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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

VERFASSER: 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: Trade Marks Patents and Designs Federation
Commentaires reçus de :

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Trade Marks Patents and Designs Federation

EPC 2000 Implementing Regulations

Comments by the Trade Marks Patents and Designs Federation on the Draft Version of New Implementing Regulations under the EPC 2000 (June 2002, IMPREGS e)

General points:

1. Our comments relate only to the English text of the draft regulations. It may be that there are differences between the different language texts, or it may be that some of the infelicities in the English text result from translation from an original text in another language. We have not been able to check on such matters.
2. Apart from major changes resulting from the needs of EPC 2000, many relatively small changes have been made that are not called for by EPC 2000. While we accept that there are circumstances where adjusting the wording of individual rules can be justified, in particular, to align wording with that in international treaties such as TRIPS and PLT, or to ensure that terminology is consistent throughout, we do not accept that changes should be made only for the sake of supposed linguistic improvement. Unnecessary changes in wording, including omissions, create confusion and uncertainty as to whether a change reflects a change in scope or meaning. We suggest that the draft regulations should be scrutinised again with a view to restoring the previous wording wherever there was no intention to change the scope of the text concerned.
3. We are concerned that a number of matters that should have been transferred from the Convention to the Implementing Regulations and some matters that were covered by the previous regulations have been left to the President to decide. Some of these matters will be mentioned under individual rules below.
4. It should be made clear by an addition to each individual rule concerned (e.g., rules 1, 5, 36(3), 58a(2)(b), 64a(2), 89a) or, perhaps better, by adjusting rule 84, that whenever a reference to a “period to be specified” occurs, the period will be specified by the European Patent Office in the individual case, not by any other party or in any other way (e.g., not by definition in the Convention or Regulations).
5. It should be made clear also that the expression “unless otherwise provided” (see e.g., rule 5) means as otherwise provided in the Convention or Implementing Regulations, and nowhere else.
6. References to “proof” in the previous regulations have generally been replaced by “evidence” (see e.g., rules 7, 13, 14, 20, 21, 63(2)(c)). While we agree that full legal proof may be too severe a standard and some change may be desirable, evidence must be strong, not merely assertion. It should be made clear throughout that evidence should be satisfactory or convincing.

7. Previous references to suspension have usually but not always been replaced by “stay”. If this change is to be made, it should be done comprehensively (e.g., in rule 92).
8. References in some rules (e.g., rule 26(2)(d), rule 29(1)(b)) to “letters” should be replaced by “paragraph”, “sub-paragraph”, etc as the case may be.
9. The numbering policy for the new rules is not very clear. New rules corresponding to previous ones do not always have the same numbers. (E.g., previous rules 28 and 28 a are replaced by rules 23 g –j, previous rule 55 is replaced by rule 55 b while 55 a is used for another subject.) Sometimes the numbers of previous rules have been used for new rules concerning quite different subjects (see e.g., rule 85 a) while elsewhere, numbers have not been re-used when the rule is dropped, e.g., previous rule 96. The numbering arrangements need further consideration.
10. The current regulations, to be replaced by the new regulations, are referred to herein as the “previous” regulations.

Comments on individual rules:

It is not always possible to separate the more serious problems from less serious and minor ones, so these comments treat the individual rules in numerical order and are not in order of importance.

Rule 1 Language in written proceedings

Paragraph (3), 2nd and 3rd sentences: The rule appears to give the European Patent Office discretion not to require translations and not to disregard documents that have not been translated. We consider that, not least for the benefit of other parties that may be concerned, “may” should be replaced by “shall” in both sentences.

Rule 2 Language in oral proceedings

Paragraph (1): The previous wording should be restored. The change from “one” to “any” other official language appears to change the meaning.

Rule 16 Partial transfer of right by virtue of final decision

Paragraph (1): “Disclosed” in the previous wording is to be preferred to “contained”.

Rule 17 Designation of inventor

Paragraph (1): The draft rule should be modified to allow for the designation of inventor, when not the applicant, to be provided in a single document with the request for grant, as happens already with electronically filed cases.

