

Implementing Regulations to the EPC 2000

Objectives

1. Adaption of IR to EPC 2000:
 - Provisions transferred
from Convention to IR
 - Provisions for **new procedures**
(limitation, petition for review)
2. Adaption to **PLT 2000**
3. **Editorial** improvements

No amendment to existing procedures unless required by EPC 2000 or PLT

No implementation of new ideas

Entry into force

When EPC 2000 enters into force

Future amendments to present IR to be incorporated in IR 2000 before its entry into force

Renumbering as a last step before entry into force

CA/PPL 5/02 rev. 2

Structure of IR 2000

Parts of IR related to
parts of the
Convention

Main points of modernisation

1. Rules on filing of patent applications adapted to PLT
2. Chapter on biotechnological inventions
3. Examination and opposition procedure: provisions transferred from Convention to IR
4. Limitation procedure
5. Appeal procedure: provisions transferred from Convention to IR

6. Petition for review
7. Common provisions governing procedure: provisions transferred from Convention to IR
8. New concept for further processing and re-establishment of rights
9. Attorney-client-privilege
10. PCT rules: provisions transferred from Convention to IR, re-structured, boards of appeal no longer responsible for protests

Overview on **new features of IR 2000**

- Limitation
- Petition for review
- Further processing and re-establishment of rights
- Attorney-client-privilege

Overview on **new rules on filing**

Limitation procedure

Article 105a(1) EPC 2000

At the request of the proprietor, the European patent may be revoked or be **limited by an amendment of the claims.**

Rule 63b EPC 2000

Subject of limitation proceedings

The subject of limitation or revocation proceedings under Article 105a shall be the European patent as **granted** or as **amended in opposition or limitation** proceedings before the European Patent Office.

Rule 63c EPC 2000

Competence of the Examining Division

Decisions on requests for limitation or revocation of the European patent under Article 105a shall be taken by the Examining Division. Article 18, paragraph 2, shall apply *mutatis mutandis*.

Article 105a(2) EPC 2000

Request for limitation or revocation

The request may not be filed while opposition proceedings in respect of the European patent are pending.

Rule 63e(1) EPC 2000

Precedence of opposition proceedings

(1) The request for limitation or revocation shall be deemed not to have been filed if opposition proceedings in respect of the patent are **pending at the time of filing the request.**

Rule 63e(2) EPC 2000

(2) If, at the time of filing an opposition to a European patent, **limitation** proceedings in respect of that patent are **pending**, the Examining Division shall terminate the limitation proceedings and order the reimbursement of the limitation fee.

Rule 63d(2) EPC 2000

Requirements of the request

The request shall contain:

(a) particulars of the **proprietor of the European patent** making the request (the requester) as provided in Rule 26, paragraph 2(c), and an indication of the Contracting States for which the requester is the proprietor of the patent;

(b) the **number of the patent** whose limitation or revocation is requested, and a list of the Contracting States in which the patent has taken effect;

(c) where appropriate, the names and addresses of the **proprietors of the patent for those Contracting States in which the requester is not the proprietor** of the patent, and evidence that the requester is entitled to act on their behalf in the proceedings;

(d) where limitation of the patent is requested, the complete **text of the amended claims** and, as the case may be, of the description and drawings as amended;

(e) where the requester has appointed a representative, particulars as provided in Rule 26, paragraph 2(d).

Rejection as inadmissible if these requirements are not fulfilled (Rule 67f EPC 2000).

Rule 63g(1) EPC 2000

Decision on the request for revocation

If a request for revocation is admissible, the Examining Division shall revoke the patent and communicate this to the requester.

Rule 63g(2) EPC 2000

Decision on the request for limitation

If a request for limitation is admissible, the Examining Division shall examine whether the amended claims constitute a limitation vis-à-vis the claims as granted

or amended in opposition or limitation proceedings and comply with Article 84 and Article 123, paragraphs 2 and 3.

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

Rule 63g(3) EPC 2000

Fees, translation of claims, grace period after communication informing on failure to observe time limit

Rule 63g(4) EPC 2000

If the requester does not respond in due time to the communication issued under paragraph 2, or if the request for limitation is not allowable, or if the requester fails to perform the acts required under paragraph 3 in due time, the Examining Division shall reject the request.

