formulae [...] presented sideways shall be **placed** so that the tops of the tables or formulae are at the left-**hand** side of the sheet.

(11) [...] Values shall be expressed in [...] units [...] **conforming to** international **standards**, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement **shall** also be expressed in units **conforming to** international **standards**. [...] Use should be made of the technical terms, **conventions, formulae**, signs and symbols generally accepted in the field in question.

(12) *Unchanged*

(14) Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings and interlineations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Rule 36

Documents filed subsequently

(1) Rules 27, 29 and 32 to 35 shall apply to documents replacing documents making up the European patent application. Rule 35, paragraphs 2 to 14, shall also apply to the translation of the claims referred to in Rule 51.

(2) All documents other than those referred to in the first sentence of paragraph 1 shall normally be typewritten or printed. There must be a margin of about 2.5 cm on the left-hand side of each page.

(3) All documents, with the exception of annexed documents, filed after filing of the European patent application must be signed. If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit to be laid down by that Office. If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received.

(13) Each sheet shall be reasonably free from erasures and shall be free from alterations [...]. Non-compliance with this rule may be authorised if the authenticity of the content is not **impugned** and the requirements for good reproduction are not **thereby jeopardised**.

Rule 36

Documents filed subsequently

(1) *Unchanged*

(2) All documents other than those **making up the application** shall **generally** be typewritten or printed. There **shall** be a margin of about 2.5 cm on the left-hand side of each page.

(3) All documents [...] filed after filing the application **shall** be signed, **with the exception of annexed documents**. If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit **to be specified**. If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been **filed**.

(4) Such documents as must be communicated to other persons or as relate to two or more European patent applications or European patents, must be filed in a sufficient number of copies. If the party concerned does not comply with this obligation in spite of a request by the European Patent Office, the missing copies shall be provided at the expense of the party concerned.

(5) Notwithstanding paragraphs 2 to 4 the President of the European Patent Office may permit documents filed after filing of the European patent application to be transmitted to the European Patent Office by other means of communication and lay down conditions governing their use. He may, in particular, require that within a period laid down by him written confirmation be supplied reproducing the contents of documents so filed and complying with the requirements of these Implementing Regulations; if such confirmation is not supplied in due time, the documents shall be deemed not to have been received.

(4) Documents **to be** communicated to other persons, or **relating** to two or more European patent applications or European patents, **shall** be filed in a sufficient number of copies. **Where a party fails to comply with this requirement despite an invitation to do so from** the European Patent Office, the missing copies shall be provided at the expense of **that** party [...].

(5) **Rule 24, paragraph 2, shall apply *mutatis mutandis*.**

Chapter III Renewal Fees

Rule 37

Payment of renewal fees

(1) Renewal fees for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due.

[Article 86(2) EPC 1973:

When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time.]

(2) An additional fee shall be deemed to have been paid at the same time as the renewal fee within the meaning of Article 86, paragraph 2, if it is paid within the period laid down in that provision.

(3) Renewal fees already due in respect of an earlier application up to the date on which a European divisional application is filed must also be paid for the divisional application and fall due when the latter is filed. These fees and any renewal fee falling due within a period of four months from the filing of the divisional application may be paid without an additional fee within that period. If payment is not made in due time, the renewal fees may still be validly paid within six months of the due

Chapter III Renewal Fees

Rule 37

Payment of renewal fees

(1) **A** renewal fee for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due.

(2) If a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period.

(3) **A** renewal fee already due in respect of an earlier application **at** the date on which a [...] divisional application is filed **shall** also be paid for the divisional application and **is due on its filing. This** fee and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee. **Paragraph 2 shall apply [...].**

date, provided that the additional fee under Article 86, paragraph 2, is paid at the same time.

(4) Renewal fees shall not be payable for a new European patent application filed pursuant to Article 61, paragraph 1(b), in respect of the year in which it was actually filed and any preceding year.

Chapter IV Priority

Rule 38 Declaration of priority and priority documents

(1) The declaration of priority referred to in Article 88, paragraph 1, shall state the date of the previous filing and the State in or for which it was made and shall indicate the file number.

(2) The date and State of the previous filing must be stated on filing the European patent application; the file number shall be indicated before the end of the sixteenth month after the date of priority.

Paragraphs (3)-(5) become new Rule 38a(1)-(3) EPC

(6) The particulars stated in the declaration of priority shall appear in the published European patent application and also on the European patent specification.

(4) **A** renewal fee shall not be payable for a new European patent application filed **under** Article 61, paragraph 1(b), in respect of the year in which it was [...] filed and any preceding year.

Chapter IV Priority

Rule 38 Declaration of priority [...]

(1) The declaration of priority referred to in Article 88, paragraph 1, shall **indicate** the date of the previous **application**, the State in or for which it was **filed** and [...] the file number.

(2) The **declaration of priority shall preferably be made** on filing the European patent application. **It may still be made within sixteen months from the earliest priority date claimed, unless the applicant has filed a request under Article 93, paragraph 1(b).**

(3) The particulars **of** the declaration of priority shall appear in the published European patent application and [...] the European patent specification.

See Rule 38 EPC

(3) The copy of the previous application must be filed before the end of the sixteenth month after the date of priority. The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application.

(4) The copy of the previous application shall be deemed duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions laid down by the President of the European Patent Office.

*[See Article 88(1) EPC 1973:
[...] if the language of the latter [previous application] is not one of the official languages of the European Patent Office, a translation into one of such official languages.]*

See Rule 38 EPC

(5) The translation of the previous application required under Article 88, paragraph 1, must be filed within a time limit to be set by the European Patent Office, but at the latest within the time limit under Rule 51, paragraph 4. Alternatively,

Rule 38a

Priority documents

(1) An applicant claiming priority shall file a copy of the previous application within sixteen months of the earliest [...] priority date claimed.[...] This copy and the date of filing of the previous application shall be certified as correct by the authority with which that application was filed.

(2) The copy of the previous application shall be deemed **to be** duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions **determined** by the President of the European Patent Office.

(3) Where the previous application is not in one of the official languages of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned, the European Patent Office shall invite the applicant for or proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. [...] Alternatively, a declaration may be submitted that the European patent application is a complete translation

a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 4 shall apply *mutatis mutandis*.

Rule 38a

Issuing priority documents

On request, the European Patent Office shall issue a certified copy of the European patent application (priority document) to the applicant. The President of the European Patent Office shall determine all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.

of the previous application. Paragraph 2 shall apply *mutatis mutandis*.

Rule 38b

Issuing priority documents

On request, the European Patent Office shall issue **to the applicant** a certified copy of the European patent application **invoked as a** priority document, under **the conditions determined by** the President of the European Patent Office [...], including the form of the priority document and the circumstances under which an administrative fee **shall be paid**.

Present wording

PART IV IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

Chapter I Examination by the Receiving Section

Rule 39 Communication following the examination on filing

If the European patent application fails to meet the requirements laid down in Article 80, the Receiving Section shall communicate the disclosed deficiencies to the applicant and inform him that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within one month. If he does so, he shall be informed of the date of filing.

Revised wording

PART IV IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

Chapter I Examination by the Receiving Section

Rule 39 [...] Examination on filing

If the examination under Article 90, paragraph 1, reveals that the application fails to meet the requirements laid down in Rule 25d, paragraphs 1, 2 and 3, last sentence the European Patent Office shall inform the applicant of any deficiencies and advise him that the application will not be dealt with as a European patent application unless such deficiencies are remedied within two months. If the applicant does this, he shall be informed of the date of filing accorded by the Office.

Rule 39a **Missing parts of the description or missing drawings**

(1) If the examination under Article 90, paragraph 1, reveals that parts of the description, or of drawings referred to in the description or in the claims, appear to be missing, the European Patent Office shall invite the applicant to file the missing parts within two months. The applicant may not invoke the omission of such a communication.

(2) If missing parts of the description or missing drawings are filed later than the date of filing, but within two months of the date of filing or of a communication under paragraph 1, the application shall be re-dated to the date on which those parts were filed, unless the missing parts of the description or missing drawings are withdrawn within one month of their filing.

(3) If the missing parts of the description or missing drawings are filed within the period under paragraph 2, and the application claims priority of an earlier application, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 25d, paragraph 1, were fulfilled, where the applicant so requests and files a copy of the previous application and, where the previous application is not in an official language of the European Patent Office, a translation thereof in one of these languages, within the period under paragraph 2. Rule 38a, paragraph 2, shall apply *mutatis mutandis*.

(4) If the applicant fails to file the missing parts of the description or missing drawings in due time, they shall be deemed not to have been filed. Any references to such missing parts of the description or missing drawings shall be deemed to be deleted.

(5) The applicant shall be informed of any new date of filing of the application.

See Rule 43(3) EPC

(3) The applicant shall be informed of any new date of filing of the application.

Rule 40

Examination for certain
physical requirements

[See Article 91 EPC 1973:

(1) If a European patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Receiving Section shall examine whether:

(a) the requirements of Article 133, paragraph 2, have been satisfied;

(b) the application meets the physical requirements laid down in the Implementing Regulations for the implementation of this provision;

(c) the abstract has been filed;

(d) the request for the grant of a European patent satisfies the mandatory provisions of the Implementing Regulations concerning its content and, where appropriate, whether the requirements of this Convention concerning the claim to priority have been satisfied;

[...]

(f) the designation of the inventor has been made in accordance with Article 81;

Rule 40

Examination [...] as to
formal requirements

If the European patent application has been accorded a date of filing, the European Patent Office shall examine in accordance with Article 90, paragraph 3, whether:

(a) a translation of the application required under Article 14, paragraph 2, has been filed in due time;

(b) the request for grant of a European patent satisfies the requirements of Rule 26;

(c) the application contains one or more claims and an abstract in accordance with Article 78, paragraph 1(c) and (e);

(d) the filing fee and the search fee have been paid in accordance with Rule 25b;

(e) the designation of the inventor has been made in accordance with Rule 17, paragraph 1;

(f) where appropriate, the requirements laid down in Rules 38 and 38a concerning the claim to priority have been satisfied;

(g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.]

The physical requirements which a European patent application must satisfy pursuant to Article 91, paragraph 1(b), shall be those prescribed in Rule 27a, paragraphs 1 to 3, Rule 32, paragraphs 1 and 2, Rule 35, paragraphs 2 to 11 and 14, and Rule 36, paragraphs 2 and 4.

Rule 41

Rectification of deficiencies in the application documents

(1) If the examination provided for in Article 91, paragraph 1(a) to (d), reveals deficiencies in the European patent application, the Receiving Section shall inform the applicant accordingly and invite him to remedy the deficiencies within such period as it shall specify. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies in accordance with the observations of the Receiving Section.

(2) Paragraph 1 shall not apply where the applicant, while claiming priority, has omitted to indicate on filing the European patent application the date or State of first filing.

(3) Paragraph 1 shall not apply where the examination reveals that the date of the first filing given on filing the European patent application precedes the date of filing of the European patent application by more than one year. In this event the

(g) where appropriate, the requirements of Article 133, paragraph 2, have been satisfied;

(h) [...] the application meets the [...] requirements [...] laid down in Rules 23f, 32, 35 and 36.

Rule 41

Correction of deficiencies in the application documents

(1) If [...] the European patent application [...] **does not comply with the requirements of Rule 40(a) to (c), (g) and (h), the European Patent Office** shall inform the applicant accordingly and invite him to **correct** the deficiencies **noted** within **a period to be specified**. The description, claims and drawings may be amended only to an extent sufficient to remedy **such deficiencies [...]** .

(2) *Deleted*

(3) *Deleted*

Receiving Section shall inform the applicant that there will be no right of priority for the application unless, within one month, the applicant indicates a corrected date, lying within the year preceding the date of filing of the European patent application.

Rule 42

Subsequent identification of the inventor

(1) If the examination provided for in Article 91, paragraph 1(f), reveals that the inventor has not been identified in accordance with the provisions of Rule 17, the Receiving Section shall inform the applicant that the European patent application shall be deemed to be withdrawn unless this deficiency is corrected within the period prescribed by Article 91, paragraph 5.

(2) In the case of a European divisional application or a new European patent application filed pursuant to Article 61, paragraph 1(b), the time limit for identifying

Rule 41a

Deficiencies in claiming priority

If the file number of the previous application under Rule 38, paragraph 1, or the copy of that application under Rule 38a, paragraph 1, have not been filed in due time, the European Patent Office shall inform the applicant accordingly and invite him to file them within a period to be specified.

Rule 42

Subsequent designation of the inventor

(1) If [...] the inventor has not been **designated** in accordance with Rule 17, the **European Patent Office** shall inform the applicant that the European patent application shall be **refused** unless **the designation is made within 16 months of the date of filing of the application or, if priority is claimed, of the date of priority.**

(2) Where, **in** a [...] divisional application or a new [...] application **under** Article 61, paragraph 1(b), **the inventor has not been designated in accordance with**

the inventor may in no case expire before two months after the communication referred to in paragraph 1, which shall state the time limit.

Rule 43

Late-filed or missing drawings

(1) If the examination provided for in Article 91, paragraph 1(g), reveals that the drawings were filed later than the date of filing of the European patent application, the Receiving Section shall inform the applicant that the drawings and the references to the drawings in the European patent application shall be deemed to be deleted unless the applicant requests within a period of one month that the application be re-dated to the date on which the drawings were filed.

(2) If the examination reveals that the drawings were not filed, the Receiving Section shall invite him to file them within one month and inform him that the application will be re-dated to the date on which they are filed, or, if they are not filed in due time, any reference to them in the application shall be deemed to be deleted.

(3) The applicant shall be informed of any new date of filing of the application.

Rule 17, that designation may still be made within two months of the [...] communication under paragraph 1 [...], if the period under paragraph 1 expires earlier.

Rule 43

Late-filed or missing drawings

(1) *Deleted - See Rule 39a EPC*

(2) *Deleted - See Rule 39a EPC*

(3) *Deleted - has become Rule 39(6) EPC*

Chapter II
European search report

Rule 44

Content of the European search report

- (1) The European search report shall mention those documents, available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.
- (2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).
- (3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.
- (4) Any document which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.
- (5) The European search report shall be drawn up in the language of the proceedings.

Chapter II
European search report

Rule 44

Content of the European search report

- (1) *Unchanged*
- (2) Each citation shall be referred to the claims to which it relates. **Where appropriate**, relevant parts of the documents cited shall be identified [...] by indicating the page, column and lines or the diagrams.
- (3) - (6) *Unchanged*

(6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.

Rule 45
Incomplete search

If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as is practicable, draw up a partial European search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report.

Rule 46
European search report
where the invention lacks unity

(1) If the Search Division considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that if the European search report is to cover the other inventions, a

Rule 45
Incomplete search

If the **European Patent Office** considers that the European patent application does not comply with **this** Convention to such an extent that it is **impossible** to carry out a meaningful search into the state of the art on the basis of all or some of the **subject-matter claimed**, it shall either **issue a declaration to that effect** or, as far as is practicable, draw up a partial European search report. The declaration **or** the partial report [...] shall be considered, for the purposes of subsequent proceedings, as the European search report.

Rule 46
European search report
where the invention lacks unity

(1) If the **European Patent Office** considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial European search report on those parts of the [...] application which **appear to represent the main invention** [...]. It shall inform the applicant that **for** the European search report to cover the other inventions, a further search fee must be paid, for each invention involved, within

further search fee must be paid, for each invention involved, within a period to be fixed by the Search Division which must not be shorter than two weeks and must not exceed six weeks. The Search Division shall draw up the European search report for those parts of the European patent application which relate to inventions in respect of which search fees have been paid.

(2) Any fee which has been paid under paragraph 1 shall be refunded if, during the examination of the European patent application by the Examining Division, the applicant requests a refund and the Examining Division finds that the communication referred to in the said paragraph was not justified.

[See Article 92 EPC 1973:

(2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.]

Rule 47

Definitive content of the abstract

(1) At the same time as drawing up the European search report, the Search Division shall determine the definitive content of the abstract.

(2) The definitive content of the abstract shall be transmitted to the applicant together with the European search report.

[...] a period to be specified, which shall neither be shorter than two weeks nor exceed six weeks. The [...] European search report shall be drawn up for those parts of the [...] application relating to inventions in respect of which search fees have been paid.

(2) Any fee paid under paragraph 1 shall be refunded if, during the examination of the European patent application [...], the applicant requests a refund and the Examination Division finds that the communication **under paragraph 1** was not justified.

Rule 46a

Transmittal of the European search report

Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

Rule 47

Definitive content of the abstract

Upon drawing up the European search report, the **European Patent Office** shall determine the definitive content of the abstract **and transmit it to the applicant together with the search report.**

(2) *Deleted*

Chapter III
Publication of the
European patent application

Rule 48

Technical preparations for publication

(1) The President of the European Patent Office shall determine when the technical preparations for publication of the European patent application are to be deemed to have been completed.

(2) The European patent application shall not be published if it has been finally refused or withdrawn or deemed to be withdrawn before the termination of the technical preparations for publication.

Rule 49

Form of the publication of European patent applications and European search reports

[See Article 93 EPC 1973:

(2) The publication shall contain the description, the claims and any drawings as filed and, in an annex, the European search report and the abstract, in so far as the latter are available before the termination of the technical preparations for publication. If the European search report and the abstract have not been published at the same time as the application, they shall be published separately.]

Chapter III
Publication of the
European patent application

Rule 48

Technical preparations for publication

(1) *Unchanged*

(2) The [...] application shall not be published if it has been finally refused or withdrawn or **is** deemed to be withdrawn before the termination of the technical preparations for publication.

Rule 49

Form of the publication of European patent applications and European search reports

(1) The publication of the European patent application shall contain the description, claims and any drawings as filed and, in an annex, [...] the European search report and the abstract, where these are available prior to the termination of the technical preparations for publication [...]. If the European search report and the abstract are not published at the same time as the application, they shall be published subsequently.

(1) The President of the European Patent Office shall prescribe the form of the publication of the European patent application and the data which are to be included. The same shall apply where the European search report and the abstract are published separately. The President of the European Patent Office may lay down special conditions for the publication of the abstract.

(2) The designated Contracting States shall be specified in the published European patent application.

(3) If, before the termination of the technical preparations for publication of the European patent application, the claims have been amended pursuant to Rule 86, paragraph 2, the new or amended claims shall be included in the publication in addition to the original claims.

Rule 50

Information about publication

(1) The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 94, paragraphs 2 and 3.

(2) The applicant may not invoke the omission of the communication provided for in paragraph 1. If a later date than the date of the mention of the publication is specified in the communication, the later

(2) The President of the European Patent Office shall **determine** the form of the publication of the [...] application and the data [...] to be included. The same shall apply where the European search report and the abstract are published separately. [...]

(3) The designated Contracting States shall be **indicated** in the published [...] application.

(4) If, before the termination of the technical preparations for publication of the [...] application, the claims have been amended **under** Rule 86, paragraph 2, the new or amended claims shall be included in the publication in addition to the claims **as filed**.

Rule 50

Information about publication

(1) The European Patent Office shall **inform** the applicant **of** the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention [...] to **Rule 50a, paragraph 1, and Article 94, paragraph 2 [...]**.

