

## ***Implementing Regulations to the Convention for the European patent for the common market***

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IMPLEMENTING REGULATIONS

TO THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON

MARKET

### **PART I. IMPLEMENTING REGULATIONS TO PART I OF THE CONVENTION** ➡

#### **CHAPTER I. ORGANIZATION OF THE SPECIAL DEPARTMENTS** ➡

##### **Rule 1**

Allocation of duties to the departments of the first

instance

1. The President of the European Patent Office shall determine the number of Revocation Divisions. He shall allocate duties to these departments by reference to the international classification.

2. The President of the European Patent Office shall, with the agreement of the Select

Committee of the Administrative Council, determine in detail the duties for which the Patent Administration Division is responsible pursuant to Article 7.

3. In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Patent Administration Division and the Revocation Divisions.

4. The President of the European Patent Office may entrust to employees who are not technically or legally qualified members the execution of individual duties falling to the Patent Administration Division or the Revocation Divisions, and involving no technical or legal difficulties.

## **Rule 2**

Administrative structure of the special departments

1. The Revocation Divisions may be grouped together administratively with the Examining Divisions and

Opposition Divisions so as to form directorates, or may form a directorate together with the Patent Administration Division.

2. The special departments may be grouped together administratively with other departments of the European Patent Office so as to form Directorates-General or may form a separate Directorate-General; in the latter case, Rule 12 (3) of the Implementing Regulations to the European Patent Convention shall apply, but the appointment of a vice-president to the Directorate-General shall be decided upon by the Select Committee of the Administrative Council.

## ***CHAPTER II. LANGUAGES OF THE SPECIAL DEPARTMENTS ➡***

### **Rule 3**

Language of the proceedings

1. Rules 1 to 3, 5, 6 (2) and 7 of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to proceedings before the special departments.

2. A reduction in the limitation fee, revocation fee or appeal fee shall be allowed the proprietor of a patent or an applicant for revocation who avails himself of the options provided for in Article 10 (4). The reduction shall be fixed in the Rules relating to Fees at a percentage of the total of the fees.

## **PART II. IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION ➡**

### **Rule 4**

Suspension of proceedings

Rule 13 of the Implementing Regulations to the European Patent Convention shall apply

mutatis mutandis to limitation proceedings and revocation proceedings.

### **Rule 5**

Entries regarding claims to the right to Community

patents

The entries referred to in Article 23 (4) shall be made:

- a. at the request of the registrar of the court before which the proceedings are instituted;
- b. at the request of the claimant or any other interested person.

### **Rule 6**

Filing of translations and payment of fees in examination or

opposition proceedings

1. When sending the invitation referred to in Rule 51 (6) of the Implementing Regulations to the European Patent Convention, the European Patent Office shall also invite the applicant for the patent to file, within the period set by it, the translations prescribed in Article 29 (1) and to pay, within the same period, the fee for the publication of the translations of the claims.

2. When sending the invitation referred to in Rule 58 (5) of the Implementing Regulations to the European Patent Convention, the European Patent Office shall also invite the proprietor of the patent to file, within the period referred to in the said paragraph, the translations prescribed in Article 29 (2) and to pay the fee for the publication of the translations of the claims.

3. The period for filing the translations prescribed in Article 30 (1) and (2) shall be three months from the date of publication in the Community Patent Bulletin of the mention of the grant of the Community patent or, as the case may be, of the decision on the maintenance of the Community patent in amended form.

4. If the acts required by paragraph 2 are not performed in due time they may still be validly performed within two months of notification of the communication pointing out the failure to observe the time limit, provided that within this two-month period an additional fee in accordance with the Rules relating to Fees is paid.

### **Rule 7**

Forwarding of translations

The European Patent Office shall enter in the Register of Community Patents the date on which the translations prescribed in Article 30 are filed. Copies of the translations shall be forwarded to the central industrial property offices

of the Contracting States concerned by post within the

three days following the expiry of the period laid down in Rule 6 (3).

