

## Explanatory remarks to the Implementing Regulations

### Introduction

The revision of the European Patent Convention in November 2000 made it necessary to overhaul the entire corpus of the Implementing Regulations to the EPC.

The revision of the Implementing Regulations is based on the text in force as at 1 July 2002 and pursues the following three objectives:

1. Making the adjustments required by the substantive amendments to the EPC 1973 and those dictated by the implementation of the Patent Law Treaty of 1 June 2000.
2. Integrating the provisions transferred from the EPC to the Implementing Regulations.
3. Ensuring the consistency of the Implementing Regulations with the new text of the EPC 2000, restructuring and streamlining the Regulations, and standardising and harmonising their wording in the three languages.

Amendments unrelated to these goals have not been taken up for the purpose of this revision exercise. Such other amendments will, however, be made independently, whenever the need arises, on the basis of the Implementing Regulations currently in force.

The following general points should be noted:

1. The English text of the Implementing Regulations uses two different terms for the same notion, i.e. "time limit" or "period". Wherever possible, for the sake of consistency, "time limit" has been replaced by "**period**".
2. Where the Rules refer to "**a period to be specified**", this means a period specified by the EPO in the individual case. New Rule 84(1) EPC makes this clear.

3. Where the Rules contain the expression "**unless otherwise provided**", this means unless otherwise provided in the Convention or the Implementing Regulations.

4. Where the Rules specify a period to be observed following an invitation or communication from the EPO, the **period always starts with the notification** of such communication, since all decisions, notices and communications have to be notified to the parties (Article 119 EPC 2000, Rules 77-83). Therefore, the provisions concerned need not expressly refer to the requirement of notification (see eg Rules 39, 39a, 41).

## **PART I**

### IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION

#### **Chapter I**

##### RULES 1-7 EPC

Rules 1-7 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

**Rule 6 EPC** - Filing of translations and reduction of fees  
(Preparatory document: MR/2/00, pages 5-10)

Under Article 6(3) PLT, the Office may require a translation if the application is not filed in one of the official languages. The PLT does not set a time limit for filing the translation, but provides that the applicant must be notified if no translation is filed, giving him the opportunity to supply the translation within a period of at least two months from the date of notification (Article 6(7) PLT in conjunction with Rule 6(1) PLT). Such notification is provided for in Rule 41 EPC. This, together with the one-month period specified in Rule 6(1), means that the applicant will always have a minimum of three months, from the date of filing the application, to file the translation.

## **Chapter II**

### **RULES 8-12 EPC**

The existing Rules 8 to 12 EPC mainly concern the organisation of the European Patent Office. To reflect the distinction between the departments of first and second instance, Chapter II of Part I of the Implementing Regulations to the EPC 2000 is divided into two sections:

Section 1: General matters (existing Rules 8, 9 and 12 EPC)

Section 2: Organisation of the Boards of Appeal and the Enlarged Board of Appeal (previous Rules 10 and 11).

#### **Rule 8 EPC - Patent classification**

The European Convention on the International Classification of Patents for Invention of 19 December 1954, referred to in the existing Rule 8 EPC, has never been applied at the EPO, as the Strasbourg Agreement entered into force on 7 October 1975, before the setting-up of the EPO on 1 November 1977. This reference can therefore be deleted.

#### **New Rule 8a EPC - Administrative structure of the European Patent Office**

concerns the content of the previous Rule 12 EPC. These provisions apply to the EPO as a whole and are therefore included in the section headed "General matters".

The key provision of the existing Rule 12(1) - that the number of directorates in which the Examining Divisions and Opposition Divisions are grouped together is to be decided by the President - is already implied by the President's general power of decision. This part of the existing Rule 12 can therefore be deleted. The administrative grouping of Examining and Opposition Divisions is addressed in modified form in Rule 9(1) EPC.

The new Rule 8a(1) replaces the list of departments in proceedings before the EPO with a general reference to Article 15 EPC. The deletion of the substance of the existing Rule 12(2), second sentence, EPC takes account of Articles 16 and 17 EPC 2000.

**Rule 9 EPC** - Allocation of duties to the departments of first instance

reflects the administrative grouping into directorates of the departments involved in the grant procedure - ie the Search Divisions, Examining Divisions and Opposition Divisions, made up of technically qualified examiners.

The powers of the President laid down in Rule 9(2) and (3) EPC are retained.

Rule 9(4) EPC is deleted. No registry of an Opposition Division has ever been set up. The tasks in question are performed by "employees" within the meaning of Rule 9(3) EPC. The President's general power of decision already enables him to entrust the fixing of costs to formalities officers with specialist knowledge.

**Rules 10 und 11 EPC** - Presidium of the Boards of Appeal; Business distribution scheme for the Enlarged Board of Appeal and adoption of its Rules of Procedure

The version of Rules 10 and 11 EPC valid since 2 January 2002 is retained. Only the references to the EPC in Rules 10(6) and 11(1) and (2) need to be modified, in the light of the EPC 2000. The wording of Rule 11(1) and (2) EPC has been slightly amended to make the emphasis positive, instead of negative as in the existing version.

**Rule 12 EPC** - Administrative structure of the European Patent Office

In view of their general character, the provisions of the existing Rule 12 EPC have been transferred to the new Rule 8a in Section 1, "General matters".

**PART II**

## IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

**Chapter I**

## RULES 13-16 EPC

Rules 13-16 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

**Rule 13 and 16 EPC** - Stay of proceedings; Partial transfer of the right to the European patent

To make the structure of the Implementing Regulations clearer, the Rules concerning an applicant who is not entitled are separated from the provisions applying to a patent proprietor who is not entitled. Accordingly, the substance of Rule 13(4) EPC and Rule 16(3) EPC is moved to Part V of the Implementing Regulations, governing the opposition procedure, and inserted in the new Rule 56a EPC. The title of Chapter I is modified accordingly.

**Rule 14 EPC** - Limitation on withdrawals

The current title has been amended as it is misleading, since it refers only to the withdrawal of the European patent application itself, whereas the Rule also governs the withdrawal of a designation.

**New Rule 14a EPC** - Procedure under Article 61, paragraph 1

(Preparatory document: MR/2/00, pages 51-52)

The requirements for a third party to invoke the remedies provided for in Article 61(1) EPC have been transferred to the Implementing Regulations and are now contained in the proposed new Rule 14a EPC.

**Rule 15 EPC** - Filing of a new European patent application by the entitled person

For clarity's sake, Rule 15(2) EPC is subdivided into paragraphs 2 and 3, concerning the time limits for payment of filing and search fees, and designation fees. In conformity with Article 51(3) EPC 2000, the legal consequences of failure to pay such fees in due time are also laid down in these provisions.

The current Rule 15(3) has been deleted, as a new application under Article 61 must always

be filed directly with the EPO (see Articles 61(2) and 76(1) EPC 2000).

## **Chapter II**

### **RULES 17-19 EPC**

Rules 17-19 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

#### **Rule 17 EPC** - Designation of the inventor

(Preparatory document: MR/2/00, pages 173-176)

The list of data previously contained in Article 128(5) EPC 1973 is now incorporated in Rule 17(3).

## **Chapter III**

### **RULES 20-22 EPC**

Rules 20-22 EPC have been streamlined and their wording aligned with the style of the EPC 2000.

#### **Rule 20 EPC** - Registration of transfers

The new wording of Rule 20(1) EPC does not imply any change of current practice with respect to the standard of evidence required for transfers to be registered.

## **Chapter IV**

### **RULE 23 EPC**

#### **Rule 23 EPC** - Certificate of exhibition

has been reorganised for the sake of clarity, and divided into sub-paragraphs (a) to (d).