(2) The applicant may not invoke the omission of the communication **under** paragraph 1. If a later date than the date of the mention of the publication is specified in the communication, the later date shall

date shall be the decisive date as regards the time limit for filing the request for examination unless the error is apparent.

[See Article 94 EPC 1973:

(2) A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request shall not be deemed to be filed until after the examination fee has been paid. The request may not be withdrawn.

[See Article 96 EPC 1973:

(1) If the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application.

(3) If the applicant fails to reply in due time to any invitation under paragraph 1 [...], the application shall be deemed to be withdrawn.]

be the decisive date as regards the **period** for filing the request for examination unless the error is **obvious**.

Rule 50a

Request for examination

(1) The applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn.

(2) If the request for examination has been filed before the European search report, accompanied, as the case may be, by a communication under Article 94, paragraph 3, has been transmitted to the applicant, the European Patent Office shall invite the applicant to indicate, within a period to be specified, whether he wishes to proceed further with the application, and shall give him the opportunity to comment on the search report or the communication and to amend, where appropriate, the description, claims and drawings.

(3) If the applicant fails to reply in due time to the communication under paragraph 2, the application shall be deemed to be withdrawn.

Chapter IV

Examination by the Examining Division

Rule 51

Examination procedure

- (1) In the communication under Article 96, paragraph 1, the European Patent Office shall give the applicant an opportunity to comment on the European search report and to amend, where appropriate, the description, claims and drawings.
- (2) In any communication under Article 96, paragraph 2, the Examining Division shall, where appropriate, invite the applicant to correct the deficiencies noted and to amend the description, claims and drawings.
- (3) Any communication under Article 96, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.
- (4) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period to be specified, which may not be less than two months or more than four months. The period shall be extended once by a maximum of two months provided the

Chapter IV

Examination by the Examining Division

Rule 51

Examination procedure

- (1) *Deleted*
- (1) In any communication under **Article 94, paragraph 3**, the Examining Division shall, where appropriate, invite the applicant to correct **any** deficiencies noted and to amend the description, claims and drawings **within a period to be specified**.
- (2) Any communication under **Article 94, paragraph 3**, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.
- (3) *Unchanged*

applicant so requests before it expires. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.

(5) If the applicant, within the period laid down in paragraph 4, requests amendments under Rule 86, paragraph 3, or the correction of errors under Rule 88, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.

(6) If the Examining Division does not consent to an amendment or correction requested under paragraph 5, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 7, shall be refunded.

(7) If the European patent application in the text intended for grant comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees

(4) If the applicant, within the period laid down in paragraph **3**, requests amendments under Rule 86, paragraph 3, or the correction of errors under Rule 88, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.

(5) If the Examining Division does not consent to an amendment or correction requested under paragraph **4**, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph **6**, shall be refunded.

(6) If the European patent application in the text intended for grant comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees

in respect of each additional claim within the period laid down in paragraph 6 unless the said fees have already been paid in accordance with Rule 31, paragraph 1.

(8) If the fees for grant and printing or the claims fees are not paid in due time or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn.

(8a) If the designation fees become due after the communication under paragraph 4 has been notified, the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 4 has been notified and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 4 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the grant of the European patent.

in respect of each additional claim within the period laid down in paragraph 5 unless the said fees have already been paid **under** Rule 31 [...] **or Rule 110.**

(7) *Unchanged*

(8) If the designation fees become due after the communication under paragraph 3 has been notified, the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 3 has been notified and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 3 shall indicate the designated Contracting States which require a translation **under** Article 65, paragraph 1.

(11) *Unchanged*

Rule 52

Grant of the European patent to different applicants

Where different persons are entered in the Register of European Patents as applicants in respect of different Contracting States, the Examining Division shall grant the European patent for each Contracting State to the applicant or applicants registered in respect of that State.

Chapter V

The European patent specification

Rule 53

Technical preparations for publication and form of the specification of the European patent

Rules 48 and 49, paragraphs 1 and 2, shall apply mutatis mutandis to the specification of the European patent. The specification shall also contain an indication of the time limit for opposing the European patent.

Rule 54

Certificate for a European patent

(1) As soon as the specification of the European patent has been published the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent, to which the specification shall be annexed. The certificate shall certify that the patent has been granted, in respect of the invention described in the

Rule 52

Grant of the European patent to different applicants

Where different persons are **recorded** in the Register of European Patents as applicants in respect of different Contracting States, the **European Patent Office** shall grant the European patent for each Contracting State **accordingly [...]**.

Chapter V

The European patent specification

Rule 53

[...] Publication and form of the specification **[...]**

Rules 48 and 49, paragraphs **2** and **3**, shall apply **[...]** to the specification of the European patent. The specification shall also contain an indication of the time limit for opposing the European patent.

Rule 54

Certificate for a European patent

(1) As soon as the specification of the European patent has been published, the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent, to which the specification shall be annexed, **certifying** that the patent has been granted **for** the invention described in the patent specification, to the

patent specification, to the person named in the certificate, for the Contracting States designated in the specification.

(2) The proprietor of the patent may request that duplicate copies of the European patent certificate be supplied to him upon payment of an administrative fee.

person named in the certificate, for the Contracting States **indicated** in the specification.

(2) *Deleted*

Present wording

PART V

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

[See Article 99 EPC 1973:

(3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.]

Rule 55

Content of the notice of opposition

[See Article 99 EPC 1973:

... Notice of opposition shall be filed in a written reasoned statement]

The notice of opposition shall contain:

(a) the name and address of the opponent and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) the number of the European patent against which opposition is filed, and the name of the proprietor and title of the invention;

Revised wording

PART V

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

Chapter I Opposition procedure

Rule 55a

Surrender or lapse of the patent

An opposition may be filed even if the European patent has been surrendered in all the designated States or has lapsed in all those States.

Rule 55b

Form and content of the [...] opposition

(1) Notice of opposition shall be filed in a written reasoned statement.

(2) The notice of opposition shall contain:

(a) **particulars** of the opponent **as provided in** Rule 26, paragraph 2(c);

(b) - (c) *Unchanged*

(c) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;

(d) if the opponent has appointed a representative, his name and the address of his place of business, in accordance with the provisions of Rule 26, paragraph 2(c).

Rule 56

Rejection of the notice of opposition
as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and Rule 55, subparagraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2) If the Opposition Division notes that the notice of opposition does not comply with provisions other than those mentioned in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not corrected in good time the Opposition Division shall reject it as inadmissible.

(d) if the opponent has appointed a representative, **particulars as provided in** Rule 26, paragraph 2(d).

Rule 56

Rejection of the [...] opposition
as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, **or** Rule 55b, **paragraph 2(b) or (c)**, it shall reject the [...] opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2) If the Opposition Division notes that the notice of opposition does not comply with provisions other than those **referred to** in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within **a** period **to be specified**. If the notice of opposition is not corrected in **due** time, the Opposition Division shall reject **the opposition** as inadmissible.

(3) Any decision to reject a notice of opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice.

See Rule 13(4) EPC

(4) If a third party provides proof to the European Patent Office during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the European Patent Office shall stay the opposition proceedings unless the third party consents to the continuation of such proceedings. Such comment must be communicated in writing to the European Patent Office; it shall be irrevocable. However, the suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. Paragraphs 2 and 3 shall apply *mutatis mutandis*.

See Rule 16(3) EPC

(3) Where a third party has, in accordance with Article 99, paragraph 5, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may contain for these States claims, a description and drawings which are different from those for the other designated Contracting States.

(3) Any decision to reject **an** opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice **of opposition**.

Rule 56a

Procedure where the proprietor is not entitled

(1) If a third party provides **evidence**, during opposition proceedings or during the opposition period, that he has **instituted** proceedings against the proprietor of the European patent, [...] seeking a judgment that he is entitled to **that** patent, [...] opposition proceedings **shall be stayed** unless the third party **communicates to the European Patent Office in writing his** consent to the continuation of such proceedings. Such **consent** shall be irrevocable. However, [...] proceedings **shall not be stayed** until the Opposition Division has deemed the opposition admissible. **Rule 13**, paragraphs 2 and 3, shall apply *mutatis mutandis*.

(2) Where a third party has, in accordance with Article 99, paragraph 4, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may, **for these States**, contain claims, a description and drawings [...] different from those for the other designated Contracting States.

Rule 57

Preparation of the examination of the opposition

- (1) The Opposition Division shall communicate the opposition to the proprietor of the patent and shall invite him to file his observations and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the Opposition Division.
- (2) If several notices of opposition have been filed, the Opposition Division shall communicate them to the other opponents at the same time as the communication provided for under paragraph 1.
- (3) The observations and any amendments filed by the proprietor of the patent shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division.
- (4) In the case of a notice of intervention in opposition proceedings the Opposition Division may dispense with the application of paragraphs 1 to 3.

Rule 57a

Amendment of the European patent

Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition

Rule 57

Preparation of the examination of the opposition

- (1) The Opposition Division shall communicate the **notice of** opposition to the proprietor of the patent and shall **give** him **the opportunity** to file his observations and to [...] **amend**, where appropriate, [...] the description, claims and drawings within a period to be **specified**.
- (2) If several notices of opposition have been filed, the Opposition Division shall communicate them to the other opponents at the same time as the communication [...] under paragraph 1.
- (3) **The Opposition Division shall communicate any** observations and [...] amendments filed by the proprietor of the patent [...] to the other parties [...] **and** shall **invite them**, if it considers **this** expedient, to reply within a period to be **specified**.
- (4) In the case of an [...] intervention **under Article 105**, the Opposition Division may dispense with the application of paragraphs 1 to 3.

Rule 57a

Amendment of the European patent

Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition

specified in Article 100, even if the respective ground has not been invoked by the opponent.

Rule 58

Examination of opposition

At present there is no equivalent provision in the Implementing Regulations

(1) All communications issued pursuant to Article 101, paragraph 2, and all replies thereto shall be communicated to all parties.

(2) In any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, he shall, where appropriate, be invited to file, where necessary, the description, claims and drawings in amended form.

(3) Where necessary, any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the maintenance of the European patent.

specified in Article 100, even if the **relevant** ground has not been invoked by the opponent.

Rule 58

Examination of opposition

(1) The Opposition Division shall be obliged to examine only those grounds for opposition which are mentioned in the opponent's statement under Rule 55b, paragraph 2(c). Grounds for opposition not invoked by the opponent may be examined by the Opposition Division of its own motion under Article 100 if they would prejudice the maintenance of the European patent.

(2) [...] Communications under Article 101, paragraph 1, second sentence, and all replies thereto shall be sent to all parties.

(3) In any communication to the proprietor of the European patent under Article 101, paragraph 1, second sentence, he shall, where appropriate, be given the opportunity to amend, where necessary, the description, claims and drawings [...]. Where necessary, the communication shall contain a reasoned statement [...] covering all the grounds against the maintenance of the European patent.

See present Rule 58 (4) - (8):

(4) Before the Opposition Division decides on the maintenance of the European patent in the amended form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent.

(5) If disapproval of the text communicated by the Opposition Division is expressed, examination of the opposition may be continued; otherwise, the Opposition Division shall, on expiry of the period referred to in paragraph 4, request the proprietor of the patent to pay, within three months, the fee for the printing of a new specification of the European patent and to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings.

(7) The communication of the Opposition Division under paragraph 5 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

(6) If the acts requested under paragraph 5 are not performed in due time they may still be validly performed within two months of notification of a communication pointing out the failure to

Rule 58a

Maintenance of the European patent in amended form

(1) Before the Opposition Division decides **to maintain** the European patent **as [...]** amended [...], it shall inform the parties **of the text in which** it intends to maintain the patent [...] and shall invite them to **file** their observations within a period of two months if they disapprove of **that text [...]**.

(2) If **a party disapproves** of the text communicated by the Opposition Division [...], examination of the opposition may be continued. **Otherwise**, the Opposition Division shall, on expiry of the period **under** paragraph 1, **invite** the proprietor of the patent

(a) to pay the **prescribed** fee [...], and

(b) to file a translation of any amended claims in the [...] official languages of the European Patent Office other than the language of the proceedings, **within a period to be specified**.

This communication [...] shall indicate the designated Contracting States which require a translation **under** Article 65, paragraph 1.

(3) If the acts **required** under paragraph 2(a) and (b) are not performed in due time they may still be [...] performed within two months of a communication **concerning** the failure to observe the time

observe the time limit, provided that within this two-month period a surcharge equal to twice the fee for printing a new specification of the European patent is paid.

(8) The decision to maintain the European patent as amended shall state which text of the European patent forms the basis for the maintenance thereof.

Rule 59

Requests for documents

Documents referred to by a party to opposition proceedings shall be filed together with the notice of opposition or the written submissions in two copies. If such documents are neither enclosed nor filed in due time upon invitation by the European Patent Office, it may decide not to take into account any arguments based on them.

Rule 60

Continuation of the opposition proceedings by the European Patent Office of its own motion

(1) If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months as from a notification by the European Patent Office of the surrender or lapse.

limit [...], provided that within this [...] period a surcharge [...] is paid. **Otherwise, the patent shall be revoked.**

(4) The decision to maintain the European patent as amended shall state which text of the [...] patent forms the basis for the **decision**.

Rule 59

Requests for documents

Unchanged

Rule 60

Continuation of the opposition proceedings by the European Patent Office of its own motion

(1) If the European patent has been surrendered **in all the designated States or** has lapsed **in all those States**, the opposition proceedings may be continued at the request of the opponent filed within two months **of a communication from** the European Patent Office **informing him of** the surrender or lapse.

(2) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

Rule 61

Transfer of the European patent

Rule 20 shall apply mutatis mutandis to any transfer of the European patent made during the opposition period or during opposition proceedings.

Rule 61a

Documents in opposition proceedings

Part III, Chapter II, of the Implementing Regulations shall apply mutatis mutandis to documents filed in opposition proceedings.

Rule 62

Form of the new specification of the European patent in opposition proceedings

Rule 49, paragraphs 1 and 2, shall apply mutatis mutandis to the new specification of the European patent.

Rule 62a

New certificate for a European patent

Rule 54 shall apply mutatis mutandis to the new specification of the European patent.

(2) *Unchanged*

Rule 61

Transfer of the European patent

Unchanged

Rule 61a

Documents in opposition proceedings

Unchanged

Rule 62

Form of the new specification of the European patent [...]

Unchanged

Rule 62a

New certificate for a European patent

Unchanged

Rule 63
Costs

- (1) Apportionment of costs shall be dealt with in the decision on the opposition. Such apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties.
- (2) A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs. The request shall only be admissible if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.
- (3) The request for a decision by the Opposition Division on the awarding of costs by the registry, stating the reasons on which it is based, must be filed in writing to the European Patent Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for the awarding of costs has been paid.
- (4) The Opposition Division shall take a decision on the request referred to in paragraph 3 without oral proceedings.

Rule 63
Costs

- (1) **The apportionment of costs arising from oral proceedings or the taking of evidence** shall be dealt with in the decision on the opposition. Such apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties.
- (2) **The Opposition Division shall, on request, fix the amount of costs to be paid under a final decision apportioning them.** A bill of costs, with supporting evidence, shall be attached to the request [...]. Costs may be fixed once their credibility is established.
- (3) **A request for a decision by the Opposition Division may be filed [...] within one month [...] of the communication on the fixing of costs under paragraph 2. The request shall be filed in writing [...] and state the grounds** on which it is based. It shall not be deemed to be filed until the **prescribed** fee [...] has been paid.
- (4) The Opposition Division shall **decide** on the request **under** paragraph 3 without oral proceedings.

At present there is no equivalent provision in the Implementing Regulations

[See Article 105 EPC 1973:

(1) In the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. ...

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid. Thereafter the intervention shall, subject to any exceptions laid down in the Implementing Regulations, be treated as an opposition.]

Rule 63a

Intervention of the assumed infringer

(1) Notice of intervention shall be filed within three months of the date on which proceedings referred to in Article 105 are instituted.

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid.

At present there are no equivalent provisions in the Implementing Regulations

Chapter II Limitation procedure

Rule 63b Competence of the Examining Division

Decisions on requests for limitation or revocation of the European patent under Article 105a shall be taken by the Examining Division. Article 18, paragraph 2, shall apply *mutatis mutandis*.

Rule 63c Requirements of the request

- (1) The request for limitation or revocation of a European patent shall be filed in writing.**
- (2) The request shall contain:**
 - (a) particulars of the requester as provided in Rule 26, paragraph 2(c);**
 - (b) the number of the patent whose limitation or revocation is requested, and a list of the Contracting States in which the patent has taken effect;**
 - (c) where appropriate, the names and addresses of the proprietors of the patent for those Contracting States in which the requester is not the proprietor of the patent, with evidence of their assent to the requested limitation or revocation of the patent;**
 - (d) where limitation of the patent is requested, the complete text of the**

amended claims on which the limitation is to be based.

(e) where the requester has appointed a representative, particulars as provided in Rule 26, paragraph 2(d).

Rule 63d

Rejection of the request as inadmissible

(1) The Examining Division shall reject the request for limitation or revocation of the European patent as inadmissible if opposition proceedings in respect of the patent are pending at the time of filing the request. If the opposition was not communicated to the requester under Rule 57 at the time of filing the request, the Examining Division shall order the reimbursement of the limitation fee or revocation fee.

(2) If the Examining Division finds that the request fails to comply with the requirements of Rule 63c, it shall invite the requester to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied, the Examining Division shall reject the request as inadmissible.

Rule 63e

Termination of limitation proceedings

If, at the time of filing an opposition to a European patent, a request for limitation of the patent has been validly

filed, the Examining Division shall terminate the limitation proceedings and order the reimbursement of the limitation fee.

Rule 63f

Examination of the request for limitation

If the request for limitation is admissible, the Examining Division shall examine whether the text of the amended claims constitutes a limitation vis-à-vis the claims as granted or amended in opposition proceedings and complies with the requirements of Article 84 and Article 123, paragraphs 2 and 3.

Rule 63g

Decision on the request

(1) If the examination reveals that a request for revocation is admissible, the Examining Division shall revoke the patent and communicate this to the requester.

(2) If the examination under Rule 63f reveals that a request for limitation is allowable, the Examining Division shall communicate this to the requester and invite him to pay the prescribed fee and to file a translation of the amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period to be specified.

(3) If the requester performs the acts required under paragraph 2 in due time, the Examining Division shall limit the patent.

(4) If the examination under Rule 63f reveals that a request for limitation cannot be allowed, or if the requester fails to perform the acts required under paragraph 2 in due time, the Examining Division shall reject the request.

Rule 63h

Form of the amended European patent specification

The President of the European Patent Office shall decide on the form in which the amended European patent specification is to be published and the information it is to contain.

Present wording

PART VI IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION

[See Article 106 EPC 1973:

(4) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.

(5) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount is in excess of that laid down in the Rules relating to Fees.]

[See Article 106 EPC 1973:

(2) An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.]

Rule 64

Content of the notice of appeal

The notice of appeal shall contain:

Revised wording

PART VI IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION

Chapter I Appeal procedure

Rule 63i Appeal against apportionment and fixing of costs

(1) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.

(2) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount **exceeds** that **of the fee for appeal**.