### **Rule 8**

Revision of the translation

The corrected translation provided for in Article 29 (6) shall not have any legal effect until the fee for its publication has been paid.

### **Rule 9**

Registering transfers, licences and other rights

1. Rules 20 to 22 of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to entries made in the Register of Community Patents.

2. The request provided for in Article 24 (2) must, in the case of subparagraph (a), be made within two months, or in the case of subparagraph (b), within four months, of receipt of notification from the European Patent Office that the name of a new proprietor has been entered in the Register of Community Patents.

3. Where a Community patent is involved in bankruptcy or like proceedings, an entry to this effect shall be made in the Register of Community Patents on request of the competent national authority. The entry shall not incur a fee.

4. The entry referred to in paragraph 3 shall be deleted at the request of the competent national authority. The request shall not incur a fee.

5. Where a European patent application in which the Contracting States are designated is involved in bankruptcy or like proceedings, paragraphs 3 and 4 shall apply mutatis mutandis but the reference to the Register of Community Patents shall be understood as being a reference to the Register of European Patents provided for in the European Patent Convention.

### **Rule 10**

Licences of right

1. Any person who wishes to use the invention after a statement provided for in Article 43 (1) has been filed, shall declare his intention to the proprietor of the patent by registered letter. The declaration shall be deemed to have been made one week after posting of the registered letter. A copy of this declaration, stating the date upon which the declaration was posted, shall be sent to the European Patent Office. Failing this, the European Patent Office shall, in the event of withdrawal of the statement, consider the declaration not to have been made.

2. The declaration shall state how the invention is to be used. After the declaration has been made, the person making it shall be entitled to use the invention in the way he has stated.

3. The licensee shall be obliged at the end of every quarter of a calendar year to report to the proprietor of the patent on the use made thereof and to pay the compensation therefor. If this obligation is not complied with, the proprietor of the patent may lay down a further

suitable time limit for this purpose. If the time limit is not complied with the licence shall expire.

4. A request for review of the compensation determined by the Revocation Division may be made only after the expiry of one year from the last determination of compensation.

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

### **CHAPTER I. RENEWAL FEES** ➔

#### **Rule 11**

Payment of renewal fees

1. Rule 37 (1) and (2) of the Implementing Regulations to the European Patent Convention shall apply to the payment of renewal fees for Community patents.

2. An additional fee shall be deemed to have been paid at the same time as the renewal fee within the meaning of Article 48 (2) if it is paid within the period laid down in that provision.

#### **Rule 12**

Period for the entry of surrender

The period referred to in Article 49 (3) shall be three months from the date on which the proprietor of the patent has proved to the European Patent Office that he has informed the licensee of his intention to surrender. If, before expiry of the period, the proprietor of the patent proves to the European Patent Office that the licensee agrees to the surrender, it may be entered immediately.

### **CHAPTER II. LIMITATION PROCEDURE** ➔

#### **Rule 13**

Period for the filing of the request for limitation

Rule 12 shall apply mutatis mutandis to the filing of the request for limitation of the Community patent.

#### **Rule 14**

Content of the request for limitation

The request for limitation of a Community patent shall contain:

- a. the number of the Community patent which it is sought to limit, the name of the proprietor and the title of the invention;
- b.

the amendments sought;

- c. if the proprietor of the patent has appointed a representative, his name and the address of his place of business in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention.

## **Rule 15**

Rejection of the request for limitation as inadmissible

If the Revocation Division notes that the request for limitation of a Community patent does not comply with Article 51 (1) and (3) and Rule 14, it shall communicate this to the proprietor of the patent and shall invite him to remedy the deficiencies noted within such a period as it may specify. If the request for limitation is not corrected in good time, the Revocation Division shall reject it as inadmissible.

## **Rule 16**

Examination of the request for limitation

1. If the request for limitation of the Community patent is admissible, the proprietor of the patent shall, in any communication pursuant to Article 52 (2), where appropriate, be invited to file the description, claims and drawings in amended form.

