



EPO - Amendments to the Implementing Regulations - Rule 71EPC

[CAPL 7/10]

IP Federation comments :May 2010. ref : PP04A/10

First, we are seriously concerned about the proposal in paragraphs 22 et seq. and 30 et seq. of the SACEPO document to introduce a practice (said to be a return to pre 2002 practice) whereby the examining division would include, on its own initiative, new proposals in the text communicated to the applicant for approval. While minor issues might be dealt with in this way (e.g., bringing statement of invention into conformity with claims or correcting minor linguistic errors), the matters referred to in paragraph 34 include quite serious changes, such as deletion of general statements, introduction of background art summaries and amendment of independent claims. Dealing with these matters should be the direct responsibility of the applicant.

We consider that no new matter should be introduced on the initiative of the examining division into the text to be communicated under rule 71(3) without the **previous** agreement of the applicant. In suitable cases, such as dealing with minor matters, this agreement could be obtained by telephone.

As regards the proposed changes in Rule 71, we have two comments:

(i) Proposed change to paragraph 71(2)

We consider that it is essential that the reasoned statement communicated under Article 94(3) EPC should cover all the grounds against the grant of the European patent. The proposed paragraph should be amended to include the word "all".

As we observed in our recent paper on EPO Efficiency (PP03/10)^{*}, the examiner's communication should be comprehensive, raising all objections and dealing with all citations. First communications should not omit major objections and concern themselves only with secondary and peripheral matters, though at present they often do.

(ii) Proposed change to paragraph 71(3)

We do not consider that related bibliographic data should be included in the information communicated to the applicant under this paragraph. The applicant should **not** be responsible for checking, under proposed paragraph 71(5), that the bibliographic information has been transposed correctly from the application documents (and possibly jeopardising the validity of the application in the event that it has not). The EPO should retain responsibility for ensuring the accuracy of the transposed bibliographic information.

It might be noted that subsequent paragraphs 71(6) and 71(7) do not refer to bibliographic data, so the rule gives no procedure in the event that the data is faulty.

* Copy attached.



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