

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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August 13, 2002

## **epi POSITION PAPER RELATING TO THE NEW IMPLEMENTING REGULATIONS UNDER THE EPC 2000**

### **I GENERAL COMMENTS**

1) It appears that the proposed new Implementing Regulations contain amendments of a linguistic or clerical character which were not made in order to adapt the implementing regulations to the revised EPC 2000.

The **epi** questions the need for these amendments. In fact, such amendments could lead to juridical uncertainty and interpretation difficulties. In many cases, a change made in only one language leads to questions as to why the other language versions have not been correspondingly modified. Generally speaking, the **epi** would favour maintaining the status quo for the wording of the Implementing Regulations in the three official languages unless an amendment is absolutely necessary for clarification or, particularly, for harmonization of the three versions of the Regulations.

2) As examples of such inappropriate amendments, the following may be cited, even if they may not be the best examples :

Rule 1(3) is amended in the English version by changing the first words « documents to be used for purposes of evidence » to read « documentary evidence ». The corresponding French version reading « les documents utilisés comme moyens de preuve » remains unamended.

The corresponding German version presently reading « Schriftstücke, die als Beweismittel .... » is amended to read « Schriftliche Beweismittel... ».

These proposed changes do not seem really necessary.

Rule 2(2), is amended by changing « in the case of oral proceeding, the employees of the European Patent Office may, instead of the language of the proceedings, use one of the other official languages of the European Patent Office » to read : « in oral proceedings, employees of the European Patent Office may use any official language of the European Patent Office as the language of the proceedings ».

This amendment seems to imply that in oral proceedings, it would be possible for EPO employees to shift from one official language to another whilst the present wording seems to imply that only one official language should be used.

The corresponding change proposed in the French version : « peuvent utiliser une langue officielle de l'Office Européen des Brevets autre que la langue de la procédure » seems to have a different meaning from the newly amended English version.

The German version is left unamended.

It seems therefore that the proposed amendments in Rule 2(2) tend to introduce the possibility of discrepancies in interpretation of the three versions.

3) In view of the fact that the coming into force of the revised EPC 2000 cannot be expected for some years, it does not appear advisable to decide now the definitive wording of the Implementing Regulations which would then be frozen until entry into force of the revised EPC 2000.

The **epi** therefore stresses that further amendments of the Implementing Regulations may appear necessary before the revised EPC 2000 comes into force.

## **II SPECIFIC COMMENTS ON AMENDED RULES**

These comments are based mainly on the English version, assuming that mere clerical or linguistic changes should not be considered as substantial changes.

### **- Rule 1(3) Language in written proceedings**

The indication of « a period to be specified » does not seem to us to be sufficiently precise. The **epi** would prefer to indicate that said period is «to be specified by the EPO in accordance with the provisions of Rule 84 ».

### **- Rule 2(1) Language in oral proceedings**

The proposed amendment permitting the use of any official language of the EPO during oral proceedings is welcomed by practitioners.

### **- Rule 5 Certification of translations**

The statement of “a period to be specified” does not seem to be sufficiently precise. The **epi** would again suggest indicating that said period is “to be specified by the EPO in accordance with the provisions of Rule 84”. The **epi** considers that the sanction for not filing the certificate in due time is rather harsh and we would suggest stating instead that “the EPO may consider the document as not having been filed”.

The statement “unless otherwise provided” seems unclear and we suggest it be cancelled.

### **- Rule 6(1) Filing of translations and reduction of fees**

The proposed amendment which is in line with article 6(7) of the PLT together with Rule 41(1) is acceptable.

As there is apparently no doubt that the provision also applies to divisional applications, cancellation of the second sentence of present Rule 6(1) appears acceptable.

- **Rule 18 Publication of the mention of the inventor**

The **epi** feels the proposed amendment constitutes a substantive change as it would make it possible for an applicant to avoid designating an inventor without filing evidence of the fact that the inventor has effectively waived his right to be mentioned.