Petition for review

- Possibility to correct serious deficiencies
- Preservation of legal certainty

- Exhaustive list of grounds on which petition for review may be filed
- Rather strict procedural requirements for admissibility
- Preliminary examination in ex parte proceedings

- Extraordinary legal remedy
- Re-opening of appeal proceedings
- No decision on the merits by the EBA itself but re-opening of appeal proceedings

Article 112a(2) EPC 2000

Petition for review by the Enlarged Board of Appeal

The petition may only be filed on the grounds that:

(a) a member of the Board of Appeal took part in the decision in breach of Article 24, paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4;

(b) the Board of Appeal included a person not appointed as a member of the Boards of Appeal;

(c) a fundamental violation of Article 113 occurred;

(d) any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or

(e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.

Rule 67a EPC 2000

Further fundamental procedural defects

A fundamental procedural defect under Article 112a, paragraph 2(d), may have occurred where the Board of Appeal,

(a) contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or

(b) decided on the appeal without deciding on a request relevant to that decision.

Rule 67b EPC 2000

Criminal acts

A petition for review may be based on Article 112a, paragraph 2(e), if a competent court or authority has finally established that the criminal act occurred; a conviction is not necessary.

Rule 67c EPC 2000

Obligation to raise objections

A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

Article 112a(4) EPC 2000

The petition for review shall be filed in a **reasoned** statement, in accordance with the Implementing Regulations. If based on paragraph 2(a) to (d), the petition shall be filed within two months of notification of the decision of the Board of Appeal.

If based on paragraph 2(e), the petition shall be filed within two months of the date on which the criminal act has been established and in any event not later than five years from notification of the decision of the Board of Appeal. The petition shall not be deemed to have been filed until after the prescribed fee has been paid.

Rule 67d EPC 2000

Contents of the petition for review

(1) The petition shall contain:

(a) particulars of the **petitioner** as provided in Rule 26, paragraph 2(c);

(b) an indication of the **decision to be reviewed**.

(2) The petition shall indicate the **reasons for setting aside** the decision of the Board of Appeal and the **facts and evidence** on which the petition is based.

Rule 67f(2) EPC 2000

Procedure in dealing with petitions for review

The Enlarged Board of Appeal

(a) consisting of two legally qualified members and one technically qualified member shall examine all petitions for review and shall reject those which are clearly inadmissible or unallowable; such decision shall require unanimity;

(b) consisting of four legally qualified members and one technically qualified member shall decide on any petition not rejected under sub-paragraph (a).

Rule 67f(3) EPC 2000

The Enlarged Board of Appeal as composed according to paragraph 2(a) shall decide without the **involvement of other parties** and **on the basis of the petition as filed.**

Rule 67g EPC 2000

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 re-opened, unless such reimbursement is inequitable.

Further processing and re-establishment of rights

Further processing: normal remedy

- within two months of the communication informing on the failure to observe time limit or the loss of a right: payment of fee for further processing and completion of omitted act

Re-establishment: exception

- additionally it must be shown that all due care required by the circumstances has been taken

Re-establishment ruled out

1. Where further processing is possible (Rule 85b(3) EPC 2000)

However: re-establishment is possible in the time limit for requesting further processing

2. In respect of the period for requesting re-establishment of rights

(Article 122(4), first sentence, EPC 2000, Rule 85b(3) EPC 2000)

Further processing ruled out

Under Article 121 EPC 2000:

- Priority year (Article 87(1))
- Time limits for appeal and petitions for review
- Time limit for further processing
- Time limit for re-establishment

Further processing ruled out

Under Rule 85a(2) EPC 2000

- Rule 6(1) translation of a patent application not filed in an official EPO language
- Rule 14a(1)(a) remedies under Article 61 EPC of the person truly entitled to file the European application

- Rule 25d(3) reference filing:
copy/translation of previously filed
application
- Rule 37(2) grace period for renewal fee
- Rule 38(2) time limit for priority declaration
- Rule 39 time limit to remedy deficiencies
according to which the application cannot
be dealt with as a European patent
application

- Rule 39a later filing of missing parts of description or drawings
- Rule 41 invitation to correct deficiencies of an application which has been accorded a filing date
- Rule 41a invitation to correct deficiencies in respect of priority claiming
- Rule 69(2) appealable decision on loss of rights

Attorney-client-privilege

Article 134a(1)(d) EPC 2000

Institute of Professional Representatives before the European Patent Office

The Administrative Council shall be competent to adopt
and amend provisions governing

...

- (d) the obligation of confidentiality on the professional representative 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.

