

CA/49/12

Orig.: en

Munich, 27.04.2012

SUBJECT: Amendments to the Implementing Regulations to the EPC -
Rule 53 EPC

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: 1. Committee on Patent Law (for opinion)
2. Administrative Council (for decision)

SUMMARY

It is proposed to amend Rule 53 EPC so as to provide for a legal sanction in case of failure to comply with an invitation under Rule 53(3) EPC to file the translation of a previous application whose priority is claimed within the meaning of Article 87 EPC where the validity of the priority claim is relevant to the determination of the patentability of the invention concerned. Non compliance with this requirement would result in the loss of the right of priority. The introduction into the EPC of a specific legal sanction would clarify the consequences of non-compliance with the invitation to file the requested translation, an issue of particular importance for both applicants and the EPO. This would further ensure that consideration could be given to the interest of third parties in transparency and legal certainty.

This document takes into account the discussion of the proposal with the users during the 5th and 6th meetings of the SACEPO Working Group Rules as well as the results of the web-based users' consultation which took place from 15.12.2011 until 20.01.2012.

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PART I

I. CONTEXT

1. Article 88 EPC has undergone significant changes as a consequence of the general overhaul of the EPC in 2000 which focused on increasing the flexibility of the EPC and reflecting the norms imposed by the PCT and the PLT. For these purposes, all formal requirements for claiming priority contained in Article 88(1) EPC 1973 were moved to the Implementing Regulations and the obligation to file systematically a copy of the previous application and its translation was removed. One of these requirements concerned the filing of a translation of the priority application (cf. CA/PL 17/98; CA/PL100/00, p. 79).
2. Under the present regime a translation of a previous application which priority is claimed can only be requested from the applicant for or proprietor of a European patent under the simultaneous conditions provided for in Rule 53(3) EPC: the previous application is not in an official language of the EPO and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned.
3. The EPC nevertheless does not provide for a specific legal sanction in case of non-compliance with an invitation under Rule 53(3) EPC. The possible legal consequences of the failure to supply the requested translation are mentioned in the Guidelines for Examination in the EPO (A-III, 6.8, C-V, 3.4 and D-VII, 2) which state that the intermediate documents which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will be considered to belong to the prior art under Articles 54(2) or 54(3) EPC.
4. Rule 53(3) EPC specifies that the translation is to be filed within a time limit specified by the Examining or Opposition division. In most of the cases, e.g. where a search opinion is issued and where the validity of the priority is considered as to be of relevance to the determination of the patentability of the invention concerned at the stage of the completion of the extended European search report, the invitation under Rule 53(3) EPC is sent along with the search report and applicants are given a four-month time limit from notification of the invitation to file the requested translation.
5. For reasons of legal certainty and transparency but also in order to streamline the proceedings before the EPO, it is proposed to amend Rule 53 EPC as to provide for a legal sanction in the case of non-compliance with the invitation to file a translation of a previous application which priority is claimed under Rule 53(3) EPC and that the period for filing the translation - when requested for the purposes

of the examination proceedings - is aligned to the period for filing the request for examination pursuant to Rule 70(1) EPC or, where applicable, for indicating whether it is wished to proceed further with the application pursuant to Rule 70(2) EPC. The non-observance of the time limit for filing the translation would be the loss of the right of priority in respect of the European patent application or European patent. The loss of rights which would ensue from the failure to timely file the translation could be remedied during examination proceedings by filing a request for further processing in accordance with Article 121 EPC.

II. ARGUMENTS

6. The validity of a priority claim is of particular importance when relevant prior art has been made available to the public during the priority interval within the meaning of Article 54(2) EPC or if the content of the European patent application is totally or partially identical with the content of another European patent application within the meaning of Article 54(3) EPC, such other application claiming a priority date or having a filing date within the priority interval. In such cases, the competent EPO organ must investigate whether the priority date(s) claimed may be accorded to the appropriate parts of the European patent application or patent. When the previous application from which priority is claimed is in non official language of the EPO, this substantial examination can only be thoroughly performed when the translation of the application is duly filed under Rule 53(3) EPC (see Guidelines for Examination in the EPO, C-V, 2.1 and D-III, 5).
7. With the entry into force of the EPC 2000, the filing of a translation under Rule 53(3) EPC has become a formal requirement with substantive effect. In contrast to the system applicable under the EPC 1973, the translation requirement is no longer a matter which forms part of the examination on filing and as to formal requirements governed by Article 90 EPC. During examination proceedings the non-compliance with the invitation under Rule 53(3) EPC may on the contrary lead to the refusal of the application under Article 97(2) EPC on substantive grounds: because the Examining Division is not in a position to verify whether the priority document refers to the same invention disclosed in the application under examination (Article 87(1) and (4) EPC), the validity of the hitherto acknowledged right of priority is put in jeopardy. This has the further consequence that the intermediate document(s) would be considered to belong to the prior art under Articles 54(2) or 54(3) EPC and to be prejudicial to the novelty or inventive step of the European patent application. This interpretation is supported by the wording and context of Article 88(1) EPC as revised which, in contrast to Article 88(1) EPC 1973 no longer contains the translation requirement. Instead it refers to "any other