Paragraph (3): The new rule allows the President to prescribe the further data to be sent to the designated inventor. The former rule required that the designated inventor should be informed of the further data mentioned in the former Article 128(5) EPC1973. The revised Article 128(5) EPC2000 now indicates that particulars specified in the implementing regulations may be communicated or published. Thus particulars to be communicated should be set out in the regulations, not prescribed by the President (see also comments on rule 96, which concern this issue).

Rule 18 Publication of mention of inventor

Paragraph (1): The previous wording should be restored. In particular, the previous reference to informing the EPO of a waiver should be retained.

Rule 23 Certificate of exhibition

The previous wording on the matter dealt with in new sub-paragraph (b) should be restored. The changed wording might lead to a change in the standard.

(Previous) Rule 23a Prior application as state of the art

We readily agree that this rule should be deleted and consider that this should be done immediately, without waiting for EPC2000 to enter into force.

Rule 23h Expert solution

Paragraph (2): The previous rule 28(5) indicated at the end that the nominated expert should treat the requester as a third party. We consider that this is an important safeguard that should be included in the new rule.

Rule 23j Availability of biological material

We consider that it should be mandatory, not optional, to make a new deposit if for any reason a viable sample of the original deposit ceases to be available, if the patent is to remain valid.

We are not happy that the provisions for making a new deposit are now entirely reliant on the provisions of the Budapest Treaty, with deletion of most of the previous corresponding rule 28a. We observe that this approach has not been applied to the rule governing the original deposit (rule 23g, previous rule 28), so the original deposit may not even be with a depository subject to the Budapest Treaty.

Previous rule 28a required a copy of the receipt issued by the depository institution to be forwarded to the EPO. This requirement appears to have been dropped and we consider that it should be restored.

We prefer the previous rule, which in paragraph (5) recognised the provisions of the Budapest Treaty without requiring all new deposits to be deposited in accordance with those provisions.

Rule 25 d Date of filing

Paragraph (1) (c): We are unhappy about this provision, which enable a date of filing to be given to a document where the description is merely a reference to a previous patent application. While we recognise the need to align with the PLT, we consider that the rule should make clear that the reference should be to a single, self-contained document, whose full text description is precisely what the description of the invention should be, so that subsequent confusion as to the intended content of the description is minimised.

Rule 26 Request for grant

Paragraph (1): We object to the deletion of the second sentence of the previous rule. The change appears to indicate that forms will no longer be free, or possibly not even made available.

Rule 29 Form & content of claims

Paragraph (1): The potential role of non-technical features, e.g., in computer implemented inventions should be recognised by adding “and non technical features if appropriate” after technical features in subparagraphs (a) and (b).

Paragraph (6): We object to the change from “rely on” to “contain”, which appears to narrow the scope of the previous rule.

Rule 31 Claims incurring fees

Paragraph (2): We are unhappy that the revised rule concerning claims incurring fees appears to allow a fee to be charged every time claims are filed during the prosecution of the application. This will cause confusion, increase costs and increase the risk of inadvertent loss of rights in the event that some payments are overlooked. The principle should be that claims fees are charged as at present at the time of filing the application which will be the subject of search and topped up (under rule 51(6)) at grant if the number of claims then present is greater.

Rule 34 Prohibited matter

Paragraphs (2) and (3): The previous wording should be restored. In particular, the EPO should decide on what matter is to be omitted.

Rule 38 Declaration of priority

Paragraph (2): This provision should make clear that the declaration of priority should not be later than a request under Article 93(1)(b) made earlier than 16 months from the earliest priority date.

We emphasise that this new provision should not be allowed to lead to delays in publication of applications. In order to encourage applicants to file the declaration of priority on filing, it might be appropriate to charge a fee for those declarations filed later. Are we right to assume that it will be possible to correct errors in the declaration within the 16 month period?

Rule 38 a Priority documents

Paragraph (3): The rule should be adjusted to make clear that the translation of the previous document should be requested as soon as it appears to the EPO that the priority claim may be relevant in the determination of patentability.

