

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
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VIA FACSIMILE

Dear Sirs

We send this firm's comments on the draft Implementing Regulations under EPC 2000:

Rule	Comments
1(3), 6(2)	a) in <u>ex parte</u> proceedings the translation should be into the language of the proceedings; in opposition into the official language used by the opponent or the language of the proceedings. b) Why does this apply only to a Notice of Appeal and not to the Grounds?
13(1)	It remains unclear whether the proceedings must be in a court recognised under the Protocol.
13(2)	Why "only"? Surely "resumed not less than 3 months"?
13(4)	The confusion remains as to whether the "not ... less than 2 months" is declaratory or conditional
15(1)	"Taken or recognised" does not repeat the full wording of Rule 14(2).
19(1)	Why should the proprietor consent when under Rule 18(2) he is already under a requirement?
23(e)(3)	An explicit statement of industrial application being required here is in contradiction to the EPO's (correct) view that all chemical compounds are industrially applicable.
23(4), 23(5)	Rule 24(4) refers to any authority qualified under Article 75(1)(b); Rule 24(5) and also 25a(1) refer only to <u>central</u> authorities.
24(1), 25(1)	Rule 25(1) leaves it unclear as to what is meant by "EPO" in Article 76; compare Rule 24(1)

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Rule	Comments
25d(2)	<p>(i) "It" in line 5 is ambiguous. The reference cannot per se replace description etc. It is the previously filed application that does so.</p> <p>(ii) It appears that this rule is intended to apply to divisionals. In that case, however, (3) would be inapplicable.</p>
25d(3)	<p>i) Is the translation additional to the copy of the previously filed application?</p> <p>ii) Does Rule 7 apply? If it does not, what is the sanction for non-compliance?</p>
26(1)(h)	Why should one be forced to designate a plurality of states? Also, ultra vires Article 79(2).
31(2)	<p>i) "One month of filing the claims" is not restricted to the time of application. Fees would be paid progressively throughout the procedure.</p> <p>ii) Such a result would render Rule 110(1) and Rule 51(6) nugatory.</p> <p>iii) On a literal construction, a fee would be paid every time an excess claim was filed irrespective of how many excess claims fees has already been paid. Contrast the final phrase of Rule 51(6).</p> <p>iv) The concept of abandonment of a claim is wholly obscure. The sanction should be deemed withdrawal of the application, allowing further processing.</p>
35	The translation referred to in Rule 25d is not covered.
38(2)	"Unless" appears to be retroactive. The intention seems to be to require the declaration not later than the Article 93(1)(b) request. Why not say so?
38a(1)	"With which" is unclear in relation to PCT applications which are filed in the "wrong" Receiving Office.
39(3)	"Completely contained in" is totally insufficient. The test should be that of Article 123(2).
50a(2)	Since Rule 86(2) gives an opportunity to amend at this stage anyway, what is the final phrase of this doing?

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Rule	Comments
50a(3)	The "Communication" in Rule 50a(2) is under Article 94(3) only. It appears that this paragraph should also refer to the "invitation" in Rule 50a(2).
51(3)	Should be old (4) unchanged.
51(4)	i) What is the procedure if the applicant approves the claims but not the description? There is no provision.
51(7)	Should be old 51(8) unchanged.
54	Who is "the proprietor" to whom the certificate is issued, in view of Rule 52?
55b(2)(b), 56(1)	It is absurd that the omission of the title should be a fatal error. This should fall under Rule 56(2), or be omitted altogether.
57a	Why "grounds"?
58(3)	Where a ground is raised ex officio under Rule 58(1) a communication <u>must</u> be issued not only "covering" but specifying and justifying the objection (A 113 EPC).
58(a)(2)(b) second sentence	Which "communication" (see Art 101(1))? The confusion between the optional nature of a communication resulting from an opponent's submissions and the essential nature of one arising from ex officio objection must be dealt with.
Limitation procedure	The rules should make clear that consequential amendments may be made to the description and drawings.
63d	In line 7 "communicated" should be "notified".
63f	Examination under Article 84 should be restricted to the amendment, not apply to the claims generally, in line with current opposition jurisprudence.
85a(1)	The rule is ambiguous. Is a communication required both in the case of exceeding a time limit and in the case of loss of rights? If not, the final line should read ".... or of a loss of rights"; if it is, the words "communication (etc)" should be repeated.

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Rule	Comments
85a(2)	It appears that the period under rule 25(1) should also be excluded.
85b	Ruling out re-establishment "for" any period for which further processing is available rules out almost all terms. "During" seems to have been intended. To avoid black holes why not provide that any re-establishment application filing during such a period shall be treated as an application under A 121?
102(a)(2)	Why necessarily plural states?
104(4)	"Within one month of filing the application" as distinct from its receipt presents problems in the case mentioned in Rule 104(3).
110(2)	The present practice of the EPO is to regard the invitation under rule 109 as being also the communication under rule 110(2) in the case where claims are added as a result of the invitation. In view of the availability of further processing under new A 121/rule 85a it should be made clear that the communication under rule 110(2) must be a separate one, issued after the failure becomes apparent.
110(4)	See Rule 31(2), comment (iv).

Yours faithfully



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