

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:

Comments received from:

American Intellectual Property Law Association

Commentaires reçus de :

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July 19, 2002

Mr. Gerte Kolle
International Legal Affairs
European Patent Office
Erhardtstr. 27
D-80331 Munich
GERMANY

Re: Comments on Draft Regulations under EPC 2000

Dear Gerte,

I am writing you on behalf of the more than 14,000 members of the American Intellectual Property Law Association regarding the Draft Regulations under EPC 2000 published by the European Patent Office on June 7, 2002. As you know, we have had slightly more than one month to review the 151 pages of the Draft Regulations, so we may wish to augment the limited comments we are now able to provide.

Overall, AIPLA believes that the EPO has done a good job with the proposed Rules. As we understand the Draft Regulations, the biggest change is that many provisions that were found in EPC 1973 have now been moved from the Articles to the Regulations. This will make it easier for the EPO to change and adapt and provide a flexibility that we believe is generally positive. The Regulations have also been amended to track the WIPO Patent Law Treaty concluded in June 2000.

We believe that the majority of the changes are logical and acceptable. The one exception involves the "Limitation Procedure" set forth in Part V, Chapter II. Rule 63b-h implements new Article 105a which provides a mechanism by which a European patent may be revoked or limited in scope at the request of the proprietor, subject to a fee. The request to limit the scope of a European patent requires that the proprietor submit an amended set of claims. The EPO will examine the claims only to determine whether or not the amendment actually limits the patent and meets formality requirements. No other examination will take place. Assuming that the requirements for limitation or revocation are met, the Examining Division of the EPO will grant the request. If the requirements are not met the request will be denied.

In the event of a conflict between a limitation or revocation proceeding and a third party opposition proceeding, the opposition proceeding will normally have priority. There does appear to be a discrepancy, however, between the explanatory remarks concerning Rule 63e relating to Article 105a(2) and proposed Rule 63e. The explanatory remarks suggest that where an opposition proceeding is initiated following the lodging of the request for limitation that the limitation proceedings will be terminated. Where an opposition proceeding is requested following

the initiation of a revocation proceeding, the revocation proceeding will continue. This makes sense and potentially saves an opponent a significant amount of money, but it does not seem to be implemented in Rule 63e. We would suggest, therefore, that proposed Rule 63e be amended to incorporate the concept that, in the event of a conflict between a revocation and a later filed opposition, the opposition be stayed until a decision is reached in the revocation proceeding. To that end, we suggest that a second sentence (underscored) be added so that Rule 63e would read:

"If, at the time of filing an opposition to a European patent, the request for limitation of the patent has been validly filed, the Examining Division shall stay the limitation proceedings and order the reimbursement of the limitation fee. If, at the time of filing an opposition to a European patent, the request for revocation of the patent has been validly filed, the Examining Division shall stay the opposition until a decision is reached on the request for revocation, and terminate the opposition if the patent is revoked."

We appreciate the opportunity to offer this comment and we will continue to review the Draft Regulations.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is fluid and cursive, with the first name "Michael" and last name "Kirk" clearly distinguishable.

Michael K. Kirk
Executive Director