

SUBJECT: Draft Implementing Regulations under the EPC 2000

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for information)

SUMMARY

For reasons of economy it has been decided that this document should include only those pages of CA/PL 5/02 Rev. 2 which have been amended in the light of comments received on that document. Amendments are marked in the text.

(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 and shall be filed with the European Patent Office in Munich, The Hague or Berlin.**

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 15, paragraph 2, Rule 25, paragraph 3, or 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;

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 55

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 55a

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

(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) The 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 of the patent 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 **decision within the meaning of Article 61, paragraph 1**, [...] 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.

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; Rule 55a shall apply *mutatis mutandis*. 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

Procedure for limitation procedures or revocation

Rule 63b

Subject of limitation proceedings

The subject of limitation or revocation proceedings under Article 105a shall be the European patent as granted or as amended in opposition or limitation proceedings before the European Patent Office.

Rule 63c

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 63d

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 proprietor of the European patent making the request (the requester) as provided in Rule 26, paragraph 2(c), and an indication of the Contracting States for which the requester is the proprietor of the patent;

(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 a 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

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) particulars of the **investigation to be carried out means of giving or obtaining evidence;**

(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**.

(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 appropriate**, a description and drawings which are different from those for the other designated ~~Contracting~~ States.

(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) 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 of notification of** this communication ~~is notified~~; or

(b) **otherwise**, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the ~~date on which this~~ **notification of this** communication is notified.

(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 or limitation proceedings~~ **by the European Patent Office**; 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

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

designation fee is paid in due time, the European patent application shall be deemed to be withdrawn.

(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 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

(2) Where the priority of an earlier application is claimed and the file number or copy provided for in Article 88, 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

(2) Where the priority of an earlier application is claimed and the file number **of the previous application or the copy 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

(a) it considered that the application did not comply with the requirement of unity of invention, and

within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the 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*.

(b) the applicant did not pay all additional fees **in accordance with** Article 17, paragraph 3(a) **PCT**,

[...] 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 [...].