Rule 38 b Issuing priority documents

It is not clear why wording changes have been made. This is an example of seemingly unnecessary change.

Rule 39 Examination on filing

The rule should make clear when the two-month period for remedying deficiencies starts to run.

Rule 39 a Missing parts of the description or missing drawings

Paragraph (1): It should be made clear when the two-month period for filing missing parts starts to run.

We object to the inclusion of the last sentence in this paragraph. Since the EPO is under an obligation to issue an invitation to file missing parts, an applicant should be able to rely on receiving such an invitation in a clear case. While the examination under article 90 cannot be more than a general non-technical check on the presence of a satisfactory description and drawings, it should be permissible to invoke a failure to comply with the obligation in cases where the Office has been negligent, for example, overlooking the fact that a complete page is missing.

Rule 45 Incomplete search

Changes in wording have been introduced and in particular “claims” becomes “subject matter claimed”, which may be of different scope. Does this mean that there will be changes in practice? If not, why change?

We consider that the declaration to be issued in connection with an incomplete search should be reasoned and that the rule should say so.

Rule 46 European search report where invention lacks unity

Paragraph (1): We object to the change made here. It is not appropriate for the EPO to decide on and search only the parts of the application which represent “the main” invention (whatever that means). The previous wording should be reinstated.

Rule 46 a Transmittal of the European search report

We consider that applicants should be able to elect not to receive copies of cited documents. Many companies already access citations electronically via the Internet. A second paragraph to the rule could introduce a suitable provision.

Rule 52 Grant of the European patent to different applicants

The previous wording is more precise and better. It should be retained.

Rule 54 Certificate for a European patent

Previous Paragraph (2): We object to the deletion of this paragraph. It should continue to be possible for proprietors to request duplicate copies of the European patent certificate.

Rule 56 Rejection of the opposition as inadmissible

Paragraph (1): We object to the possibility that an opposition may be rejected as a result of non-compliance with the lesser requirements of paragraph 2(b) of rule 55 b (e.g., the requirement for the

title). While it must be possible to identify the European patent that is being opposed, its number should be sufficient for this.

Rule 58 Examination of opposition

Paragraph (1): The first sentence should make completely clear that the opposition division is obliged to examine in full all the grounds raised by the opponent and cannot choose to disregard any of them.

The second sentence appears to need some rewording. Article 100 EPC does not provide the basis for action by the opposition division (of its own motion) but sets out the grounds for opposition. The reference to article 100 should follow the first three words of the sentence.

Rule 58 a Maintenance of the European patent in amended form

Paragraph (4): The wording seems even less clear than that used in the corresponding previous rule 58(8). The rule should make clear that the decision to maintain the European patent as amended has to identify the particular text of the patent to which the decision applies.

Rule 60 Continuation of opposition proceedings by the EPO of its own motion

Paragraph (1): The previous wording of the opening part of the rule should be retained. The patent may have been surrendered in some states and may have lapsed in others. This is covered by the previous wording but not by the new.

Limitation procedure – rules 63 b – 63 h

We are very concerned that none of these new rules makes any provision for the involvement of third parties who may be adversely affected by the limitation of the patent. It should be possible for a third party to object to the limitation and become a party to the proceedings (i.e., to “oppose” the limitation even when the nine month period for opposing a newly granted patent has expired).

We have heard it said that Article 115 EPC may enable third parties to make observations on the limitation, but this is not clearly so. Article 115 is concerned with applications and in any event an implementing regulation would be required to make it effective. However, even if a concerned third party could use Article 115, this would not meet the basic point that the third party should be able to participate in the proceedings.

We suggest that a further rule should be introduced to provide for the right of a third party to object to the limitation and to participate as an objector in the proceedings.

Rule 63 c Requirements of the request

Paragraph (2)(a): We consider that the particulars of the requester should also indicate in which contracting state[s] he is the proprietor of the European patent.

