

**CA/PL 10/02 Add. 3**

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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

VERFASSER: 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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Eingegangene Stellungnahme von:  
Comments received from: FICPI  
Commentaires reçus de :

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## **Draft FICPI position paper to**

### **New Implementing Regulations under the EPC 2000**

FICPI welcomes the initiative taken by the European Patent Organization with the public release of the draft Implementing Regulations with explanatory remarks on 7 June 2002 and the accompanying notice from the European Patent Office contained in SACEPO working document SACEPO 3/02 of 10 June 2002.

With the short time limit until 12 July 2002 for submission of observation to the 150-page-long draft it has for natural reasons not been possible to collect the views of all relevant circles within FICPI, including members of the subcommittee of the Study and Works Commission of FICPI entrusted with European patent questions.

Therefore, the present submission may only be taken as a provisional summary reflecting immediate views of the author as chair of the European patent questions sub-committee.

In general, the European Patent Office is to be congratulated for the substantial efforts laid down in the preparation of the draft implementing regulations and the very impressive result of this effort.

In the view of FICPI the draft Implementing Regulations have successfully achieved the three objectives stated in the SACEPO working document, i.e.

- 1) Making the adjustments required by substantive amendments to the EPC 1973 and those dictated by the implementation of the Patent Law Treaty of 1 June 2000;
- 2) Integrating the provisions transferred from the EPC to the Implementing Regulations; and
- 3) Ensuring the consistency of the Implementing Regulations with the drafting style of the EPC 2000, i.e. restructuring the Implementing Regulations, streamlining the Rules and aligning their wording to reflect the terminology of the new Convention.

With respect to some of the specific provisions of the draft the following observations are submitted:

#### **Rule 25d**

The adaptation of EPC filing date requirements to the Patent Law Treaty, including the option in subsections (1) (c) and (2) for obtaining a filing date



by reference to a previously filed application as an alternative to a description, is welcomed as a substantial contribution to added flexibility for applicants in emergency situations, where urgency of action is needed to preserve rights.

### **Rule 38**

The option provided by subsection (2) for submitting all three elements of a priority claim, i.e. priority date, country and application number, as well as correction of any of these elements up to the 16 months' date is a significant improvement with respect to the corresponding provision of the Implementing Regulations presently in force.

### **Rule 38a**

Although the abolition of the requirement under current EPO practice for filing of a certified translation of a priority document in a language different from the official languages of the EPC, as required by the Patent Law Treaty, will undoubtedly be welcomed by many applicants, assessment of the validity of a priority claim, e.g. with respect to "prior art" published in the priority interval would become more difficult and expensive for third parties seeking an opinion outside proceedings before the office.

In the view of FICPI it should be considered to extend the provision of subsection (3) throughout the life of a European patent to allow an invitation to the patent proprietor to submit the translation to the office on the request of a national of future European competent court in the course of litigation involving the validity of the priority claim.

### **Rule 63c**

Although FICPI would agree to the proposed implementing regulations with respect to the limitation and revocation proceedings on request by the patent owner, the view is taken that clarification of the requirement for the "requester", who is not mentioned in Article 105a of EPC 2000, to be proprietor of the patent for at least one contracting state, would be desirable.

### **Rule 89a**

FICPI has noted with interest the proposed provision for mandating the EPO to require prior art information to be submitted by the applicant. This appears to follow recent trends in other national offices, such as the Australian and Japanese Patent Offices, to copy existing US practice in this regard. It is noted, however, that the option provided for in subsection



(b) does not include submission of a translation of prior art in a language different from the three official EPO languages.

Moreover, the exact meaning of the terms “other prior art” and “taken into consideration” is not very clear, and there appears to be no sanction for an applicant's failure to respond to the invitation by the office.

### **Rule 101a**

FICPI can fully endorse the proposed implementation of the competence given to the Administrative Council to adopt provision with respect to the attorney evidentiary privilege provided for in Article 134 a of EPC 2000 as well as the explanatory remarks to this proposal.

In the view of FICPI the proposed provisions could well serve as a model for grant of an attorney client privilege also in administrative and legal proceedings at the national level in EPC contracting states, in which such a privilege does not exist for non-lawyer patent attorneys.

5 July 2002  
Knud Raffnsoe