## Chapter V

### RULE 23a EPC

Rule 23a, and with it, Chapter V, have been deleted following the deletion of Article 54(4) EPC 1973.

## Chapter VI

### RULES 23b-23e EPC

Chapter VI, concerning biotechnological inventions, becomes **Chapter V**, replacing the old Chapter V, now deleted.

**New Rule 23f** (= Rule 27a EPC) - Requirements of European patent applications relating to nucleotide and amino acid sequences

For the sake of clarity and consistency, this provision is inserted in Chapter V, dealing with biotechnological inventions, after the current Rule 23e.

### **New Rules 23g-23i** (= Rule 28 EPC)

For the sake of clarity and consistency, Rules 28 and 28a are inserted in Chapter V, dealing with biotechnological inventions, after Rule 23f.

The current Rule 28, headed "Deposit of biological material", is very long and difficult to read. It lumps the deposit of biological material together with the questions of availability, the issue of a sample and the expert solution, and a number of purely formal provisions.

Rule 28 is therefore restructured as follows:

Rule 23g	Deposit of biological material
Rule 23h	Expert solution
Rule 23i	Availability of biological material, issue of samples, relevant arrangements

### **New Rule 23g EPC - Deposit of biological material**

Paragraphs (1) and (2) of the existing Rule 28 form the new Rule 23g, dealing with the deposit of biological material.

### **New Rule 23h EPC - Expert solution**

The new Rule, headed "Expert solution", comprises paragraphs (4) and (5) of the current Rule 28.

### **New Rule 23i EPC - Availability of biological material**

The new Rule, headed "Availability of biological material", comprises paragraphs (3), (6), (7), (8) and (9) of the current Rule 28.

### **New Rule 23j (= Rule 28a EPC) - New deposit of biological material**

The existing Rule 28a, concerning the new deposit of biological material, is largely modelled on Article 4 of the Budapest Treaty and, like the current Rule 28, is difficult to read:

- Rule 28a(1), with the exception of the second requirement for the continuing availability of biological material (copy of the receipt of the deposit forwarded to the EPO), corresponds to Article 4(1)(a) and (d) and 4(2) of the Budapest Treaty (BT).
- Rule 28a(2) corresponds to Article 4(1)(b)(i) BT.
- Rule 28a(3) corresponds to Article 4(1)(b)(i) and (e) BT.
- Rule 28a(4) corresponds to Article 4(1)(c) BT.

The revised and shortened version of this Rule follows the example of Article 14 of Directive 98/44/EC and includes an express reference to the Budapest Treaty.



However, as indicated above, the existing Rule 28a includes an additional requirement for the continuing availability of biological material, ie that a copy of the receipt of the deposit be forwarded within four months from the date of the new deposit. This requirement is to be incorporated in the new Rule.

Finally, it should be emphasised that the details of the procedure for making the new deposit will be set out in the Guidelines for Examination.

In view of the new structure of Rule 28, the current Rule 28a becomes Rule 23j.

## **PART III**

### **IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION**

#### **Chapter I**

##### **RULES 24-25d**

#### **Rule 24 EPC - General provisions**

(Preparatory document: MR/2/00, pages 63-64)

The details of Article 75(1)(a) EPC 1973 were moved to Rule 24(1) EPC, which has also been restructured for increased clarity and aligned with the wording of the EPC 2000.

#### **Rule 25 EPC - European divisional applications**

(Preparatory document: MR/2/00, pages 65-66)

New paragraph 2 of Rule 25 EPC provides that divisional applications are to be filed in the language of the proceedings for the earlier application, and incorporates parts of the old Article 76(1) EPC 1973.

Moreover, pursuant to Article 51(3) EPC 2000, the amended Rule 25 EPC not only specifies the fees to be paid, with their time limits, but also refers to the legal consequences of failure to pay in due time. The current Rule 25(2) EPC is accordingly subdivided into paragraphs (3) and (4) for ease of reference.

**New Rule 25a EPC** - Forwarding of European patent applications

(Preparatory document: MR/2/00, pages 67-70)

Details regarding the forwarding of European patent applications from the central industrial property offices of the Contracting States to the EPO, contained in Article 77(1) and (5) EPC 1973, as well as the substance of Article 77(2) and (3) EPC 1973, were transferred to the new Rule 25a EPC. In Rule 25a(2), last sentence, the claims fees have been included, with the consequence that Rule 31(2), last sentence, is redundant.

**New Rule 25b EPC** - Filing fee and search fee

(Preparatory document: MR/2/00, pages 71-72)

The period for payment of the filing fee and the search fee under Article 78(2) EPC 1973 has been transferred to the new Rule 25b EPC. The legal consequence of failure to pay these fees in due time is already established in the new Article 78(2) EPC 2000, so there is no need to repeat it in Rule 25b EPC.

**New Rule 25c EPC** - Designation fees

(Preparatory document: MR/2/00, pages 73-74)

The period for payment of the designation fee under Article 79(2) EPC 1973 is transferred to the Implementing Regulations, as is the substance of the last two sentences of Article 79(3) EPC 1973, concerning the consequences of withdrawal of all the designations and the principle that designation fees are not refundable. These are now included in the new Rule 25c EPC, drafted in the style of the EPC 2000.

The legal consequence of failure to pay a designation fee in due time (Article 91(4) EPC 1973) is inserted in Rule 25c(2) EPC; the legal consequence in cases where no designation fee is paid or all designations are withdrawn is laid down in Rule 25c(3) EPC.

**New Rule 25d EPC** - Date of filing

(Preparatory document: MR/2/00, pages 75-76)

Article 80 EPC 2000 states that the Implementing Regulations shall specify the requirements for a date of filing. The wording of the new Rule 25d(1) EPC follows the model of Article 5(1) and (7) PLT 2000.

Under Article 5(7) and Rule 2(5)(a) PLT, contracting parties are obliged to accept a reference to a single, previously filed application instead of a description and any drawings, provided that the previously filed application is properly identified. These requirements are inserted in Rule 25d(2).

In such a case, any party to the PLT may request the filing of a copy of the previously filed application (Rule 2(5)(b) PLT) - unless such a copy is already available to the contracting party (Rule 4(3) PLT) - and, where appropriate, of a translation of that application. The requirements relating to this are grouped under Rule 25d(3) EPC.

As no individual filing date is accorded to a divisional application, Rule 25d is not applicable to divisional applications.

## **Chapter II**

### **RULES 26-36**

Rules 26-36 EPC have been streamlined and aligned with the drafting style of the EPC 2000.

#### **Rule 26 EPC - Request for grant**

The second sentence of Rule 26(1) is deleted as superfluous. It goes without saying that forms are made available free of charge by the EPO and the national authorities.

The contact information referred to under Rule 26(2)(c) is updated and brought into line with the current EPO Request for grant form. Thus, Rule 26(2)(c) now recommends that the applicant indicate his fax number instead of his telegraphic or telex address.

Rule 26(2)(h) is deleted to reflect Article 79(1) EPC 2000.

**Rule 31 EPC - Claims incurring fees**

The wording of Rule 31(1) EPC has been aligned with Article 2(15) of the Rules relating to Fees and subdivided into paragraphs 2 and 3 for added clarity. As claims are no longer required for a filing date, Rule 31(2) now refers to the filing of the first set of claims.

Rule 31(3), second sentence, has been deleted, with its substance transferred to Rule 25a(2) EPC.

**Rule 32 EPC - Form of the drawings**

Some redundant wording has been removed from Rule 32(2)(j) EPC. In this context, the terms "keywords" and "catchwords" have equivalent meanings. Moreover, electric circuits and block schematic diagrams are diagrams, and since these, by virtue of Rule 32(3) EPC, are deemed to be drawings, Rule 32(2)(j) has been simplified by referring to drawings only.