2. Where necessary, any communication pursuant to Article 52 (2) shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the limitation of the patent.

3. Before the Revocation Division decides on the limitation of the patent, it shall inform the proprietor of the extent to which it intends to limit the patent, and shall request him to pay within three months the fee for printing a new patent specification and to file the translation prescribed in Article 53 (2) (b) within the same period. If within that period the proprietor has communicated his disapproval of the patent being limited to this extent, the communication of the Revocation Division shall be deemed not to have been made, and the limitation proceedings shall be resumed.

4. The further period referred to in Article 53 (3) shall be two months.

5. The decision to limit the patent shall state the text of the patent as limited.

## **Rule 17**

Resumption of limitation proceedings

Where limitation proceedings have been stayed because of revocation proceedings which result in a decision under Article 58 (2) or (3), the Revocation Division, after the publication of the mention of such decision, shall communicate to the proprietor of the patent that the proceedings will be resumed after notification of this

communication to the proprietor. Rule 13 (5) of the Implementing Regulations to the European Patent Convention shall apply *mutatis mutandis*.

## **Rule 18**

Different claims, description and drawings in the case of

limitation

Where it is decided to limit a Community patent in respect of one or some of the Contracting States, the Community patent may, where appropriate, contain, for that State or States, claims and, if the Revocation Division considers it necessary, a description and drawings which are different from those for the other Contracting States.

## **Rule 19**

Form of the new specification following limitation proceedings

The President of the European Patent Office shall prescribe the form of the publication of the new specification of the Community patent and the data which are to be included.

## **CHAPTER III. REVOCATION PROCEDURE ➔**

### **Rule 20**

Content of the application for revocation

An application for revocation of a Community patent shall contain:

- a. the name and address of the applicant for revocation and the State in which his residence or principal place of business is located, in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention;
- b. the number of the patent in respect of which revocation is applied for, the name of the proprietor and the title of the invention;
- c. a statement of the extent to which revocation is applied for and of the grounds on which the application is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;
- d. if the applicant has appointed a representative, his name and the address of his place of business, in accordance with Rule 26 (2) (c) of the Implementing Regulations to the European Patent Convention.

### **Rule 21**

Security for the costs of proceedings

The security for the costs of the proceedings shall be deposited in a currency in which fees may be paid. It must be deposited with a financial or banking establishment included

in the list drawn up by the President of the European Patent Office. The national law of the Contracting State in which the establishment has its place of business shall apply to any such security.

## **Rule 22**

### Rejection of the application for revocation as inadmissible

1. The Revocation Division shall communicate the application for revocation to the proprietor of the patent who may comment on its admissibility within one month.

2. If the Revocation Division notes that the application for revocation does not comply with Article 55 (1) and (4) and Rule 20, as well as Rule 3 of these Implementing Regulations in conjunction with Rule 1 (1) of

the Implementing Regulations to the European Patent Convention, it shall communicate this to the proprietor and to the applicant and shall invite the applicant to remedy the deficiencies noted within such period as it may specify. If the application for revocation is not corrected in good time, the Revocation Division shall reject it as inadmissible.

3. Any decision to reject an application for revocation as inadmissible shall be communicated to the proprietor of the patent.

## **Rule 23**

### Preparation of the examination of the application for

### revocation

1. If the application for revocation is admissible, the Revocation Division shall invite the proprietor of the patent to file his observations and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the Revocation Division.

2. The observations and any amendments filed by the proprietor of the patent shall be communicated to the applicant who shall be invited by the Revocation Division, if it considers it expedient, to reply within a period to be fixed by the Revocation Division.

## **Rule 24**

### Examination of the application for revocation

1. All communications issued pursuant to Article 57 (2) and all replies thereto shall be communicated to all parties.

2. In any communication from the Revocation Division to the proprietor of the patent pursuant to Article 57 (2), he shall, where appropriate, be invited to file the description, claims and drawings in amended form.

