

CA/PL 10/02 Add. 13

Orig.: d,e,f

München/Munich, 17.09.2002

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: UNICE
Commentaires reçus de :

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JPC/MLB/mgh/5.1/6/1

9 September 2002

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Mr Gert Kolle
Director International Legal Affairs
European Patent Office – EPO
Erhardtstrasse 27

D-80331 München

Dear Mr Kolle,

RE: DRAFT IMPLEMENTING REGULATIONS ON EPC 2000 – UNICE'S COMMENTS

We would like to thank you for the opportunity provided to us to comment on the Draft Implementing Regulations on the EPC 2000 prepared by the EPO last July.

In this context, I take pleasure in forwarding to you a copy of UNICE's comments on this draft.

Should you have any question concerning elements of the attached comments, please do not hesitate to contact us directly.

Yours sincerely,



Jérôme P. Chauvin
Director, Company Affairs Department

Encl.

**DRAFT IMPLEMENTING REGULATIONS ON EPC 2000
(CA/PL 5/02)**

UNICE COMMENTS

1. GENERAL COMMENTS

In response to the European Patent Office's call for comments on the Draft Implementing Regulations for EPC 2000, UNICE would like to submit the following observations for the consideration of the Office.

Before filing detailed comments, UNICE would like to register a general remark concerning the language used in the English version of the text to which UNICE's comments refer (CA/PL 5/02; Orig.: English; Munich, 18.06.2002).

In UNICE's view, there have been **unnecessary changes in the language** of the text, containing amendments of linguistic or clerical character and therefore creating discrepancies of interpretation as well as additional complexity in the adaptation of the said Regulation (e.g. in Rule 1(3) "*documents to be used for purposes of evidence*" was changed into "*documentary evidence*"; in Rule 2(2) "*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*" was changed into "*in oral proceeding, employees of the European Patent Office may use any official language of the European Patent Office as the language of the proceedings*"; references to the word "*proof*" used in the previous Regulation have generally been replaced by "*evidence*" which should then be specified further, being qualified either "*satisfactory evidence*" or "*convincing evidence*").

2. DETAILED COMMENTS

RULE 1(3) – LANGUAGE IN WRITTEN PROCEEDINGS

UNICE believes that the expression "***a period to be specified***" should be replaced by "***a period to be specified by the European Patent Office in accordance with Rule 84 EPC***" in order to avoid any uncertainty and ambiguity. Besides, UNICE would to register the **same comment concerning Rules 5, 36(3), 58a(2)(b), 64a(2) and 89a.**

RULE 5 – CERTIFICATION OF TRANSLATIONS

In UNICE's view, the expression "***unless otherwise provided***" should be more precise, being replaced with "***unless otherwise provided in the EPC or its Implementing Regulations***".

RULE 17(1) – DESIGNATION OF THE INVENTOR

UNICE would like to suggest that this draft Rule be modified in order to allow for the designation of the inventor, when not the applicant, to be provided in a single document with the request for grant, as it happens already with electronically filed cases.

RULE 23 a – PRIOR APPLICATION AS STATE OF THE ART

UNICE supports the proposed change. However, the deletion of this Rule should not wait until EPC 2000 comes into force since it is already obsolete now: as in the application as published all designations are still present and valid, Rule 23a clearly violates Article 54(3)(4) EPC and is thus clearly misleading under the present practice and should therefore disappear.

RULE 23 j – NEW DEPOSIT OF BIOLOGICAL MATERIAL

In UNICE's opinion, this rule for new deposit should not rely solely on the Budapest Treaty. In that respect, UNICE regrets that the previous requirement to send a copy of the receipt to the EPO has been omitted and strongly believes that the wording of the corresponding **previous Rule 28a was more appropriate** since it *inter alia* gave precedence to Budapest provisions in paragraph (5).

Furthermore, if a deposit of biological material ceases to be available from a depository institution there does not seem to be any obligation to replace it: from the use of the word "may" this appears to be entirely optional. In old Rule 28a there was encouragement to make a new deposit of the material, to avoid an interruption in availability of the material. In that respect, UNICE would like to suggest to change "may" with "should" or "shall".

RULE 25 a (1)(a) – FORWARDING OF EUROPEAN PATENT APPLICATIONS

With respect to this Rule, UNICE would like to suggest that if the central industrial property office of a Contracting State that has received a European patent application has not informed the applicant within two months of filing that the subject of the application requires further examination as to its liability to secrecy, the applicant may forward a copy of the European patent application to the European Patent Office together with a declaration signed by a professional representative or a legal practitioner and certifying that the copy is identical to the application filed with the central industrial property office concerned.

Should the national patent office not act, the applicant can take the necessary steps and thus prevent the application from becoming abandoned. Moreover, an applicant missing the 14-months deadline may now invoke Article 121 EPC to keep the single European patent application rather than some impracticable bundle of national patent applications.

In addition, it should be foreseen that, the applicant should provide convincing evidence that both texts are identical.

RULE 25 d (1)(c) – DATE OF FILING

UNICE considers that, if a reference to a previously filed patent application is to suffice for a description, as permitted by the Patent Law Treaty, then the reference should be to a single self-contained document, so that subsequent confusion is minimised.