**Rule 35 EPC - General provisions governing the presentation of the application documents**

Rule 35(11) EPC (formerly Rule 35(12)) has been streamlined so that the single principle at issue - that applicants must use the nomenclature and signs generally accepted in the technical field in question - is stated in a general form.

**Rule 36 EPC - Documents filed subsequently**

Rule 36(5) has been replaced by a reference to Rule 24(2) EPC, which completely covers the matter addressed in the previous paragraph 5.

**Chapter III****Rule 37 EPC****Rule 37 EPC - Payment of renewal fees**

(Preparatory document: MR/2/00, pages 77-78)

The substance of Article 86(2) EPC 1973 has been moved to Rule 37(2) EPC.

The consequences of non payment of a renewal fee are laid down in Article 86(1) EPC 2000 and therefore not repeated here.

Rule 37 EPC has been streamlined and aligned with the style of the EPC 2000.

## **Chapter IV**

### **RULES 38-38a EPC**

(Preparatory document: MR/2/00, pages 83-84)

Rules 38 and 38a EPC set out the requirements to be met when claiming priority under Article 88(1) EPC. Rule 38 EPC deals with the declaration of priority; Rule 38a EPC concerns the priority documents.

#### **Rule 38 EPC - Declaration of priority**

Paragraph 1 refers to a first filing in a WTO member, to reflect Article 87(1) EPC 2000.

Paragraph 2 provides that the complete declaration of priority - including the file number of the previous application - shall, preferably, be made on filing the application. However, in accordance with Article 13(1), Rules 14(1) and (3) PLT as well as Rule 26bis PCT, a declaration of priority may also be made later, ie within 16 months from the priority date claimed, or, where the applicant has requested early publication of the application, until the filing of such a request. Declarations made on filing may be corrected within that period.

The new system is thus based on the principle that the declaration of priority should be made on filing the application, while allowing late claiming of priority or correction of the priority declaration within the above-mentioned 16-month period. This is a significant relaxation of the requirements vis à vis the current Rule 38(2) EPC, under which at least the date and the state of the previous application have to be indicated on filing. For the time being, it is not intended to make use of Article 13(4) PLT and prescribe that a fee be paid if priority is claimed late or a correction of the priority declaration is made.

**New Rule 38a EPC** - Priority documents

has been brought into line with the PLT 2000 and streamlined. Paragraph 3 reflects the requirements of Rule 4(4) PLT, to the effect that a translation of a previous application which was not filed in an official language will no longer be required as a matter of course; instead, the applicant or, as the case may be, the patentee will be invited by the EPO to file such translation only where the validity of the priority claim is relevant to determining whether the invention is patentable.

**PART IV**

## IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

**Chapter I**

## RULES 39-43 EPC

**Rule 39 EPC** - Examination on filing

deals with the examination under Article 90(1). The Office has to examine whether the requirements for the accordance of a date of filing are fulfilled, and if necessary must give the applicant an opportunity to correct deficiencies pursuant to Article 90(4) EPC 2000. The two-month period provided is consistent with Article 5(3) and Rule 2(1) PLT 2000.

**New Rule 39a EPC** - Missing parts of the description or missing drawings

Under Article 5(5) PLT, the applicant must be informed if a part of the description or drawings appears to be missing.

The new Rule 39a EPC corresponds to the stipulations of Article 5(6) PLT. If the applicant, either after an invitation under Rule 39(1) EPC or of his own motion, files a missing part of the description or drawings within two months from the filing date or the communication under paragraph 1, the application will be re-dated (Rule 39a(2), Rule 2(3) PLT).

The applicant may withdraw subsequently filed parts of the description or drawings in order to retain his original filing date (Rule 39a(2) EPC).

If the application claims priority, and the missing part of the description or drawings was contained in the priority application, that missing part of the description or drawings may, if the requirements of Rule 39a(3) EPC are met, be included in the application without loss of the original date of filing (Article 5(6)(b) EPC and Rule 2(4) PLT).

#### **Rule 40 EPC - Examination as to formal requirements**

concerns the formalities examination to be conducted under Article 90(3) EPC 2000 after a date of filing has been accorded. The provision incorporates the substance of the old Article 91(1) EPC 1973.

Claims have been introduced in Rule 40(c) EPC, as these are no longer a prerequisite for the accordance of a date of filing.

#### **Rule 41 EPC - Correction of deficiencies in the application documents**

implements Article 90(4) EPC 2000, according to which the applicant must be given the opportunity to correct deficiencies of his application. With regard to deficiencies in claiming priority, a new Rule 41a EPC has been introduced.

#### **New Rule 41a EPC - Deficiencies in claiming priority**

Under the new Rule the applicant will be invited to indicate the file number of the previous application or to file a copy thereof if this has not already been done within the 16-month period under Rules 38(2) EPC and 38a(1) EPC. In accordance with Article 90(5) EPC 2000, the right of priority will be lost if the deficiencies noted in the invitation are not corrected within the period specified. Re-establishment of rights will be available as a legal remedy in such cases.

In the case of other deficiencies of the priority claim, eg no indication of the date or State of

the previous application, no invitation will be issued. This corresponds to the situation under the current Rule 38(2) EPC in conjunction with Rule 41(2) EPC and is necessary because this information is needed for publication of the application. Thus, where the date or State of the previous application are not indicated within 16 months from the priority date the right of priority will be lost. However, as above, re-establishment of rights will be available.

#### **Rule 42 EPC** - Subsequent designation of the inventor

The time limit in Article 91(5) EPC 1973 is taken over in Rule 42(1) EPC. Instead of being deemed withdrawn, the application will be refused if no designation of the inventor is filed in due time (see Article 90(5) EPC 2000).

Rule 42(2) has been redrafted in order to clarify that also in divisional applications and applications under Article 61(1)(b) the designation of inventor is due on filing. If the designation is not made on filing the application, the EPO will invite the applicant to make it within a period to be specified.

#### **Rule 43 EPC** - Late-filed or missing drawings

is deleted, as late-filed drawings are now dealt with under Rule 39a EPC.

## **Chapter II**

### **RULES 44-47 EPC**

#### **Rule 44 EPC** - Content of the European search report

The current Rule 44(2) EPC lists examples in brackets of how relevant parts of the documents cited are to be identified and referred to the claims. Since the list is not exhaustive, and there are other possibilities of identifying documents, the bracketed wording is to be deleted and its content transferred to the Guidelines for Examination in the EPO, with explanations if necessary.

#### **New Rule 46a EPC** - Transmittal of the European search report



The wording of Article 92(2) EPC 1973 is incorporated in the new Rule.

### **Chapter III**

#### **RULES 48-50 EPC**

**Rule 49 EPC** - Form of the publication of European patent applications and European search reports

The substance of Article 93(2) EPC 1973 is incorporated in this Rule, which now makes it clear that the abstract is always included in the published application..

**New Rule 50a EPC** - Request for examination

contains the details of the request for examination under Article 94(1) EPC 2000. The substance of Article 96(1) EPC 1973 and of current Rule 51(1) is incorporated in Rule 50a(2) and (3) EPC.

**Rule 51 EPC** - Examination procedure

The substance of Rule 51(1) is incorporated in the new Rule 50a(2).

### **Chapter V**

#### **The European patent specification**

#### **RULES 53-54**

**Rule 53 EPC** - Content and form of the specification

Instead of referring to Rules 48 and 49, which were only partly applicable to the publication of the specification of the European patent, Rule 53 now deals with all aspects of the publication of the specification, including its contents (taken over from Article 98 EPC 1973).