Rule 63j Surrender or lapse of the patent

The decision of **an** Opposition Division **may be appealed** even if the European patent has been surrendered **in** all the designated States **or** has lapsed **in all those States**.

Rule 64

Content of the notice of appeal and the **statement of grounds**

(1) The notice of appeal shall contain:

- (a) the name and address of the appellant in accordance with the provisions of Rule 26, paragraph 2(c);
- (b) a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested.

Rule 66 EPC

Examination of appeals

- (1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

[See Article 110 EPC 1973:

- (2) In the examination of the appeal, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself.*

- (a) **particulars** of the appellant **as provided in** Rule 26, paragraph 2(c);

- (b) **an indication of** the decision which is impugned, **and**

- (c) **a request defining the subject of the appeal.**

- (2) **In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the impugned decision, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based.**

Rule 64a

Examination of appeals

- (1) Unless otherwise provided, the provisions relating to proceedings before the department which has **taken** the **appealed** decision shall **apply** to appeal proceedings.

- (2) In the examination of the appeal [...] the Board of Appeal shall, **if necessary**, invite the parties [...] to file observations, within a period to be **specified** [...], on communications from another party or issued by itself.

(3) *If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision under appeal was taken by the Legal Division.]*

Rule 65

Rejection of the appeal as inadmissible

(1) If the appeal does not comply with Articles 106 to 108 and with Rule 1, paragraph 1, and Rule 64, sub-paragraph (b), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with the provisions of Rule 64, sub-paragraph (a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

Rule 66

Examination of appeals

(1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.

(3) If the applicant fails to reply in due time to **a communication** under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision **impugned** was taken by the Legal Division.

Rule 65

Rejection of the appeal as inadmissible

(1) If the appeal does not comply with Articles 106 to 108 **or** Rule 1, paragraph 1, **Rule 63i, Rule 64, paragraph 1(b) or (c) or paragraph 2**, the Board of Appeal shall reject it as inadmissible, unless **any** deficiency has been remedied before the relevant time limit **under** Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with [...] **Rule 64, paragraph 1(a)**, it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within **a period to be specified**. If the **deficiencies are not remedied** in **due** time, the Board of Appeal shall reject **the appeal** as inadmissible.

Rule 66

Form of decision of the Board of Appeal

(1) *Deleted - transferred to Rule 64a(1)
EPC*

(2) The decision shall be authenticated by the Chairman of the Board of Appeal and by the competent employee of the registry of the Board of Appeal, either by their signature or by any other appropriate means. The decision shall contain:

- (a) a statement that it is delivered by the Board of Appeal;
- (b) the date when the decision was taken;
- (c) the names of the Chairman and of the other members of the Board of Appeal taking part;
- (d) the names of the parties and their representatives;
- (e) a statement of the issues to be decided;
- (f) a summary of the facts;
- (g) the reasons;
- (h) the order of the Board of Appeal, including, where appropriate, a decision on costs.

Rule 67

Reimbursement of appeal fees

The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall be ordered by the department whose decision has been impugned and, in other cases, by the Board of Appeal.

(2) *Becomes sole paragraph - text unchanged*

Rule 67

Reimbursement of appeal fees

(1) The appeal fee shall be reimbursed

(a) if the appeal is deemed not to have been filed, or

(b) in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation, or

(c) if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the time limit for filing that statement has expired.

(2) The department whose decision is impugned shall order the reimbursement if it revises its decision and considers reimbursement equitable by reason of a substantial procedural violation. In all other cases, matters of reimbursement shall be decided by the Board of Appeal.

At present there are no equivalent provisions in the Implementing Regulations

Chapter II

Petitions for review by the Enlarged Board of Appeal

Rule 67a

Further fundamental procedural defects

A fundamental procedural defect under Article 112a, paragraph 2(d), may have occurred where the Board of Appeal,

(a) contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or

(b) decided on the appeal without deciding on a request relevant to that decision.

Rule 67b
Criminal acts

A petition for review may be based on Article 112a, paragraph 2(e), if a competent court or authority has finally established that the criminal act occurred; a conviction is not necessary.

Rule 67c
Obligation to raise objections

A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where the raising of the objection during the appeal proceedings was impossible.

Rule 67d
Contents of the petition for review

- (1) The petition shall contain:**
 - (a) particulars of the petitioner as provided in Rule 26, paragraph 2(c);**
 - (b) an indication of the decision to be reviewed.**
- (2) The petition shall indicate the facts and evidence on which it is based.**

Rule 67e

Examination of the petition

(1) If the petition does not comply with Article 112a, paragraphs 1, 2 or 4, Rule 67c or Rule 67d, the Enlarged Board of Appeal shall reject it as inadmissible, unless any defect has been remedied before the relevant period under Article 112a, paragraph 4, expires.

(2) If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision of the Board of Appeal and order the re-opening of the proceedings before the Board of Appeal responsible under Rule 10, paragraph 4. The Enlarged Board of Appeal may order that members of the Board of Appeal who participated in taking the decision set aside shall be replaced.

Rule 67f

Procedure in dealing with petitions for review

(1) In proceedings under Article 112a the provisions relating to proceedings before the Boards of Appeal shall apply, unless otherwise provided. Time limits may be shortened.

(2) The Enlarged Board of Appeal

(a) consisting of two legally qualified members and one technically qualified member shall decide on petitions which are clearly inadmissible or unallowable; such decision shall require unanimity;

(b) consisting of four legally qualified members and one technically qualified member shall decide on any petition not rejected under sub-paragraph (a).

(3) The Enlarged Board of Appeal as composed according to paragraph 2(a) shall decide in written proceedings, without the involvement of other parties and on the basis of the petition as filed.

(4) If the petition for review is rejected under paragraph 2(a), the decision shall concisely indicate the ground on which it is based.

Rule 67g

Reimbursement of the fee for petitions for review

The Enlarged Board of Appeal shall order the reimbursement of the fee for a petition for review if

(a) the petition is deemed not to have been filed, or

(b) the proceedings before the Boards of Appeal are reopened, unless such reimbursement is inequitable.

Present wording

PART VII

IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION

Chapter I

Decisions and communications of the European Patent Office

Rule 68

Form of decisions

(1) Where oral proceedings are held before the European Patent Office, the decision may be given orally. Subsequently the decision in writing shall be notified to the parties.

(2) Decisions of the European Patent Office which are open to appeal shall be reasoned and shall be accompanied by a written communication of the possibility of appeal. The communication shall also draw the attention of the parties to the provisions laid down in Articles 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication.

Rule 69

Noting of loss of rights

(1) If the European Patent Office notes that the loss of any right results from the Convention, without any decision concerning the refusal of the European

Revised wording

PART VII

IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION

Chapter I

Decisions and communications of the European Patent Office

Rule 68

Form of decisions

(1) *Unchanged*

(2) Decisions of the European Patent Office which are open to appeal shall be reasoned and shall be accompanied by a written communication of the possibility of appeal, **drawing [...]** the attention of the parties to [...] Articles 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication.

Rule 69

Noting of loss of rights

(1) If the European Patent Office notes that **a loss of rights has occurred**, without any decision concerning the refusal of the European patent application

patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence, it shall communicate this to the person concerned in accordance with the provisions of Article 119.

(2) If the person concerned considers that the finding of the European Patent Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the European Patent Office. Such decision shall be given only if the European Patent Office does not share the opinion of the person requesting it; otherwise the European Patent Office shall inform the person requesting the decision.

Rule 70

Signature, name, seal

(1) Any decision, communication and notice from the European Patent Office is to be signed by and to state the name of the employee responsible.

(2) Where the documents mentioned in paragraph 1 are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may also be dispensed with. The same applies to pre-printed notices and communications.

or the grant, revocation or maintenance of the European patent, or the taking of evidence, it shall communicate this to the **party** concerned [...].

(2) If the **party** concerned considers that the finding of the European Patent Office is inaccurate, **it** may, within two months **of [...]** the communication **under** paragraph 1, apply for a decision on the matter [...]. [...] The European Patent Office shall **take such decision only** if **it** does not share the opinion of the person requesting it; otherwise, **it** shall inform the **party** [...].

Rule 70

Signature, name, seal

(1) Any decisions, **summonses**, **notices and** communications [...] from the European Patent Office **are** to be signed by and to state the name of the employee responsible.

(2) Where **a** document **referred to** in paragraph 1 **is** produced by the employee responsible using a computer, a seal may replace the signature. Where the document **is** produced automatically by a computer, the employee's name may also be dispensed with. The same **shall apply** to pre-printed notices and communications.

[See Article 115 EPC 1973

(1) ... Such observations must be filed in writing and must include a statement of the grounds on which they are based. ...

(2) The observations referred to in paragraph 1 shall be communicated to the applicant for or proprietor of the patent who may comment on them.]

Chapter II

Oral proceedings and taking of evidence

Rule 71

Summons to oral proceedings

(1) The parties shall be summoned to oral proceedings provided for in Article 116 and their attention shall be drawn to paragraph 2 of this Rule. At least two months' notice of the summons shall be given unless the parties agree to a shorter period.

(2) If a party who has been duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without him.

Chapter II

Observations by third parties

Rule 70a

Observations by third parties

(1) Any observations by a third party shall be filed in writing and state the grounds on which they are based.

(2) Any such observations shall be communicated to the applicant for or proprietor of the patent, who may comment on them.

Chapter III

Oral proceedings and taking of evidence

Rule 71

Summons to oral proceedings

(1) The parties shall be summoned to oral proceedings **under** Article 116, **drawing** their attention [...] to paragraph 2 of this Rule. At least two months' notice of the summons shall be given unless the parties agree to a shorter period.

(2) If a party [...] duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without **it**.

Rule 71a

Preparation of oral proceedings

(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. Rule 84 shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

(2) If the applicant or patent proprietor has been notified of the grounds prejudicing the grant or maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis.

Rule 72

Taking of evidence by the European Patent Office

(1) Where the European Patent Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If oral

Rule 71a

Preparation of oral proceedings

Unchanged

Rule 72

Decision on taking of evidence

(1) Where the European Patent Office considers it necessary to hear **a party, witness or expert**, or to carry out an inspection, it shall **take** a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If **the hearing of a witness**

evidence of witnesses and experts is requested by a party, the decision of the European Patent Office shall determine the period of time within which the party filing the request must make known to the European Patent Office the names and addresses of the witnesses and experts whom it wishes to be heard.

At present there is no equivalent provision in the Implementing Regulations

[See Article 117 EPC 1973:

(3) If the European Patent Office considers it necessary for a party, witness or expert to give evidence orally, it shall either:

(a) issue a summons to the person concerned to appear before it ...

See present Rule 72

(2) At least two months' notice of a summons issued to a party, witness or expert to give evidence shall be given unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision mentioned in paragraph 1, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;

(b) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke under the provisions of Rule 74, paragraphs 2 to 4;

or expert is requested by a party, the decision [...] shall **specify** the period [...] within which the **requester** must make known [...] the **name and address** of **any witness or expert concerned**.

Rule 72a

Summons to give evidence before the European Patent Office

(1) A summons to give evidence before the European Patent Office shall be issued to the parties, witnesses or experts concerned.

(2) At least two months' notice of a summons issued to a party, witness or expert to **testify** shall be given unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision **under Rule 72**, indicating [...] the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses **or** experts are to be heard;

(b) the names of the parties [...] and particulars of the rights which the witnesses or experts may invoke under [...] Rule 74, paragraphs 2 to 4;

(c) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he inform the European Patent Office within a time limit to be fixed by the Office whether he is prepared to appear before it.

At present there is no equivalent provision in the Implementing Regulations

[See Article 117 EPC 1973:

(2) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.]

[See present Rule 72

(3) Before a party, witness or expert may be heard, he shall be informed that the European Patent Office may request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or in an equally binding form.

(4) The parties may attend an investigation and may put relevant questions to the testifying parties, witnesses and experts.

At present there is no equivalent provision in the Implementing Regulations

[See Article 117 EPC 1973:

(4) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow his evidence to be heard by a competent court

(c) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence under **Rule 72c**, and **an invitation to** inform the European Patent Office, within a **period** to be **specified**, whether he is prepared to appear before it.

Rule 72b

Examination of evidence before the European Patent Office

(1) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.

(2) Before a party, witness or expert may be heard, he shall be informed that the European Patent Office may request the competent court in the country of residence of the person concerned to re-examine his testimony under oath or in an equally binding form.

(3) The parties may attend an investigation and may put relevant questions to the testifying party, witness or expert.

Rule 72c

Hearing by a competent national court

(1) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow him to be heard by a competent court in his country of residence. If this is

in his country of residence. On receipt of such a request, or if there has been no reply to the summons by the expiry of a period fixed by the European Patent Office in the summons, the European Patent Office may, in accordance with the provisions of Article 131, paragraph 2, request the competent court to hear the person concerned.

(5) If a party, witness or expert gives evidence before the European Patent Office, the latter may, if it considers it advisable for the evidence to be given on oath or in an equally binding form, request the competent court in the country of residence of the person concerned to re-examine his evidence under such conditions.

(6) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence on oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert either through the intermediary of the court or directly.]

Rule 73

Commissioning of experts

(1) The European Patent Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

requested, or if no reply is received within the period specified in the summons, the European Patent Office may, in accordance with Article 131, paragraph 2, request the competent court to hear the person concerned.

(2) If a party, witness or expert has been heard by the European Patent Office, the latter may, if it considers it advisable for the testimony to be given under oath or in an equally binding form, issue a request under Article 131, paragraph 2, to the competent court in the country of residence of the person concerned to re-examine his testimony under such conditions.

(3) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence under oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert either through the intermediary of the court or directly.

Rule 73

Commissioning of experts

(1) The European Patent Office shall decide in what form the **opinion of** an expert whom it appoints shall be submitted.

(2) The terms of reference of the expert shall include:

- (a) a precise description of his task;
 - (b) the time limit laid down for the submission of the expert report;
 - (c) the names of the parties to the proceedings;
 - (d) particulars of the rights which he may invoke under the provisions of Rule 74, paragraphs 2 to 4.
- (3) A copy of any written report shall be submitted to the parties.
- (4) The parties may object to an expert. The department of the European Patent Office concerned shall decide on the objection.

Rule 74

Costs of taking of evidence

- (1) The taking of evidence by the European Patent Office may be made conditional upon deposit with it, by the party who requested the evidence to be taken, of a sum the amount of which shall be fixed by reference to an estimate of the costs.
- (2) Witnesses and experts who are summoned by and appear before the European Patent Office shall be entitled to appropriate reimbursement of expenses

(2) The terms of reference of the expert shall include:

- (a) *Unchanged*
 - (b) the **period specified** for the submission of **his opinion**;
 - (c) *Unchanged*
 - (d) particulars of the rights which he may invoke under [...] Rule 74, paragraphs 2 to 4.
- (3) A copy of any written **opinion** shall be submitted to the parties.
- (4) *Unchanged*

Rule 74

Costs of taking of evidence

- (1) The taking of evidence by the European Patent Office may be made conditional upon deposit with it, by the party [...] **requesting** the evidence to be taken, of **an amount** to be fixed by reference to an estimate of the costs.
- (2) Witnesses **or** experts who are summoned by and appear before the European Patent Office shall be entitled to appropriate reimbursement of expenses

for travel and subsistence. An advance for these expenses may be granted to them. The first sentence shall apply to witnesses and experts who appear before the European Patent Office without being summoned by it and are heard as witnesses or experts.

(3) Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks.

(4) The Administrative Council shall lay down the details governing the implementation of the provisions of paragraphs 2 and 3. Payment of amounts due pursuant to these paragraphs shall be made by the European Patent Office.

Rule 75

Conservation of evidence

(1) On request, the European Patent Office may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision which it may be called upon to take with regard to an existing European patent application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in

for travel and subsistence. An advance for these expenses may be granted to them.

This [...] shall also apply to persons who appear before the European Patent Office without being summoned by it and are heard as witnesses or experts.

(3) *Unchanged*

(4) The Administrative Council shall lay down the details [...] implementing [...] paragraphs 2 and 3. **Any [...] amounts due under these provisions** shall be **paid** by the European Patent Office.

Rule 75

Conservation of evidence

(1) On request, the European Patent Office may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision which it may be called upon to take with regard to **a [...] European** patent application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in

sufficient time to allow him to attend. He may ask relevant questions.

(2) The request shall contain:

(a) the name and address of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) sufficient identification of the European patent application or European patent in question;

(c) the designation of the facts in respect of which evidence is to be taken;

(d) particulars of the way in which evidence is to be taken;

(e) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence.

(3) The request shall not be deemed to have been filed until the fee for conservation of evidence has been paid.

(4) The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the European Patent Office required to take the decision liable to be affected by the facts to be established. The provisions of the Convention with regard to the taking of evidence in proceedings before the European Patent Office shall be applicable.

sufficient time to allow him to attend. He may ask relevant questions.

(2) The request shall contain:

(a) **particulars** of the **requester [...]** as **provided in** Rule 26, paragraph 2(c);

(b) *Unchanged*

(c) **an indication** of the facts in respect of which evidence is to be taken;

(d) - (e) *Unchanged*

(3) The request shall not be deemed to have been filed until the **prescribed** fee [...] has been paid.

(4) The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the European Patent Office **which would have** to take the decision liable to be affected by the facts to be established. The provisions [...] with regard to the taking of evidence in proceedings before the European Patent Office shall **apply**.

Rule 76

Minutes of oral proceedings and of taking of evidence

- (1) Minutes of oral proceedings and of the taking of evidence shall be drawn up containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.
- (2) The minutes of the testimony of a witness, expert or party shall be read out or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. If his approval is not given, his objections shall be noted.
- (3) The minutes shall be authenticated by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence, either by their signature or by any other appropriate means.
- (4) The parties shall be provided with a copy of the minutes.

Rule 76

Minutes of oral proceedings and of taking of evidence

Unchanged

Chapter III

Notifications

Rule 77

General provisions on notifications

- (1) In proceedings before the European Patent Office, any notification to be made shall take the form either of the original document, a copy thereof certified by, or bearing the seal of, the European Patent Office or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.
- (2) Notification shall be made:
- (a) by post in accordance with Rule 78;
- (b) by delivery on the premises of the European Patent Office in accordance with Rule 79;
- (c) by public notice in accordance with Rule 80, or
- (d) by such technical means of communication as determined by the President of the European Patent Office and under the conditions laid down by him governing their use.
- (3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the provisions applicable to the said office in national proceedings.

Chapter IV

Notifications

Rule 77

General provisions [...]

- (1) *Unchanged*
- (2) Notification shall be made:
- (a) - (c) *Unchanged*
- (d) by such technical means of communication as **are** determined by the President of the European Patent Office and under the conditions laid down by him [...].
- (3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the **law** applicable to **that** office in national proceedings.

Rule 78

Notification by post

(1) Decisions incurring a time limit for appeal, summonses and other documents as decided on by the President of the European Patent Office shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter.

(2) Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

(3) Notification by registered letter, whether or not with advice of delivery, shall be deemed to have been effected even if acceptance of the letter has been refused.

(4) To the extent that notification by post is not covered by paragraphs 1 to 3, the law of the State on the territory of which the notification is made shall apply.