Rule 101a(1) EPC 2000

Attorney evidentiary privilege

Where advice is sought from a professional representative in his capacity as such, all **communications between the professional representative and his client** or any other person, relating to that purpose

and falling under Article 2 of the Regulation on discipline for professional representatives, are **permanently privileged from disclosure in proceedings before the European Patent Office**, unless such privilege is expressly waived by the client.

Rule 101a(2) EPC 2000

Such privilege from disclosure shall apply, in particular, to any communication or document relating to:

(a) the assessment of the patentability of an invention;

(b) the preparation or prosecution of a European patent application;

(c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application.

Article 2 of the Regulation on Discipline

„Professional secrecy

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

Filing of a European patent application

Rule 25d(1) EPC 2000

The date of filing of a European patent application shall be the date on which the documents filed by the applicant contain:

- (a) an indication that a European patent is sought;**

- (b) information identifying the applicant or allowing the applicant to be contacted;**
and

- (c) a description or reference to a previously filed application.**

Rule 25d(2) EPC 2000

A **reference** to a previously filed application under paragraph 1(c) shall state the **filing date** and **number** of that application and the **Office** with which it was filed. Such reference shall indicate that it replaces the description and any drawings.

Rule 25d(3) EPC 2000

Where the application contains a reference under paragraph 2, a copy of the **previously filed application** shall be filed **within two months** of filing the application. Where the previously filed application is not in an official language of the European Patent Office, a **translation** thereof in one of these languages shall be filed within the same period. Rule 38a, paragraph 2, shall apply *mutatis mutandis*.

Article 90(1) EPC 2000

Examination on filing and examination as to formal requirements

(1) The European Patent Office shall examine, in accordance with the Implementing Regulations, whether the application satisfies the requirements for the accordancy of a date of filing.

Rule 39 EPC 2000

Examination on filing

If the examination under Article 90, paragraph 1, reveals that the application fails to meet the requirements laid down in Rule 25d, paragraph 1(a) or (c), paragraph 2 or paragraph 3, first sentence, the

European Patent Office shall inform the applicant of any deficiencies and advise him that the application will not be dealt with as a European patent application unless such deficiencies are remedied within two months. If the applicant does this, he shall be informed of the date of filing accorded by the Office.

Rule 39a(1) EPC 2000

Missing parts of the description or missing drawings

If the examination under Article 90, paragraph 1, reveals that parts of the description, or of drawings referred to in the description or in the claims, appear to be missing, the European Patent Office

shall invite the applicant to file the missing parts within two months. The applicant may not invoke the omission of such a communication.

Rule 39a(2) EPC 2000

If missing parts of the description or missing drawings are filed later than the date of filing, but within two months of the date of filing or of a communication under paragraph 1, the application shall be re-dated to the date on which those parts were filed, unless the missing parts of the description or missing drawings are withdrawn within one month of their filing.

Rule 39a(3) EPC 2000

If the missing parts of the description or missing drawings are filed within the period under paragraph 2, and the application claims priority of an earlier application, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 25d, paragraph 1, were fulfilled,

where the applicant so requests and files a copy of the previous application and, where the previous application is not in an official language of the European Patent Office, a translation thereof in one of these languages, within the period under paragraph 2. Rule 38a, paragraph 2, shall apply *mutatis mutandis*.

Rule 39a(4) and (5) EPC 2000

(4) If the applicant fails to file the missing parts of the description or missing drawings in due time, any references to those parts of the description or drawings shall be deemed to be deleted.

(5) The applicant shall be informed of any new date of filing of the application.

Claiming of priority

Rule 38(1) EPC 2000

The **declaration of priority** referred to in Article 88, paragraph 1, shall indicate the **date** of the previous filing, the **State or Member of the World Trade Organization** in or for which it was made and [...] the **file number**.

Rule 38(2) EPC 2000

The declaration of priority shall **preferably be made on filing the European patent application**. It may **still be made or corrected within sixteen months from the earliest priority date** claimed. However, a declaration of priority may not be made or corrected after a request under Article 93, paragraph 1(b), has been filed.

Rule 38(3) EPC 2000

The particulars of the declaration of priority shall appear in the published European patent application and the European patent specification.

Rule 41a EPC 2000

Deficiencies in claiming priority

If the file number of the previous application under Rule 38, paragraph 1, or the copy of that application under Rule 38a, paragraph 1, have not been filed in due time, the European Patent Office shall inform the applicant accordingly and invite him to file them within a period to be specified.