**PART V****IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION****Chapter I****Opposition procedure****RULES 55a-63a EPC**

Since the provisions dealing with limitation proceedings have been incorporated in Part V of the Implementing Regulations, this Part has been divided into two chapters. The new **Chapter I** is headed "Opposition procedure". The new Rules have been streamlined and brought into line with the EPC 2000.

**New Rule 55 EPC** - Surrender or lapse of the patent  
(Preparatory document: MR/2/00, pages 109-110)

is taken over from Article 99(3) EPC 1973.

**New Rule 55a EPC** - Form and content of the opposition  
(Preparatory document: MR/2/00, pages 109-110)

The new paragraph 1 incorporates Article 99(1), second sentence, EPC 1973. The heading is amended accordingly. The new Rule has also been drafted in the style of the EPC 2000.

**Rule 56 EPC** - Rejection of the opposition as inadmissible

has been brought into line with the style of the EPC 2000. The reference to Rule 1(1) in paragraph 1 has been deleted, as it is incorrect: if a notice of opposition is filed in a language other than an official language of the EPO and the required translation (Rule 1(1)) is not filed in due time, the notice of opposition is deemed not to have been filed (Article 14(4) EPC 2000).

**New Rule 56a EPC** (= Rules 13(4) and 16(3) EPC) - Procedure where the proprietor

of the patent is not entitled

Part II, Chapter I of the Implementing Regulations currently deals with the procedure to be followed where either the applicant or the proprietor of a patent was not entitled to file the application or obtain the patent.

The remedies under Article 61(1) EPC, where the applicant is a non-entitled person, are subject to the requirement that the patent has not yet been granted. This condition has been moved from the Convention to the new Rule 14a(1)(b) EPC.

On the other hand, the current Rule 13(4) EPC provides for a stay of proceedings during the opposition procedure where a third party can provide evidence that he is challenging the patentee's entitlement before a national court. Likewise, Rule 16(3) EPC applies to the partial transfer of the right to a patent by virtue of a final decision.

To make the structure of the Implementing Regulations more coherent, the substance of Rules 13(4) and 16(3) EPC has been moved to Part V of the Implementing Regulations, governing the opposition procedure, and integrated as the new Rule 56a EPC.

**Rules 57 and 57a EPC** - Preparation of the examination of the opposition; Amendment of the European patent

have been brought into line with the style of the EPC 2000.

**Rule 58 EPC** - Examination of opposition  
(Preparatory document: MR/2/00, pages 111-114)

The new paragraph 1 incorporates the principles established by the Enlarged Board of Appeal regarding the examination of grounds for opposition by the Opposition Division (see G10/91, OJ EPO 1993, 420). Paragraphs 2 and 3 have been brought into line with the style of the EPC 2000.

**New Rule 58a EPC** - Maintenance of the European patent in amended form

(Preparatory document: MR/2/00, pages 115-118)

Article 102(3) EPC 1973 and Rule 58(4)-(8) are transferred to the new Rule 58a EPC, which concerns only the maintenance of the European patent in amended form. The legal consequences of failure to pay the fee or file the translation in due time are set out in paragraph 3; the amount of the fee and surcharge is laid down in the Rules relating to Fees.

**Rule 60 EPC** - Continuation of the opposition proceedings by the European Patent Office of its own motion

has been brought into line with the style of the EPC 2000.

**Rule 62 EPC** - Content and form of the new specification of the European patent

has been redrafted to correspond to new Rule 53. A reference to Rule 54 is included so as to make Rule 62a redundant.

**Rule 63 EPC** - Costs

(Preparatory document: MR/2/00, pages 121-122)

The details of decisions on the apportionment of costs and the procedure for fixing costs are grouped together in Rule 63 EPC.

Paragraph 1 remains unchanged. Paragraph 2, first sentence, is taken from Article 104(2), first sentence, EPC 1973, and incorporates, as before, the principle that costs may only be fixed on the basis of a final decision apportioning them. Paragraph 3, first sentence, amalgamates Article 104(2), second sentence, EPC 1973 with part of the existing Rule 63(3) EPC.

**New Rule 63a EPC** - Intervention of the assumed infringer

(Preparatory document: MR/2/00, pages 123-124)

The details in Article 105 EPC 1973 are transferred to the new Rule 63a EPC. The insertion in paragraph 2 of the reference to Rule 55a makes it clear that on filing notice of intervention, particulars corresponding to those in the notice of opposition must be given.

## **Chapter II**

### **Limitation procedure**

#### **RULES 63b-63h EPC**

(Preparatory document: MR/2/00, pages 125-130)

Rules 63b-63h, in the new Chapter II of Part V of the Implementing Regulations, contain the provisions governing the details of the limitation procedure (Articles 105a, 105b, 105c EPC 2000). As indicated in the explanatory remarks on these Articles, the limitation procedure is designed as an ex parte procedure which does not provide for the participation of third parties. However, third parties may present observations under Article 115 EPC 2000.

#### **New Rule 63b EPC - Subject of proceedings**

defines the subject of the centralised limitation or revocation procedure before the EPO. The provision makes it explicit that only the European patent as granted or amended by the EPO is to be the subject of such proceedings.

#### **New Rule 63c EPC - Competence of the Examining Division**

assigns the new tasks to the Examining Divisions. This is expedient because of the nature of the issues, ie the amendment of the claims, in an ex parte procedure which essentially involves assessing technical questions concerning the drafting of the claims. As regards the composition and work of the Examining Division in limitation proceedings, Article 18(2) EPC 2000 is to apply mutatis mutandis.

Responsibility needs to be assigned expressly to the Examining Divisions, because the Convention itself only implies such responsibility indirectly (Article 21(3)(a) EPC 2000). For

reasons of legal coherence and transparency, it is better to establish the competence of the Examining Divisions in the Implementing Regulations than to allocate such duties by decision of the President under Rule 9(2) EPC.

### **New Rule 63d EPC - Requirements of the request**

sets out the details of the requirements to be met by a request for limitation or revocation of a European patent.

Paragraph 1 provides that the request shall be filed in writing. The request must indicate whether limitation or revocation is sought. Under Article 105a(1) EPC 2000, the request is only deemed to be filed when the limitation or revocation fee has been paid. The amount of the appropriate fee is laid down in the Rules relating to Fees. The request does not have to be accompanied by a statement of reasons, but this can be expedient where, for example, the requester's entitlement or the limiting effect of the requested amendment of the claims are not unambiguously apparent from the request documents.

Paragraph 2 specifies the information and the documents which the request must contain. Sub-paragraphs (a), (b) and (e) deal with the identification of the requester and, where appropriate, the representative, as well as the patent to which the request relates (see the corresponding provisions in Rule 55b EPC).

Paragraph 2(c) refers to the cases in which the requester is not the patent proprietor for all the contracting states in which the European patent has become valid (ie granted, validated and not revoked). In these cases, he must indicate the further patent proprietors concerned and show that he is entitled to act on their behalf in the limitation or revocation proceedings. In view of the ab initio effect of limitation and revocation under Article 68 EPC 2000, this requirement also applies to patent proprietors in states where the European patent has already expired.

Limitation of the European patent under Article 105a(1) EPC 2000 is only possible by an amendment of the claims. Paragraph 2(d) prescribes accordingly that the request must contain the complete text of the amended claims. A separate set of claims for a particular

Contracting State may also be presented under Rule 87.

The filing of a description modified in accordance with the amended text of the claims is not prescribed, since the text granted will normally support the claims as amended. If the requester nevertheless wishes to amend the description, he may do so, appending the amended version to his request. The same applies in respect of the drawings.