3. Where necessary, any communication from the Revocation Division to the proprietor of the patent pursuant

to Article 57 (2) shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the maintenance of the Community patent.

4. Before the Revocation Division decides on the maintenance of the patent in the amended



form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of one month if they disapprove of the text in which it is intended to maintain the patent.

5. If disapproval of the text communicated by the Revocation Division is expressed, examination of the revocation may be continued; otherwise, the Revocation Division shall, on expiry of the period referred to in paragraph 4, request the proprietor of the patent to pay within three months the fee for the printing of a new specification and to file the translations prescribed in Article 58 (3) (b) within the same period.

6. The further period referred to in Article 58 (4) shall be two months.

7. The decision to maintain the patent as amended shall state which text of the patent forms the basis for the maintenance thereof.

### **Rule 25**

Joint processing of applications for revocation

1. The Revocation Division may order that two or more applications for revocation pending before it and relating to

the same Community patent be dealt with jointly in order to carry out a joint investigation and take a joint decision.

2. The Revocation Division may rescind an order given pursuant to paragraph 1.

### **Rule 26**

Different claims, description and drawings in the case of

revocation

Where revocation of a Community patent is pronounced in respect of one or more of the Contracting States, Rule 18 shall apply mutatis mutandis.

### **Rule 27**

Form of the new specification following revocation

proceedings

Rule 19 shall apply to the new specification of the Community patent referred to in Article 59.

### **Rule 28**

Other provisions applicable to revocation proceedings

Rules 59, 60 and 63 of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to requests for documents, continuation of revocation proceedings by the European Patent Office of its own motion and costs in revocation

proceedings.

## **PART IV. IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION** ➔

### **Rule 29**

Entries in the Register of Community Patents

1. Rule 92 (1) (a) to (l), (o), (q) to (u) and (w), (2) and

(3) of the Implementing Regulations to the European Patent Convention shall apply mutatis mutandis to the Register of Community Patents.

2. The Register of Community Patents shall also contain the following entries:

- a. date of lapse of the Community patent in the cases provided for in Article 50 (1) (b) and (c);
- b. date of filing of the statement provided for in Article 43;
- c. date of receipt of a request for limitation of the Community patent;
- d. date and purport of the decision on the request for limitation of the Community patent;
- e. date of receipt of an application for revocation of the Community patent;
- f. date and purport of the decision on the application for revocation of the Community patent;
- g. particulars of matters referred to in Article 23 (4);
- h. a record of the information communicated to the European Patent Office concerning proceedings under the Protocol on Litigation.

### **Rule 30**

Additional publications by the European Patent Office

The President of the European Patent Office shall determine in what form the translations filed pursuant to the

Convention by the applicant for or proprietor of a patent and, where appropriate, corrected translations, shall be published and whether particulars of such translations and corrected translations should be entered in the Community Patent Bulletin.

### **Rule 31**

Other common provisions

Rules 36 and 106 and the provisions of Part VII of  
the Implementing Regulations to the European Patent

Convention, with the exception of Rules 85 (3), 86, 87, 92 and 96, shall apply mutatis  
mutandis subject to the following:

- a. Rule 69 shall not apply to decisions on requests for limitation or on applications for revocation of the Community patent;
- b. the Select Committee of the Administrative Council shall determine the details of the application of Rule 74 (2) and (3);
- c. the term 'Contracting States' shall be understood as meaning the States parties to this Convention.

## **PART V. IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION** ➡

### **Rule 32**

Option between a Community patent and a European patent

1. The statement referred to in Article 81 (1) must be filed, and the fees paid, before or when the applicant approves, in accordance with Rule 51 (4) of the Implementing Regulations to the European Patent Convention, the text in which the patent is to be granted.

2. The prescribed fees referred to in Article 81 (1) shall consist of:

- a. an additional fee in accordance with the Rules relating to Fees; and
- b. if the designation of more than three Contracting States is to be maintained, the currently prescribed designation fee for each additional Contracting State over and above the first three.