

Report Q176

Implementing Regulations for the amended EPC

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Comments on the draft implementing regulations for the European Patent Convention as revised in 2000 (EPC 2000)

On June 7, 2002, the European Patent Office published a first draft of the Implementing Regulations for the amended EPC. A selected number of organisations - among them the AIPPI - have been invited to file observations on quite short notice. So the Special Committee Q176 has been formed on June 28, 2002 with the following members:

Jochen Ehlers, Germany (Chairman)
Ivan Hjertman, Sweden (Co-Chairman)
Geoffrey Bayliss, United Kingdom (Secretary)
Marcelino Curell Aguilá, Spain
Michael Meller, USA
Axel Casalonga, France (since Nov. 2002)
Bruno Phélip, France (until Nov. 2002).

The Special Committee of AIPPI focussed mainly on those parts of the draft Implementing Regulations which have been newly added to the EPC. In addition, the Special Committee pointed out some inconsistencies between the draft Implementing Regulations and the EPC. The comments have been forwarded to the European Patent Office on behalf of AIPPI on September 3, 2002.

Fortunately, most of our recommendations have indeed been taken into consideration so that the revised Implementing Regulations for the EPC 2000 indeed comply with most of our recommendations. Herein below, we summarize in a first section those recommendations, which have been taken into consideration by the EPO and in a second section those aspects, which have not.

1. Summary of the recommendations of AIPPI which have been accepted by EPO

Rule 6

The first draft of the new Implementing Regulations included a term of just one month for filing the translation of a European patent application not filed in an official language of the EPO. The actual version of the Implementing Regulations defines a term of three months after filing of the application (13 months from the priority date latest). We recommended to revert to the original (longer) term.

According to Rule 40 a) and Rule 41 of the revised Implementing Regulations, the applicant is invited to file the translation of the application required under Art. 14, paragraph 2 within a term of two months from notification, if the applicant has not filed the translation of the application in time. So in practice, the new term is extended to at least 3 months. This amendment indeed addresses our criticism regarding the previous draft.

Rule 25 (4)

We observed that the case that no designation fee is paid is not mentioned. We proposed to include a reference to new Rule 25 c) (3). We proposed a second sentence with the following wording: "*Rule 25 c) (2) and (3) is applicable.*"

The new Implementing Regulations indeed have been accordingly amended.

Rule 26 (2) h)

We proposed to delete Rule 26 (2) h). According to the original wording the request shall contain the designation of the contracting state or states in which protection of the invention is desired. This is contrary to Art. 79 (1), according to which all the contracting states shall be deemed to be designated in the request.

The EPO followed this recommendation and indeed deleted this paragraph.

Rule 31 (2)

According to Rule 25 d), an application may contain no claims at the date of filing. This is a change to the present legal situation. Consequently, the proposed new Rule 31 (2) according to the first draft Implementing Regulations determines that the claim fees shall be paid within one month of filing the claims. We pointed out that this wording can be misleading. Namely, if new claims are filed during the course of the examination procedure, it would have been questionable whether or not additional claim fees are to be paid for each newly filed set of claims. Of course this is not what has been intended. We assumed - and requested a corresponding clarification - that claim fees shall be paid - as previously - at two instances: At the time, the original claims are filed and at the time the European patent application is ready for being granted.

The European Patent Office followed this recommendation. New Rule 31 (2) now defines that "*...the claim fees shall be paid within one month of filing the first set of claims...*".

Rule 35 (3)

We pointed out that the reference to paragraph 11 of Rule 35 appears to be incorrect. According to our impression the correct reference should be to Rule 35 (10).

Indeed, the revised Rule 35 (3) now refers to paragraph 10 instead of paragraph 11.

Rule 38 (declaration of priority)

We included a number of amendments and corrections regarding this Rule. Firstly, we proposed to use the term "filing date" instead of the term "date". Fortunately, the European Patent Office followed this approach and the new Rule 38 (1) is now accordingly amended.