The **epi** therefore suggests that the Rule be reworded to make clear that a letter or a written statement from the inventor has to be filed at the EPO by the applicant if an inventor does not wish to be mentioned. Of course, such a letter or written statement should be kept in the non-public part of the file.

- **Rule 20(1) Registration of transfers**

The **epi** prefers the present wording of Rule 20(1) where it is clear that the EPO must be satisfied by the documents produced that the transfer has effectively taken place. The proposed amendment seems to imply that the EPO would no longer make any check of the documents produced.

The **epi** also notes that registration of transfers (as well as licenses) are presently accepted after grant of the European patent during the opposition procedure, if any. Consequently, it could be advisable to extend the provisions of Rule 20 (and also of Rules 21 and 22) to granted European patents.

Registration of transfers of a patent also seems required for the purposes of a limitation procedure as only the proprietor can be requester.

- **Rule 22 Special entries for license registrations**

It should be made clear that these special entries are sub-categories of the registration provided for in Rule 21 and that therefore, the provisions of Rule 20(1) also apply to making a record under Rule 22.

- **Rule 31 Claims incurring fees**

According to the proposed changes, it appears that an applicant would be liable to pay claims fees each time he files a new set of claims, the number of which exceeds ten and the number of the previously filed claims.

The **epi** therefore suggests that this Rule be amended to clearly state that claims fees for more than ten claims should only be payable "at the filing" of the application.

In case of amended set of claims filed during prosecution, any claims fee should only be payable at the time of acceptance of the application simultaneously with the granting and printing fees.

- **Rule 32(2)(a) Form of the drawings**

While the use of colors on drawings should normally be avoided, some situations exist where colors are useful or even necessary.

The **epi** therefore suggests further amendment of this rule so that coloring would be accepted if really necessary.

- **Rule 34(2) and (3) Prohibited matter**

According to the proposed changes, it is not clear who is responsible for omitting prohibited matter from the application as published.

The **epi** prefers the previous wording, making clear that the EPO is responsible for omitting such matter from the application as published.

- **Rule 35(3) General provisions governing the presentation of the application documents**

The words "subject to paragraph 11" should read "subject to paragraph 10".

- **Rule 38(1) Declaration of priority**

It is suggested that "file number" should be changed to the more usual wording "application number".

- **Rule 38a(3) Priority documents**

According to the proposed amendment, a translation of a priority document in a language other than the three official languages of the EPO will not be in the file. A third party will have to make their own translation in order to assess the validity of the priority of the granted patent. The **epi**, conscious of the PLT provisions on this question, would nevertheless suggest adding into this rule that the EPO could invite the applicant or proprietor of the European patent to file a translation of the priority documents "upon request of a third party".

- **Rule 39 Examination on filing**

It should be made clear that the two months mentioned are "from the notification of the EPO".

- **Rule 39a Missing parts of the description or missing drawings**

The same comment can be made as for Rule 39.

In paragraph 1 of Rule 39a, the **epi** suggests canceling the last sentence reading "The applicant may not invoke the omission of such a communication". In fact, the **epi** considers that a part inadvertently omitted in a patent application should not lead to a complete loss of rights. Receiving a communication from the EPO protects the applicant against such an excessive consequence.

- **Rule 42(2) Subsequent designation of the inventor**

This paragraph relating to divisional applications or to new applications under Article 61 is not clearly understood.

- **Rule 45 Incomplete search**

The **epi** considers that the EPO should at least explain the reasons why it considers that it is impossible to carry out a meaningful search. The **epi** suggests therefore that this rule be further amended to provide for the EPO to send a reasoned declaration.

- **Rule 46 European search report where the invention lacks unity**

The proposed changes now provide for the possibility of the EPO to determine which is the main invention.

The **epi** considers that the applicant is entitled to decide on which invention he wants the search report to be established. The **epi** therefore prefers the wording of present Rule 46 where the search is made on the invention or the group of inventions "first mentioned in the claims".

- **Rule 54 Certificate for a European patent**

The **epi** suggests that the wording be revised to make clear that several certificates can successively be obtained upon request by the proprietor of the patent.

The new wording could possibly be drafted, taking into consideration paragraphs 1 and 2 of present Rule 54.

