

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)

Eingegangene Stellungnahme von:
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Commentaires reçus de :

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Comments from the UK Delegation concerning the draft version (June 2002) of the New Implementing Regulations under the EPC 2000

General comments

- 1) The purpose of the draft New Implementing Regulations under the EPC 2000 is to give effect to the changes to the EPC agreed at the Diplomatic Conference in November 2000. Many of these changes were designed to streamline and simplify the EPC by transferring much of the detail to the Implementing Regulations. As a consequence the UK considers that in the absence of a strong reason to the contrary, the Implementing Regulations should specify exactly the details and conditions which have to be met rather than leaving them to be prescribed or defined elsewhere (i.e., outside of these regulations) or left to the discretion of another body or person.
- 2) While it is appropriate to modernise the language of the implementing regulations, it is important to ensure that such modernisation does not result in changes to the meaning of the modernised regulations. Such changes in meaning should be avoided as there was no mandate from the Diplomatic Conference to change practice by these new regulations. It is therefore considered very important that unless there is a clear and justified need for change that the existing wording will be retained.
- 3) In general, UK interests thought that the use of the term "*to be specified*" in relation to time limits is not very user friendly and that time periods should preferably be specified in the relevant Rule [rather than referred to in general terms in Rule 84]. However, the UK appreciates that this mechanism has been chosen to provide maximum flexibility for the Implementing Regulations to adapt to future changes in such time limits. Thus, the UK proposes that the President/Office publish a list of time periods which relate to each rule at regular intervals in the EPO Bulletin.

Specific Comments

Rule 2(1)

- 4) Why has "*one of the other official languages*" been replaced by "*any official language*". This new phrase does not have the same meaning as the previous wording, it is wider and implies that both other official languages may be used.

Rule 2(2)

- 5) Clarification of the changes to Rule 2(2) is required. Why has the phrase "*in the course of*" been replaced by "*in*"? The implication from this change is that the other language could be used throughout the entire proceedings. This may have an adverse effect on the ability of the parties to follow these proceedings. This

textual change has not been highlighted in the draft version. The original wording is preferred by UK interests.

Rule 17(3) and Rule 96

- 6) New Article 128(5) states that the Office may communicate or publish “*the particulars as specified in the implementing regulations*”. This requirement has been ignored in rule 17(3) by leaving it to the discretion of the President to define and by deleting rule 96 completely. These particulars are significant as they specify the data to be published and the minimum such requirements must be stated specifically in the Regulations. Why should the President have the discretion to specify the further data required? The UK considers that new Rule 17(3) Combined with the deletion of Rule 96 clearly do not meet the requirements of Article 128(5) EPC 2000.

Rule 23h(2)(b)

- 7) The new Rule should retain the phrase “*the requester being regarded as a third party*” found at the end of current Rule 28(5)(b). This is a useful clarification and should be retained.

Rule 23j(1) and (2)

- 8) New rule 23j(1) is a significant change from previous rule 28a(1). It removes the requirement to forward a copy of the receipt issued by the depositary authority to the EPO. If, as envisaged under Article 4(1) of the Budapest Treaty, there is a need to make a new deposit to a different depositary authority, how would this be notified? What is the justification for such a change?
- 9) A similar question arises with Rule 23j(2). Why has the substance of old rule 28a(3) been deleted? Why will the notification of the date no longer be printed in the OJEPO?
- 10) Rule 23j(1) refers to the deposit being made “*in accordance with the provisions of the Budapest Treaty*”. As a result, why is it necessary to include the second paragraph (Rule 23j(2)) in this rule. Furthermore, why is the text of this paragraph taken from Article 14(2) of the Biotech directive [“*depositor certifying*”] rather than Article 4(1)(c) of the Budapest Treaty [“*depositor alleging*”]. This change appears to be confusing and without justification.

Rule 31(2)

- 11) As currently written, this new rule will require the applicant to pay a fee for all subsequent claims above the first ten filed including those filed in response to examiner actions. The purpose of this rule is to discourage large numbers of claims in the initial application, it is not supposed to penalise the applicant for filing new claims arising from examination of the application. Suggest the

phrase “*the first set of*” be inserted after “*within one month of filing*” and before “*the claims*”.

Rule 38(2)

- 12) Suggest that an additional phrase “*in which case the declaration must be filed no later than that request*” is added at the end of the second sentence. This will make it clear that the declaration of priority must be filed at the same time as the request for early publication (i.e., Art 93(1)(b) request).

Rules 39 and 39a

- 13) What does the time limit of two months in Rule 39 and Rule 39a relate to? This should be specified; suggest insertion of “*from notification of such deficiencies*” after “*two months*” in both rules.
- 14) Last sentence of Rule 39a(1) should be deleted as it places too harsh a burden on the applicant. This requirement also appears to have no basis in EPC 2000.

Rule 46

- 15) A clear explanation of the proposed change to Rule 46 is required before such a major change can be considered. This is a clear example where the redrafted rule has a significantly different meaning to the original rule. Such a change has no basis in EPC 2000. Why is it proposed at this time and in this way? By proposing such a significant change the Office is contradicting the terms of the consultations on these draft Implementing Regulations (notice from EPO dated 7 June 2002).
- 16) What is the basis for the change from “*first invention*” to “*main invention*”. No explanation of this change is offered in the Explanatory Remarks. This is a very major change of concept and raises a number of important questions? Where is it proposed to explain what “*main invention*” mean, e.g., in the EPO examining Guidelines? Is this related to the question of Complex Applications? Will the choice of the ‘*main invention*’ be solely at the discretion of the Search Division of the EPO? Will the applicant be contacted regarding their preference?
- 17) Under the current Rule 46, it is clear that it is the ‘*first invention*’ mentioned in the claims that will be searched. The current wording leaves little or no scope for confusion and should not be changed unless there is a clear and justified reason. No such change should be considered until all its implications have been discussed.

