

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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Eingegangene Stellungnahme von:  
Comments received from: Chartered Institute of Patent Agents  
Commentaires reçus de :

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**Comments of the Chartered Institute of Patent Agents  
on the June 2002 Version of the  
New Implementing Regulations under the EPC**

*These comments are submitted by the Chartered Institute of Patent Agents, which is the professional body for patent attorneys in the United Kingdom.*

General Comments

1. Many of the changes to the EPC that were agreed at the Diplomatic Conference in November 2000 were to streamline and simplify the EPC by transferring details to the Implementing Regulations. It is therefore important for such details, including conditions and time limits to be met by applicants or by the EPO, to be set out clearly and unambiguously in the Implementing Regulations. It is not acceptable for these matters to be dealt with outside these regulations; it is clearly not in the best interests of users always to be required to refer to multiple documents in order to be sure of using the system properly. Moreover, users may not be given an opportunity to comment on the acceptability of the details defined in such other documents, or left to the discretion of another body or person.
2. The draft includes many amendments that are not required to give effect to the EPC 2000, but which are intended to modernise the language. Some of these amendments appear to alter the meaning of the Regulations or are susceptible to an interpretation that could alter the meaning, and hence the practice. We believe that any possibility of an unintentional change in the meaning of the regulations should be avoided. In any event, changing the wording of a rule always raises a question in the minds of users as to whether this implies a change in practice. If everyone knows what is meant by a rule, taking into account the case law that has developed, why change it? Changes to modernise the language should only be made where they really are required for clarity.
3. There are a number of changes which are neither related to EPC 2000 nor to modernisation of the language. Such changes should not be included in this draft but should be made the subject of separate proposals which can be discussed outside the context of EPC 2000.

4. We have only seen the English version of the draft Implementing Regulations. It is important to review the draft in all three official languages, not least to help us to establish whether some of the changes are merely in drafting style or whether they are more substantial.
5. The Implementing Regulations are changed every year for one reason or another. The Regulations currently under consideration will not be operational for 3-5 years and it appears that they will be “frozen” during this period. We think there is a danger that they could be overtaken by other rule changes during this period. Therefore we suggest that they should not be frozen, but that it should be possible to improve them, for the benefit of all, to take account of developments during the period before they become operational.

### Specific Comments

#### Rule 1 (3) and many subsequent instances

The phrase “within a period to be specified” does not clarify who will specify the period nor what principles will be applied. We would prefer each Rule to specify the time period. However, if this could create difficulties in the event that the time periods need to be amended in future, we suggest that the phrase should be expanded to read “within a period to be specified by the European Patent Office in accordance with Rule 84”. In this case, Rule 84 should include a list of the time periods; only one rule, Rule 84, would need to be amended to change any of these time limits. In addition, an up-to-date list of time periods that relate to each rule should be available on the EPO website and published in the EPO Bulletin each time there is a change.

#### Rule 2 (1)

The phrase “any official language” does not have the same meaning as the previous wording, as it would allow both other official languages to be used.

## Rule 2 (2)

The substitution of “in” for “in the course of” alters the meaning and implies that the other language could be used throughout the proceedings, which may adversely affect the ability of the parties to follow those proceedings. We prefer the existing wording.

## Rule 6 (1)

The one month time period is different. We would prefer to retain the current, more generous, period, which is just as consistent with PLT.

## Rule 6 (3)

In our view, the new language is not very clear.

## Rules 7, 13 and 56a and subsequent instances

The change of “proof” to “evidence” may be interpreted as changing the standard.

## Rule 9

Delete the opening “The”

## Rule 16 (1)

It may be argued that changing “disclosed” to “contained” alters the meaning. In our view, the new wording is less clear than the current version.

## Rule 17 (3) and Rule 96

New Article 128 (5) states that the Office may communicate or publish “the particulars as specified in the Implementing Regulations”. This requirement is not met by leaving it to the discretion of the President. The minimum requirements for data to be published should be stated explicitly in the Regulations. In our opinion,

new Rule 17 (3) combined with the deletion of Rule 96 do not meet the requirements of Article 128 (5) EPC 2000.

#### Rule 18

The new wording changes the meaning. Although this change may turn out not to be significant in practice, we do not see a need for it.

#### Rule 20

The new wording, “providing evidence” rather than “satisfying the European Patent Office”, appears to change the standard. Whilst such a change may be desirable, it should be considered properly and not just made accidentally.