In accordance with Rule 1(2) EPC, the text of the amended claims and, where appropriate, of the description must be filed in the language of the proceedings in which the patent was granted. Since the amended claims form the basis for limitation and for the publication of the amended specification of the European patent, they must comply with the general provisions concerning the form of documents filed with the EPO (Rule 36 EPC).

#### **New Rule 63e EPC - Precedence of opposition proceedings**

deals with the relationship between limitation and opposition proceedings. Paragraph 1 governs the situation where, at the time of filing opposition, proceedings relating to the patent are pending (Article 105a(2)). In such a case the request will be deemed not to have been filed and reimbursement of the fee for limitation or revocation is to be ordered.

Paragraph 2 provides that limitation proceedings already pending at the time of filing an opposition to the European patent for which limitation is requested are to be terminated by the Office of its own motion. Reimbursement of the limitation fee will be ordered in such cases. However, paragraph 2 does not apply where revocation of the European patent is requested.

This complies with the principle of the precedence of opposition proceedings, as laid down in Article 105a(2) EPC 2000, and takes account of the fact that the requester in these cases has the option of resorting to the opposition procedure for prosecuting his interests.

**New Rule 63f EPC - Rejection of the request as inadmissible**

concerns the examination as to admissibility of requests under Article 105a EPC 2000. The question of admissibility is only to be considered where the request for revocation or limitation is not to be dealt with under Rule 63e and where it has been validly filed, ie when the relevant fee under Article 105a(1) has been paid and the general requirements for the validity of procedural acts before the EPO have been fulfilled (eg Rules 1(1), 36(3) and 36(5) EPC). If this is not the case, the formalities officer will inform the requester that a valid request has not been filed, and state why this is so.

The provision is modelled on Rule 56 EPC, applying to opposition proceedings, and provides that requests for limitation or revocation of the European patent are to be rejected as inadmissible if the requirements of Rule 63d EPC concerning such requests are not fulfilled, or are not fulfilled within the period specified in the invitation to remedy the deficiencies.

Examination and decisions as to admissibility are the responsibility of the formalities officer. The details of this are laid down on the basis of Rule 9(3) EPC, authorising the President to entrust duties to employees who are not technically or legally qualified examiners.

**New Rule 63g EPC - Decision on the request**

concerns the examination of, and decision on, requests for limitation or revocation which have been found to be admissible.

Paragraph 1 deals with the request for revocation and provides that the European patent is to be revoked where the request is admissible. The requester must be informed of the revocation and told when the decision will be published in the European Patent Bulletin.

Paragraph 2 concerns the examination for compliance with the substantive requirements for limitation of the European patent. It must be established whether the requested amendment of the claims actually constitutes a limitation (which, for example, is not the case where amendments are made purely for the purposes of clarification or claiming an aliud) and



whether the requirements of Articles 84 und 123(2) and (3) EPC have been met, and, where appropriate, whether the amendments to the description or the drawings are in line with these requirements. This examination is carried out on the basis of the amended claims and the amended description as submitted by the requester in accordance with Rule 63d(2)(d) EPC.

If the request does not comply with the requirements set out above, the Examining Division will give the requester **one** opportunity to amend the claims and the description within a period to be specified. Errors of transcription or obvious mistakes can be rectified on request or by the Office of its own motion (Rule 88 EPC). Since the request can be filed again at any time, depriving the requester of the possibility of making further amendments does not seem unreasonably harsh.

In principle, there should be no examination as to whether the subject-matter of the limited patent is patentable under Articles 52 to 57 EPC or whether the supposed aim of the limitation - eg delimitation with respect to particular prior art - is actually achieved by the requested amendment of the claims.

Under paragraph 3, if a request for **limitation** of the European patent is to be allowed, the requester has to file a translation of the amended claims and pay the fee for printing the amended patent specification before the limitation can be decided.

Under paragraph 4, the request for limitation of the European patent is rejected if the requester does not respond to the communication under paragraph 2, or if it cannot be allowed. This also applies if the requester fails to perform the acts required under paragraph 3 in due time.

**New Rule 63h EPC** - Content and form of the amended European patent specification

corresponds to the new version of Rule 62 EPC.

## **PART VI**

### **IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION**

## **Chapters I and II**

### **RULES 63i-67 EPC**

The transfer of some provisions from the Convention and the new Article 112a EPC 2000 have made it necessary to extend Part VI of the Implementing Regulations and divide the material into two chapters: Chapter I, concerning the appeal procedure (Articles 106 to 112 EPC) and Chapter II, containing the rules for proceedings under Article 112a EPC.

### **Rules 63i-67 EPC**

(Preparatory document: MR/2/00, pages 131-136)

Chapter I of Part VI comprises the Rules (implementing, in particular, Articles 106, 108 and 110 EPC) which govern the procedural provisions applicable in appeal proceedings, the admissibility of the appeal and the examination of the appeal as to admissibility and allowability.

### **New Rule 63i EPC - Appeal against apportionment and fixing of costs**

On the basis of Article 106(3) EPC 2000, the substance of Article 106, paragraphs 4 and 5, EPC 1973 is transferred to the new Rule 63i.

### **New Rule 63j EPC - Surrender or lapse of the patent**

transfers Article 106(2) EPC 1973 to the Implementing Regulations. The original wording "for all the designated States" would be appropriate if, for example, a centralised procedure existed for surrendering European patents. The amended wording "**in** all the designated States" is more in keeping with the idea of a "bundle" of national patents.

### **Rule 64 EPC - Content of the notice of appeal and the statement of grounds**

Paragraph 1 defines the contents of the notice of appeal to be filed within the period specified in Article 108, first sentence, EPC 2000. Paragraph 2 defines the contents of the statement of grounds of appeal to be filed within the period specified in Article 108, third sentence, EPC

2000.

New Rule 64(1) takes up requirements mentioned in the current Rule 64(a) and (b), namely the indication of the appellant and the decision impugned. However, under the current Rule 64(b), the notice of appeal already has to include a statement identifying the extent to which amendment of the impugned decision is requested. This rarely presents a problem in appeals filed by an opponent; as a rule, an opponent will request that the decision impugned be set aside and the patent be revoked (partially or in its entirety). However, where the appellant is the patent proprietor, the amended patent claims are nearly always filed with the statement of grounds for appeal, and it is only then that the precise nature of the requested amendment of the decision impugned becomes apparent. Consequently, this requirement is moved to paragraph 2, defining the content of the statement of grounds of appeal, which up to now has only been concretised by board of appeal case law under Article 108, third sentence, EPC.

The requirement of Rule 64(1)(c) EPC takes into account that the appellant's initial request, according to the case law of the Enlarged Board of Appeal (see G 9/92 and G 4/93, OJ EPO 1994, 875, and G 1/99, OJ EPO 2001, 381), defines the subject of the appeal and thereby the framework of the appeal proceedings. As a rule, the notice of appeal should already clarify whether the decision under appeal is contested as a whole or only partially, and define the extent of the issues raised in the appeal proceedings.

#### **New Rule 64a EPC - Examination of appeals**

is taken from the current Rule 66(1) EPC.

Paragraphs 2 and 3, transferred from Article 110(2) and (3) EPC 1973, now clearly refer to examination for admissibility, as well as to the consideration of allowability. The Board of Appeal will invite the parties "as often as necessary" to file observations on communications from the board or submissions of the other party.

#### **Rule 65 EPC - Rejection of the appeal as inadmissible**

sets out the provisions to be observed in examining for admissibility. The cross-references have been brought into line with the Implementing Regulations to the EPC 2000. For the deletion of the reference to Rule 1(1), see the remarks on Rule 56.

If the appeal is admissible, it will be examined for allowability (Article 110 EPC 2000).