Further, we proposed a clarification of Rule 38 (2): We proposed that within the term for filing a declaration of priority, a correction of the declaration should be possible as well. Again, the European Patent Office fortunately followed this proposal. New Rule 38 (2) now indeed reads in its second sentence: "*It [i.e. the declaration of priority] may still be made or corrected within 16 months from...*".

Further, we proposed another clarification in Rule 38 (2): We proposed an amendment according to which the declaration of priority still can be made until filing a request under Art. 93, paragraph 1 (b). Indeed, such a clarification is now included in Rule 38 (2) of the revised Implementing Regulations.

Still further, we suggested still another clarification in Rule 38 (2). Namely, Art. 87 (1) (b) introduces the possibility to claim priority from a first application filed in or for any member of the WTO. In practical terms, this concerns territories which are not parties to the

Paris Convention, but which are members of the WTO. For example, Taiwan is not a party to the Paris Convention. Nevertheless, since January 1, 2002, Chinese Taipei (that is Taiwan) is member of the WTO. So we suggested for the sake of legal clarity concerning the right to claim priority from a first application to replace the wording "...the state in or for which it was filed..." by the term "...the state, or member of the WTO, in or for which it was filed...".

Fortunately, the EPO accepted exactly this wording and Rule 38 (1) is now accordingly amended.

Rule 39 a)

According to subparagraph 4 of Rule 39 a), if the applicant fails to file missing parts of the description or missing drawings in due time (after a related notification from the European Patent Office), they shall be deemed not to have been filed. We pointed out that this does not make sense. Namely, if the applicant does not file missing parts of the application documents they are actually missing. Therefore it is not necessary to define that they shall be deemed not to have been filed. We suggested another wording for Rule 39 a) (4). This wording has been taken into consideration literally; new Rule 39 a) (4) now complies exactly to our proposal.

Rule 46 (1)

The originally suggested amendment to Rule 46 (1) has been criticized by us with some emphasis. According to the actual version of Rule 46 (1), the European Patent Office shall draw up a partial European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Art. 82 first mentioned in the claims. According to the proposed new version of this rule the partial European search report shall be established for those parts of the application which "...appear to represent the main invention"; so it would have been up to the search examiners to determine for which part of the application a partial European search report will be drawn up. This Rule is quite important in practise and the result would not have been in favour of the applicants. Namely, we wondered how an examiner would be in a position to determine which parts of the application "...appear to represent the main invention." We stated our fear that ? in practise - the search examiner just looks for those parts of the application, which are easiest to be handled. These are possibly those parts, where he is aware of relevant prior art. But most often, exactly these aspects are not those which are of highest interest for the applicants. We therefore proposed to stick to the previous wording of Rule 46 (1). We pointed out that the applicant should have the right, that - in case the European patent application does not comply with the requirements of unity of invention - the search report shall be established for those parts which are mentioned first in the claims. We felt that this solution complies with the interests of the applicants.

Fortunately, we have been successful with this criticism. New Rule 46 (1) EPC now complies with this request and reflects the wording of the present Rule 46 (1).

Rule 54 (2)

According to the first draft of the Implementing Regulations, Rule 54 (2) has been deleted. According to the actual version of Rule 54 (2), the proprietor of the patent may request that duplicate copies of the European patent certificate be supplied to him upon payment of a administrative fee. We have had difficulties to understand why this provision shall be deleted. According to our opinion, the patentee should have - also in the future - the possibility e.g. to hand over further certificates to the inventors in order to acknowledge their work. In order to enable him in this respect, it appeared for us necessary

to get duplicate copies of the European patent certificate - against payment of a fee - also in the future.

Fortunately, the European Patent Office followed our requirement and included previous Rule 54 (2) - without any further amendment - in the new Implementing Regulations again.