- **Rule 56(1) Rejection of the opposition as inadmissible**

The **epi** does not agree with the addition of Rule 55b, paragraph 2(b). The **epi** considers that an opposition should not be rejected as inadmissible simply because the title of the invention has been omitted in the notice of opposition.

Alternatively, Rule 55b(2)(b) could be streamlined by cancelling any reference to the title or even the name of the patentee.

- **Rule 57(1) Preparation of the examination of the opposition**

The proposed changes could be misunderstood.

The **epi** prefers maintenance of the previous wording stating "to file amendments".

- **Rule 58(1) Examination of opposition**

The **epi** is concerned about the length of the opposition procedure and particularly in case of appeal when the Board of Appeal refers the case back to the first instance. In order to avoid such a lengthy procedure, the EPI suggests that the opposition division examines all the grounds invoked by the opponent during the procedure.

The **epi** therefore suggests that the proposed wording be further amended to reflect this situation.

The proposed wording “the opposition division shall be obliged” appears strange and not exactly in line with the French and German corresponding versions. The wording “shall examine” could be preferred.

- **Rule 58a(2) Maintenance of the European patent in amended form**

With the proposed wording, the period of time in which the prescribed fee must be paid is not clear.

It is suggested to shift “within a period to be specified” before paragraphs a) and b).

- **Rule 63c(2)(c) Requirements of the request for limitation**

In addition to the provisions proposed, the **epi** suggests that provision be made according to which the EPO shall inform a licensee if such a licensee is recorded at the EPO, so that said licensee be aware of a limitation request filed by the proprietor of the patent.

- **Rule 63e Termination of limitation proceeding**

The **epi** agrees with the proposed wording according to which the limitation proceeding is terminated if an opposition is subsequently filed. As a matter of fact, the opposition procedure is more balanced being an inter partes procedure and the Opposition Division has the possibility of also deciding on the validity of the limited claims, which is not the case during limitation procedure.

- **Rule 63f Examination of the request for limitation**

The **epi** agrees that the limitation procedure should be swift and simple. However, this should not lead to the result that the requester is obliged to file a new limitation request upon immediate rejection of the request by the EPO. Consequently, the **epi** wishes to make clear that the Examining Division will authorize the requester to answer a notification expressing the opinion of the Examining Division, thus permitting the requester to file further amended limited claims.

A corresponding provision could be introduced in Rule 63f or alternatively in Rule 63g(4). It should also be made clear that it is possible to request different limitations for different member states of the EPC.

- **Rule 63h Form of the amended European patent specification**

The **epi** wishes to stress that the description of the European patent after limitation should be amended to reflect the limited claims. Otherwise, the courts and third parties could have difficulties in interpreting the scope of protection according to Article 69 EPC.

- **Rule 64a(2) and (3)**

Concerning paragraph 2, the **epi** prefers the maintenance of the previous wording of Article 110 EPC 1973 stating “as often as necessary”. The appeal procedure is an important procedure where both parties must have the possibility of presenting all their arguments. It

would be unfair and contrary to the interests of both parties to limit the rights of the parties to file observations.

The **epi** approves the proposed amendment of paragraph 3 in view of the fact that further processing according to Article 121 EPC will apply to this situation where the European patent application is deemed to be withdrawn.

- **Rule 67a(b) Further fundamental procedural defects (Procedure for Review)**

The **epi** is concerned that the procedure for Review now introduced could exaggeratedly lengthen many procedures.

In order to limit such a risk, the procedural defects which can be presented should be defined in a strictly limited way. While this is the case for paragraph a), the **epi** considers that paragraph b) leaves the door open to any kind of procedural defect and is therefore too broad.

The **epi** suggests further amending the proposal by stating in paragraph b) : “decided on the appeal without deciding on a clearly stated request relevant to that decision”.

- **Rule 67d(1) Contents of the petition for review**

The **epi** considers that the petition should also contain the grounds which are the basis of the petition.

