



**Ausschuss für Europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen**

European Patent Office
SACEPO Sekretariat
D – 80298 München

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**10th meeting of the SACEPO Working Party on Rules
epi proposals for amendments to EPC Implementing Regulations**

Dear Sirs,

The European Patent Practice Committee (EPPC) is the largest committee of the **epi**, but it also has the broadest remit: it considers and discusses all questions pertaining to, or connected with, practice under (1) the EPC, (2) the PCT, and (3) “the future EU Patent Regulation”, including any revision thereof, except all questions in the fields of other committees: Biotech, OCC, PDC, LitCom, and EPO Finances.

The EPPC is presently organised with seven permanent sub-committees (EPC, Guidelines, MSBA, EPO–**epi** Liaison, PCT, Trilateral & IP5, and Unitary Patent). Additionally, ad hoc working groups are set up when the need arises; in particular, thematic groups have been created in the fields of CII (computer-implemented inventions) and PAOC (pure and applied chemistry).

The EPC subcommittee closely follows all developments in the framework of the EPC and has further elaborated the following list of suggestions for future amendments to the Implementing Regulations which had first been submitted as non-paper SACEPO/WPR 6/10 for the 4th meeting of the SACEPO Working Party on Rules on 08 December 2010:

1. Rule 62a – Applications containing a plurality of independent claims

1.1. The present wording of Rule 62a provides:

- (1) *If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search shall be carried out on the basis of the first claim in each category.*

- 1.2. Only the first claim in each category is searched. This is problematic for many non- EP originating applications.
- 1.3. It is proposed to allow further search fees to be paid for further claims in the same category.

2. Rule 78(1) – Procedure where the proprietor of the patent is not entitled

- 2.1. The present wording of Rule 78 provides:

(1) If a third party provides evidence, during opposition proceedings or during the opposition period, that he has instituted proceedings against the proprietor of the European patent, seeking a decision within the meaning of Article 61, paragraph 1, opposition proceedings shall be stayed unless the third party communicates to the European Patent Office in writing his consent to the continuation of such proceedings. Such consent shall be irrevocable. However, proceedings shall not be stayed until the Opposition Division has deemed the opposition admissible. Rule 14, paragraphs 2 to 4, shall apply mutatis mutandis.

- 2.2. Opposition proceedings are stayed when entitlement proceedings are pending. However, for limitation proceedings no such stay is foreseen.
- 2.3. The legitimate third party's interests in obtaining entitlement to a not unnecessarily limited European patent are thus subordinated to procedural efficiency.
- 2.4. In order to overcome this drawback, the concept of Rule 78(1) could be extended to also include limitation proceedings. The occurrence of entitlement proceedings during limitation proceedings is considered exceptional, so that in these rare cases the legitimate expectation of the third party could prevail over the procedural efficiency.

3. Rule 85 – Transfer of the European patent

- 3.1. The present wording of Rule 85 provides:

Rule 22 shall apply to any transfer of the European patent made during the opposition period or during opposition proceedings.

- 3.2. The Registration of a transfer of a granted European patent before the EPO is therefore limited to the opposition period or opposition proceedings. However, limitation proceedings can be initiated at any time after grant.
- 3.3. This is an issue for all European patents which are transferred after grant, and, in particular, those EP patents which are transferred after the opposition period has expired or opposition proceedings have been terminated.
- 3.4. In order to overcome this drawback of Rule 85 the possibility to register a transfer could be extended to any time after grant, however, with a direct effect limited to the EPO register. Based on EPO Form 2544, the patent proprietor could then have the national registers updated.

- 3.5. It is proposed to amend the wording of Rule 85 e.g. as follows:

*Rule 22 shall apply to any transfer of the European patent made **after grant** during the ~~opposition period or during opposition proceedings~~.*

Alternatively it may be envisaged to introduce a corresponding provision in the framework of Rules 90 to 96 EPC, which deal with limitation proceedings.

- 3.6. A third, and perhaps more straightforward alternative might be to extend the scope of Rule 22 to also cover European patents at any time after grant:

Rule 22 – Registration of transfers

*(1) The transfer of a European patent application **or European patent** shall be recorded in the European Patent Register at the request of an interested party, upon production of documents providing evidence of such transfer.*

- 3.7. In the context of the unitary patent and the UPC, such an amendment makes sense. This would be a very cost-effective procedure, in particular if it required those countries that are UPC to give automatic effect to such a recordal.

This would largely remove from the political sphere the question of whether recordal fees are payable under the unitary patent regime as the fees would be paid under the EPC, not the Regulation.

Non-UPC countries could continue to require national formalities for such transfer if they wish.

4. Rule 134(1) – Extension of “periods”

- 4.1. The present wording of Rule 134 provides:

(1) If a period expires on a day on which one of the filing offices of the European Patent Office under Rule 35, paragraph 1, is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, mail is not delivered there, the period shall extend to the first day thereafter on which all the filing offices are open for receipt of documents and on which mail is delivered. The first sentence shall apply mutatis mutandis if documents filed by one of the technical means of communication permitted by the President of the European Patent Office under Rule 2, paragraph 1, cannot be received.