### **Rule 66 EPC** - Form of decision of the Board of Appeal

corresponds to the previous Rule 66(2) EPC.

### **Rule 67 EPC** - Reimbursement of appeal fees

Paragraph 1(a) takes up the text of the present Rule 67 EPC.

Paragraph 1(b) goes some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution - in case the other party appeals - can be withdrawn, if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective time limits for filing the notice of appeal and filing the statement of grounds of appeal, ie before any great expense of effort by the parties or the Office.

Paragraph 2 codifies the case law of the Legal Board of Appeal (J 32/95, OJ EPO 1999, 713).

## **Chapter II**

### **NEW RULES 67a-67g EPC**

#### **New Rules 67a-67g EPC**

(Preparatory document: MR/2/00, pages 23-24, 137-146)

The new Rules 67a to 67g EPC, grouped together in Chapter II of Part VI, implement Article 112a EPC 2000.

**New Rule 67a** - Further fundamental procedural defects

implements Article 112a(2)(d) EPC.

The right to oral proceedings, addressed in Rule 67a(a) EPC, is an important aspect of the "right to be heard". Ignoring a request for oral proceedings may therefore constitute a fundamental procedural defect, which in proceedings under Article 112a EPC 2000 merits the same treatment as the cases covered by Article 112a(2)(a) to (c) EPC. It is up to the Enlarged Board of Appeal to assess the seriousness of the procedural defect. Only non-appointment of oral proceedings which contravenes Article 116 EPC is to be a reason for re-opening appeal proceedings.

The seriousness of the fundamental procedural defect addressed in Rule 67a(b) EPC is also to be assessed by the Enlarged Board of Appeal, which must interpret the terms "fundamental" and "relevant" to this end. The assumption is that only requests submitted in writing or requests which the party had recorded in the minutes of the oral proceedings will fall within the ambit of that provision. Furthermore, the wording of Rule 67a(b) implies that the fundamental procedural defect must have occurred with respect to the appeal. Therefore, requests relating to the apportionment of costs, the reimbursement of the appeal fee or other requests concerning collateral issues are not addressed by the present provision. A partial re-opening of appeal proceedings with respect to collateral issues only is not desirable.

**New Rule 67b EPC** - Criminal acts

provides that only a criminal act finally established by a competent court or authority can serve as the basis for proceedings under Article 112a(2)(e) EPC 2000. The act may be "finally established" in any of the following ways:

- by a final judgment under (criminal) law;
- by another final decision of a competent court,
- by a final decision of a competent authority (eg under administrative criminal law, to the extent that such a breach of law can be liable to influence the decision of the Board of Appeal).

The operative criterion is not whether the (criminal) court or authority has passed sentence,

as this would leave out cases where, for example, the perpetrator dies before sentence can be pronounced, or where a finding of diminished capacity makes sentencing impossible. Instead, the crucial issue is whether an act constituting a criminal offence has actually occurred, and whether the fact of its having occurred has been definitely established by a competent court or authority.

#### **New Rule 67c EPC - Obligation to raise objections**

establishes the obligation to raise any procedural objections already during the appeal proceedings, in so far as the party adversely affected by the defect is - or should be - aware of it. It will be up to the Enlarged Board of Appeal to interpret the term "impossible" and to develop an appropriate standard for assessing whether or not it was "impossible" to object against the procedural defect during appeal proceedings.

#### **New Rule 67d EPC - Contents of the petition for review**

implements Article 112a(4), first sentence EPC 2000, particularly in respect of the petitioner's duty to substantiate his allegations. The "reasoned statement" prescribed in Article 112a(4), first sentence, EPC 2000 has to be filed within the time limits laid down in Article 112a(4), second and third sentences. Its contents must meet the requirements laid down in Rule 67d.

#### **New Rule 67e EPC - Examination of the petition**

Paragraph 1 lists the admissibility requirements to be met by petitions for review.

Paragraph 2 concerns the decision of the Enlarged Board of Appeal if the petition is allowable. In accordance with the legal character of the petition as a special remedy, the Enlarged Board will set aside the decision of the Board of Appeal (by "cassatory" decision or *iudicium rescindens*) and order that the proceedings be re-opened. The proceedings are re-opened before the Board of Appeal responsible under the business distribution scheme enacted under Rule 10(4) EPC; however, the Enlarged Board of Appeal may order that members of the board be replaced.

**New Rule 67f EPC - Procedure in dealing with petitions for review**

Paragraph 1 is the parallel provision to Rule 64a(1) EPC (previous Rule 66(1)). The provisions relating to appeal proceedings apply in particular to proceedings before the Enlarged Board of Appeal in the five-member composition under paragraph 2(b). The special rules for proceedings before the Enlarged Board in the three-member composition no longer apply if the Enlarged Board of Appeal has to decide in the composition provided in Rule 67f(2)(b) EPC. Rule 84(2) EPC should not be applicable, enabling the Enlarged Board to shorten time limits in the interests of procedural efficiency.

Paragraph 2 implements Article 22(2), second sentence, EPC 2000.

Proceedings concerning a petition for review are conducted in their initial phase in accordance with paragraph 3; in the interests of legal certainty, review proceedings which clearly have no chance of succeeding must be ended swiftly. Proceedings under paragraph 3 will therefore be conducted in writing, without involving the other parties. The involvement of other parties is not necessary at this stage, since full proceedings will in any case be instituted if the petition is not rejected as clearly inadmissible or unallowable. If the petition is rejected as clearly inadmissible or unallowable, the other parties are not adversely affected, as proceedings on the petition for review are terminated and the legal situation remains as stated by the Board of Appeal.

In proceedings under Rule 67f(3) EPC the petitioner will be invited to attend oral proceedings if he has so requested, or if the Enlarged Board of Appeal considers this expedient, in which case it will issue an invitation of its own motion. If necessary, the period to be observed for issuing the invitation may be shortened. At the end of the oral proceedings, the Enlarged Board will either reject the petition for review as inadmissible or unallowable, or continue the proceedings in the five-member composition under Rule 67f(2) EPC, with the involvement of the other parties. The case will be decided "on the basis of the petition as filed", ie on the basis of the reasons submitted, within the period laid down in Article 112a(4) EPC and supported by facts and evidence, for setting aside the decision.

The decisions of the Enlarged Board of Appeal must be reasoned, in accordance with

general principles.

From Articles 106 and 112a EPC it follows that there is no right of further appeal against a decision of the Enlarged Board of Appeal concerning a petition for review.

### **New Rule 67g EPC** - Reimbursement of the fee for petitions for review

deals with reimbursement of the fee for a petition for review. Reimbursement will normally be made if a fundamental procedural defect is found to have occurred, but the Enlarged Board of Appeal needs to have the possibility of withholding reimbursement in exceptional cases.

## **PART VII**

### **IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION**

#### **Chapter I**

##### **RULES 68-70 EPC**

Rules 68-70 EPC have been brought into line with the style of the EPC 2000.

#### **Chapter II**

##### **RULE 70a EPC**

The new Rule 70a, implementing Article 115 EPC, is inserted in the new Chapter II, headed "Observations by third parties".

The subsequent chapters are renumbered accordingly.

### **New Rule 70a EPC** - Observations by third parties

(Preparatory document: MR/2/00, pages 147-148)

transfers Article 115(1), second sentence, and (2) EPC 1973 to the Implementing Regulations.



### **Chapter III**

#### **RULES 71-76 EPC**

**New Rules 72a-72c EPC** - Summons to give evidence before the European Patent Office; Examination of evidence before the European Patent Office; Hearing by a competent national court (Preparatory document: MR/2/00, pages 149-152)

These Rules deal with the taking of evidence and largely correspond to the current Rule 72 EPC, but also implement Article 117(2)-(6) EPC 1973. For the sake of clarity and legibility, the provisions have been divided into four separate Rules and drafted in the style of the EPC 2000.