Rule 56 (1)

We criticized the proposed Rule 56 (1) as being too strict. Namely, according to Rule 56 (1) an opposition is rejected as inadmissible, if the notice of opposition does not comply with the provision of Rule 55 b) paragraph 2 (b). We understood this wording in that way that an opposition is rejected, if any of these three indications of Rule 55 (b) (2) b) is missing. So if the notice of opposition e.g. contains the application number, the publication number, but possibly not some other indications like the name of the proprietor and the title of the invention, the opposition would have been inadmissible. We proposed to require only those indications which are necessary to unambiguously identify the European patent against which opposition is filed.

Again, the European Patent Office followed our recommendation. According to new Rule 56 (1), an opposition is rejected just if a patent is not "sufficiently identified". This exactly complies with our requirement.

Part V, Chapter II - Centralized limitation or revocation procedure Rule 63 b), c), d), e), f), g) and h)

Regarding this new provision we included numerous proposals which have been partly accepted and partly dismissed. To start with, here are those recommendations which have now been taken into consideration:

First of all we proposed to concentrate Rules 63 d), f) and g) in one new Rule in order to increase clarity of the new procedure. The EPO followed this recommendation, cf. new Rule 63 d).

We proposed a slightly different wording in Rule 63 g) which has been partly accepted.

The suggested handling by the examining division - according to the first draft Implementing Regulations - did not foresee any communications at all between the requestor and the European Patent Office. We pointed out that there are good grounds that the requestor should have an opportunity to file comments. For example, an examiner may have obtained a possible ill founded understanding of the requested amended. And even if it will always be possible to file a new request for limitation, the existence of an earlier, rejected request certainly has the potential to complicate potential legal actions based on the patent in a state for which it was granted, and also to create complications and legal actions under corresponding patents in other countries, such as the US.

In fact, since the substance examination is not re-undertaken, except under exceptional circumstances, the request is either accepted or rejected. According to the explanatory notes, the requestor will be limited to the text of the amended claims submitted at the time of the request. If the slightest problem arises for the acceptance of the amendment, the request would have been obliged to introduce a new amendment procedure, which would have been extremely rigid and might have had unfavourable consequences, for example, if the amendment has been required within the frame work of a legal action in a state. The rejection of the requested amendment might be misunderstood by the national court or, in any case, delays its decision. We pointed out that it would be regrettable to impose an appeal procedure on a petitioner when it is a matter, perhaps, of providing a simple modification of form to a petition for amendment of claims.

Fortunately, the European Patent Office followed this suggestion and the revised Rule 63 g) (2) now provides the possibility for such a dialog. Accordingly, the revised Rule now contain the following sentence:

"If the request does not comply with these requirements, the examining division shall give the requestor one opportunity to correct any deficiencies noted, and to amend the claims and, where appropriate, the description and any drawings, within a period to be specified".

We believe, that this is really a good success of our work.

Rule 46 a) - Part VI, Chapter I ("Appeal procedure")

According to the original wording, *"In the examination of the appeal the Board of Appeal shall, if necessary, invite the parties to file observations..."*. We did not understand the term *"if necessary"* and proposed to delete this term. Fortunately, the European Patent Office followed this recommendation.

Part VI, Chapter II - Revision by the Enlarged Board of Appeal (Re: Art. 112 a)

This chapter is entirely new and indeed quite important. Most of our recommendations have not been accepted apart from the following small issue: We suggested that the term *"person"* in Rule 69 (2) shall be replaced by the better term *"party"*. The European Patent Office accepted this recommendation and amended new Rule 69 (2) accordingly. This is - compared to the issues that are dismissed (see herein below) - unfortunately a comparatively unimportant success.

2. Summary of the recommendations of AIPPI which have not been accepted by EPO

Rules 39 and 39 a)

Rules 39 and 39 a) have been drawn up to harmonize them with the PLT. Rules 39 and 39 a) concerns deficiencies of an application at the time of filing, in particular missing parts of the description or missing drawings.