Rule 78

Notification by post

(1) Decisions incurring a [...] **period** for appeal **or a petition for review**, summonses and other **such** documents as **determined** by the President of the European Patent Office shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter.

(2) - (3) *Unchanged*

(4) To the extent that notification by post is not covered by paragraphs 1 to 3, the law of the State **in** which the notification is made shall apply.

Rule 79

Notification by delivery by hand

Notification may be effected on the premises of the European Patent Office by delivery by hand of the document to the addressee, who shall on delivery acknowledge its receipt. Notification shall be deemed to have taken place even if the addressee refuses to accept the document or to acknowledge receipt thereof.

Rule 80

Public notification

(1) If the address of the addressee cannot be established, or if notification in accordance with Rule 78, paragraph 1, has proved to be impossible even after a second attempt by the European Patent Office, notification shall be effected by public notice.

(2) The President of the European Patent Office shall determine how the public notice is to be given and the beginning of the period of one month on the expiry of which the document shall be deemed to have been notified.

Rule 81

Notification to representatives

(1) If a representative has been appointed, notifications shall be addressed to him.

Rule 79

Notification by delivery by hand

Notification may be effected on the premises of the European Patent Office by delivery by hand of the document to the addressee, who shall on delivery acknowledge its receipt. Notification shall be deemed to have **been effected** even if the addressee refuses to accept the document or to acknowledge receipt thereof.

Rule 80

Public notification

Unchanged

Rule 81

Notification to representatives

(1) *Unchanged*

(2) If several such representatives have been appointed for a single interested party, notification to any one of them shall be sufficient.

(3) If several interested parties have a common representative, notification of a single document to the common representative shall be sufficient.

Rule 82

Irregularities in the notification

Where a document has reached the addressee, if the European Patent Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the European Patent Office as the date of receipt.

Chapter IV

Time limits

Rule 83

Calculation of time limits

(1) Periods shall be laid down in terms of full years, months, weeks or days.

(2) Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another

(2) If several [...] representatives have been appointed for a single [...] party, notification to any one of them shall be sufficient.

(3) If several [...] parties have a common representative, notification of a single document to the common representative shall be sufficient.

Rule 82

Irregularities in the notification

Unchanged

Chapter V

Time limits

Rule 83

Calculation of **periods**

Unchanged

period. Where the procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.

(3) When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

(4) When a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

(5) When a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.

Rule 84

Duration of time limits

Where the Convention or these Implementing Regulations specify a period to be determined by the European Patent Office, such period shall be not less than two months nor more than four months; in certain special circumstances it may be up to six months. In certain special cases, the period may be extended upon request, presented before the expiry of such period.

Rule 84a

Late receipt of documents

(1) A document received late at the European Patent Office shall be deemed to have been received in due time if it was posted, or delivered to a recognised delivery service, in due time before the expiry of the time limit in accordance with the conditions laid down by the President of the European Patent Office, unless the document was received later than three months after expiry of the time limit.

(2) Paragraph 1 shall apply *mutatis mutandis* to the time limits provided for in the Convention where transactions are carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

Rule 84

Periods specified by the European Patent Office

Unless otherwise provided, a period to be **specified** by the European Patent Office [...] shall be **neither** less than two months nor more than four months; in [...] special circumstances it may be up to six months. In certain [...] cases, the period may be extended upon request, presented before the expiry of such period.

Rule 84a

Late receipt of documents

(1) A document received late at the European Patent Office shall be deemed to have been received in due time if it was posted, or delivered to a recognised delivery service, in due time before [...] expiry of the **period** in accordance with the conditions laid down by the President of the European Patent Office, unless the document was received later than three months after expiry of the **period**.

(2) Paragraph 1 shall apply *mutatis mutandis* to **any period** [...] where transactions are carried out with the competent authority in accordance with Article 75, paragraphs 1(b) or [...] 2(b).

Rule 85

Extension of time limits

(1) If a time limit expires on a day on which one of the filing offices of the European Patent Office in the sense of Article 75, paragraph 1(a) is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered there, the time limit shall extend until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

(2) If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the European Patent Office, the time limit shall extend to the first day following the end of the period of interruption or dislocation for parties resident in the State concerned or who have appointed representatives with a place of business in that State. The first sentence shall apply *mutatis mutandis* to the period referred to in Article 77, paragraph 5. In the case where the State concerned is the State in which the European Patent Office is located, this provision shall apply to all parties. The duration of the above-mentioned period shall be as stated by the President of the European Patent Office.

Rule 85

Extension of **periods**

(1) If a **period** expires on a day on which one of the filing offices of the European Patent Office in the sense of **Rule 24, paragraph 1**, is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered there, the **period** shall extend **to** the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

(2) If a **period** expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the European Patent Office, the **period** shall extend to the first day following the end of the **interval** of interruption or dislocation for parties resident in the State concerned or who have appointed representatives with a place of business in that State. The first sentence shall apply *mutatis mutandis* to the period referred to in **Rule 25a, paragraph 2. [...] Where** the State concerned is the State in which the European Patent Office is located, this provision shall apply to all parties. The duration of the above-mentioned **interval of interruption or dislocation** shall be as stated by the President of the European Patent Office.

(3) Paragraphs 1 and 2 shall apply *mutatis mutandis* to the time limits provided for in the Convention in the case of transactions carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

(4) If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates the proper functioning of the European Patent Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month after the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as stated by the President of the European Patent Office.

(5) Without prejudice to paragraphs 1 to 4, evidence may be offered that on any of the ten days preceding the day of expiration of a time limit the mail service was interrupted or subsequently dislocated on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the party or his representative resides or has his place of business or is staying. If such circumstances are proven to the satisfaction of the European Patent Office, a document received late shall be deemed to have been received in due time provided that the mailing has been effected within five days after the mail service was resumed.

(3) Paragraphs 1 and 2 shall apply *mutatis mutandis* to **any periods where [...]** transactions **are** carried out with the competent authority in accordance with Article 75, paragraphs 1(b) or 2(b).

(4) If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates the proper functioning of the European Patent Office so that any communication from the Office to parties concerning the expiry of a **period** is delayed, acts to be completed within such a **period** may still be [...] completed within one month [...] of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as stated by the President of the European Patent Office.

(5) Without prejudice to paragraphs 1 to 4, evidence may be offered that on any of the ten days preceding the day of **expiry** of a **period** the mail service was interrupted or subsequently dislocated on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the party or his representative resides or has his place of business or is staying. If such circumstances are proven to the satisfaction of the European Patent Office, a document received late shall be deemed to have been received in due time provided that the mailing has been effected within five days after the mail service was resumed.

Rule 85a

Period of grace for payment of fees

(1) If the filing fee, the search fee, a designation fee or the national basic fee have not been paid within the time limits provided for in Article 78, paragraph 2, Article 79, paragraph 2, Rule 15, paragraph 2, Rule 25, paragraph 2, or Rule 107, paragraph 1(c), (d) and (e), they may still be validly paid within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.

(2) Designation fees in respect of which the applicant has dispensed with notification under paragraph 1 may still be validly paid within a period of grace of two months of expiry of the normal time limits referred to in paragraph 1, provided that within this period a surcharge is paid.

[see Article 121 EPC 1973:

(2) The request shall be filed in writing within two months of the date on which either the decision to refuse the application or the communication that the application is deemed to be withdrawn was notified. The omitted act must be completed within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.]

Rule 85a

Period of grace for payment of fees

Deleted

Rule 85a

Further processing

(1) Further processing under Article 121, paragraph 1, shall be requested by payment of the prescribed fee within two months of the communication concerning 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 under Rule 6(1), Rule 14a, paragraph 1(a), Rule 25d, paragraph 3, first sentence, Rule 37, paragraph 2, Rule 38, paragraph 2,

[See Article 121 EPC 1973:

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

Rule 85b

Period of grace for the filing of the request for examination

If the request for examination has not been filed within the time limit provided for in Article 94, paragraph 2, or Rule 107, paragraph 1(f), it may still be validly filed within a period of grace of one month from notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid.

[See Article 122 EPC 1973:

(2) The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-payment of a renewal fee, the period specified in Article 86, paragraph 2, shall be deducted from the period of one year.]

Rules 41 and 41a, and Rule 69, paragraph 2, as well as in respect of the periods referred to in Article 121, paragraph 4.

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

Rule 85b

Period of grace for the filing of the request for examination

Deleted

Rule 85b

Re-establishment of rights

(1) Any request for re-establishment of rights under Article 122, paragraph 1, shall be filed in writing within two months of the removal of the cause of non-compliance with the period, or at the latest within one year of the expiry of the unobserved time limit. Any request for re-establishment of rights in respect of the period specified in Article 87, paragraph 1, shall be filed within two months of the expiry of that period. The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.

[See Article 122 EPC 1973:

(3) The application must state the grounds on which it is based, and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for re-establishment of rights has been paid.]

[See Article 122 EPC 1973:

(4) The department competent to decide on the omitted act shall decide upon the application.

Chapter VI **Amendments and corrections**

Rule 86

Amendment of the European patent application

(1) Before receiving the European search report the applicant may not amend the description, claims or drawings of a European patent application except where otherwise provided.

(2) After receiving the European search report and before receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings.

(2) The request shall state the grounds on which it is based and shall set out the facts on which it relies. The omitted act shall be completed within the relevant period for filing the request according to paragraph 1.

(3) Re-establishment of rights shall be ruled out in respect of any period for which further processing under Article 121 is available and in respect of the period for requesting re-establishment of rights.

(4) The department competent to decide on the omitted act shall decide on the request for re-establishment of rights.

Chapter VI **Amendments and corrections**

Rule 86

Amendment of the European patent application

(1) Before receiving the European search report the applicant may not amend the description, claims or drawings of a European patent application **unless** otherwise provided.

(2) After **receipt of** the European search report [...], the applicant may, of his own volition, amend the description, claims and drawings.

(3) After receipt of the first communication from the Examining Division the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.

(4) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

Rule 87

Different claims, description and drawings
for different States

If the European Patent Office notes that, in respect of one or some of the designated Contracting States, the content of an earlier European patent application forms part of the state of the art pursuant to Article 54, paragraphs 3 and 4, or if it is informed of the existence of a prior right under Article 139, paragraph 2, the European patent application or European patent may contain for such State or States claims and, if the European Patent Office considers it necessary, a description and drawings which are different from those for the other designated Contracting States.

(3) - (4) *Unchanged*

Rule 87

Different claims, description and drawings
for different States

If the European Patent Office [...] is informed of the existence of a prior right under Article 139, paragraph 2, the European patent application or European patent may, [...] for such State or States, **contain** claims and, **where** [...] necessary, a description and drawings which are different from those for the other designated Contracting States.

Rule 88

Correction of errors in documents filed with the European Patent Office

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

Rule 89

Correction of errors in decisions

In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected.

At present there is no equivalent provision in the Implementing Regulations

Rule 88

Correction of errors in documents filed with the European Patent Office

Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns **the** description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

Rule 89

Correction of errors in decisions

Unchanged

Chapter VII
Information on prior art

Rule 89a
Information on prior art

The European Patent Office may invite the applicant to provide, within a period to be specified, information on:

(a) search reports drawn up on patent applications in national or regional proceedings and concerning an invention to which the European patent application relates;

Chapter VI

Interruption of proceedings

Rule 90

Interruption of proceedings

(1) Proceedings before the European Patent Office shall be interrupted:

(a) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Article 134, proceedings shall be interrupted only on application by such representative;

(b) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the European Patent Office;

(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the European Patent Office.

(b) other prior art taken into consideration in the examination of national or regional patent applications and concerning an invention to which the European patent application relates.

Chapter VIII

Interruption of proceedings

Rule 90

Interruption of proceedings

(1) Proceedings before the European Patent Office shall be interrupted:

(a) *Unchanged*

(b) in the event of the applicant for or proprietor of a [...] patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings [...];

(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a [...] patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings [...].

(2) When, in the cases referred to in paragraph 1 (a) and (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings before the European Patent Office, the European Patent Office shall communicate to such person and to any interested third party that the proceedings shall be resumed as from a date to be fixed by the European Patent Office.

(3) In the case referred to in paragraph 1(c), the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the European Patent Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall communicate to the applicant for or proprietor of the patent:

(a) where Article 133, paragraph 2, is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified, or

(b) where Article 133, paragraph 2, is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

(2) When, in the cases referred to in paragraph 1 (a) **or** (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings [...], **it shall notify** such person and, **where applicable**, [...] any [...] third party that the proceedings **will** be resumed as from a **specified** date [...].

(3) In the case referred to in paragraph 1(c), the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the [...] Office has **informed** the other parties [...] of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall communicate to the applicant for or proprietor of the patent:

(a) *Unchanged*

(b) **otherwise**, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

(4) The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the patent at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed up to the end of two months after such date.

Chapter VII

Waiving of enforced recovery procedures

Rule 91

Waiving of enforced recovery procedures

The President of the European Patent Office may waive action for the enforced recovery of any sum due if the sum to be recovered is minimal or if such recovery is too uncertain.

Chapter VIII

Information to the public

Rule 92

Entries in the Register of European Patents

(1) The Register of European Patents shall contain the following entries:

(4) **Any periods**, other than **those** for [...] requesting [...] examination and [...] paying [...] renewal fees, in force [...] at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed **within** two months after such date.

Deleted

Rule 91

Waiving of enforced recovery procedures

Deleted

Chapter IX

Information to the public

Rule 92

Entries in the Register of European Patents

(1) The Register of European Patents shall contain the following entries:

(a) number of the European patent application;	(a) <i>Unchanged</i>
(b) date of filing of the European patent application;	(b) date of filing of the [...] application;
(c) title of the invention;	(c) <i>Unchanged</i>
(d) classification code given to the European patent application;	(d) classification symbols assigned to the [...] application;
(e) the Contracting States designated;	(e) <i>Unchanged</i>
(f) family name, given names, address and the State in which the residence or principal place of business of the applicant for or proprietor of the European patent is located;	(f) particulars of the applicant for or proprietor of the [...] patent [...] as provided in Rule 26, paragraph 2(c) ;
(g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 18, paragraph 1;	(g) <i>Unchanged</i>
(h) family name, given names and address of the place of business of the representative of the applicant for or proprietor of the patent referred to in Article 134; in the case of several representatives only the family name, given names and address of the place of business of the representative first named, followed by the words "and others", shall be entered; however, in the case of an association referred to in Rule 101, paragraph 9, only the name and address of the association shall be entered;	(h) particulars of the representative of the applicant for or proprietor of the patent as provided in Rule 26, paragraph 2(d) ; in the case of several representatives only the particulars of the representative first named, followed by the words "and others" [...] and , in the case of an association referred to in Rule 101, paragraph 9, only the name and address of the association [...];

(i) priority data (date, State and file number of the previous application);	(i) <i>Unchanged</i>
(j) in the event of a division of the European patent application, the numbers of the European divisional applications;	(j) in the event of a division of the [...] application, the numbers of all the [...] divisional applications;
(k) in the case of European divisional applications and a new European patent application under Article 61, paragraph 1(b), the information referred to under sub-paragraphs (a), (b) and (i) with regard to the earlier European patent application;	(k) in the case of a divisional application [...] or a new [...] application under Article 61, paragraph 1(b), the information referred to in sub-paragraphs (a), (b) and (i) with regard to the earlier [...] application;
(l) date of publication of the European patent application and where appropriate date of the separate publication of the European search report;	(l) date of publication of the [...] application and, where appropriate, date of the separate publication of the European search report;
(m) date of filing of the request for examination;	(m) <i>Unchanged</i>
(n) date on which the European patent application is refused, withdrawn or deemed to be withdrawn;	(n) date on which the [...] application is refused, withdrawn or deemed to be withdrawn;
(o) date of publication of the mention of the grant of the European patent;	(o) <i>Unchanged</i>
(p) date of lapse of the European patent in a Contracting State during the opposition period and, where appropriate, pending a final decision on opposition;	(p) <i>Unchanged</i>
(q) date of filing opposition;	(q) <i>Unchanged</i>
(r) date and purport of the decision on opposition;	(r) <i>Unchanged</i>

(s) dates of suspension and resumption of proceedings in the cases referred to in Rule 13;

(t) dates of interruption and resumption of proceedings in the case referred to in Rule 90;

(u) date of re-establishment of rights provided that an entry has been made in accordance with sub-paragraph (n) or sub-paragraph (r);

(v) the filing of a request to the European Patent Office pursuant to Article 135;

(w) rights and transfer of such rights over a European patent application or European patent where these are recorded pursuant to these Implementing Regulations.

(2) The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the Register of European Patents.

(3) Extracts from the Register of European Patents shall be delivered on request on payment of an administrative fee.

Rule 93

Parts of the file not for inspection

The parts of the file which shall be excluded from inspection pursuant to Article 128, paragraph 4, shall be:

(s) dates of suspension and resumption of proceedings in the cases referred to in Rules 13 **and 56a**;

(t) *Unchanged*

(u) date of re-establishment of rights **where** an entry has been made **under** sub-paragraphs (n) or [...] (r);

(v) the filing of a request **for conversion under** Article 135, **paragraph 3**;

(w) rights and transfer of such rights **relating to an [...]** application or **a** European patent where [...] these Implementing Regulations **provide that they shall be** recorded.

(2) *Unchanged*

(3) *Deleted*

Rule 93

Parts of the file **excluded from** inspection

The parts of the file which shall be excluded from inspection **under** Article 128, paragraph 4, shall be:

- (a) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal;
- (b) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties;
- (c) the designation of the inventor, if he has waived his right to be mentioned under Rule 18, paragraph 1;
- (d) any other document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent.

Rule 94

Procedures for the inspection of files

- (1) Inspection of the files of European patent applications and patents shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way.
- (2) The President of the European Patent Office shall determine all file-inspection arrangements, including the circumstances in which an administrative fee is payable.

(a) *Unchanged*

(b) draft decisions and **notices**, and all other documents, used for the preparation of decisions and **notices**, which are not communicated to the parties;

(c) *Unchanged*

(d) any other document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the [...] **European** patent.

Rule 94

Procedures for the inspection of files

Unchanged

Rule 95

Communication of information contained in the files

Subject to the restrictions provided for in Article 128, paragraphs 1 to 4, and in Rule 93, the European Patent Office may, upon request, communicate information concerning any file of a European patent application or European patent subject to the payment of an administrative fee. However, the European Patent Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

Rule 95a

Constitution, maintenance and preservation of files

(1) The European Patent Office shall constitute, maintain and preserve files relating to all European patent applications and patents.

(2) The President of the European Patent Office shall determine the form in which the files relating to European patent applications and patents shall be constituted, maintained and preserved.

(3) Documents incorporated in an electronic file shall be considered to be originals.

(4) Files relating to European patent applications and patents shall be preserved for at least five years from the end of the year in which:

Rule 95

Communication of information contained in the files

Subject to the restrictions **laid down** in Article 128, paragraphs 1 to 4, and in Rule 93, the European Patent Office may, upon request, communicate information concerning any file **relating to** a European patent application or European patent subject to the payment of an administrative fee. However, the European Patent Office may **refer to** the option **of file** inspection **where** it deems this to be appropriate in view of the quantity of information to be supplied.