Editorial amendments have been made to Rules 71, 72, 73, 74 and 75 EPC.

### **Chapter IV**

#### **RULES 77-82 EPC**

Editorial amendments have been made to Rules 77 to 79 and 81 EPC.

### **Chapter V**

#### **RULES 83-85b EPC**

**Rule 84 EPC** - Periods specified by the European Patent Office

New paragraph 1 of Rule 84 makes clear what is meant by a "period to be specified". The other amendments are purely editorial.

**Rule 85 EPC** - Extension of periods

Amendments are purely editorial.

**Rules 85a and 85b EPC**

have been deleted to take account of the extended application of further processing under Article 121 EPC 2000 (see also the explanatory remarks on the new Rule 85a).

### **New Rule 85a EPC - Further processing**

contains provisions implementing Article 121 EPC 2000.

Rule 85a(1) lays down the requirements (period, fee, completion of omitted act) to be met for the EPO to allow further processing under Article 121(2). The content of the new Rule largely corresponds to Article 121(2) EPC 1973. However, in view of the broadened scope of application of further processing, the period is no longer triggered by notification of the loss of the European patent application but by notification of either the failure to observe the time limit or of the loss of rights. With regard to the extension of further processing to periods for payment of fees, the current requirement that a request for further processing be made in writing has been waived. Under the new system, the request is to be made simply by payment of the prescribed fee. The relevant fees for the various cases will be laid down in the Rules relating to Fees.

On the basis of Article 121(4), second sentence EPC 2000, Rule 85a(2) excludes the following periods from further processing: EPC Rules 6(1) (filing of a translation under Article 14(2) EPC 2000), 14a(1)(a) (enforcement of rights under Article 61), 25d(3) (filing of a copy of the previously filed application to which reference is made or a translation thereof), 37(2) (payment of renewal fees), 38(2) (late declaration of priority), 39 (examination on filing), 39a (missing parts of description or missing drawings), 41 (correction of deficiencies in application documents), 41a (correction of deficiencies in claiming priority) and 69(2) (request for appealable decision).

The period under Rule 6(1) EPC is excluded because the failure to meet this time limit may be remedied under Rule 41 EPC. The same considerations apply to the two-month periods in Rule 25d(3) EPC. The three-month period under Rule 14a(1)(a) EPC is excluded from further processing because it is not monitored by the EPO and no communication can be issued if it is missed. This is acceptable because the exclusion implicitly recognises that, in principle, the entitled person under Article 61(1) EPC has access to the remedies provided by the EPC to

deal with failure to observe time limits. Therefore, if he misses this time limit, he can apply for re-establishment of rights.

The reason for excluding the six-month period under Rule 37(2) EPC is that the latter is a period of grace (see Article 5*bis* of the Paris Convention - period of grace for payment of fees). This means that there is a structure whose effect corresponds to the legal remedy of further processing. It should also be noted that re-establishment of rights is possible in respect of the period under Rule 37(2) EPC.

In view of the publication of the application, the new time limit for late declaration of priority under Rule 38(2) EPC does not permit further processing.

The exclusion of the time limits in Rules 39, 39a, 41 and 41a EPC is based in particular on the fact that the procedure under these Rules is a form of legal remedy.

Similar considerations apply to the two-month period under Rule 69 EPC, which allows for an administrative review of any loss of rights resulting from the Convention. If the time limit for requesting such a review is missed, the loss of rights becomes final without any further decision or communication being issued by the EPO. Thus the necessary procedural starting point for further processing is lacking. However, further processing also has to be ruled out on substantive grounds, as the procedure under Rule 69 EPC already has a remedial character.

The provision of Article 121(3) EPC 1973 regarding competence for decisions on requests for further processing is transferred to Rule 85a(3).

### **New Rule 85b EPC - Re-establishment of rights**

contains the detailed provisions implementing Article 122 EPC 2000.

Paragraph 1, based on the existing law (Article 122(2) and (3) EPC 1973), lays down the periods for filing requests and establishes the requirement for payment of a fee.

However, to simplify the existing time limit structure, and in view of the relevant provisions of the PLT 2000 (Article 12(1)(ii) and Rule 13(2)(ii)), the six-month period of grace under the new Rule 37(2) EPC is not to be deducted from the period of one year for requesting re-establishment of rights. The latter period now begins on expiry of the six-month time limit for payment of renewal fees, instead of on the date when payment falls due. Under Rule 69 EPC, a (computer-generated) communication is automatically sent to the applicant within two months of the expiry of the time limit for payment; in practice, therefore, the period for requesting re-establishment of rights in such cases will seldom be invoked, and the *de facto* extension of this period under the new arrangement does not put third parties at an unreasonable disadvantage.

Under the new law, re-establishment of rights is also possible in respect of the priority period under Article 87(1) EPC. In view of this, and because of the central importance of the date of filing and/or priority for the valid claiming of priority, Rule 85b(1) EPC lays down a time limit specifically for such cases, where there is an urgent need for clarity. Any request for re-establishment of rights in respect of the priority period must be filed within two months of the expiry of that period (see also Article 13(2) and Rule 14(4) PLT).

Paragraph 2 incorporates the provisions of Article 122(2) and (3) EPC 1973 concerning the statement of grounds and facts and the completion of the omitted act.

Paragraph 3, based on Article 122(4), second sentence, EPC 2000, rules out the re-establishment of rights in respect of any periods for which further processing is available. Under the new system, either further processing or re-establishment of rights may be requested if a specific time limit has been missed. During the grant procedure only further processing will normally be available - re-establishment of rights thus only comes into play where further processing is excluded with regard to a specific period (see, in particular, Rule 85a(2)). The limitation of the possibility of re-establishment of rights during the grant procedure will, however, be offset to some extent by the fact that re-establishment of rights with regard to the period for further processing will continue to be possible.

Paragraph 4 incorporates Article 122(4) EPC 1973 regarding competence for decisions on requests for re-establishment of rights.

## **Chapter VI**

RULES 86-89 EPC

### **Rule 87 EPC** - Different claims, description and drawings for different States

The amendment takes account of the revised Article 54 EPC 2000.

## **Chapter VII**

NEW RULE 89a EPC

### **New Rule 89a EPC** - Information on prior art (Preparatory document: MR/2/00, pages 167-168)

The new Chapter VII, headed "Information on prior art" contains the new Rule 89a, which takes account of Article 124(1) EPC 2000 and specifies the types of information on prior art which the EPO may require from the applicant - ie information on prior art relied upon in national or regional proceedings concerning similar applications in respect of an invention to which the European patent application relates.

## **Chapters VIII-IX**

RULES 90-99 EPC

Editorial amendments have been made to Rules 90-99 EPC.

### **Rule 91 EPC** - Waiving of enforced recovery procedures

is deleted, and its substance transferred to the Rules relating to Fees.

### **Rule 92 EPC** - Entries in the European Patent Register

Paragraph 3 is deleted, as there is no need for a legal basis in the EPC itself for a simple administrative procedure in which no change is envisaged.

**Rule 96 EPC** - Additional publications by the European Patent Office  
(Preparatory document: MR/2/00, pages 173-176)

is deleted. The substance of sub-paragraphs (a) to (e) of Article 128(5) EPC 1973 is incorporated in Rule 17(3).

**Chapter X**

**RULES 100-102 EPC**

Rules 100 to 102 have been streamlined and their wording aligned with the style of the EPC 2000.

