

BETRIFFT: Entwurf der Ausführungsordnung zum EPÜ 2000
- Stellungnahmen
SUBJECT: Draft Implementing Regulations under the EPC 2000
- Comments
OBJET : Avant-projet du nouveau règlement d'exécution de la CBE 2000
- Commentaires

VERFASSEN: Ratssekretariat
DRAWN UP BY: Council Secretariat
ORIGINE : Le secrétariat du Conseil

EMPFÄNGER: Ausschuß "Patentrecht" (zur Unterrichtung)
ADDRESSEES: Committee on Patent Law (for information)
DESTINATAIRES : Le comité "Droit des brevets" (pour information)

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Comments from the Confederation of Danish Industries (DI) on the Draft Implementing Regulations

On behalf of DI, I hereby send the comments prepared by DI as regards the draft Implementing Regulations. The comments are structured by reference to the Rule numbers.

Rule 31 (Claims fee)

The wording in the draft is ambiguous.

First, is it the intention that fees are to be paid if additional claims are filed during proceedings?

Second, should fees be paid every time amendments are being made to the claims filed?

Third, if two claims are merged into one during proceedings, would this amount to a new claim being filed?

This would not appear expedient. DI prefers that the fee is paid at the end of proceedings when the patent is accepted, i.e. the fee is paid for the claims allowed.

However, if the intention of the wording is to limit the number of claims EPO will have to investigate as part of the procedure, this could be solved in other ways. For instance, the fee could be paid from the maximum number of claims that occurred in the patent at any time of the proceedings. In this case, if a patent application were filed containing 11 claims, later elaborated to 15 claims while the patent were finally issued containing 12 claims, fee would be paid for 15 claims. By such a procedure, an incentive for proprietors to focus is given without unduly jeopardising the legitimate interest of the main part of the applicants.

Rule 32 (Drawings)

In general, this provision should take better account of the developments of modern technology. This applies to the use of colours, drawing instruments and text.

First, DI fully recognises the need to limit the use of colours. However, in cases where the use of colours actually contributes to increased clarity, this should not be prohibited. This could for instance be the case where several graphs have to be displayed in the same diagram. If the maintenance of the exclusion is based on matters of cost, this could be solved through the payment of additional fees.

Second, the reference in rule 32 (2) (e) to drawing instruments should be widened. E.g. to "drawing instrument, machine or other appropriate means", the only demand being sufficient clarity / unambiguity.

Third, rule 32 (2) (j) excludes any use of text, except for a few words. This is outdated. DI recognises the need to minimise the use of text in drawings. However, more text should be allowed where this contributes to increased clarity and where the text occurs naturally. This is for instance the case with chemical spectra, which contain bits of explanatory text. Today, these will have to be converted to pure drawings - without increasing clarity at all. Hence, the rule appears too rigid.

Rule 35 (General provisions)

In paragraph nine, the size of capital letters is specified. Having in mind the wide range of fonts available today, DI proposes that the size of lower-case letters is specified too. Furthermore, the minimum acceptable size of indices in formulas should be specified.

Rule 44 (Content of the European search report)

Rule 44 (2): In line with the new drafting style, "diagrams" should be replaced with "drawings".

Rule 63 ff (Limitation procedure)

DI generally supports the inclusion of a limitation procedure. However, there are some elements that ought to be carefully considered.

First, the procedure - as described in the IR - appears rather inflexible. The wording of the rules leaves the impression that there is no possibility for dialogue between the EPO and the proprietor during the procedure. Either all requirements are met - or the application must be rejected.

It would be expedient to allow the EPO to inform about flaws in an applications, as this would provide the proprietor with an understanding of the need for corrections. What if only a few words caused the problem? So, the result would not have to be the filing of a completely new application and thus increased costs and bureaucracy. Both the proprietor and the EPO would benefit from this. Should the exclusion of any dialogue be due to matters of cost, this could be solved by payment of additional fees in case of corrections.

Second, mistakes will inevitably occur, i.e. limitations are being allowed that should have been rejected. In this case, third parties will suffer great damage. The only option for them is to initiate formal proceedings in all countries covered by the patent, which is definitely not satisfactory.

Instead, they should be allowed to file oppositions as part of the limitation procedure. After all, they are the ones suffering in case of any mistakes occurring. This procedure is well known in limitation cases at the Danish Patent Office, where it works to the satisfaction of all parties. In case the EPO should reject this proposal, the absolute minimum requirement for the procedure must be openness, i.e. applications for limitation should be made public in the Patent Register, allowing interested parties to file observations.

Rule 64 a (Examination of appeals)

Why has EPO chosen to apply the word "impugned" in rule 64 a (3) instead of "appealed", which is used in rule 64 a (1)? In the absence of any specific reason, DI suggests consistent use of the word "appealed" instead of "impugned".

Rule 69 (Noting of loss of rights)

The draft uses "person" as well as "party" in the second paragraph. DI proposes the consistent use of "party" instead of "person".

Rule 89 a (Information on prior art)

The scope of this provision is not completely clear. It states that applicants may *be invited* to provide: "...information on a) search reports...". Does this mean that an applicant may be forced to hand in complete search reports from other proceedings?

DI strongly opposes such a demand as it would not by any means be justified by legitimate concerns, i.a. cost or need for exact information. On the contrary, it would only provide competitors with easy access to knowledge about "patent free" areas. Proprietors should not be forced to support their competitors' efforts to "invent around" patents.

It is recognised that, in the name of expediency, applicants should contribute with information readily available during proceedings. It is in the interest of all parties that the foundation on which decisions are made and patents granted is as accurate as possible. However, the full search report is not necessary for this purpose. It would fully suffice if the rule were redrafted in a way so that applicants might inform about all prior arts of which they are aware. This could be by the delivery of abstracts of search reports, citations made in search reports etc.

Rule 101 a (Attorney evidentiary privilege)

This rule should also mention the preparation and prosecution *of oppositions*.

Yours sincerely,

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