Rule 54

- 18) Why has former paragraph (2) been deleted? How will the proprietor obtain duplicate copies of his European Patent certificate in future?

Rule 56

- 19) This rule appears to set tougher requirements for requesting opposition than existed under EPC 1973. Why is it necessary to include requirements from Rule 55, paragraph (2)(b)? If the application number is used in error, instead of the patent number, will the opposition application be rejected?

Rule 58a(2)(a)

- 20) No time limit is specified for paying the required fee.

Rules 63b to 63h

- 21) We are concerned that these rules, as drafted, raise questions of legal certainty. How will Article 69 and its Protocol be applied to a limited patent? While, it is agreed that the limitation procedure would be less costly in time and expense for the patent proprietor if he is not required to amend the description, such a limitation procedure could increase legal uncertainty regarding how the court will interpret the original description with respect to a set of limited claims. Should these regulations recognise the possibility of amendments to the description?
- 22) A second general concern arises regarding the clarity and transparency of this new limitation procedure? How will a person reading a limited patent specification know what changes have been made?
- 23) A third general concern is what happens if the person requesting the limitation procedure was not entitled to do so? What sanction is available if such a limitation has been granted? Under Art 123(3) EPC 2000, if such a limitation has been granted in error, the original version of the patent before limitation cannot be restored. For example, should the rules say that, if proper assent is not given, the request shall be deemed never to have been made and any limitation shall be deemed not to have been granted?

Rule 63c(2)(a)

- 24) Why is the word "*requester*" used in this instance rather than "*proprietor*"? Article 105a EPC 2000 indicates that the request must be made by the proprietor. If retain "*requester*" how will one confirm that this request is a valid one and that the person making it is the proprietor of the patent? Rule 63c appears to imply that the requestor may not be the proprietor? Under what circumstances will this situation apply? The requestor must, at least, be the proprietor in one of the EPC Contracting States [cf. Art. 105a EPC 2000]? Suggest that the phrase "*if the requester is not the proprietor as at the time of*

grant, evidence must be provided as to how he derives title as proprietor” is added to paragraph (2)(a).

Rule 63e

- 25) Would like clarification on how rule 63e will be applied? Will the request for an opposition procedure automatically terminate a limitation procedure? Will limitation only be possible once the opposition procedure has been completed? If so this should not be the case. One should be allowed to proceed with limitation procedure before beginning opposition – less costly, faster procedure, can remove reason for opposition, allows patent holder to act directly on information re. prior art received from a third party.

Rule 63h

- 26) This Rule should be more explicit regarding the requirements for publication of the limited patent. Patents which have been subject to limitation should be clearly identified as such. The original claims could be shown in strike-out (i.e., with a line through them) in combination with the limited claims so that the exact nature of the limitations made are clear. Furthermore, if the patent description has not been amended, assuming such amendment is possible [see paragraph 17], a printers note should be included on the first page of the specification as a warning that the description has not been amended to agree with the limited claims, e.g., *“The description above has not been amended to reflect the limitations made to the claims”*

Rule 64(1)(c) and Rule 64(2)

- 27) Rule 64 also appears to place greater requirements on the applicant than was the case under EPC 1973. What is the justification from EPC 2000 for the extra requirements laid out in Rule 64(1)(c) and Rule 64(2)? What does “*defining the subject of the appeal*” mean in Rule 64(1)(c)? Suggest that the current wording be retained.

Rule 67a

- 28) Consider that a further sub-paragraph (c) should be added to the list of fundamental defects which will allow for review if there is a failure to ensure and provide “*the right to a fair & impartial hearing*” (cf. Art.6 of the European Convention on Human Rights).

Rule 84

- 29) Why has this rule been changed? Suggest that the meaning is much clearer if the words “*certain*” and “*special*” are interchanged to read “... *in certain circumstances it may be up to six months. In special cases, the period may be extended upon request...*”.

Rule 85(a)

- 30) It is not clear why Rule 41, Rule 41a and Rule 25d (paragraph 3, 1st sentence) have been excluded from further processing? Subject to clarification, suggest that these exclusions, especially Rule 41 and Rule 41a be removed.

Rule 96

- 31) See comments in paragraph (6) above regarding Rule 17(3).

Rule 101

- 32) This new rule regarding evidentiary privilege is welcomed. However, we consider that Rule 101(1) may be too narrowly drafted. It should also cover the giving as well as the seeking of advice. For example, does this cover advice given by the representative on his own initiative, such as comments with regard to a particularly relevant citation in a search report forwarded to the client? What if the representative makes a comment regarding potential infringement? Does this also cover the case where the advice is sought by a professional representative or associate acting for the client?

Rule 105(3)

- 33) No details are provided regarding the composition of the three member panel to consider the protest. Further detail should be included. Suggest panel composition should be the same as that for oppositions. Clarification as to why this should be at the discretion of the President of the EPO is required.