Paragraph (2)(d): Bearing in mind that amendment of the patent in proceedings before the EPO is permitted by Article 123 EPC (in accordance with the implementing regulations) and that it may be desirable to amend the description of the invention to align with amended claims, as occurs in opposition proceedings, this sub-paragraph should refer to description and claims (compare rule 57 a, relating to opposition).

Rule 63 d Rejection of the request as inadmissible

Paragraph (1): The second sentence should make clear that fees should be reimbursed if the requester has not been informed of an opposition before the filing of the request.

Rule 63 e Termination of limitation proceedings

We see no reason for terminating limitation proceedings in the event of a later filed opposition, unless the requester agrees. It should be possible to consolidate the two actions.

Rule 63 g Decision on the request

We consider that if the EPO decides that the patent can be revoked or limited, then it should provide a reasoned decision, which will be available to third parties who may be involved in litigation concerning the patent.

Rule 63 h Form of the amended European patent specification

We do not consider that the rules should say nothing about what is to be published and leave matters to be decided by the President. The patent should be republished if it has been amended and the document should make clear that the patent has been limited. The changes relative to the unlimited text should be identified or highlighted.

Moreover, we consider that an entry should be made in the register of European patents. Rule 92(2) permits the President to decide this, but it *would* be better to add the subject to rule 92(1).

There should also be provision for advertisement; bearing in mind that limitation may be effected long after the patent has been granted, when those *affected* may no longer be keeping it under active review.

Rule 64 Content of notice of appeal and statement of grounds

The information required in a notice of appeal is to be increased. New sub-paragraph (1)(c) calls for a request defining the subject of appeal. It is not clear what this means, as distinct from the impugned decision and the grounds for appeal. New paragraph (2) calls for a statement of grounds indicating both reasons and facts and evidence. This additional requirement at the notice stage may help to streamline appeals. However, insofar as the new proposals change existing practice, they should be properly discussed with users before being introduced.

Rule 64 a Examination of appeals

Paragraph (2): The wording does not properly reflect the wording of previous Article 110 EPC 1973, which required the Board of Appeal to invite parties to file observations, as often as necessary. We consider that the wording of the previous article should be adopted.

Petitions for review by the enlarged board of appeal – rules 67a – 67g***Rule 67 a Further fundamental procedural defects***

We consider that the wording in the opening part of the rule “may have occurred” should be more definite, e.g., “shall be deemed to have occurred”

A further sub paragraph (c) should be added to cover the situation where the proceedings of the Board of Appeal were manifestly not fair and impartial (e.g., allowing major evidence to be submitted for the first time at a hearing). We do not consider that this requirement is fully covered in Articles 112a and 113 EPC2000.

The wording of sub-paragraph (b) is unclear. What is meant by a “request relevant to that decision”? Perhaps this wording is intended to describe the situation where the Board has ignored grounds, evidence or comments submitted by a party in the appeal proceedings. We consider that revision is necessary to clarify this.

Rule 67 d Contents of the petition for review

Paragraph (1): We consider that a new sub-paragraph should be added calling for the reasons or grounds justifying the review.

Rule 67 f Procedure in dealing with petitions for review

Paragraph (1): The last sentence allows time limits to be shortened. We consider that the rule should make clear that even so, time limits must be reasonable in the circumstances and never less than 10 days

Paragraph (3): We are unhappy that the three member “screening” board under rule 67f(2)(a) that considers the admissibility of a petition decides without the involvement of other parties. At the least, the petitioner should be invited to comment before the board rejects the petition.

Rule 69 Noting of loss of rights

Paragraph (1): The previous wording, which refers to Article 119 EPC (unchanged in 2000), should be retained, to avoid confusion as to whether the scope of this rule has changed. Article 119 is the basis for rules and procedures concerning notifications, including the “ten day rule”.

Rule 72 a Summons to give evidence before the EPO

Paragraph (1): This paragraph and sub-paragraphs (2)(a) and (2)(b) should be drafted consistently in the singular (party, witness, expert).