#### Rule 23 (b)

Use of the word “attest” rather than “stating” arguably changes the standard. What exactly is meant by “attest” here? Also, “display” may not be an appropriate word for all types of invention.

#### Rule 23 h (2) (b)

The phrase “requester being regarded as a third party” found at the end of current Rule 28 5 (b) is a useful clarification and should be retained in this rule.

#### Rule 23 j (1) and (2)

This is a significant change from current rule 28 a (1). It removes the requirement to forward a copy of the receipt issued by the depositary authority to the EPO. If there is a need to make a new deposit to a different authority, as envisaged under Article 4 (1) of the Budapest Treaty, how will this be notified? Why has the substance of current rule 28 a (3) been deleted? Why will notification of the date no longer be printed in the OJEPO?

Since 23 j (1) refers to the deposit being made “in accordance with the provisions of the Budapest Treaty”, it is not necessary to include 23 j (2). Moreover, why is the text of 23 j (2) taken from Article 14 (2) of the Biotech Directive (“depositor certifying”) rather than Article 4 (1) (c) of the Budapest Treaty (“depositor alleging”). This could cause confusion.

#### Rule 25 d (1) (c)

We appreciate that this has been amended for consistency with the PLT. However, we are concerned that the new wording opens the door to the practice of incorporating prior specifications by reference. We suggest that “of which the priority date is claimed” should be added to clarify the circumstances in which reference to an earlier filed specification is permissible.

#### Rule 25 d (2)

Does this make sense? If an applicant is making a reference, that applicant will not actually file a specification. Therefore, the reference cannot “replace” anything. Perhaps it should say:

“A reference to .... was filed and shall indicate that the description and any claims or drawings filed in connection with the previously filed application are to be used as the equivalent documents for the European application”

#### Rule 26

Is the new wording compatible with plans for electronic filing?

Does the deletion of the second sentence of Rule 26 (1) mean that the EPO can charge for forms? We do not agree to such a change.

In Rule 26 (d), the expression “letter (c)” is less clear than the current “sub-paragraph (c)”. (This point also applies to Rule 29 (1) (b))

#### Rule 31 (2)

This amendment is not acceptable to applicants because it would require payment of claims fees every time amended sets of more than 10 claims are filed in response to the search report or examination reports. This is a substantial change and we do not agree with it because it will increase costs and complicate the system for users. It should be clarified that any claims fees are to be paid within one month of filing the first set of claims. Also, Rule 31 (3) is rather harsh if you have to pay a fee every time you amend the claims.

#### Rule 34 (2) and (3)

It should be clarified that it is the EPO that decides upon what matter is omitted.

#### Rule 38 (2)

It would be advisable to clarify that the declaration of priority must be filed at the same time as a request for early publication under Article 93 (1) (b). The phrase, “in which case the declaration must be filed no later than that request” could be added. In addition, use of a ‘preferably’ clause creates uncertainty.

#### Rule 38 a (3)

It would be sensible to specify the circumstances in which validity of the priority claim is relevant, i.e. if intervening prior art is identified during Search or Examination.

#### Rules 39 and 39a

When does the two month period start? We propose insertion of “from notification of the deficiencies” in each of these rules.

We see no good reason for inclusion of the last sentence of Rule 39 (a) (1) and suggest that it should be deleted, especially as the explanation given by the EPO indicates that the EPO must inform the applicant.

#### Rule 42 (2)

The new wording is confusing.

#### Rule 46

We are extremely unhappy with this change which alters the meaning significantly. There is no basis for this change in EPC 2000, so a clear explanation of the reason for proposing this change is required before it can be considered properly.

We are not sure what is meant by “main invention”. This clearly differs from the current “first invention” and raises some important questions. Will the applicant be consulted about what constitutes the “main invention”? Where is it proposed to explain what “main invention” means? Does this have anything to do with complex applications?

We prefer the current wording, which is clear and unambiguous. No such change should be contemplated until there has been an opportunity to discuss all of its implications.

#### Rule 54

Why has former paragraph (2) been deleted? This change is disadvantageous for proprietors.

#### Rule 56

We do not agree with inclusion of the requirements of Rule 55 2 (b). As it stands, it is rather draconian. An opposition could be deemed to be inadmissible merely because



an opponent omitted the title, but otherwise sufficiently identified the patent being opposed.

#### Rule 57 (1)

The change from “to file amendments” to “to amend” alters the meaning by implying an absolute right to amend, contrary to previous practice. Is this change in meaning intentional?