Rule 95a

Constitution, maintenance and preservation of files

(1) *Unchanged*

(2) The President of the European Patent Office shall determine the form in which **these** files [...] shall be constituted, maintained and preserved.

(3) *Unchanged*

(4) **Any** files [...] shall be preserved for at least five years from the end of the year in which:

(a) the application is refused or withdrawn or is deemed to be withdrawn;

(b) the patent is revoked pursuant to opposition proceedings; or

(c) the patent or the extended term or corresponding protection under Article 63, paragraph 2, lapses in the last of the designated States.

(5) Without prejudice to paragraph 4, files relating to European patent applications which have given rise to divisional applications under Article 76 or new applications under Article 61, paragraph 1(b), shall be preserved for at least the same period as the files relating to any one of these last applications. The same shall apply to files relating to any resulting European patents.

Rule 96

Additional publications by the European Patent Office

(1) The President of the European Patent Office may provide that, and in what form, the data referred to in Article 128, paragraph 5, shall be communicated to third parties or published.

(2) The President of the European Patent Office may provide for the publication of new or amended claims received after the time mentioned in Rule 49, paragraph 3, the form of such publication and the entry in the European Patent Bulletin of particulars concerning such claims.

(a) *Unchanged*

(b) the patent is revoked **in** opposition proceedings; or

(c) the patent or the [...] corresponding protection under Article 63, paragraph 2, lapses in the last of the designated States.

(5) Without prejudice to paragraph 4, files relating to [...] applications which have given rise to divisional applications under Article 76 or new applications under Article 61, paragraph 1(b), shall be preserved for at least the same period as the files relating to any one of these last applications. The same shall apply to files relating to any resulting European patents.

Rule 96

Additional publications by the European Patent Office

Deleted

Chapter IX

Legal and administrative co-operation

Rule 97

Communications between the European Patent Office and the authorities of the Contracting States

(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the above central industrial property offices.

(2) Expenditure in respect of communications under paragraph 1 shall be chargeable to the authority making the communications, which shall be exempt from fees.

Rule 98

Inspection of files by or via courts or authorities of the Contracting States

(1) Inspection of the files of European patent applications or of European patents by courts or authorities of the Contracting States shall be of the original documents or of copies thereof; Rule 94 shall not apply.

(2) Courts or Public Prosecutors' Offices of the Contracting States may, in the course of their proceedings, communicate

Chapter X

Legal and administrative co-operation

Rule 97

Communications between the European Patent Office and the authorities of the Contracting States

(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of **this** Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the **said** central industrial property offices.

(2) Expenditure in respect of communications under paragraph 1 shall be **borne by** the authority making the communications, which shall be exempt from fees.

Rule 98

Inspection of files by or via courts or authorities of the Contracting States

(1) *Unchanged*

(2) Courts or Public Prosecutors' Offices of the Contracting States may, in the course of their proceedings, communicate

to third parties files or copies thereof transmitted to them by the European Patent Office. Such communications shall be effected in accordance with the conditions laid down in Article 128; they shall not incur the payment of the administrative fee.

(3) The European Patent Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors' Offices of the Contracting States, indicate such restrictions as may, under Article 128, paragraphs 1 and 4, be applicable to the communication to third parties of files concerning a European patent application or a European patent.

Rule 99

Procedure for letters rogatory

(1) Each Contracting State shall designate a central authority which will undertake to receive letters rogatory issued by the European Patent Office and to transmit them to the authority competent to execute them.

(2) The European Patent Office shall draw up letters rogatory in the language of the competent authority or shall attach to such letters rogatory a translation into the language of that authority.

(3) Subject to the provisions of paragraphs 5 and 6, the competent authority shall apply its own law as to the procedures to be followed in executing such requests. In particular, it shall apply appropriate measures of compulsion in accordance with its own law.

to third parties files or copies thereof transmitted to them by the European Patent Office. Such communications shall be effected in accordance with [...] Article 128 **and shall not be subject to any fee.**

(3) The European Patent Office shall, **when transmitting** the files [...], **draw attention to the** restrictions **which** may, under Article 128, paragraphs 1 and 4, **apply to file inspection by** third parties [...].

Rule 99

Procedure for letters rogatory

(1) Each Contracting State shall designate a central authority [...] to receive letters rogatory issued by the European Patent Office and to transmit them to the authority competent to execute them.

(2) *Unchanged*

(3) Subject to [...] paragraphs 5 and 6, the competent authority shall apply **national** law as to the procedures to be followed in executing such requests **and**, in particular, **as to the** appropriate measures of compulsion [...].

(4) If the authority to which the letters rogatory are transmitted is not competent to execute them, the letters rogatory shall be sent forthwith to the central authority referred to in paragraph 1. That authority shall transmit the letters rogatory either to the competent authority in that State, or to the European Patent Office where no authority is competent in that State.

(5) The European Patent Office shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place and shall inform the parties, witnesses and experts concerned.

(6) If so requested by the European Patent Office, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority.

(7) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the Organisation to reimburse any fees paid to experts and interpreters and the costs incurred by the procedure of paragraph 6.

(8) If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the

(4) *Unchanged*

(5) *Unchanged*

(6) *Unchanged*

(7) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the Organisation to reimburse any fees paid to experts **or** interpreters and the costs **arising from** the procedure **under** paragraph 6.

(8) If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the

European Patent Office, appoint a suitable person to do so. When seeking the consent of the European Patent Office, the competent authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, the Organisation shall reimburse any costs incurred; without such consent, the Organisation shall not be liable for such costs.

Chapter X Representation

Rule 100

Appointment of a common representative

(1) If there is more than one applicant and the request for the grant of a European patent does not name a common representative, the applicant first named in the request shall be considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative this representative shall be considered to be the common representative unless the first named applicant has appointed a professional representative. The same shall apply *mutatis mutandis* to third parties acting in common in filing notice of opposition or intervention and to joint proprietors of a European patent.

(2) If, during the course of proceedings, transfer is made to more than one person, and such persons have not appointed a

European Patent Office, appoint a suitable person to do so. When seeking **such** consent [...], the competent authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, the Organisation shall reimburse any costs incurred; **otherwise**, the Organisation shall not be liable for such costs.

Chapter XI Representation

Rule 100

Appointment of a common representative

(1) If there is more than one applicant and the request for grant of a European patent does not name a common representative, the applicant first named in the request shall be **deemed** to be the common representative. However, if one of the applicants is obliged to appoint a professional representative, this representative shall be **deemed** to be the common representative, unless the first named applicant has appointed a professional representative. The same shall apply to third parties acting in common in filing **a** notice of opposition or intervention and to joint proprietors of a European patent.

(2) If **the European patent application is transferred** to more than one person, and such persons have not appointed a

common representative, paragraph 1 shall apply. If such application is not possible, the European Patent Office shall require such persons to appoint a common representative within two months. If this request is not complied with, the European Patent Office shall appoint the common representative.

Rule 101 Authorisations

(1) Representatives acting before the European Patent Office shall upon request file a signed authorisation within a period to be specified by the European Patent Office. The President of the European Patent Office shall determine the cases where an authorisation is to be filed. The authorisation may cover one or more European patent applications or European patents and shall be filed in the corresponding number of copies.

Where the requirements of Article 133, paragraph 2, have not been satisfied, the same period shall be specified for the notification of the appointment of a representative and for the filing of the authorisation.

(2) A general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A single copy shall be sufficient.

common representative, paragraph 1 shall apply ***mutatis mutandis***. If such application is not possible, the European Patent Office shall **invite** such persons to appoint a common representative within a **period to be specified**. If this **invitation** is not complied with, the European Patent Office shall appoint the common representative.

Rule 101 Authorisations

(1) The President of the European Patent Office shall determine the cases **in which a signed authorisation shall be filed by representatives acting before the European Patent Office**.

(2) **Where a representative fails to file such an authorisation, the European Patent Office shall invite him to do so within [...] a period to be specified**. The authorisation may cover one or more European patent applications or European patents and shall be filed in the corresponding number of copies.

(3) Where the requirements of Article 133, paragraph 2, have not been satisfied, the same period shall be specified for the [...] appointment of a representative and the filing of the authorisation.

(4) A general authorisation **may be filed** enabling a representative to act in respect of all the patent transactions of **a party [...]**. A single copy shall **suffice**.

(3) The President of the European Patent Office may determine and publish in the Official Journal of the European Patent Office the form and content of:

(a) an authorisation in so far as it relates to the representation of persons as defined in Article 133, paragraph 2;

(b) a general authorisation.

(4) If the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other legal consequences provided for in the Convention, be deemed not to have been taken.

(5) The provisions of paragraphs 1 and 2 shall apply mutatis mutandis to a document withdrawing an authorisation.

(6) Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his authorization has been communicated to the European Patent Office.

(7) Subject to any provisions to the contrary contained therein, an authorisation shall not terminate vis-à-vis the European Patent Office upon the death of the person who gave it.

(8) If several representatives are appointed by a party, they may,

(5) The President of the European Patent Office may determine [...] the form and content of:

(a) an authorisation [...] relating to the representation of persons **under** Article 133, paragraph 2;

(b) *Unchanged*

(6) If **a required** authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall **be deemed not to have been taken**, without prejudice to any other legal consequences provided for **by this** Convention.

(7) Paragraphs **2** and **4** shall apply to **the withdrawal of** an authorisation.

(8) A representative [...] **shall be deemed** to be authorised [...] until the termination of his authorisation has been communicated to the European Patent Office.

(9) **Unless it expressly provides otherwise**, an authorisation shall not terminate vis-à-vis the European Patent Office upon the death of the person who gave it.

(10) If **a party appoints** several representatives, they may **act either**

notwithstanding any provisions to the contrary in the notification of their appointment or in the authorisation, act either jointly or singly.

(9) The authorisation of an association of representatives shall be deemed to be authorisation of any representative who can establish that he practises within that association.

At present there is no equivalent provision in the Implementing Regulations

jointly or singly, notwithstanding any provisions to the contrary in the **communication** of their appointment or in the authorisation [...].

(11) The authorisation of an association of representatives shall be deemed to be **an** authorisation of any representative who can **provide evidence** that he practises within that association.

Rule 101a
Attorney evidentiary privilege

(1) Where advice is sought from a professional representative in his capacity as such by a client, all communications between the professional representative and his client or any other person, relating to that purpose, are permanently privileged from disclosure in proceedings before the European Patent Office unless such privilege is expressly waived by the client.

(2) Such privilege from disclosure shall apply, in particular, to any communication or document relating to:

(a) the assessment of the patentability of an invention;

(b) the preparation or prosecution of a European patent application;

Rule 102

Amendment of the list of professional representatives

(1) The entry of a professional representative shall be deleted from the list of professional representatives if he so requests or if, despite repeated reminders, he fails to pay the annual subscription to the Institute of Professional Representatives before the European Patent Office before the end of the year for which the subscription is due.

(2) After the expiry of the transitional period provided for in Article 163, paragraph 1, and without prejudice to any disciplinary measures taken under Article 134, paragraph 8(c), the entry of any professional representative may be deleted automatically in the following cases only:

(a) in the event of the death or legal incapacity of the professional representative;

(b) in the event of the professional representative no longer being a national of one of the Contracting States, unless he was entered on the list during the transitional period or was granted exemption by the President of the European Patent Office in accordance with Article 134, paragraph 6;

(c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application.

Rule 102

Amendment of the list of professional representatives

(1) The entry of a professional representative shall be deleted from the list of professional representatives if he so requests or if, despite repeated reminders, he fails to pay the annual subscription to the Institute [...] before the end of the year for which the subscription is due.

(2) [...] **Without** prejudice to any disciplinary measures taken under Article 134a, paragraph 1(c), the entry of **a** professional representative may be deleted **ex officio [...] only**:

(a) in the event of **his** death or legal incapacity [...];

(b) **where he is** no longer a national of one of the Contracting States, unless he was [...] granted **an** exemption [...] **under** Article 134, paragraph 7(a);

(c) in the event of the professional representative no longer having his place of business or employment within the territory of one of the Contracting States.

(3) A person whose entry has been deleted shall, upon request, be re-entered in the list of professional representatives if the conditions for deletion no longer exist.

(c) **where he** no longer **has** his place of business or employment within [...] one of the Contracting States.

(3) **Any person entered on the list of professional representatives under Article 134 (2) or (3)** whose entry has been deleted shall, upon request, be re-entered **on that** list if the conditions for deletion no longer exist.

Present wording

PART VIII

IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

[See Article 135 EPC 1973:

(2) The request for conversion shall be filed within three months after the European patent application has been withdrawn or after notification has been made that the application is deemed to be withdrawn, or after a decision has been notified refusing the application or revoking the European patent. The effect referred to in Article 66 shall lapse if the request is not filed in due time.]

[See Article 136 EPC 1973:

(2) That office shall, subject to the provisions of national security, transmit the request, together with a copy of the European patent application, directly to the central industrial property offices of the Contracting States specified by the applicant in the request.]

[See Article 136 EPC 1973:

(1) ... shall specify the Contracting States in which application of the procedure for the grant of a national patent is desired.]

Revised wording

PART VIII

IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

Rule 102a

Filing and transmission of the request for conversion

(1) The request for conversion referred to in Article 135, paragraph 1(a) or (b), shall be filed within three months of the withdrawal of the European patent application, or of the communication that the application is deemed to be withdrawn, or of the decision refusing the application or revoking the European patent. The effect of the European patent application under Article 66 shall lapse if the request is not filed in due time.

(2) When transmitting the request for conversion to the central industrial property offices of the Contracting States specified in the request, the central industrial property office concerned or the European Patent Office shall attach to the request a copy of the file relating to the European patent application or European patent.

[See Article 136 EPC 1973:

(1) The European Patent Office shall transmit the request to the central industrial property offices of the Contracting States specified therein, accompanied by a copy of the files relating to the European patent application or the European patent].

[See Article 136 EPC 1973:

(2) The effect referred to in Article 66 shall lapse if such transmission is not made within twenty months after the date of filing or, if a priority has been claimed, after the date of priority].

Rule 103

Information to the public in the event of conversion

(1) The documents which, in accordance with Article 136, accompany the request for conversion shall be communicated to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specifications of the national patent resulting from the conversion of a European patent application must mention that application.

(3) Article 135, paragraph 4, shall apply if the request for conversion referred to in Article 135, paragraphs 1(a) or (2), is not transmitted before the expiry of a period of twenty months from the date of filing or, if priority has been claimed, the date of priority.

Rule 103

Information to the public in the event of conversion

(1) The documents **accompanying** the request for conversion **under Rule 102a, paragraph 2**, shall be **made available** to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specification of the national patent resulting from the conversion of a European patent application **shall** mention that application.

Present wording

PART IX

IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION

Rule 104

The European Patent Office as a receiving
Office

[See Article 151 EPC 1973:

(1) The European Patent Office may act as a receiving Office within the meaning of Article 2(xv) of the Cooperation Treaty if the applicant is a resident or national of a Contracting State to this Convention in respect of which the Cooperation Treaty has entered into force.]

[See Article 152 EPC 1973:

(1) If the applicant chooses the European Patent Office as a receiving Office for his international application, he shall file it directly with the European Patent Office. Article 75, paragraph 2, shall nevertheless apply mutatis mutandis.]

(1) When the European Patent Office acts as a receiving Office under the Cooperation Treaty, the international application shall be filed in English, French or German. It shall be filed in three copies; the same applies to any of the documents referred to in the check list provided for in Rule 3.3(a)(ii) of the Regulations under the Cooperation Treaty except the receipt for the fees paid or the cheque for the

Revised wording

PART IX

IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION

Rule 104

The European Patent Office as a receiving
Office

(1) The European Patent Office shall be competent to act as a receiving Office within the meaning of the PCT if the applicant is a resident or national of a Contracting State to this Convention and to the PCT. Without prejudice to paragraph 3, if the applicant chooses the European Patent Office as a receiving Office, the international application shall be filed directly with the European Patent Office; Article 75, paragraph 2, shall apply *mutatis mutandis*.

(2) When the European Patent Office acts as a receiving Office under the PCT, the international application shall be filed in English, French or German. The President of the European Patent Office may determine that the international application and any related item shall be filed in more than one copy.

payment of fees. The President of the European Patent Office may, however, decide that the international application and any related item shall be filed in fewer than three copies.

(2) If the provisions of paragraph 1, second sentence, are not complied with, the missing copies shall be prepared by the European Patent Office at the expense of the applicant.

(3) If an international application is filed with an authority of a Contracting State for transmittal to the European Patent Office as the receiving Office, the Contracting State must ensure that the application reaches the European Patent Office not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, after the date of priority.

[See Article 152 EPC 1973:

(3) Each international application shall be subject to the payment of the transmittal fee, which shall be payable within one month after receipt of the application.]

Rule 105

The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

(1) In the case of Article 17, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the search fee shall be payable for each further invention for which an international search is to be carried out.

(2) *Deleted*

(3) If an international application is filed with an authority of a Contracting State for transmittal to the European Patent Office as the receiving Office, the Contracting State **shall** ensure that the application reaches the European Patent Office not later than two weeks before the end of the thirteenth month **from** filing or, if priority is claimed, **from** the date of priority.

(4) The transmittal fee for the international application shall be paid within one month of filing the application.

Rule 105

The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

(1) In the case of Article 17, paragraph 3(a) **PCT**, an additional **international [...]** search fee shall be **paid** for each further invention for which an international search is to be carried out.

(2) In the case of Article 34, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the preliminary examination fee shall be payable for each further invention for which the international preliminary examination is to be carried out.

(3) Without prejudice to Rules 40.2(e) and 68.3(e) of the Regulations under the Cooperation Treaty, where an additional fee has been paid under protest, the European Patent Office shall review whether the invitation to pay the additional fee was justified and, if it does not so find, shall refund the additional fee. If the European Patent Office after such a review considers the invitation to be justified, it shall inform the applicant accordingly and shall invite him to pay a fee for the examination of the protest ("protest fee"). If the protest fee is paid in due time, the protest shall be referred to the Board of Appeal for a decision.

Rule 106

The national fee

The national fee provided for in Article 158, paragraph 2, shall comprise the following fees:

- (a) a national basic fee equal to the filing fee provided for in Article 78, paragraph 2, and
- (b) the designation fees provided for in Article 79, paragraph 2.

(2) In the case of Article 34, paragraph 3(a) **PCT**, an additional fee [...] **for international** preliminary examination shall be **paid** for each further invention for which the international preliminary examination is to be carried out.