- **Rule 67f(1) and (3) Procedure in dealing with petitions for review**

The **epi** agrees that the procedure should not be exaggeratedly long. However, in view of the importance of the matter, including the possibility of canceling a decision taken by a Board of Appeal, the **epi** considers that the procedure for review should be complete with the parties having the possibility of fully explaining their arguments. Consequently, the statement of the last sentence “time limits may be shortened” which appears to be somewhat undefined, could lead to a shortened and incomplete procedure.

The **epi** therefore suggests that this sentence be cancelled.

In paragraph 3, the **epi** notes that the procedure for review according to paragraph 2(a) appears to be an exclusively written procedure.

The **epi** however considers that the right to have oral proceedings is a fundamental right of the parties which should not be forgotten even in cases which are deemed to be “clear”. Furthermore, the **epi** disagrees with the idea that the Enlarged Board of Appeal would decide, even in such situations, “without the involvement of other parties” In fact, the other parties must have the right to present their arguments.

- **Rule 72 Decision on taking of evidence**

The title of this rule should probably better be further amended simply to read “Taking of evidence”.



The **epi** considers that the hearing of witnesses or experts should always be recorded so that a transcript of the hearing could be used afterwards in the continuation of the proceedings. The **epi** therefore suggests that a corresponding provision be introduced in Rule 72 or in Rule 72b.

- **Rule 85a(2) Further processing**

The **epi** does not agree with the introduction, as exceptions which are ruled out from further processing, of the provisions of Rules 41 (correction of deficiencies in the application documents) and 41a (deficiencies in claiming priority). As a matter of fact, even if a legal remedy is provided for the situations mentioned in Rules 41 and 41a, those situations concern small deficiencies for which the **epi** does not see any reason for excluding further processing.

- **Rule 85b(3) Reestablishment of rights**

The proposed rule according to which reestablishment of rights is ruled out in respect of any period for which further processing is available does not seem advisable. In fact, in practice, difficulties could still arise in a situation for which further processing could have been made. Furthermore, the basis of a reestablishment of rights is the fact that an applicant or a proprietor was unable to observe a time limit in spite of all due care. It was not the intention, when revising Article 122 EPC, to exclude as a general rule all the situations for which further processing is possible.

It would be inequitable for applicants and proprietors to lose their rights, if they failed to request further processing, when they could still show that the non-observance of the time limit, which caused the refusal of the relevant application, could be explained in such a way that reestablishment of rights could be obtained.

It must also not be forgotten that the difficulty which made it impossible to observe the time limit may well continue after expiry of the time limit for requesting further processing.

For all these reasons, the **epi** suggests modifying the proposal so as not to exclude the situations for which further processing is available.

- **Rule 89a(b) Information on prior art**

This newly introduced provision should not give rise to a broad interpretation. The **epi** suggests that communication of prior art be limited to a corresponding patent application. The wording could therefore be completed by stating "concerning a priority application or an application claiming the same priority as the European patent application".

- **Rule 92(3) Entries in the Register of European Patents**

The **epi** does not understand the reason for deleting this paragraph. It must be noted that in some countries, certified extracts from the Register of European Patents are required (for example to obtain an order for "saisie-contrefaçon" from a French judge).

Reintroduction of this paragraph is therefore suggested.

- **Rule 101a Attorney evidentiary privilege**

The **epi** warmly welcomes this new rule and would like to make the following small observation.

The French version (Règle 101bis) should be amended to replace the word “client” by the word “mandant” in accordance with the wording of the French version of the Regulation on discipline (Règlement en matière de discipline des mandataires agréés).

Similarly, the German version of Rule 101a should be amended by replacing “Mandant” by “Auftraggeber” for the same reasons as previously mentioned.

This would make clearer that the “client” mentioned in the English version can be the company where the professional representative is an employee or a subsidiary of that company.

- **Rule 105(3)**

The **epi** is concerned that the independence of the three members composing the panel could be challenged. It may be argued that the proposed wording does not exactly comply with Article 6 of the European Convention on Human Rights.

Consequently, the **epi** suggests specifying that the three members are selected from the Boards of Appeal.

For the EPPC  
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