#### Rule 58 a (2) (a) and (b)

What is the time limit? It is not entirely clear whether the phrase “within a period to be specified” in 58 a (2) (b) is intended also to apply to payment of the fees in accordance with 58 a (2) (a). We would suggest moving “within a period to be specified” to just before sub-paragraph (a).

#### Rule 63 (1)

The current wording refers to costs in general, but the new rule refers to two specific types of costs only. We do not see any reason for this change and believe that the current wording should be retained.

#### Rules 63 b to 63 h

These rules dealing with the new limitation procedures under EPC 2000 are completely new and need to be thought through carefully. More time should be allowed to consult, review and reflect on these proposals.

EPC 2000 does not specify whether or not adaptation of the description of a patent, of which the claims are limited under the new limitation procedure, will be required. It is extremely important for the regulations governing the new limitation procedure to specify such a requirement for amending the description to correspond to the limited claims. Otherwise, it will be impossible to apply Article 69 and its Protocol to a

limited patent. It would clearly be contrary to the public interest not to require adaptation of the description to the limited claims.

The regulations also need to deal with the situation where the person requesting the limitation procedure is not entitled to do so.

Clarification is required of how Rule 63 e will be applied. Will the request for an opposition procedure automatically terminate a limitation procedure? Does the opposition have to be admissible? Will limitation only be possible after the opposition procedure has been completed? Will the EPO simply not consider any application for limitation until the period for filing an opposition has expired? We see no reason why a request for limitation should not be dealt with within the 9 month opposition period. It may well dispose of the opposition before it is filed.

Rule 63 h needs to give more detail about how limited patents are to be identified as such.

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

These amendments in particular do not seem to have been occasioned by EPC 2000. Why have the extra requirements of Rule 64 (1) (c) and 64 (2) been added? It is not clear what is meant by Rule 64 (1) (c). We prefer the current Rule 64.

Rule 64 a (2)

The wording in the Rule is not quite the same as in the Article. The Article says “as often as necessary” whereas the Rule says “if necessary”. The wording in the Rule seems to allow the Board not to invite the parties, whereas the Article seems to oblige the Board to invite the parties. We believe that the wording from the Article should be used.

#### Rule 67 a

Perhaps a further sub-paragraph (c) should be added to allow review if there is was failure to ensure and provide the right to a fair and impartial hearing.

#### Rule 67 d

Should this also include a requirement to set out the grounds for the petition?

#### Rule 67 f

Should there not be a limit on how much the time limits may be shortened?

#### Rule 72 a

Rule 72 uses the singular (party, witness, expert). Rule 72 a uses the plural (parties, witnesses, experts). There seems no reason for this inconsistency.

#### Rule 84

Why has this been changed?

#### Rule 85 a

We do not understand why Rules 41, 41a and 25d have been excluded from further processing. These exclusions should be removed.

#### Rule 85 b (3)

We believe that this Rule should be changed to allow re-establishment even in circumstances where further processing could have been used. There will be instances where the problem which caused a further-processable limit to be missed persists beyond the further processing deadline. In such circumstances, it should be possible to request re-establishment.

If re-establishment of rights is to be ruled out in respect of all periods for which further processing is available, it should at least be stated explicitly that re-establishment will be available if the time limit for requesting further processing is missed.

#### Rule 87

Does this exclude the possibility of having different sets of claims if the EPO itself finds out about the intervening publication?

#### Rule 89 a

There should be a restriction to a single invitation to prevent this from developing into an onerous ongoing obligation on the applicant. It would also be helpful if the EPO could specify, perhaps in the Guidelines for Examination, the circumstances in which it might issue such a request.

#### Rule 96

See comments re Rule 17 (3)

#### Rule 101 a

This new rule on privilege is warmly welcomed. However, it may be too narrow. It should cover giving as well as seeking advice, i.e. advice given where it is not specifically sought, and should cover the situation where a representative employed by a company is acting for his employer or a subsidiary or affiliate thereof. It should also apply to advice regarding potential (in addition to actual) infringement. Also, it may be open to question by a Court, what is meant by “that purpose”. Finally, it is not clear whether “in particular” in sub-paragraph (2) is intended to be limiting. We do not think it should be limiting and would prefer “but shall not be limited to”.

### Rule 105 (3)

Further detail should be included regarding the composition of the three member panel. We do not think this should be at the discretion of the President of the EPO. There is concern that the three members may not be perceived as being independent; they should be selected from Boards of Appeal for consistency with Article 6 of the European Convention on Human Rights.

The Chartered Institute of Patent Agents

30<sup>th</sup> July, 2002