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TRADE MARKS PATENTS & DESIGNS FEDERATION (TMPDF)

AMENDMENTS TO THE IMPLEMENTING REGULATIONS TO THE EPC 2000

Comments on the draft Implementing Regulations set out in document CA/PL 17/06 (Munich 07.08.2006)

Introduction:

The proposed amendments to the implementing regulations to EPC 2000 introduce a number of improvements. Ignoring infelicities of drafting where the meaning seems clear, we have only a small number of comments on the amendments, as set out in part A below.

However, very few of the proposed amendments concern the matters that we raised in our comments submitted in November 2002. It may be that those comments were not considered before the implementing regulations were adopted by the Administrative Council in December 2002. We therefore repeat in part B below the comments that we made then. Those marked by asterisks may be considered as particularly important.

References to the "previous" regulations herein are to the implementing regulations for EPC 1973, currently in force.

Some practitioners take the view that the renumbering of the rules will cause confusion. We understand that it has been proposed that the rules set out in the EPC 2000 Regulations should at least be known by a different, distinctive, name and suggest that this proposal should be seriously considered.

Part A: Comments on amendments to the EPC 2000 Implementing Regulations proposed in CA/PL 17/06

New rule 2: Filing of and formal requirements for documents (no previous equivalent)

Paragraph (1): An earlier Office commentary said that the 2 month time period for providing confirmation would be non-extendable, but "non-extendable" no longer appears in the text. We consider that it should be extendable and that further processing may be requested.

Paragraph (2): We consider that the last sentence should be made more definite and should say that a document authenticated by other appropriate means permitted by the President **shall** meet the legal requirements of signature [**not** "shall be deemed to"] **in all proceedings** involving the document concerned. "Deeming" by the Office may not satisfy other jurisdictions.

New rule 10: Transition of responsibility from the receiving section to the examining division (no previous equivalent)

Paragraph (1): *The reference to Article 94(1) seems to imply that the receiving section invariably ceases to be responsible when the request for examination is filed, which is not necessarily the case. It would be better to drop the reference to "under Article 94(1)" in paragraph (1) and replace it with "under paragraphs (2) to (4) below".*

"Transition" in the rule heading might better read "transfer".

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Rule 40 (ex 25 d): Date of filing

Paragraph (3): PLT rule 2(5)(b)(ii) says that a certified copy may be required, to be filed within a time limit which shall be **not less than four months** from the date of receipt of the application containing the reference. Proposed rule 40(3) breaches this requirement. Regardless of the desire to align with the one month allowed under rule 6 and the availability of a further two months, the proposed rule does not provide the minimum four months required under the PLT. The new provision should be brought clearly into compliance with the PLT.

Rule 56 (ex 39 a): Missing parts of the description or missing drawings

Paragraph 4(b): There is a reference in this paragraph to "any references referred to in paragraph (1)", but paragraph (1) does not refer to "references". Some adjustment seems to be needed.

Rule 71 (ex 51): Examination procedure

Paragraph (3): We accept that the period for paying the grant and printing fees and filing translations into the other two EPO languages will no longer be extendable, subject to it being confirmed that further processing may be requested in respect of this time limit.

Rule 124 (ex 76): Minutes of oral proceedings and of taking of evidence

Paragraph (2): We consider that the right of witness, expert or party to approve the minutes is important in all circumstances. Transcribed oral evidence may be important outside the confines of the EPO. The right should **not** be abolished when the testimony has been recorded verbatim by technical means. There might well be situations (e.g., resulting from the speech patterns of the witness or ineffective recording or confusion in transcription) where the minutes could be inaccurate. We might expect of course that the right would often be waived.

Rule 135 (ex 85 a): Further processing

Paragraph (2): We have previously commented on the long list of rules in this paragraph containing time limits that do not benefit from further processing (see part B below). The aim should be to keep this list as short as possible. However, rather than reducing the list, the Office proposes to extend it. We accept that opportunities for further processing should be restricted in respect of time limits for information essential for publication (rules 31(2), 52(2) and (3), 60(1)) or where other remedies exist (rule 51(2) to (5)). However, we do not consider that the argument that the Office is unaware of any real need for further processing justifies adding rule 64 (additional search fees if invention lacks unity) to the list.

Rule 136 (ex 85 b): Re-establishment of rights.

Paragraph (1): The Office argument concerning the period of uncertainty following a petition for review under Article 112a EPC 2000 could be made in respect of a number of other time limits where the possibility of reestablishment of rights increases the period of uncertainty before it is clear whether a patent, and of what scope, will be granted. Moreover, in the overall time frame of opposition, consideration by the Board of Appeal and then consideration by the Enlarged Board following a petition, a reasonable period in which to consider making a request for reestablishment of rights should not be greatly significant. We consider that petitioners should have adequate time to consider an adverse decision before submitting the petition. One year may be too long, but two months is inadequate.