**Rule 101 EPC** - Authorisations

Paragraph 1 as presently drafted is somewhat misleading, in that the first sentence implies that in principle, unless requested to do so, representatives need not file a signed authorisation, when in fact, in the cases set down by the President, representatives are to file an authorisation and will receive an invitation should they fail to do so. For the sake of clarity, Rule 101(1) EPC has therefore been redrafted and subdivided into new paragraphs 1 to 3.

**New Rule 101a EPC** - Attorney evidentiary privilege  
(Preparatory document: MR/2/00, pages 189-192)

The new Article 134a(1)(d) EPC 2000 bestows competence on the Administrative Council to adopt provisions governing the obligation of confidentiality of professional representatives and the privilege from disclosure in proceedings before the European Patent Office in respect of communications between a professional representative and his client or any other person.

The obligation of confidentiality binding professional representatives is provided for by Article 2 of the Regulation on discipline for professional representatives. As some legal systems distinguish between this obligation of confidentiality and an evidentiary privilege protecting the confidentiality of attorney-client communications, it is opportune to include a

new Rule, entrenching such an evidentiary privilege for communications between professional representatives and their clients which are subject to the representative's professional obligation of confidentiality. Rule 101a(1) EPC draws its language from the definition of the evidentiary privilege in US law as cited from Wigmore's *Evidence* in the *Bristol-Myers Squibb v. Rhone Poulenc Rorer* case (Southern District of New York, 19 April 1999).

It is clear that the word "client" in new Rule 101a(1) EPC encompasses any person for whom the representative may be acting, whether an individual or a corporation, the representative's employer, the associated or subsidiary company of the employer, etc.

The reference to Article 2 of the Regulation on discipline has been added to align the provision more closely with the US requirement that such communications should be of a confidential nature. This was implicit in the original draft, but the new wording makes clear that only such communications subject to the representatives' obligation of secrecy are covered by the evidentiary privilege.

Article 2 of the Regulation on discipline reads:

"Professional secrecy

A professional representative shall be bound not to disclose information accepted by him in confidence in the exercise of his duties, unless he is released from this obligation."

**Rule 102 EPC** - Amendment of the list of professional representatives

(Preparatory document: MR/2/00, pages 183-188 and 239-244)

Article 163 EPC 1973 dealt with the conditions under which national representatives in a state having newly acceded to the EPC could be entered on the list of professional representatives during a transitional period. With the expiry of the initial transitional period, Article 163 had lost its relevance and was therefore deleted.

However, the substance of the "grandfather clause" in Article 163 EPC 1973 was inserted into Article 134 EPC 2000 as a permanent feature, in order to deal with the integration of

national representatives of countries acceding to the Convention in the future.

Rule 102 EPC has therefore been amended to eliminate references to the initial transitional period. The wording of paragraph 3 is expanded to make it clear that professional representatives entered on the list under the grandfather clause and subsequently deleted are entitled to re-enter the list without being required to pass the European qualifying examination.

## **PART VIII**

### **IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION**

#### **RULES 102a-103 EPC**

**New Rule 102a EPC** - Filing and transmission of the request for conversion  
(Preparatory document: MR/2/00, pages 193-198)

The following elements have been deleted from Articles 135 and 136 EPC 1973 and transferred to Rule 102a EPC:

- period for filing the request for conversion;
- lapse of the effect of the European patent application under Article 66 EPC if the request for conversion is not submitted in due time;
- obligation on the national Office or the EPO to attach to the request for conversion a copy of the European patent application or the European patent;
- time limit for transmitting the request for conversion.

Despite the reference to Article 66 EPC in Article 135(4) EPC 2000, the same reference is also necessary in Rule 102a(1), second sentence, since the effect referred to in Article 66 EPC can lapse not only in the case of failure to transmit the request for conversion (Article 135(4) EPC 2000), but also if the request is not submitted in due time.

**Rule 103 EPC** - Information to the public in the event of conversion

The amendments take account of the deletion of Article 136 EPC 1973, the substance of



which is reflected partly in Article 135 EPC 2000 and partly in the new Rule 102a(2) and (3) EPC.

## **PART IX**

### **IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION**

#### **Rules 104-112 EPC**

(Preparatory document: MR/2/00, pages 207-230)

The details of procedure deleted from Articles 150-157 EPC 1973 have been transferred, where necessary, to the Implementing Regulations. The wording of Rules 104-112 EPC has been streamlined and brought into line with the EPC 2000.

#### **Rule 104 EPC - The European Patent Office as a receiving Office**

The amendments result from the consolidation of Articles 151 und 152 EPC 1973 in Article 151 EPC 2000. Some details omitted from the latter have also been transferred to the Implementing Regulations. The new version of Rule 104(1) incorporates the conditions - deleted from Article 151 EPC 2000 - under which the EPO acts as receiving Office. The second sentence sets out the principle, originally enshrined in Article 152(1) EPC 1973, that an international application must be filed directly with the EPO if the latter has been chosen as a receiving Office. The exception already provided for in Article 151 EPC 2000 (Article 75(2) EPC nevertheless applies *mutatis mutandis*) is reiterated here for the sake of clarity.

The first sentence of the present Rule 104(1) is transferred to paragraph 2. The second and third sentences are deleted, since the filing of applications in three copies will soon become unnecessary, as in the case of Euro-direct applications.

The new version of Rule 104(2), first sentence, is taken from the existing paragraph 1. The second sentence introduces a precautionary provision authorising the President to decide the further details of the scope and nature of the application documents.

The existing version of Rule 104(2) is redundant in view of the deletion of the second and

third sentences from paragraph 1.

Rule 14 PCT already authorises the receiving Office to require payment of a remittal fee. The new paragraph 4 merely re-states this for the sake of clarity.

**Rule 105 EPC** - The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

The two-tiered review system for the PCT protest procedure under Article 154(3) and 155(3) EPC 1973 in conjunction with Rule 105 EPC is no longer provided for under Article 152 EPC 2000. As was already pointed out in the explanatory remarks on Article 152 EPC 2000, Rule 105(3) now provides for a simplified protest procedure in accordance with Rules 40.2(c)-(e) and 68.3(c)-(e) PCT which continues to guarantee legal certainty. It also establishes the legal basis for settling further details by decision of the President of the EPO, who will have to decide on the composition of the review panel in full compliance with Rules 40.2(d) and 68.3(d) PCT.

**Rule 106 EPC** - The national fee

is deleted, as it is no longer necessary, since Article 158(2) EPC 1973 as well as Article 54(4) EPC 1973 and Rule 23a have been deleted. The filing fee (i.e. the equivalent of the national fee under Articles 22 and 39 PCT) and the designation fees are clearly referred to in Rule 107. That is sufficient.

**Rule 107 EPC** - The European Patent Office as a designated or elected Office - Requirements for entry into the European phase

The amendments are purely editorial. The deletion in paragraph 1(e) of the reference to Article 157(2)(b) takes account of the deletion of the relevant fee provision from Article 153 EPC 2000. All fees falling due on entry into the European phase, together with the provisions on the legal consequences of non-payment, have now been transferred to the Implementing Regulations (see also Rules 108 and 110) EPC.

Article 153(2) EPC 1973 governing competence for review under Article 25 PCT is transferred to the new paragraph 3 of Rule 107.

**Rule 108 EPC** - Consequences of non-fulfilment of certain requirements

In the new version of paragraph 3, the third sentence is deleted, in view of the legal remedy established by Article 121 EPC 2000 and concretised in the new Rule 85a EPC.

**Rules 109-112 EPC** - Amendment of the application; Claims incurring fees; Examination of certain formal requirements by the European Patent Office; Consideration of unity by the European Patent Office

Amendments are purely editorial or consequential to other amendments made elsewhere.