(3) Where an additional fee has been paid under protest [...] **and** the European Patent Office [...] **upholds its view that** the invitation to pay the [...] fee was [...] justified, it shall inform the applicant accordingly and [...] invite him to pay a fee for the examination of the protest ("protest fee"). If the protest fee is paid in due time, the protest shall be referred to a **panel composed of three members** for a decision. **Further details shall be determined by the President of the European Patent Office.**

Rule 106

The national fee

Unchanged

Rule 107

The European Patent Office as a
designated or elected Office -
Requirements for entry into the European
phase

(1) In the case of an international application as referred to in Article 150, paragraph 3, the applicant must perform the following acts within a period of thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

(a) supply, where applicable, the translation of the international application required under Article 158, paragraph 2;

(b) specify the application documents, as originally filed or in amended form, on which the European grant procedure is to be based;

(c) pay the national basic fee provided for in Rule 106(a);

(d) pay the designation fees if the time limit specified in Article 79, paragraph 2, has expired earlier;

(e) pay the search fee provided for in Article 157, paragraph 2(b), where a supplementary European search report has to be drawn up;

(f) file the request for examination provided for in Article 94, if the time limit specified in Article 94, paragraph 2, has expired earlier;

Rule 107

The European Patent Office as a
designated or elected Office -
Requirements for entry into the European
phase

(1) In **respect** of an international application **under Article 153**, [...] the applicant **shall** perform the following acts within [...] thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

(a) *Unchanged*

(b) specify the application documents, as originally filed or **as** amended [...], on which the European grant procedure is to be based;

(c) *Unchanged*

(d) pay the designation fees if the **period under Rule 25c** has expired earlier;

(e) pay the search fee [...], where a supplementary European search report has to be drawn up;

(f) file the request for examination provided for in Article 94, if the **period under Rule 50a, paragraph 1**, has expired earlier;

(g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 37, paragraph 1;

(h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 23.

(2) Where the European Patent Office has drawn up an international preliminary examination report the examination fee shall be reduced as laid down in the Rules relating to Fees. If the report was established on certain parts of the international application in accordance with Article 34, paragraph 3(c), of the Cooperation Treaty, the reduction shall be allowed only if examination is to be performed on the subject-matter covered by the report.

[See Article 153 EPC 1973:

(2) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.]

Rule 108

Consequences of non-fulfilment of certain requirements

(1) If either the translation of the international application or the request for examination is not filed in due time, or if the national basic fee or the search fee is not paid in due time, or if no designation

(g) *Unchanged*

(h) *Unchanged*

(2) Where the European Patent Office has drawn up an international preliminary examination report, the examination fee shall be reduced **in accordance with** the Rules relating to Fees. If the report was established on certain parts of the international application in accordance with Article 34, paragraph 3(c) **PCT**, the reduction shall be allowed only if examination is to be performed on the subject-matter covered by the report.

(3) The Examining Division shall be competent to take decisions of the European Patent Office under Article 25, paragraph 2(a) PCT.

Rule 108

Consequences of non-fulfilment of certain requirements

(1) *Unchanged*

fee is paid in due time, the European patent application shall be deemed to be withdrawn.

(2) The designation of any Contracting State in respect of which the designation fee has not been paid in due time shall be deemed to be withdrawn.

(3) If the European Patent Office notes that the application or the designation of a Contracting State is deemed to be withdrawn under paragraph 1 or 2, it shall communicate this to the applicant. Rule 69, paragraph 2, shall apply *mutatis mutandis*. The loss of rights shall be deemed not to have occurred if, within two months of notification of the communication under sentence 1, the omitted act is completed and a surcharge is paid.

Rule 109

Amendment of the application

Without prejudice to Rule 86, paragraphs 2 to 4, the application may be amended once, within a non-extendable period of one month as from notification of a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 157, paragraph 2.

Rule 110

Claims incurring fees Consequence of non-payment

(1) If the application documents on which the European grant procedure is to be

(2) *Unchanged*

(3) If the European Patent Office notes that the application or the designation of a Contracting State is deemed to be withdrawn under paragraph 1 or 2, it shall communicate this to the applicant. Rule 69, paragraph 2, shall apply *mutatis mutandis*. [...]

Rule 109

Amendment of the application

Without prejudice to Rule 86, paragraphs 2 to 4, the application may be amended once, within a non-extendable period of one month [...] from [...] a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under **Article 153, paragraph 7**.

Rule 110

Claims incurring fees Consequence of non-payment

(1) If the application documents on which the European grant procedure is to be

based comprise more than ten claims, a claims fee shall be payable for the eleventh and each subsequent claim within the period provided for in Rule 107, paragraph 1.

(2) Any claims fees not paid in due time may still be validly paid within a non-extendable period of grace of one month as from notification of a communication pointing out the failure to pay. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims.

(3) Any claims fees paid within the period provided for in paragraph 1 and which are in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned.

Rule 111

Examination of certain formal requirements
by the European
Patent Office

(1) If the data concerning the inventor prescribed in Rule 17, paragraph 1, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the data within such period as it shall specify.

(2) Where the priority of an earlier application is claimed and the file number or copy provided for in Article 88,

based comprise more than ten claims, a claims fee shall be **paid** for the eleventh and each subsequent claim within the period **under** Rule 107, paragraph 1.

(2) Any claims fees not paid in due time may still be [...] paid within a non-extendable period [...] of one month [...] of [...] a communication **concerning** the failure to pay. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims

(3) Any claims fees paid within the period **under** paragraph 1 and [...] in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) *Unchanged*

Rule 111

Examination of certain formal requirements
by the European
Patent Office

(1) **Where** the **information** concerning the inventor **under** Rule 17, paragraph 1, **has** not yet been submitted [...] **within** the period **under** Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the **information** within **a period to be specified**.

(2) Where the priority of an earlier application is claimed and the file number **of the previous application or the copy**

paragraph 1, and Rule 38, paragraphs 1 to 3, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the number or copy of the earlier application within such period as it shall specify. Rule 38, paragraph 4, shall apply.

(3) If at the expiry of the period provided for in Rule 107, paragraph 1, a sequence listing as prescribed in Rule 5.2 of the Regulations under the Cooperation Treaty is not available to the European Patent Office, or does not conform to the prescribed standard, or has not been filed on the prescribed data carrier, the applicant shall be invited to file a sequence listing conforming to the prescribed standard or on the prescribed data carrier within such period as the European Patent Office shall specify.

Rule 112

Consideration of unity by the European Patent Office

If only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the

thereof provided for in Rule 38, paragraph 1 [...] and **Rule 38a** have not yet been submitted [...] **within** the period **under** Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish **that** number or copy [...] within **a** period **to be specified**. **Rule 38a, paragraphs 2 and 3**, shall apply.

(3) **Where**, at the expiry of the period **under** Rule 107, paragraph 1, a sequence listing as prescribed in Rule 5.2 **PCT** is not available to the European Patent Office, or does not conform to the prescribed standard, or has not been filed on the prescribed data carrier, the applicant shall be invited to file a sequence listing conforming to **that** standard or on **that** data carrier within **a** period **to be specified**.

Rule 112

Consideration of unity by the European Patent Office

(1) Where

(a) the International Searching Authority **has searched** only a part of the international application because **it** considered that the application did not comply with the requirement of unity of invention; and

(b) the applicant did not pay all additional fees **in accordance with** Article 17, paragraph 3(a) **PCT**, [...]

European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved within a period specified by the European Patent Office which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up a European search report for those parts of the international application which relate to inventions in respect of which search fees have been paid. Rule 46, paragraph 2, shall apply mutatis mutandis.

the European Patent Office shall consider whether the application complies with the requirement of unity of invention.

(2) If the European Patent Office considers [...] this not **to be** the case, it shall inform the applicant that a European search report **may** be **drawn up** in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved within a period **to be** specified [...], which may not be shorter than two weeks and may not exceed six weeks.

(3) The **European Patent Office** shall draw up a European search report for those parts of the [...] application which relate to inventions in respect of which search fees have been paid. Rule 46, paragraph 2, shall apply [...].

b

June 2002

Taskforce EPC Revision

NEW IMPLEMENTING REGULATIONS UNDER THE EPC 2000

EXPLANATORY REMARKS

PART I
IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

Chapter I
RULES 1-7 EPC

Rules 1-7 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

Rule 6 EPC

(Preparatory document: MR/2/00, pages 5-10)

Under Article 6(3) PLT, the Office may require a translation if the application is not filed in one of the official languages. The PLT does not provide for a time limit but states that the Contracting Party must notify the applicant if no translation is filed, giving him the opportunity to comply with the requirement within a time limit of at least two months from the date of notification (Article 6(7) PLT in conjunction with Rule 6(1) PLT). The notification is provided for in Rule 41(1) EPC. The applicant will thus always have a minimum period of three months to file the translation.

Chapter II
RULES 8-12 EPC

Rules 8 to 12 EPC concern the organisation of the European Patent Office. Rules 10 and 11 EPC have a wider scope than the corresponding organisational provisions for the departments of first instance. To reflect the distinction between departments of first instance and the Boards of Appeal, it is proposed that Chapter II of Part I of the Implementing Regulations to the EPC 2000 be divided into two sections:

Section 1: General matters (substance of existing Rules 8, 9 and 12 EPC);
Section 2: Organisation of the Boards of Appeal and the Enlarged Board of Appeal.

Rule 8 EPC

The new heading "Section 1" (see above) is inserted before Rule 8.

The European Convention on the International Classification of Patents for Invention of 19 December 1954, referred to in the existing Rule 8 EPC, has never been applied at the EPO, as the Strasbourg Agreement entered into force on 7 October 1975, before the setting-up of the EPO on 1 November 1977. This reference can therefore be deleted.

New Rule 8a EPC

concerns the content of the previous Rule 12 EPC. These provisions concern the EPO as a whole and are therefore included in the section headed "General matters".

The key provision of the existing Rule 12(1) - that the number of directorates in which the Examining Divisions and Opposition Divisions are grouped together is to be decided by the President - is already implied by the President's general power of decision. This part of the existing Rule 12 can therefore be deleted. The administrative grouping of Examining and Opposition Divisions is addressed in modified form in Rule 9(1) EPC.

The new Rule 8a(1) replaces the list of departments in proceedings before the EPO with a general reference to Article 15 EPC. The deletion of the substance of the existing Rule 12(2), second sentence, EPC takes account of Articles 16 and 17 EPC 2000.

Rule 9 EPC

as redrafted reflects the administrative grouping into directorates of the departments involved in the grant procedure - ie the Search Divisions, Examining Divisions and Opposition Divisions, made up of technically qualified examiners.

The possibilities offered by Rule 9(2) and (3) EPC must be retained.

Rule 9(4) EPC is deleted. No registry of an Opposition Division has ever been set up. The tasks in question are performed by "employees" within the meaning of Rule 9(3) EPC. The President's general power of decision already enables him to entrust the fixing of costs to formalities officers with specialist knowledge.

Rules 10 und 11 EPC

The new heading "Section 2" (see general comments on Part I, Chapter II, above) is inserted before Rule 10 EPC.

The version of Rules 10 and 11 EPC valid since 2 January 2002 is retained. Only the references to the EPC in Rules 10(6) and 11(1) and (2) need to be modified, in the light of the EPC 2000. The wording of Rule 11(1) and (2) EPC has been slightly amended to make the emphasis positive, instead of negative as in the existing version.

Rule 12 EPC

In view of its general character, the substance of the existing Rule 12 EPC has been transferred to the new Rule 8a in Section 1, "General matters".

PART II
IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Chapter I
RULES 13-16 EPC

Rules 13-16 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

Rule 13 and 16 EPC

To make the structure of the Implementing Regulations more coherent, the provisions applicable to an applicant who is not entitled are separated from those governing the cases where the patent has already been granted and it is thus a patent proprietor who is not entitled. Accordingly, the substance of Rule 13(4) EPC and Rule 16(3) EPC is moved to Part V of the Implementing Regulations, governing the opposition procedure, and inserted in the new Rule 56a EPC. The title of Chapter I is modified accordingly.

Rule 14 EPC

The current title has been amended as it is misleading, since it refers only to the withdrawal of the European patent application itself, whereas the Rule also governs the withdrawal of a designation.

New Rule 14a EPC

(Preparatory document: MR/2/00, pages 51-52)

The requirements for a third party to invoke the remedies provided for in Article 61(1) EPC have been transferred to the Implementing Regulations and are now contained in the proposed new Rule 14a EPC.

Rule 15 EPC

For clarity's sake, Rule 15(2) EPC is subdivided into paragraphs (2), concerning the payment of filing and search fees, and (3), relating to the designation fees. In conformity with Article 51(3) EPC 2000, the legal consequences of failure to pay such fees in due time are also laid down in these provisions.

The current Rule 15(3) has been deleted, as a new application under Article 61 should always be filed directly with the EPO (see Articles 61(2) and 76(1) EPC 2000).

Chapter II RULES 17-19 EPC

Rules 17-19 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

Rule 17 EPC

(Preparatory document: MR/2/00, pages 173-176)

The cross-reference in Rule 17(3) EPC to Article 128(5) EPC 1973 has been deleted. It is now for the President of the EPO to prescribe the further data to be communicated to the inventor (see also Rule 96).

Chapter III RULES 20-22 EPC

Rules 20-22 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

Chapter IV RULE 23 EPC

Rule 23 EPC

has been reorganised for the sake of clarity, and divided into sub-paragraphs (a) to (d).

Chapter V RULE 23a EPC

Rule 23a, and with it, Chapter V, have been deleted following the deletion of Article 54(4) EPC 1973.

Chapter VI RULES 23b-23e EPC

Chapter VI, concerning biotechnological inventions, becomes **Chapter V**, replacing the old Chapter V, now deleted.

Rule 23f (= Rule 27a EPC)

For the sake of clarity and consistency, this provision is to be inserted in Chapter V, dealing with biotechnological inventions, after the current Rule 23e.

Rules 23g-23i (= Rule 28 EPC)

For the sake of clarity and consistency, Rules 28 and 28a are to be inserted in Chapter V, dealing with biotechnological inventions, after Rule 23f.

The current Rule 28, headed "Deposit of biological material", is very long and difficult to read. It lumps the deposit of biological material together with the questions of availability, the issue of a sample and the expert solution, and a number of purely formal provisions.

Rule 28 is therefore to be restructured, by dividing it into three parts:

Rule 23g	Deposit of biological material
Rule 23h	Expert solution
Rule 23i	Availability of biological material, issue of samples, relevant arrangements.

Rule 23g EPC

Paragraphs (1) and (2) of the existing Rule 28 form the new Rule 23g, dealing with the deposit of biological material.

Rule 23h EPC

The new Rule, headed "Expert solution", comprises paragraphs (4) and (5) of the current Rule 28.

Rule 23i EPC

The new Rule, headed "Availability of biological material", comprises paragraphs (3), (6), (7), (8) and (9) of the current Rule 28.

Rule 23j (= Rule 28a EPC)

The existing Rule 28a, concerning the new deposit of biological material, is difficult to read - like the current Rule 28 - and is largely modelled on Article 4 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

It is therefore proposed that this Rule be shortened, and that an express reference to the Budapest Treaty be included, following the example of Article 14 of Directive 98/44/EC, which reads:

- "1. If the biological material deposited in accordance with Article 13 ceases to be available from the recognised depositary institution, a new deposit of the material shall be permitted on the same terms as those laid down in the Budapest Treaty.*
- 2. Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited."*

In view of the new structure of Rule 28, the current Rule 28a becomes **Rule 23j**.

PART III
IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

Chapter I
RULES 24-25d

Rule 24 EPC

(Preparatory document: MR/2/00, pages 63-64)

The details of Article 75(1)(a) EPC 1973 were moved to Rule 24(1) EPC, which has also been restructured for increased clarity and aligned with the wording of the EPC 2000.

Rule 25 EPC

(Preparatory document: MR/2/00, pages 65-66)

New paragraph 2 of Rule 25 EPC now contains the substance of the deleted Rule 4 EPC (language of a divisional application).

Moreover, pursuant to Article 51(3) EPC 2000, the amended Rule 25 EPC not only specifies the fees to be paid, with their time limits, but also refers to the legal consequences of failure to pay in due time. The current Rule 25(2) EPC is accordingly subdivided into paragraphs (3) and (4) for ease of reference.

New Rule 25a EPC

(Preparatory document: MR/2/00, pages 67-70)

Details regarding the forwarding of European patent applications from the central industrial property offices of the Contracting States to the EPO, contained in Article 77(1) and (5) EPC 1973, as well as the substance of Article 77(2) and (3) EPC 1973, were transferred to the new Rule 25a EPC. In Rule 25a(2), last sentence, the claims fees have been included, with the consequence that Rule 31(2), last sentence, is redundant.

New Rule 25b EPC

(Preparatory document: MR/2/00, pages 71-72)

The period for payment of the filing fee and the search fee under Article 78(2) EPC 1973 has been transferred to the new Rule 25b EPC. The legal consequence of failure to pay these fees in due time is already established in the new Article 78(2) EPC 2000, so there is no need to repeat it in Rule 25b EPC.

New Rule 25c EPC

(Preparatory document: MR/2/00, pages 73-74)

The period for payment of the designation fee under Article 79(2) EPC 1973 was transferred to the Implementing Regulations, as was the substance of the last two sentences of Article 79(3) EPC 1973, determining the consequences of the withdrawal of the designations of all the Contracting States and laying down the principle that designation fees are not refundable. These are now included in the new Rule 25c EPC, drafted in the style of the EPC 2000.

The legal consequence of failure to pay a designation fee in due time, previously laid down in Article 91(4) EPC 1973, is inserted in Rule 25c(2) EPC, and the legal consequence in cases where no designation fee is paid or all designations are withdrawn is inserted in Rule 25c(3) EPC.

New Rule 25d EPC

(Preparatory document: MR/2/00, pages 75-76)

Article 80 EPC 2000 states that the Implementing Regulations shall specify the requirements for a date of filing. The proposed wording of the new Rule 25d(1) EPC corresponds to Article 5(1) and (7) PLT 2000.

Under Article 5(7) and Rule 2(5)(a) PLT, contracting parties are obliged to accept a reference to a previously filed application instead of a description and any drawings, provided that the previously filed application is properly identified. These requirements are inserted in Rule 25d(2).

In such a case, any party to the PLT may request the filing of a copy of the previously filed application (Rule 2(5)(b) PLT) - unless such a copy is already available to the contracting party (Rule 4(3) PLT) - and, where appropriate, of a translation of the previous application. These requirements have been adopted under Rule 25d(3) EPC.

Chapter II

RULES 26-36

Rules 26-36 EPC have been streamlined and aligned with the drafting style of the EPC 2000.

Rule 26 EPC

The contact information referred to under Rule 26(2)(c) is updated and brought into line with the current EPO Request for grant form. Thus, Rule 26(2)(c) now recommends that the applicant indicate his fax number instead of his telegraphic or telex address.

Rule 31 EPC

The wording of Rule 31(1) EPC has been aligned with Article 2(15) of the Rules relating to Fees, which is more precise, and subdivided into two paragraphs (2) and (3) for added clarity. Rule 31(3), second sentence, has been deleted, with its substance transferred to Rule 25a(2) EPC.

Rule 32 EPC

Some redundant wording has been removed from Rule 32(2)(j) EPC. In this context, the terms "keywords" and "catchwords" have equivalent meanings. Moreover, electric circuits and block schematic diagrams are diagrams, and since these, by virtue of Rule 32(3) EPC, are deemed to be drawings, Rule 32(2)(j) has been simplified by referring to drawings only.

Rule 35 EPC

Rule 35(11) EPC (formerly Rule 35(12)) has been streamlined so that the single principle at issue - that applicants must use the nomenclature and signs generally accepted in the technical field in question - is stated in a general form, instead of being needlessly repeated with variations for three different technical fields.

