

**CA/PL 10/02 Add. 12**

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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)

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Eingegangene Stellungnahme von:  
Comments received from: National Board of Patents and Registration of Finland  
Commentaires reçus de :

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**Comments of the National Board of Patents and Registration of Finland concerning the Draft Implementing Regulations under the EPC 2000**

**General Comments**

On the whole, we are satisfied with the proposed amendments to the Rules. We however hold that Rules should be amended only where absolutely necessary. For example, replacing a word or an expression by another one may result in a change in the practice, i.e. in the interpretation of the Rule. Reasons for even the least amendments should be given in the explanatory remarks. Further, we hold that Rules should govern a matter explicitly without a possibility of a too wide interpretation, which might cause problems to an applicant.

**Detailed Comments:**

Generally, the authority which fixes the time limits should clearly appear from the Rules including the expression "within a period to be specified" (e.g. Rule 1(3)). In our opinion it would be a good idea to compile all the periods under one Rule (e.g. Rule 84).

**Rule 1 (3)**

In the revised wording of the Rule 1(3), the EPO has been given the power to consider whether to disregard or not such documentary evidence as has not been translated into one of the official languages. This is unlikely to be a real issue in practice but, in inter partes proceedings, parties that have not received the translation, e.g. of a contested document, might be at a potential financial disadvantage because of extra translation costs. If possible, it should be governed by Rules that the failure to provide a translation of a document in inter partes proceedings should lead to its refusal instead of the fact that the refusal is at the discretion of the EPO.

**Rule 26 (d)**

We do not quite understand why the word "letter" is chosen in this Rule instead of "subparagraph" that is used otherwise.

**Rule 46**

We wonder what the new expression "main invention" is intended to mean in practice. We do not agree with the amendment.

We also hold that the Rule does not pay sufficient attention to an applicant's legal safety, because it depends on the EPO's examiner alone which invention will be chosen for examination.

**Rules 63 b to 63 h**

It should clearly appear from the Rules that a "limitation procedure" and a "revocation procedure" can also be carried out by the national authorities; in other words, the national process is an alternative to a process within the EPO. This calls for Rules on how to proceed when a limitation procedure is pending both before a national authority and before the EPO at the same time, and when a request for the termination of a patent is filed. The Rules should explain how to proceed if a litigation for the right to a patent, an assignment, execution, or bankruptcy are pending nationally. Further, Rules should pay attention to the rights of a licensee and a patent holder. We also hold that it must be possible to terminate a patent during an opposition period. Printing and translation of new claims should also be governed by Rules as regards the limitation procedure.

**Rule 67 a (b)**

This Rule might be misused for filing requests for review by the Enlarged board of appeal. To limit the application of this Rule to fewer cases, it may be prudent to make it clear that the "request" in question was "explicit and clear" so that an applicant cannot seek to rely on an implied request.

**Rule 69 (1)**

We propose reinstating "... in accordance with the provisions of Article 119" referring to the way in which the loss of rights is communicated to the party concerned.

Article 119 EPC has gathered its own body of case law, and invokes Rules 69, 77 - 82, which relate to some important practices such as the "ten-day Rule". Deleting the reference to Article 119 could be understood as implying that new Rule 69 (1) EPC has been differentiated from this case law and Rules.

**Rule 89a**

It should appear from the Rule that this request can be issued only once, preferably before starting the examination of an application. There's no mentioning in the Rule about the possible need to translate the search reports to be given to the language of the proceedings (or the official languages of the EPO). Does the applicant have to give his statement in the matter?

Our partners in cooperation in Finland take up a positive attitude towards the Rule, as they believe that it will facilitate the work of the EPO's examiners. However, they are concerned about the fact that this Rule might give a push to the practice prevailing in the USA, according to which the applicant is ordered to submit material required by various authorities the whole process through, which would add to the expenses of a patent application procedure. Therefore, a wish has been expressed that the possibility of filing the request would be restricted to one single time, which is the well-working practice in Finland at the moment.

**Rule 92**

Rule 92 (1) (s) refers to "suspension" of proceedings in the cases referred to in Rules 13 and 56 a whereas Rules 13 and 56 a refer to "staying" of proceedings. We prefer the same wording in both Rules.

A provision should be included there for entries relating to (i) "the date of filing a request for limitation" and (ii) "the date and purport of the decision on limitation" (analogous to the entries relating to opposition – see Rules 92 (1) (q) and (r)).

### **Rule 101 a**

The “protective clause” specified in the new Rule 101 a is a welcome addition. However, the preamble to item (2) reads “..., in particular, ...”. It may remain unclear how this Rule is applied to the opposition period and the so called “limitation” process, for example.