**RULE 27 (1) (c) – CONTENT OF THE DESCRIPTION AND
RULE 29 (1) (a) / (b) – FORM AND CONTENT OF THE CLAIMS**

The present text does not reflect the recent case law with respect to computer-implemented inventions, wherein some role is given to non-technical features. This limited role could be indicated (e.g. by adding the words "*and non-technical features if appropriate*" after "*technical features*").

RULE 29 (6) – FORM AND CONTENT OF THE CLAIMS

UNICE takes note that there is a change of the wording "*rely on*" to "*contain*" in the phrase "*claims [...] shall not contain expressions such as [...]*". UNICE fears that such a modification might lead to a narrower interpretation, and therefore opposes the change.

RULE 31(2) – CLAIMS INCURRING FEES

Amended Rule 31 (2) provides that the claims fees shall be paid within one month of filing the claims.

Under Rule 51, a second payment point for excess claims is established, based on the number of claims in the text as approved for grant, at which time any "balance" of excess claims fees resulting from amendments to the claims during prosecution becomes payable. In the current version of the EPC, claims fees are not normally payable on any other occasion.

By changing the reference point to refer to the date of filing the claims, it appears that an unnecessary lack of clarity is introduced. For example, there are occasions throughout the prosecution history of the application when claims may be filed.

If payment of excess claims fees is linked to the date of filing claims, does this imply that excess claims fees now become payable on any occasion when amended claims are filed and the number increases to greater than 10, or greater than the number for which fees an applicant paid on filing the application? Examples might be when filing voluntary amendments to the claims under article 96(1) and Rule 51(1), or when filing amendments to the claims in response to a communication under article 96(2). This would be a significant change in practice, introducing additional procedural and payment steps with severe consequences in the event of a failure to comply.

Since, in its amended version, Rule 51 (6) still envisages a possibility for the payment of claims fees in the final stages of the grant procedure, there appears to be no need to introduce such an interim payment requirement of the sort that could be inferred from the proposed amendment to Rule 31(2).

It would therefore appear preferable in Rule 31(2) to **retain the original reference point** from which the time limit for payment of excess claims fees is measured, viz. the date of filing the application.

UNICE believes that the present system, wherein the claims fee is only payable on filing and on acceptance (see Rule 51(6)) is simpler and should remain unchanged.

RULE 38(1) – DECLARATION OF PRIORITY

According to the revised text of Article 87(1)(b), priority can be claimed from a first application filed in or for any Member of the WTO.

This is of practical importance for territories which are not Parties to the Paris Convention but which are Members of the WTO. This concerns for example one important territory, namely Taiwan. Since 1 January 2002, Taiwan has been a Member of the WTO, but it is

not party to the Paris Convention. In UNICE's view, this possibility should be clearly reflected in the Rules.

Therefore, UNICE would like to suggest that the words "*or Member of the WTO*" are inserted in Rule 38(1), so that it reads: "*the State, or Member of the WTO, in or for which it was filed*".

RULE 38 a (3) – PRIORITY DOCUMENTS

UNICE would like to suggest replacing the words "*the validity of the priority claim is relevant*" by the words "*as soon as the validity of the priority claim could be relevant*." because this relevancy can often only be established ex-post.

Rule 45 – INCOMPLETE SEARCH

UNICE would like to suggest to insert the word "*reasoned*" before "*declaration*".

RULE 46 – EUROPEAN SEARCH REPORT WHERE THE INVENTION LACKS UNITY

UNICE would prefer the Rule to **remain un-revised**, maintaining that the invention first mentioned in the claims is searched first. A change such as proposed in the Draft could create precarious situations.

RULE 54 – CERTIFICATE FOR A EUROPEAN PATENT

Whereas the proposed new wording seeks to delete the right of the proprietor to request a duplicate copy of the patent certificate on payment of a fee, UNICE would like to suggest that it **should remain possible to order a duplicate copy** of the patent certificate.

RULE 55b(2) (b) - FORM AND CONTENT OF THE OPPOSITION

In UNICE's view, this should be simplified as follows:

"(b) the application number or patent number of the European patent against which opposition is filed, ~~and the name of the proprietor and title of the invention~~;
(c) a statement ~~of the extent to which the European patent is opposed~~ and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;"

RULE 58 – EXAMINATION OF OPPOSITION

It should be made clear that the Opposition Division is obliged to **examine all grounds** that the opponent has invoked. This may be meant in the Draft, but the text is ambiguous in that respect and should be clarified further in order to reflect this situation.

It should be obviated that the Opposition Division deems some grounds as secondary and leaves them out, so that the opponent may come in a position to have to reintroduce them afterwards via an appeal procedure with remittal to the first instance. Such a procedure is far from economical.

RULES 63 b & 63 h - LIMITATION PROCEDURE

These Rules concern the very important new central limitation procedure before the EPO, introduced by Articles 105a – 105c. In accordance with these Articles, there will in principle be no substantive examination.