Rule 36 EPC

Rule 36(5) has been replaced by a mere reference to Rule 24(2) EPC, which completely covers the matter redundantly addressed in the previous paragraph 5.

Chapter III

RULE 37 EPC

Rule 37 EPC

(Preparatory document: MR/2/00, pages 77-78)

The substance of Article 86(2) EPC 1973 has been moved to Rule 37(2) EPC and combined with the current substance of that Rule.

The consequences of non-payment of a renewal fee are laid down in Article 86(1) EPC 2000 and therefore not repeated here.

Rule 37 EPC has been streamlined and aligned with the style of the EPC 2000.

Chapter IV

RULES 38-38a EPC

(Preparatory document: MR/2/00, pages 83-84)

Rules 38 and 38a EPC set out the requirements to be met when claiming priority under Article 88(1) EPC. Rule 38 EPC deals with the declaration of priority, Rule 38a EPC concerns the priority documents.

Rule 38 EPC

Paragraph 1, defining the content of the declaration of priority, has been streamlined and its wording aligned with the style of the EPC 2000.

Paragraph 2 provides that the complete declaration of priority - including the file number of the previous application - shall, preferably, be made on filing. However, in accordance with Article 13(1), Rules 14(1) and (3) PLT as well as Rule 26bis PCT, a declaration of priority may also be made later, ie within 16 months from the priority date claimed, unless the applicant has requested early publication of the application. Declarations made on filing may be corrected within that period.

The new system is thus based on the principle that the declaration of priority should be made on filing, while allowing late claiming of priority or correction of the priority declaration within the abovementioned 16-month period. This is a significant relaxation of the requirements vis à vis the current Rule 38(2) EPC, under which at least the date and the state of the previous application have to be indicated on filing. For the time being it is not intended to make use of Article 14(4) PLT and prescribe that a fee be paid if priority is claimed late or a correction of the priority declaration is made, although these possibilities put an additional burden on the Office.

New Rule 38a EPC

has been brought into line with the PLT 2000 and streamlined. Paragraph 3 reflects the requirements of Rule 4(4) PLT, to the effect that a translation of a previous application which was not filed in an official language will no longer be required as a matter of course; instead the applicant or, as the case may be, the patentee will be invited by the EPO to file such translation only where the validity of the priority claim is relevant to determining whether the invention is patentable. As in current practice, no such translation will be required where a copy thereof is to be included in the file relating to the application in accordance with the conditions fixed under Rule 38(2).

PART IV
IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

Chapter I
RULES 39-43 EPC

Rule 39 EPC

deals with the examination under Article 90(1). The Office has to examine whether the requirements for the accordancy of a date of filing are fulfilled, and must give the applicant an opportunity to correct deficiencies pursuant to Article 90(4) EPC 2000. The period of two months corresponds to Article 5(3) and Rule 2(1) PLT 2000.

New Rule 39a EPC

Under Article 5(5) PLT, the applicant must be informed if a part of the description or drawings appears to be missing.

The new Rule 39a EPC corresponds to the arrangements under Article 5(6) PLT. If the applicant, either after an invitation under Rule 39(1) EPC or of his own motion, files a missing part of the description or drawings after the filing date, but within two months from the filing date or the communication under paragraph 1, the application will be re-dated (Rule 2(3) PLT).

The applicant must be given an opportunity to withdraw subsequently filed parts of the description or drawings so that he can retain his original filing date, Rule 39a(2) EPC.

If the application claims priority, and the missing part of the description or drawings was contained in the priority application, that missing part of the description or drawings may, under certain circumstances, be included in the application without loss of the original filing date (Article 5(6)(b) and Rule 2(4) PLT). This is governed by Rule 39a(3) EPC.

Rule 40 EPC

deals with the formalities examination after a filing date has been accorded under Article 90(3) EPC 2000 and incorporates the substance of the old Article 91(1) EPC 1973.

Claims have been introduced in Rule 40(c) EPC, as these are no longer a prerequisite for the accordancy of a filing date.

Rule 41 EPC

implements Article 90(4) EPC 2000, according to which the applicant must be given the opportunity to correct deficiencies of his application. With regard to deficiencies in claiming priority, a new Rule 41a EPC has been introduced.

New Rule 41a EPC

Under the new Rule the applicant will be invited to indicate the file number of the previous application or to file a copy thereof if this has not been done within the 16-month period under Rules 38(2) EPC and 38a(1) EPC. In accordance with Article 90(5) EPC 2000 the right of priority will be lost if the deficiencies noted in the invitation are not corrected within the period specified. Re-establishment of rights will be available as a legal remedy in such cases.

In the case of other deficiencies of the priority claim, eg no indication of the date or State of the previous application, no invitation will be issued. This corresponds to the situation under the current Rule 38(2) EPC in conjunction with Rule 41(2) EPC and is necessary because this information is needed for publication of the application. Thus, where the date or State of the previous application are not indicated within 16 months from the priority date the right of priority will be lost. However, as above, re-establishment of rights will be available.

Rule 42 EPC

The time limit in Article 91(5) EPC 1973 is taken over in Rule 42(1) EPC. Instead of being deemed withdrawn, the application will be refused if no designation of the inventor is filed in due time (see Article 90(5) EPC 2000).

Rule 42(2) has been redrafted in order to clarify that also in divisional applications and applications under Article 61(1)(b) the designation of inventor is due on filing. Furthermore it is now clearer when the deficiency has to be rectified at the latest. The minimum period will always be 16 months from the filing date (of the earlier application, cf Art. 76(1) and 61(2)) or the priority date.

Rule 43 EPC

is deleted, as late-filed drawings are now dealt with under Rule 39a EPC.

Chapter II
RULES 44-47 EPC

New Rule 46a EPC

The wording of Article 92(2) EPC 1973 is incorporated in the new Rule.

Chapter III
RULES 48-50 EPC

Rule 49 EPC

The substance of Article 93(2) EPC 1973 is incorporated, with minor editorial modifications, in this Rule.

New Rule 50a EPC

contains the details of the request for examination under Article 94(1) EPC 2000. The substance of Article 96(1) EPC 1973 is incorporated in Rule 50a(2) and (3) EPC.

Paragraph 2 allows for the possibility that the search report is accompanied by a first communication from the Examining Division if the application is treated under BEST.

Rule 51 EPC

The substance of Rule 51(1) is incorporated in the new Rule 50a(2).

PART V
IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

Chapter I
Opposition procedure

RULES 55a-63a EPC

Since the provisions dealing with limitation proceedings have been incorporated in Part V of the Implementing Regulations, this Part has been divided into two chapters. The new **Chapter I** is headed "Opposition procedure". The new Rules have been streamlined and brought into line with the EPC 2000.

New Rule 55a EPC

(Preparatory document: MR/2/00, pages 109-110)

is taken over from Article 99(3) EPC 1973.

New Rule 55b EPC

(Preparatory document: MR/2/00, pages 109-110)

The new paragraph 1 implements Article 99(1), second sentence, EPC 1973. The heading is amended accordingly. The new Rule has also been drafted in the style of the EPC 2000.

Rule 56 EPC

has been brought into line with the style of the EPC 2000.

New Rule 56a EPC (= Rules 13(4) and 16(3) EPC)

Part II, Chapter I of the Implementing Regulations currently deals with the procedure to be followed where either the applicant or the proprietor of a patent was not entitled to file the application or obtain the patent.

The remedies under Article 61(1) EPC, where the applicant is a non-entitled person, are subject to the requirement that the patent has not yet been granted. This condition has been moved from the Convention to the new Rule 14a(1)(b) EPC.

On the other hand, the current Rule 13(4) EPC provides for a stay of proceedings during the opposition procedure where a third party can provide evidence that he is challenging the patentee's entitlement before a national court. Likewise, Rule 16(3) EPC applies to the partial transfer of the right to a patent by virtue of a final decision.

Given the new Rule 14a(1)(b) EPC stipulating that the provisions of Chapter I shall apply only if the patent has not yet been granted, keeping Rules 13(4) and 16(3) EPC in this Chapter would be somewhat anomalous.

To make the structure of the Implementing Regulations more coherent, the substance of Rules 13(4) and 16(3) EPC, applying to non-entitled patent proprietors, has been moved to Part V of the Implementing Regulations governing the opposition procedure, integrating them as the new Rule 56a EPC, drafted in the style of the EPC 2000.

Rules 57 and 57a EPC

have been brought into line with the style of the EPC 2000.

Rule 58 EPC

(Preparatory document: MR/2/00, pages 111-114)

The new paragraph 1 incorporates the principles established by the Enlarged Board of Appeal regarding the examination of grounds for opposition by the Opposition Division (see G10/91, OJ EPO 1993, 420). Paragraphs 2 and 3 have been brought into line with the style of the EPC 2000.

New Rule 58a EPC

(Preparatory document: MR/2/00, pages 115-118)

Article 102(3) EPC 1973 and Rule 58(4)-(8) are transferred to the new Rule 58a EPC, which concerns only the maintenance of the European patent in amended form. The legal consequences of failure to pay the fee or file the translation in due time are set out in paragraph 3; the amount of the fee and surcharge is laid down in the Rules relating to Fees.

Rule 60 EPC

has been brought into line with the style of the EPC 2000.

Rule 63 EPC

(Preparatory document: MR/2/00, pages 121-122)

The details of a decision ordering a different apportionment of costs and the procedure for fixing costs have been transferred from Article 104 EPC 1973 to Rule 63 EPC.

Paragraph 1, first sentence, makes it clear which costs are to be apportioned.

Paragraph 2, first sentence, is taken from Article 104(2), first sentence, EPC 1973, and incorporates, as before, the principle that costs may only be fixed on the basis of a final decision apportioning them.

Paragraph 3, first sentence, amalgamates Article 104(2), second sentence, EPC 1973 with part of the existing Rule 63(3) EPC.

New Rule 63a EPC

(Preparatory document: MR/2/00, pages 123-124)

The details in Article 105 EPC 1973 are transferred to the new Rule 63a EPC.

Chapter II Limitation procedure

RULES 63b-63h EPC

(Preparatory document: MR/2/00, pages 125-130)

Rules 63b-63h, in the new Chapter II of Part V of the Implementing Regulations, contain the provisions governing the details of the limitation procedure (Articles 105a, 105b, 105c EPC 2000).

New Rule 63b EPC

assigns the new tasks to the Examining Divisions. This is expedient because of the nature of the issues, ie the amendment of the claims, in an ex parte procedure which essentially involves assessing technical questions concerning the drafting of the claims. As regards the composition and work of the Examining Division in limitation proceedings Article 18(2) EPC 2000 is to apply *mutatis mutandis*.

Responsibility needs to be assigned expressly to the Examining Divisions, because the Convention itself only implies such responsibility indirectly (Article 21(3)(a) EPC 2000). For reasons of legal coherence and transparency, it is better to establish the competence of the Examining Divisions in the Implementing Regulations than to allocate such duties by decision of the President under Rule 9(2) EPC.

New Rule 63c EPC

sets out the details of the requirements to be met by a request for limitation or revocation of a European patent.

Paragraph 1 provides that the request shall be filed in writing. The request must indicate whether limitation or revocation is sought. Under Article 105a(1) EPC 2000, the request is only deemed to be filed when the limitation or revocation fee has been paid. The amount of the appropriate fee is laid down in the Rules relating to Fees. The request does not have to be accompanied by a statement of reasons, but this can be expedient where, for example, the requester's entitlement or the limiting effect of the requested amendment of the claims are not unambiguously apparent from the request documents.

Paragraph 2 specifies the information and the documents which the request must contain. Sub-paragraphs (a), (b) and (e) deal with the identification of the requester and, where appropriate, the representative, as well as the patent to which the request relates (see the corresponding provisions in Rule 55b EPC).

Paragraph 2(c) refers to the cases in which the requester is not the patent proprietor for all the contracting states in which the European patent has become valid (ie granted, validated and not revoked). In these cases, he must indicate the further patent proprietors concerned and show that they approve the requested limitation or revocation of the European patent. In view of the *ab initio* effect of limitation and revocation under Article 68 EPC 2000, this requirement also applies to patent proprietors in states where the European patent has already expired.

Limitation of the European patent under Article 105a(1) EPC 2000 is only possible by an amendment of the claims. Paragraph 2(d) prescribes accordingly that the request must contain the complete text of the amended claims. In accordance with Rule 1(2) EPC, the text must be filed in the language of the proceedings in which the patent was granted. Since the amended claims form the basis for limitation and for the publication of the amended specification of the European patent, they must comply with the general provisions concerning the form of documents filed with the EPO (Rule 36 EPC).

The filing of a description modified in accordance with the amended text of the claims is not prescribed, since the text granted will normally support the claims as amended (by the limitation of their scope). If the requester nevertheless wishes to amend the description, he may do so, making the changes in accordance with the Guidelines for Examination and appending the amended version to his request.

New Rule 63d EPC

concerns the examination as to admissibility of requests under Article 105a EPC 2000. The question of admissibility is only to be considered when a request for revocation or limitation has been validly filed, ie when the relevant fee under Article 105a(1) has been paid and the general requirements for the validity of procedural acts before the EPO have been fulfilled (eg Rules 1(1), 36(3) and 36(5) EPC). If this is not the case, the formalities officer will inform the requester that a valid request has not been filed, and state why this is so.

Paragraph 1 provides that a request for revocation or limitation of the European patent shall be rejected as inadmissible if opposition proceedings relating to the patent are pending (Article 105a(2)). Reimbursement of the fee for limitation or revocation is to be ordered if the requester was not informed of the opposition. Article 113(1) EPC is to be observed.

Paragraph 2 is modelled on Rule 56 EPC, applying to opposition proceedings, and provides that requests for limitation or revocation of the European patent shall be rejected as inadmissible if the requirements of Rule 63c EPC concerning such requests are not fulfilled, or are not fulfilled within the period specified in the invitation to remedy the deficiencies.

Examination and decisions as to admissibility are the responsibility of the formalities officer. The details of this are laid down on the basis of Rule 9(3) EPC, authorising the President to entrust duties to employees who are not technically or legally qualified examiners.

New Rule 63e EPC

supplements the provisions governing the relationship between limitation and opposition proceedings (Article 105a(2), Rule 63d(1) EPC) and provides that limitation proceedings already pending at the time of filing an opposition to the European patent for which limitation is requested are to be terminated by the Office of its own motion. Reimbursement of the limitation fee will be ordered in such cases.

This complies with the principle of the precedence of opposition proceedings, as laid down in Article 105a(2) EPC 2000, and takes account of the fact that the requester in these cases has the option of resorting to the opposition procedure for prosecuting his interests. However, Rule 63e does **not** apply where revocation of the European patent is requested.

New Rule 63f EPC

concerns examination for compliance with the substantive requirements for limitation of the European patent. It must be established whether the requested amendment of the claims actually constitutes a limitation (which, for example, is not the case where amendments are made purely for the purposes of clarification or claiming an aliud) and whether the requirements of Articles 84 und 123(2) and (3) EPC have been met.

The basis for carrying out this examination is the text of the amended patent claims as submitted by the requester in accordance with Rule 63c(2)(d) EPC. The requester cannot amend these subsequently in limitation proceedings: ie Article 123(1) and Rule 86 EPC do not apply. Errors of transcription or obvious mistakes can be rectified on request or by the Office of its own motion (Rule 88 EPC). Confining the examination to the text of the amended claims as submitted will ensure a swift decision on the request for limitation and is in the interests of legal certainty. Since the request can be filed again at any time, depriving the requester of the right to make amendments does not seem unreasonably harsh.

In principle, there should be no examination as to whether the subject-matter of the limited patent is patentable under Articles 52 to 57 EPC or whether the supposed aim of the limitation - eg delimitation with respect to particular prior art - is actually achieved by the requested amendment of the claims. However, the Examining Division may still consider the patentability of the residual patent in individual cases, for example where there are indications that the requested amendment of the claims would lead to the protection of subject-matter which is excluded from patentability.

New Rule 63g EPC

deals with the conclusion of limitation proceedings by decision on the substantive issues. Since the Examining Division is largely bound by the request as filed, in limitation proceedings - unlike opposition proceedings - there are only two alternatives: allowance or rejection.

Under paragraph 1, where **revocation** of the European patent is requested, this can be decided immediately if the examination shows it to be admissible. The requester must be informed of the revocation and told when the decision will be published in the European Patent Bulletin.

Under paragraph 2, if a request for **limitation** of the European patent is to be allowed, the requester has to file a translation of the amended claims and pay the fee for printing the amended patent specification before the limitation can be decided, in accordance with paragraph 3.

Under paragraph 4, the request for limitation or revocation of the European patent is rejected if it cannot be allowed. This also applies if the requester fails to perform the acts required under paragraph 2 in due time. To safeguard the right to be heard, the decision rejecting the request must be postponed at least until the end of the month following notification of the communication under Rule 63f EPC.

New Rule 63h EPC

provides that the contents of the amended European patent specification published by the EPO under Article 105c EPC 2000 are to be decided by the President of the EPO. These are to include, in particular, the claims as amended in the limitation proceedings and the translation prescribed under Article 14(6) EPC.

PART VI
IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION

Chapters I and II
RULES 63i-67 EPC

The transfer of some provisions from the Convention and the new Article 112a EPC 2000 have made it necessary to extend Part VI of the Implementing Regulations and divide the material into two chapters: Chapter I, concerning the appeal procedure (Articles 106 to 112 EPC) and Chapter II, containing the rules for proceedings under Article 112a EPC.

Rules 63i-67

(Preparatory document: MR/2/00, pages 131-136)

Chapter I of Part VI comprises the Rules (implementing, in particular, Articles 106, 108 and 110 EPC) which govern the procedural provisions applicable in appeal proceedings, the admissibility of the appeal and the examination of the appeal as to admissibility and allowability.

New Rule 63i EPC

On the basis of Article 106(3) EPC 2000, the substance of Article 106, paragraphs 4 and 5, EPC 1973 is transferred to the new Rule 63i.

New Rule 63j EPC

transfers Article 106(2) EPC 1973 to the Implementing Regulations. The original wording "for all the designated States" would be appropriate if, for example, a centralised procedure existed for surrendering European patents. The amended wording "**in** all the designated States" is more in keeping with the idea of a "bundle" of national patents.

Rule 64 EPC

Under the current Rule 64(b) EPC, the notice of appeal already has to include a statement identifying the extent to which amendment of the impugned decision is requested. This rarely presents a problem in appeals filed by an opponent, but where the appellant is the patent proprietor, the amended patent claims are nearly always filed with the statement of grounds for appeal, and it is only then that the precise nature of the requested amendment becomes apparent.

It is also to be noted that the requirements to be met by the statement of grounds of appeal under Article 108, third sentence, EPC have only been concretised by case law.

The proposed new version of Rule 64 EPC is based on practical requirements:

- The requirements of paragraph 1(a) and (b) ensure that the notice of appeal clearly shows which decision is impugned and by whom.
- The "request defining the subject of the appeal" in paragraph 1(c) can be interpreted by the Boards in accordance with practical needs. The notice of appeal should clearly indicate the general aim of the appeal, even if its scope cannot yet be specified in detail.
- However, the full extent of the appellant's requests must become clear in, at the latest, the statement of grounds of appeal; in principle, the appellant should present his complete case in the statement of grounds for appeal.