With respect to Rule 39 we observed that Rule 39 apparently assumes that Rule 25 d) (b) is fulfilled, i.e. that information is available allowing the applicant to be contacted, because otherwise the European Patent Office cannot inform the applicant of any deficiencies. So Rule 39 deals with the case of Rule 25 d) (1) (a) and (c), i.e. cases where no indication that a European patent is sought is included or cases where a description or a reference to a previously filed application is missing.

In such cases it does not make sense - to our conviction - to set a particular term to remedy these deficiencies. Meeting the term does not provide any benefit for the applicant. Since meeting the term does not provide any benefit for the applicant (the filing date will be shifted), we proposed to delete the reference to a two-months term. We proposed that it shall be sufficient to inform the applicant - as soon as possible - about an incomplete application which is not dealt with as a European patent application.

Further, according to Rule 39 a) (1), the applicant is invited to file missing parts of the application. According to paragraph 2 of this Rule, the applicant is informed after filing the missing documents, that the application shall be re-dated to the date on which the missing parts will be filed. He is then invited to withdraw the missing parts within a further term, which he was just ask to file, in order to keep the original filing date.

Our recommendation to ease this procedure and limit the obligation of the European Patent Office to informing the applicant accordingly has not been taken into consideration.

In our view even more important is the following: According to Rule 39 a) (1), "...*the applicant may not invoke the omission of such a communication*" ["*such a communication*" refers to a notification from the European Patent Office informing the applicant about missing parts of the application]. We pointed out that this provision is not in compliance with Art. 5 (5) PLT. According to Art. 5 (5) PLT the receiving office is committed to inform the applicant immediately, if certain application documents are obviously missing. We proposed to delete the aforementioned sentence in Rule 39 a) (1) in order to harmonize the Implementing Regulations with the wording and the purpose of the PLT. Unfortunately, the European Patent Office did not follow this recommendation.

Rule 40

In practise, the European Patent Office examines - in accordance with Art. 90 - if the European patent application contains prohibited matter as defined in Rule 34. We proposed to include this activity in the list of formal requirements as defined in Rule 40. The European Patent Office did not follow this recommendation.

Rule 41 a)

This Rule concerns deficiencies in claiming priority. According to Rule 41 a), the European Patent Office shall inform the applicant, if the file number of the previous application or the copy of that application have not been filed in due time. We recommended, that the European Patent Office shall inform the applicant in all proven cases of defect in priority claim. Unfortunately, we have been not successful with this recommendation.

Rule 55 b) (1)

This Rule concerns form and content of the opposition. The first paragraph defines that a notice of opposition shall be filed in a written reasoned statement. We proposed to allow an opposition to be filed in electronic form. We proposed that Rule 24 (2) shall be applicable *mutates mutandis*.

Again, the EPO did not follow this suggestion.

Part V, Chapter II - Centralized limitation or revocation procedure Rule 63 b), c), d), e), f), g) and h)

These Rules concern Implementing Regulations concerning the centralized limitation or revocation procedure. This is a quite important part of the Implementing Regulations, since it is based on the provisions revised at the time of the diplomatic conference in November 2000, namely new Articles 105 a), b) and c). The new Rules confirm that the role of the examining division shall be limited to checking whether the petition for amendment or revocation is justified. It is the new text of the claims that will serve essentially as a basis for the petition with the applicant, however, being able to amend the description correspondingly. It is also contemplated that the request may not be examined if there is an opposition procedure pending, this taking primacy, as results from the text issuing from the diplomatic conference.

Some of our recommendations have been accepted as mentioned above in section 1. However, some other recommendations have not been taken into consideration: New Rule 63 g) (2) requires an examination "...*whether the amended claims constitute a limitation vis-à-vis the claims...*". In the explanatory notes, in the last paragraph concerning Rule 63 f) (first version), it is stated that the examining division may indeed consider the patentability of the amended claims in individual cases,

"...for example where there are indications that the requested amendment of the claims would lead to the protection of subject matter which is excluded from patentability".