The request for limitation will either be allowed or rejected as inadmissible. This principle seems, however, to have led to an unnecessarily strict procedure before the Examining Division. The Rules do not allow any communications between the Examining Division and the requester. This means that a request for limitation will unconditionally be rejected also in cases where a short correspondence could have clarified the situation and resulted in allowance of the request. This could for example be the case when the examiner has based his rejection on an erroneous understanding of the claimed subject matter, or where the request would be allowable with a minor adjustment to the wording of the limitation.

In such cases, the proposed procedure means that the only remedy for the requester is either to appeal the decision or to file a new request for limitation. This seems to be a bureaucratic and inefficient procedure. Also, the fact that the original request is rejected could in itself have negative consequences for the patentee, for example in ongoing infringement or invalidity actions. Therefore, UNICE believes that **there should be a limited possibility for communication between the examiner and the requester.**

Finally, UNICE would also like to comment on the **Explanatory Remarks regarding Rule 63f**. These indicate that in certain cases, the Examining Division will – contrary to the principle described above – make a substantial examination of the patentability of the claims as amended. This will for example be the case “*where there are indications that the requested amendment of the claims would lead to the protection of subject-matter which is excluded from patentability*”¹. In UNICE’s view, such a situation is **not compatible with Articles 105a – 105c**: it should be clearly stated that there should be no substantive examination.

RULE 64 a (3) – EXAMINATION OF APPEAL

In UNICE’s view, a **more appropriate sanction** would be that the appeal is deemed to be withdrawn, not the whole patent application.

RULE 67 a (b) – PETITIONS FOR REVIEW BY THE ENLARGED BOARD OF APPEAL

This provision deals with petitions for review by the Enlarged Board. Rule 67a indicates that one such defect is that the Board of Appeal decided on the appeal without deciding on a request relevant to that decision. UNICE points out that this is quite “loose” in the wording, especially “*relevant*”, and **may open the way for great deal of petitioning.**

Furthermore, the text could be misused for filing petitions for review by the Enlarged Board of Appeal in a large proportion of all cases. In that respect, UNICE would like to suggest insertion of a wording such as “*explicit and clear*”.

RULE 67 f (1) - PROCEDURE IN PETITIONS FOR REVIEW

UNICE shares the view that the statement of the last sentence “*time limits may be shortened*” appears to be undefined. Such a situation could lead to a shortened and incomplete procedure. In this context, UNICE would like to suggest that this provision should be **cancelled.**

RULE 67 f (2) (a) – PROCEDURE IN DEALING FOR PETITIONS IN REVIEW

This indicates that the Enlarged Boards have a “*pre-screening team*” for petitions, to see if they are clearly inadmissible. Rule 67f (3) indicates that this team shall decide in written proceedings without the involvement of other parties.

¹ See Explanatory Remarks, page 17, second full paragraph

In UNICE's view, it is not clear whether the petitioner is involved, or this situation concerns a straight Enlarged Board written decision. UNICE wonders what is the procedure if the pre-screening team happens to make an error. UNICE would like to suggest that the petitioner at least should be able to respond with comments.

RULE 69 (1) – NOTING OF LOSS OF RIGHTS

The EPO proposes deletion of "*in accordance with Article 119 EPC*" 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 amended Rule 69(1) EPC has been differentiated from this case law and Rules.** UNICE opposes such a deletion.

RULE 85 – PERIOD OF GRACE FOR PAYMENT OF FEES

UNICE believes that the wording of Rule 85b(3) should **be clarified further** since the proposed wording could be interpreted to mean that re-establishment of rights is not available in respect of time limits to which further processing applies.

The wording of Rule 85b(3) should be amended to make it clear that re-establishment of rights in respect of a period is only ruled out if further processing under Article 121 is **still** available.

RULE 89 a (b) – INFORMATION ON PRIOR ART

In UNICE's view, the expression "*concerning [...] relates*" is too vague. The obligation to mention prior art should be limited to those mentioned in national/regional applications with the same priority right (or: that have at least one priority right in common).

RULE 92 – ENTRIES IN THE REGISTER OF EUROPEAN PATENTS

Rule 92(1)(s) refers to 'suspension' of proceedings in the cases referred to in Rules 13 and 56a whereas Rules 13 and 56a refer to 'staying' of proceedings.

RULE 101 a – ATTORNEY EVIDENTIARY PRIVILEGE

UNICE feels that the rule should make clear that privilege applies to the communications between an employed professional representative and his employer, or subsidiary and associated companies of the employer. The employer or associates should stand in the place of the "client".

RULE 105(3) – THE EUROPEAN PATENT OFFICE AS AN INTERNATIONAL SEARCHING AUTHORITY OR INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

It is UNICE's understanding that Rule 105 (3) no longer foresees that the additional fee will be refunded if the EPO review finds it was unjustified. In fact, the Rule no longer mentions the possibility that the review might find that the extra fee was unjustified.

UNICE does not see in the EPC amendments, or Patent Law Treaty, which anything to support this change. In that respect, **the old regulation that the protest should be referred to the Board of Appeal for a decision should be maintained.**

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