Paragraph (2): We consider that “testify” should be replaced by “give evidence” to be consistent with paragraph (1) and with Article 117 EPC 1973.

Rule 84 Periods specified by the EPO

This rule has been referred to briefly in the opening comments above.

A number of rules refer to a period to be specified without making it entirely clear that it is the responsibility of the European Patent Office alone to specify the period. We suggest that the opening part of the rule should read:

“Where these implementing regulations refer to a period to be specified, the European Patent Office shall specify a period that, unless otherwise provided, shall be neither less than two months... (continue as in the rest of the draft rule).

Rule 85 a Further processing

Paragraph (2): We do not understand why further processing shall “be ruled out” (a better expression might be “not be permitted”) in respect of so many periods. We accept that it should not be permitted in respect of the periods under rules 37(2) and 38(2), but consider that it should be available for other periods, save of course those referred to in Article 121(4) EPC.

Rule 85 b Re-establishment of rights

Paragraph (3): This *provision*, concerning the inadmissibility of a request for re-establishment of rights, should make clear that a request is only inadmissible while further processing is still available (and of course as the rule says, in respect of the period for requesting re-establishment). The rule should make clear that it is possible to seek re-establishment after the period for requesting further processing has expired.

Rule 87 Different claims, description and drawings for different states

The rule should be revised to allow the applicant to supply different claims, etc., for some of the designated states in the situation where the EPO discovers for itself that earlier rights exist in respect of those designated states.

Rule 89 a Information on prior art

It should be made clear in this rule that the EPO is permitted to issue only one invitation to an applicant to provide information on previous search reports. Applicants should not be called upon to update the information provided in response to this invitation.

It should be stated explicitly that the applicant may only be called upon to supply sufficient information to identify the prior art, i.e., reference numbers or other identifiers such as journal article titles, and may not be required to produce actual documents, except in cases where the EPO is otherwise unable to obtain copies of them.

The EPO should provide guidelines about the circumstances in which it will call for information.

Moreover, the wording of sub-paragraph (b), whereby applicants can be called upon to supply “other prior art taken into consideration” “concerning an invention to which the European application relates” is too vague and general. The applicant should only be expected to supply details of prior art specifically cited in relation to national/regional applications for the same invention, having at least one common priority. This is covered in sub-paragraph (a), so (b) should be cancelled.

Previous Rule 91 Waiving of enforced recovery procedures

It is not clear why the previous rule 91, concerned with waiving recovery procedures in respect of minimal sums etc., is deleted. We suggest that it should be re-instated.

Rule 96 Additional publications by the EPO

While it seems clear that the previous rule has to be changed in the light of the revised Article 128(5) EPC2000, we do not consider that deletion is the answer. A specific list of bibliographic data, of the sort set out in previous Article 128(5) EPC1973, should now appear in the regulations, as anticipated by the revised wording in Article 128(5) EPC2000. A new first paragraph in previous rule 96 would be an appropriate place for this.

The previous provisions of rule 96, suitably adjusted, could then follow this new first paragraph.

Rule 101 a Attorney evidentiary privilege

We welcome this new rule, but consider that paragraph (1) should be adjusted to make clear that the employer of an employed professional representative, or any associated or subsidiary company of the employer for whom the representative may be acting, is to be considered as the client. This might be achieved by changing the references to "client" to "party".

The paragraph should also cover the giving of advice that has not been specifically sought. The expression "relating to that purpose" is unclear in the context and should either be deleted or replaced by an expression such as "relating to the matters on which advice is sought or given".

It should be made clear in the introduction to paragraph (2) that privilege is not limited exclusively to the matters set out in sub-paragraphs (a) to (c).

Rule 105 The EPO as an ISA or IPEA

Paragraph (3): We prefer the previous provision, which made clear that the additional fee would be refunded in the event of a successful protest and that the Board of Appeal would consider the protest.

We are concerned that the Board of Appeal is to be replaced by a three-member panel determined by the President. The way in which the panel is to be established should be set out in the regulations, not left to the President's discretion.

[End of comments]