We believe that such an examination is actually contrary to Art. 105 a), b) and c). In the example taken from the explanatory notes, the granted claim would likewise have protected subject matter which is excluded from patentability. If an amendment to a claim just limits the scope of the claim, it is impossible that the scope of protection extends towards subject matter of the claim as granted. For this reason we stressed that substantive examination should not be reopened and that the examination should be clearly limited to the examination of the requirements of Art. 84 and Art. 123, paragraphs 2 and 3.

We have been not successful with this proposal, the new Implementing Regulations are - in this respect - unchanged.

Rule 67 a) - g) - Petitions for review by the Enlarged Board of Appeal

This chapter is entirely new and is concerned with petitions for review by the Enlarged Board of Appeal. According to Rule 67 c), a petition is only admissibly, where an objection in respect to the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where the raising of the objection during the appeal proceedings was impossible. Further, a fundamental procedural defect under Art. 112 a) paragraph 2 (d) may have occurred (only) where the Board of Appeal failed to arrange for the holding of oral proceedings requested by the petitioner or decided on the appeal without deciding on a request relevant to that decision. That's basically it.

So the possibilities for petitions for review by the Enlarged Board of Appeal are quite disappointing. In particular in view of the fact that decisions of Boards of Appeal cannot be appealed to any national court:

- i) Regarding the obligation to raise objections: What about an orally lodged petition which has not been noted in the minutes of the oral proceedings? Shall it be possible to obtain a revision of the minutes by the Enlarged Board of Appeal? It is well known that the minutes do not **fully** reflect the content of the discussions of the oral procedure. Further, quite often participants of a hearing before a Technical Board of Appeal become aware of a defect **after** the procedure terminated.

Our criticism on Rule 67 c) unfortunately did not lead to any amendment.

- ii) Further, we recommended to amend the list of fundamental procedural defects to include cases where the Boards of Appeal:

- decided on the appeal, although a party to the proceedings was not properly represented,
- decided on the basis of a hearing on which the provisions of publicity of proceedings were violated, or
- failed to provide a decision which states the written grounds therefore.

Again, this proposal has not been accepted.

- iii) According to Rule 67 f), the Enlarged Board of Appeal decides in written proceedings, without the involvement of other parties and on the basis of the petition as filed. Given the importance of such petitions, we considered that Art. 113 (1) EPC and Art. 116 (1) shall be applicable *mutates mutandis*.

Again, we have been not successful with this understanding.

- iv) Rule 67 g) concerns the reimbursement of the fee for petitions for review. The Enlarged Board of Appeal shall order the reimbursement of the fee for a petition for review, if the proceedings before the Boards of Appeal are reopened, unless such reimbursements is inequitable. So even if the proceedings before the Boards of Appeal are reopened, the Enlarged Board of Appeal nevertheless may decide not to reimburse the appeal fee. This is hard to understand. If the decision of the Enlarged Board of Appeal overturns that of the Board of Appeal, it is precisely because there has been a fundamental defect of procedure. Consequently, the fee should be reimbursed in all such cases. Its difficult to understand why the EPO insisted on this provision.

Rule 85 a) - Request for further processing (Art. 121)

Rule 85 a) deals with the important question of further processing (Art. 121). The text results clearly from the diplomatic conference that decided that numerous measures of the Convention would be referred to the Implementing Regulations. Although the new Rule 85 a) contain some favourable clauses for applicants, we recommended to open the procedure according to Art. 121 also to the following issues:

“Rule 6 (1): Provision of the translation from another language

Rule 25 (d): Obtaining a filing date by reference to another previously filed application

Rule 41: Correction of deficiencies in application documents.”

Unfortunately the EPO did not follow our recommendations.