New Rule 64a EPC

is taken from the current Rule 66(1) EPC.

Paragraphs 2 and 3, transferred from Article 110(2) and (3) EPC 1973, now clearly refer to examination for admissibility, where they can also be relevant, as well as to the consideration of allowability.

To ensure that appeal proceedings can be conducted efficiently, all the facts and evidence presented by the parties should in principle be included in their initial submissions (notice of appeal and statement of grounds of appeal, respondent's reply). This principle has been emphasised by the insertion of the words "if necessary" in Rule 64a(2) EPC which to this extent deviates slightly from Article 110(2) EPC 1973. The need for further investigation of the facts can be decided on a discretionary basis by the Board.

Rule 65 EPC

sets out the provisions to be observed in examining for admissibility. The cross-references have been brought into line with the Implementing Regulations to the EPC 2000.

If the appeal is admissible, it will be examined for allowability (Article 110 EPC 2000).

Rule 66 EPC

corresponds to the previous Rule 66(2) EPC.

Rule 67 EPC

Paragraph 1(a) merely clarifies the position on the basis of long-established practice.

Paragraph 1(c) could go some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution - in case the other party appeals - could be withdrawn, if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective time limits for filing the notice of appeal and filing the statement of grounds of appeal, ie before any great expense of effort by the parties or the Office.

Paragraph 2 codifies the case law of the Legal Board of Appeal (J 32/95, OJ EPO 1999, 713).

Chapter II **NEW RULES 67a-67g EPC**

New Rules 67a-67g EPC

(Preparatory document: MR/2/00, pages 23-24, 137-146)

The new Rules 67a to 67g EPC, grouped together in Chapter II of Part VI, implement Article 112a EPC 2000.

New Rule 67a

implements Article 112a(2)(d) EPC.

The right to oral proceedings, addressed in Rule 67a(a) EPC, is an important aspect of the "right to be heard". Ignoring a request for oral proceedings may therefore constitute a fundamental procedural defect, which in proceedings under Article 112a EPC 2000 merits the same treatment as the cases covered by Article 112a(2)(a) to (c) EPC. It is up to the Enlarged Board of Appeal to assess the seriousness of the procedural defect. Only non-appointment of oral proceedings which contravenes Article 116 EPC is to be a reason for re-opening appeal proceedings.

The seriousness of the fundamental procedural defect addressed in Rule 67a(b) EPC is also to be assessed by the Enlarged Board of Appeal, which must interpret the terms "fundamental" and "relevant" to this end. The assumption is that only requests submitted in writing or requests which the party had recorded in the minutes of the oral proceedings will fall within the ambit of that provision. Furthermore, the wording of Rule 67a(b) implies that the fundamental procedural defect must have occurred with respect to the appeal. Therefore, requests relating to the apportionment of costs, the reimbursement of the appeal fee or other requests concerning collateral issues are not addressed by the present provision. A partial re-opening of appeal proceedings with respect to collateral issues only is not desirable.

New Rule 67b EPC

provides that only a criminal act finally established by a competent court or authority can serve as the basis for proceedings under Article 112a(2)(e) EPC 2000. The act may be "finally established" in any of the following ways:

- by a final judgment under (criminal) law;
- by another final decision of a competent court,
- by a final decision of a competent authority (eg under administrative criminal law, to the extent that such a breach of law can be liable to influence the decision of the Board of Appeal).

The operative criterion is not whether the (criminal) court or authority has passed sentence, as this would leave out cases where, for example, the perpetrator dies before sentence can be pronounced, or where a finding of diminished capacity makes sentencing impossible. Instead, the crucial issue is whether an act constituting a criminal offence has actually occurred, and whether the fact of its having occurred has been definitely established by a competent court or authority.

New Rule 67c EPC

establishes the obligation to raise any procedural objections already during the appeal proceedings, in so far as the party adversely affected by the defect is - or should be - aware of it.

New Rule 67d EPC

implements Article 112a(4), first sentence EPC 2000, particularly in respect of the petitioner's duty to substantiate his allegations. The reasoned statement has to be filed within the time limits laid down in Article 112a(4), second and third sentences.

New Rule 67e EPC

Paragraph 1 lists the admissibility requirements to be met by petitions for review.

Paragraph 2 concerns the decision of the Enlarged Board of Appeal if the petition is allowable. In accordance with the legal character of the petition as a special remedy, the Enlarged Board will set aside the decision of the Board of Appeal (by "cassatory" decision or *iudicium rescindens*) and order that the proceedings be re-opened. The proceedings are re-opened before the Board of Appeal responsible under the business distribution scheme enacted under Rule 10(4) EPC; however, the Enlarged Board of Appeal may order that members of the board be replaced.

New Rule 67f EPC

Paragraph 1 is the parallel provision to Rule 64a(1) EPC (previous Rule 66(1)). The provisions relating to appeal proceedings apply in particular to decisions of the Enlarged Board of Appeal in the five-member composition under paragraph 2(b).

Paragraph 2 implements Article 22(2), second sentence, EPC 2000.

To conduct proceedings on a petition for review in their initial phase in accordance with paragraph 3 is a safeguard to protect legal certainty by ensuring that review proceedings which clearly have no chance of succeeding can be ended swiftly.

Under paragraph 4, the reasons for a decision rejecting a petition as clearly inadmissible or not allowable will be as brief as possible, indicating only the main reason on which the decision is based.

From Articles 106 and 112a EPC it follows that there is no right of further appeal against a decision of the Enlarged Board of Appeal concerning a petition for review.

New Rule 67g EPC

deals with reimbursement of the fee for a petition for review. Reimbursement will normally be made if a fundamental procedural defect is found to have occurred, but the Enlarged Board of Appeal needs to have the possibility of withholding reimbursement in exceptional cases.

As in the case of appeal fees (see Rule 67 EPC), it is expressly provided that the fee shall be reimbursed if the petition is deemed not to have been filed, in particular where the fee has not been paid in due time or the petitioner has failed to provide the required translation in an EPO official language.

PART VII
IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION

Chapter I
RULES 68-70 EPC

Rules 68-70 EPC have been brought into line with the style of the EPC 2000.

Chapter II
RULE 70a EPC

The new Rule 70a, implementing Article 115 EPC, is inserted in the new Chapter II, headed "Objections by third parties".

The subsequent chapters are renumbered accordingly.

New Rule 70a EPC
(Preparatory document: MR/2/00, pages 147-148)

transfers Article 115(1), second sentence, and (2) EPC 1973 to the Implementing Regulations.

Chapter III
RULES 71-76 EPC

New Rules 72a-72d EPC
(Preparatory document: MR/2/00, pages 149-152)

These Rules deal with the taking of evidence and largely correspond to the current Rule 72 EPC, but also implement Article 117(2)-(6) EPC 1973. For the sake of clarity and legibility, the provisions have been divided into four separate Rules and drafted in the style of the EPC 2000.

Editorial amendments have been made to Rules 71, 72, 73, 74 and 75 EPC.

Chapter IV

RULES 77-82 EPC

Editorial amendments have been made to Rules 77 to 79 and 81 EPC.

Chapter V

RULES 83-85b EPC

Rule 85 EPC

Amendments are purely editorial.

Rules 85a und 85b EPC

have been deleted to take account of the extended application of further processing under Article 121 EPC 2000 (see also the explanatory remarks on the new Rule 85a).

New Rule 85a EPC

contains provisions implementing Article 121 EPC 2000.

Rule 85a(1) lays down the requirements (period, fee, completion of omitted act) to be met for the EPO to allow further processing under Article 121(2). The content of the new Rule largely corresponds to Article 121(2) EPC 1973. However, in view of the broadened scope of application of further processing, the period is no longer triggered by notification of the loss of the European patent application but by notification of the failure to observe the time limit or of the loss of rights. With regard to the extension of further processing to periods for payment of fees, the current requirement that a request for further processing be made in writing has been waived. Under the new system, the request is to be made simply by payment of the prescribed fee. The relevant fees for the various cases will be laid down in the Rules relating to Fees.

On the basis of Article 121(4), second sentence EPC 2000, Rule 85a(2) excludes the following periods from further processing: EPC Rules 6(1) (filing of a translation under Article 14(2) EPC 2000), 14a(1)(a) (enforcement of rights under Article 61), 25d(3), first sentence (filing of a copy of the previously filed application to which reference is made), 37(2) (payment of renewal fees), 38(2) (late declaration of priority), 41 (correction of deficiencies in application documents), 41a (correction of deficiencies in claiming priority) and 69(2) (request for appealable decision).

The period under Rule 6(1) EPC is excluded because the failure to meet these time limits may be remedied under Rule 41 EPC. The same considerations apply to the two-month period in Rule 25d(3), second sentence, EPC for the filing of a translation of the previously filed application. The three-month period under Rule 14a(1)(a) EPC is excluded from further processing because it is not monitored by the EPO and no communication can be issued if it is missed. This is acceptable because the exclusion implicitly recognises that, in principle, the entitled person under Article 61(1) EPC has access to the remedies provided by the EPC to deal with failure to observe time limits. Therefore, if he misses this time limit, he can apply for re-establishment of rights.

The reason for excluding the six-month period under Rule 37(2) EPC is that the latter is a period of grace (see Article 5*bis* of the Paris Convention - period of grace for payment of fees). This means that there is a structure whose effect corresponds to the legal remedy of further processing. It should also be noted that re-establishment of rights is possible in respect of the period under Rule 37(2) EPC.

In view of the publication of the application, the new time limit for late declaration of priority under Rule 38(2) EPC does not permit further processing. With regard to the time limit under Rule 41 EPC, the exclusion is also based on the fact that the procedure under that Rule is a form of legal remedy. This also applies to the new Rule 41a EPC.

Similar considerations apply to the two-month period under Rule 69 EPC, which allows for an administrative review of any loss of rights resulting from the Convention. If the time limit for requesting such a review is missed, the loss of rights becomes final without any further decision or communication being issued by the EPO. Thus the necessary procedural starting point for further processing is lacking. However, further processing also has to be ruled out on substantive grounds, as the procedure under Rule 69 EPC already has a remedial character.

The provision of Article 121(3) EPC 1973 regarding competence for decisions on requests for further processing is transferred to Rule 85a(3).

New Rule 85b EPC

contains the detailed provisions implementing Article 122 EPC 2000.

Paragraph 1, based on the existing law (Article 122(2) and (3) EPC 1973), lays down the periods for filing requests and establishes the requirement for payment of a fee.

However, to simplify the existing time limit structure, and in view of the relevant provisions of the PLT 2000 (Article 12(1)(ii) and Rule 13(2)(ii)), the six-month period of grace under the new Rule 37(2) EPC is not to be deducted from the period of one year for requesting re-establishment of rights. The latter period now begins on expiry of the six-month time limit for payment of renewal fees, instead of on the date when payment falls due. Under Rule 69 EPC, a (computer-generated) communication is automatically sent to the applicant within two months of the expiry of the time limit for payment; in practice, therefore, the period for requesting re-establishment of rights in such cases will seldom be invoked, and the *de facto* extension of this period under the new arrangement does not put third parties at an unreasonable disadvantage.

Under the new law, re-establishment of rights is also possible in respect of the priority period under Article 87(1) EPC. In view of this, and because of the central importance of the date of filing and/or priority for the valid claiming of priority, Rule 85b(1) EPC lays down a time limit specifically for such cases, where there is an urgent need for clarity. Any request for re-establishment of rights in respect of the priority period must be filed within two months of the expiry of that period (see also Article 13(2) and Rule 14(4) PLT).

Paragraph 2 incorporates the provisions of Article 122(2) and (3) EPC 1973 concerning the statement of grounds and facts and the completion of the omitted act.

Paragraph 3, based on Article 122(4) EPC 2000, rules out the re-establishment of rights in respect of the time limits for requesting further processing (see the explanatory remarks on the new Rule 85(a) EPC).

Paragraph 4 incorporates Article 122(4) EPC 1973 regarding competence for decisions on requests for re-establishment of rights.

Chapter VI

RULES 86-89 EPC

Rule 87 EPC

The amendment takes account of the revised Article 54 EPC 2000.

Chapter VII NEW RULE 89a EPC

New Rule 89a EPC

(Preparatory document: MR/2/00, pages 167-168)

The new Chapter VII, headed "Information on prior art" contains the new Rule 89a, which takes account of Article 124(1) EPC 2000 and specifies the types of information on prior art which the EPO may require from the applicant - ie information on prior art relied upon in national or regional proceedings concerning similar applications in respect of an invention to which the European patent application relates.

Chapters VIII-IX RULES 90-99 EPC

Editorial amendments have been made to Rules 90-99 EPC.

Rule 91 EPC

is deleted. This is the sole provision of Chapter VII, headed "Waiving of enforced recovery procedures". The substance of Rule 91 EPC will be incorporated in the Rules relating to Fees.

Rule 96 EPC

(Preparatory document: MR/2/00, pages 173-176)

is deleted, meaning that the substance of the deleted sub-paragraphs (a) to (e) of Article 128(5) EPC is not transferred to the Implementing Regulations.

Chapter X RULES 100-102 EPC

Rules 100 to 102 have been streamlined and their wording aligned with the style of the EPC 2000.

Rule 101 EPC

Paragraph 1 as presently drafted is somewhat misleading, in that the first sentence implies that in principle, unless requested to do so, representatives need not file a signed authorisation, when in fact, in the cases set down by the President, representatives are to file

an authorisation and will receive an invitation should they fail to do so. For the sake of clarity, Rule 101(1) EPC has therefore been redrafted and subdivided into new paragraphs 1 to 3.

New Rule 101a EPC

(Preparatory document: MR/2/00, pages 189-192)

The new Article 134a(1)(d) EPC 2000 bestows competence on the Administrative Council to adopt provisions governing the obligation of confidentiality of professional representatives and the privilege from disclosure in proceedings before the European Patent Office in respect of communications between a professional representative and his client or any other person.

The obligation of confidentiality binding professional representatives is provided for by Article 2 of the Regulation on discipline for professional representatives. As some legal systems distinguish between this obligation of confidentiality and an evidentiary privilege protecting the confidentiality of attorney-client communications, it is opportune to include a new Rule, entrenching such an evidentiary privilege for communications between professional representatives and their clients. Rule 101a(1) EPC draws its language from the definition of the evidentiary privilege in US law as cited from Wigmore's *Evidence* in the *Bristol-Myers Squibb v. Rhone Poulenc Rorer* case (Southern District of New York, 19 April 1999).

Rule 102 EPC

(Preparatory document: MR/2/00, pages 183-188 and 239-244)

Article 163 EPC 1973 dealt with the transitional provisions governing the entitlement of national representatives in a state having newly acceded to the EPC to be entered on the list of professional representatives after the expiry of the initial transitional period following the founding of the Organisation. Article 163 EPC as drafted was superseded and has therefore been deleted.

Rule 102 EPC is amended, in consequence, to eliminate unnecessary references to the initial transitional period.

Nevertheless, the substance of the "grandfather clause", contained in Article 163 EPC 1973, has been inserted into Article 134 EPC 2000 as a permanent feature, in order to deal with the integration of national representatives of countries acceding to the Convention in the future. Consequently, and as requested by the *epi*, the wording of Rule 102(3) EPC has been expanded to make it clear that professional representatives entered on the list under the grandfather clause and subsequently deleted are entitled to re-enter the list without being required to pass the European qualifying examination.

PART VIII
IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

RULES 102a-103 EPC

New Rule 102a EPC

(Preparatory document: MR/2/00, pages 193-198)

The following elements have been deleted from Articles 135 and 136 EPC 1973 and transferred to Rule 102a EPC:

- period for filing the request for conversion;
- lapse of the effect of Article 66 EPC if the request for conversion is not submitted in due time;
- obligation on the national Office or the EPO to attach to the request for conversion a copy of the European patent application or the European patent;
- time limit if the request for conversion is not transmitted.

Despite the reference to Article 66 EPC in Article 135(4) EPC 2000, the same reference is also necessary in Rule 102a(1), second sentence, since the effect referred to in Article 66 EPC can lapse not only in the case of failure to transmit the request for conversion (Article 135(4) EPC 2000), but also if the request is not submitted in due time.

Rule 103 EPC

The amendments take account of the deletion of Article 136 EPC 1973, the substance of which is reflected partly in Article 135 EPC 2000 and partly in the new Rule 102a(2) and (3) EPC.

PART IX
IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION

Rules 104-112 EPC

(Preparatory document: MR/2/00, pages 207-230)

The details of procedure deleted from Articles 150-157 EPC 1973 have been transferred, where necessary, to the Implementing Regulations. The wording of Rules 104-112 EPC has been streamlined and brought into line with the EPC 2000.

Rule 104 EPC

The amendments result from the consolidation of Articles 151 und 152 EPC 1973 in Article 151 EPC 2000. Some details omitted from the latter have also been transferred to the Implementing Regulations. The new version of Rule 104(1) incorporates the conditions - deleted from Article 151 EPC 2000 - under which the EPO acts as receiving Office. The second sentence sets out the principle, originally enshrined in Article 152(1) EPC 1973, that an international application must be filed directly with the EPO if the latter has been chosen as a receiving Office. The exception already provided for in Article 151 EPC 2000 (Article 75(2) EPC nevertheless applies *mutatis mutandis*) is reiterated here for the sake of clarity.

The first sentence of the present Rule 104(1) is transferred to paragraph 2. The second and third sentences are deleted, since the filing of applications in three copies will soon become unnecessary, as in the case of Euro-direct applications.

The new version of Rule 104(2), first sentence, is taken from the existing paragraph 1. The second sentence introduces a precautionary provision authorising the President to decide the further details of the scope and nature of the application documents.

The existing version of Rule 104(2) is redundant in view of the deletion of the second and third sentences from paragraph 1.

Rule 14 PCT already authorises the receiving Office to require payment of a remittal fee. The new paragraph 4 merely re-states this for the sake of clarity.

Rule 105 EPC

The two-tiered review system for the PCT protest procedure under Article 154(3) and 155(3) EPC 1973 in conjunction with Rule 105 EPC is no longer provided for under Article 152 EPC 2000. As was already pointed out in the explanatory remarks on Article 152 EPC 2000, it is possible to provide for a simplified protest procedure which complies with Rules 40.2(c) and 68.3(c) PCT and continues to guarantee legal certainty. This has been done in the new version of Rule 105(3) EPC, which also establishes the legal basis for settling the details by decision of the President.

Rule 107 EPC

The amendments are purely editorial. The deletion in paragraph 1(e) of the reference to Article 157(2)(b) takes account of the deletion of the relevant fee provision from Article 153 EPC 2000. All fees falling due on entry into the European phase, together with the provisions on the legal consequences of non-payment, have now been transferred to the Implementing Regulations (see also Rules 106, 108 and 110) EPC.

Article 153(2) EPC 1973 governing competence for review under Article 25 PCT is transferred to the new paragraph 3 of Rule 107.

Rule 108

In the new version of paragraph 3, the third sentence is deleted, in view of the legal remedy established by Article 121 EPC 2000 and concretised in the new Rule 85a EPC.

Rules 109-112 EPC

Amendments are purely editorial or consequential to other amendments made.