- 4.2. Although not explicitly mentioned, J4/91 considers that the extension of “due dates”, in analogy with “time limits” (= period) is allowable (Reasons 3.2):

3.2 In the present case it is sufficient to examine whether the Legal Advice [5/80; note from the author], as it mentions in passing, does indeed apply to the additional period under Article 86(2) EPC [1973; note from the author]. In this case the period does not begin with the expiry of an earlier period, as it does in the above-mentioned Rules; it is a “period of grace” (“Schonfrist” - “délai de grâce”) which runs from the due date of Rule 37(1) EPC [1973]. If this due date

falls on a Saturday or Sunday, a payment actually received on the following working day is not subject to an additional fee. According to the generally held and correct interpretation, Rule 85(1) EPC [1973; now Rule 134(1) EPC 2000] applies here mutatis mutandis, even though, if interpreted strictly in line with its wording, it does not fit the circumstances of this case: a "due date" is not a "time limit" which can be "extended". As mentioned above, Rule 85 EPC [1973] is applicable to payments actually made in circumstances involving weekends/public holidays, postal strikes or dislocation of the proper functioning of the EPO, but this does not mean that the due date is "postponed". Rule 85 EPC [1973] is concerned with situations in which the EPO is prevented from receiving documents or payments, as a result of the Office being closed at weekends or on public holidays (paragraph 1), of general interruption in the delivery of mail (paragraph 2), or of dislocation of the proper functioning of the EPO (paragraph 4). Although Rule 85 EPC [1973] does say that "a time limit shall extend ..." in such circumstances, some qualification is necessary. A further, essential, precondition for this Rule to apply at all must be that an attempt at payment or filing is actually made around the time of the dislocation. A postal strike only has to be considered for it to become clear that the start of the additional period under Article 86(2) EPC [1973] is not affected by such an eventuality.

When calculating the six-month period under Article 86(2) EPC [1973], therefore, it is irrelevant whether or not the circumstances described in Rule 85 EPC [1973] occurred. It would scarcely make sense to apply Rule 85 EPC [1973] to the beginning of the additional period, although it can be applied - even on a literal construction - at the expiry of the six-month period, because a time limit expires which, in accordance with this Rule, is then "extended".

- 4.3. The practical extension of "due dates" has not been taken into consideration since.
- 4.4. It is proposed to also include "due dates" for fees into the Rule.
- 4.5. At the same time, it might be appropriate to also address the mixed terminology throughout the EPC, where "time limits" and "period" are mixed.

5. Rule 143 EPC – Entries in the European Patent Register

- 5.1. The present wording of Rule 143 EPC provides:
 - (1) *The European Patent Register shall contain the following entries: [...]*
 - (2) *The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the European Patent Register.*
- 5.2. The decision on a request for correction of an EPO decision appears in the European Patent Register. However, the request itself which occasioned that decision is not mentioned.
- 5.3. It is proposed to also include the request for correction in the European Patent Register, e.g. pursuant to a decision by the President under Rule 143(2) EPC.

6. Rule 51 (1) and (2) EPC – Payment of renewal fees

6.1. The present wording of Rule 51(1) EPC provides:

(1) A renewal fee for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than three months before they fall due.

6.2. The limitation of the window for payment to 3 months in advance of the due date does not enable paying the renewal fee at the same time as completing the other acts when entering the national phase.

6.3. It is proposed to either increase the pre-payment window to 6 months, or to allow for a specific exception when entering the national phase.

6.4. The present wording of Rule 51(2) EPC provides:

(2) If a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period.

6.5. Rule 51(2) EPC indicates that a renewal fee not paid in due time may still be paid within six months of the due date, however, by derogation from Rule 131(4) EPC, the window for payment is actually extended to the last day of the sixth month.

6.6. It is proposed to adapt the wording to reflect J4/91: a period running from the last day of the month under Rule 51(1) EPC runs to the last day of the 6th month following, by derogation from Rule 131(4) EPC.

7. Rule 43(2) EPC – Form and content of claims

7.1. The present wording of Rule 43(2) EPC provides:

(2) Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

(a) a plurality of interrelated products,

(b) different uses of a product or apparatus,

(c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

7.2. The present concept in Rule 43(2) EPC of a plurality of interrelated categories does not refer to „methods“.

7.3. It is therefore proposed to extend the concept of interrelated categories to also comprise methods.

8. Rule 4(6)

8.1. The present wording of Rule 4(6) EPC provides:

(6) *Statements by employees of the European Patent Office, parties, witnesses or experts, made in an official language of the European Patent Office, shall be entered in the minutes in that language. [...]*

8.2. In practice, the EPO applies this "where the exact wording is important (if requested)".

8.3. It is therefore suggested to amend 'shall' to 'may':

(6) *Statements by employees of the European Patent Office, parties, witnesses or experts, made in an official language of the European Patent Office, may shall be entered in the minutes in that language. [...]*

9. Rule 73 – Content and form of the specification

9.1. The present wording of Rule 4(6) EPC provides:

(1) *The specification of the European patent shall include the description, the claims and any drawings. It shall also indicate the period for opposing the European patent.*

(2) *The President of the European Patent Office shall determine the form of the publication of the specification and the data to be included.*

9.2. An error in the translated claims in the B1 publication might have an influence on the level of damages awarded. This may be relevant for national litigation based on the German, English or French version of the claims translation as published with the specification.

9.3. It is proposed to allow for a republication of the B1 specification with the corrected translation of the claims upon request, provided that a fee for republication is paid.

It would be appreciated if these suggestions could be considered, not necessarily all at the same time, in one of the next meetings of the SACEPO Working Party on Rules.

Best regards,

Sigmar Lampe
EPPC Vice Chair in charge of the EPC subcommittee