Part B: Comments originally submitted in November 2002

Rule 3 (ex 1) Language in written proceedings

Paragraph (3), 2nd and 3rd sentences: These provisions appear to give the European Patent Office discretion not to require a translation of documentary evidence and also discretion to take into account documents that have not been translated. We consider that "may" should be replaced by "shall" in both sentences, when the documents concerned are not in an official language of the EPO.

*** Rule 19 (ex 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 not only in a separate document but also in the same document as the request for grant, as happens already with electronically filed cases.

*** Rule 34 (ex 23j) New deposit of biological material**

[This text has been amplified as compared with that submitted in 2002, for clarification]

The rule on new deposits has been amended compared with the previous rule, to require that a new deposit must be made in accordance with the Budapest Treaty, under which the new deposit must be made with an international depository authority, to qualify for recognition. This is inconsistent with rule 31 (ex 23g) governing the original deposit, which only requires the deposit to be with a recognised authority. Deposit with an international authority under the Budapest Treaty, under the conditions of the Treaty, is not a requirement, or even mentioned, in rule 31. This flexibility can be useful to applicants when no convenient international Budapest depository that will accept the deposit is available.

We consider that the provisions of the previous EPC 1973 rule 28a concerning new deposits, which set out general arrangements for deposit at "recognised" depositories, not restricted to international Budapest Treaty depositories, should be retained. *Inter alia*, paragraph (5) of that rule ensures that a deposit under the provisions of the Budapest Treaty would be recognised.

*** Rule 40 (ex 25 d) Date of filing**

[amplified text]

Paragraph (1) (c): We recognise the need to align with the Patent Law Treaty, article 7(1) and rule 2(5), and accept that the description of the invention may be in the form of a reference to a previously filed patent application to secure a date of filing. However, 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 the same as the intended description of the invention, so that potential confusion as to the intended content of the description is avoided.

While we appreciate that the corresponding PCT rule permits reference to be made to only a part of the description of a previous application, this will lead to confusion as to what is actually disclosed at the date of filing and is a precedent that should **not** be followed.

Rule 41 (ex 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 43 (ex 29) Form & content of claims

[Our comment on the potential role of non-technical features is withdrawn.]

Rule 55 (ex 39) Examination on filing

The rule should make clear when the two-month period for remedying deficiencies starts to run (e.g., date of the communication giving the information, not the filing date of the application).

*** Rule 56 (ex 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 (see remark on rule 55 above).

The last sentence in this paragraph should not be included. 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. It should be permissible to invoke a failure to comply with the obligation in cases where the Office has been negligent, for example, in overlooking the fact that a complete page is missing.

Rule 84 (ex 60) Continuation of opposition proceedings by the EPO of its own motion

Paragraph (1): The wording of the opening part of the previous 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 or revocation procedure - rules 90 - 96 (ex 63 b - 63 h)**

We are very concerned that the new rules on limitation do not make 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).

The notes say that Article 115 EPC 2000 enables third parties to make observations on the limitation, but this is not clearly so. Article 115 allows the presentation of observations on the patentability of the invention, not on the admissibility of an application for limitation.

Even if a concerned third party can use Article 115, this will not meet the basic point that the third party should be able to participate in the proceedings.

We therefore 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 93 (ex 63 e) Precedence of opposition proceedings

Paragraph (2): 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 95 (ex 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 96 (ex 63 h) Content and form of the amended European patent specification

[Our first point was concerned with making an entry in the register of European patents. This has been met by adding point x to paragraph (1) of rule 143]

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 99 (ex 64) Content of notice of appeal and statement of grounds

Paragraph (1)(c): This requires there to be a request defining the subject of appeal. It is not clear what is meant by the subject of appeal, as distinct from the impugned decision (covered in sub-paragraph 1(b)) or the grounds for appeal (covered in paragraph (2)). The need for sub-paragraph 1(c) should be reconsidered.

Petitions for review by the enlarged board of appeal

*** Rule 104 (ex 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 109 (ex 67 f) Procedure in dealing with petitions for review**

Paragraph (3): We are unhappy that the three member “screening” board under rule 109(2)(a) that considers the admissibility of a petition decides without the involvement of the parties. At the least, the petitioner should be invited to comment before the board rejects the petition.

Moreover, we consider that the board should set out its reasons for rejecting a petition, as was required in an earlier draft.

*** Rule 112 (ex 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 135 (ex 85 a) Further processing**

[see also our comments in Part A above]

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) (now 51(2)) and 38(2) (now 52(2)), but consider that it should be available for other periods, save of course those referred to in Article 121(4) EPC.

Rule 136 (ex 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 141 (ex 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 is too vague and general. Applicants can be called upon to supply "information on prior art taken into consideration ...concerning an invention to which the European patent application relates". The applicant should only be expected to supply details of prior art specifically cited in relation to a national/regional application for the same invention, having at least one common priority.

Ex 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.

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

TMPDF

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NOTE: TMPDF represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. This paper represents the views of the innovative and influential companies which are members of this well-established trade association; see list of members below.

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