document required, in accordance with the Implementing Regulations". Article 88(1) EPC obviously addresses the formal requirements of claiming priority and therefore solely refers to the date, State, file number and priority document. These formal requirements are subject to Rules 58 and 59 EPC - which also do not address the translation requirement - and to Article 90(3) and (5) EPC which provides for the loss of the priority in case of non-compliance with these requirements. In opposition proceedings, where prior art is invoked in connection with a ground for opposition under Article 100(a) EPC in relation to which the priority date is of decisive importance, the failure to file the translation of the priority claim can possibly lead to the maintenance of the patent in amended form to or to its revocation.

8. The absence of an explicit sanction for failure to file the translation of the priority document is not only prejudicial to the parties to proceedings before the EPO but also to the EPO and third parties, as it increases the likelihood that within the examining or opposition proceedings applicants or patent proprietors can delay the necessary filing of a translation to a later stage or even potentially bypass the examination of the validity of the priority claim by filing amendments instead of the requested translation..
9. One of the crucial criteria to be taken into account for assessing whether an application is entitled to the date of a priority document is the criterion of identity of invention as laid down in Articles 87(1) and (4) EPC (see G 2/98, OJ EPO 2001, 413). Where the previous application from which priority is claimed is in an official language of the EPO, the examination of the entitlement to the claimed priority is performed and the applicant is informed accordingly. Where a translation of the priority claim is however necessary but has not been filed when the Examining Division has become responsible for the examination of the European patent application, the first action of the Examining Division will be to issue a communication under Article 94(3) and Rule 71(1) (2) EPC raising objections based on an invalid priority. As already indicated under Point 7, if the applicant replies to such communication by submitting substantive arguments or amendments but without filing the translation requested, the Examining Division may subsequently refuse the European patent application on the basis that the subject-matter claimed in the original or newly-filed set of claims is anticipated by the prior art under Article 54(2) or 54(3) EPC (see Guidelines for Examination in the EPO, A-III, 6.8 and C-V, 3.4). This procedure has the evident and major drawbacks that it entails the risk of an increased complexity of the procedure potentially accompanied by a plurality of amendments, thus causing unnecessary workload for the Examining Division. Further, without the translation of the priority claim it is highly questionable how the Examining Division can be in a position to

perform the necessary test for deciding whether the priority has been validly claimed. The same considerations apply to opposition proceedings. ,

10. Maintaining the current situation does not undeniably only affect the public interest in transparency of the administrative and legal proceedings but also slows down the proceedings. This would thus be in contradiction with two of the main duties of the EPO which are that proceedings should be conducted swiftly and that the EPO should not grant or maintain patents which it is convinced are not legally valid
11. Some users suggested that neither the translation of the priority document nor the legal sanction would be necessary if applicants are given the possibility to amend the application accordingly. However this suggestion is seen to be in conflict with the requirements of legal certainty and procedural efficiency recalled above and would also have further consequences in the cycle of patents, for example when partial validity is assessed in later national court proceedings. This would also inevitably give applicants or patentees claiming priority of an application which is not in an EPO official language a better procedural situation since the crucial examination of the entitlement to priority would not be performed (see Points 6 and 9) and thus lead to European patent applications or patents being treated differently depending on the language of the priority claim. As a matter of law, similar situations shall not be treated differently unless differentiation is objectively justified. No suitable and objective criteria for making such a distinction can however be identified.
12. The suggestion has also been made to limit the scope of applicability of the proposed amendment to Rule 53(3) EPC to examination proceedings and to introduce a similar rule in Part V, Chapter I of the Implementing Regulations. As results from the wording of Rule 53(3) EPC as in force, it follows that translation requirements already apply to opposition proceedings. Further Rule 86 EPC provides that Part III of the Implementing Regulations shall apply *mutatis mutandis* to documents filed in opposition proceedings. Considering that Rule 53(3) EPC is part of Part III of the Implementing Regulations, there is thus no need to include a specific rule in the regulations applicable to the opposition procedure.
13. The applicability of Article 121 EPC in case of non-observance of the time limit for filing the translation under Rule 53(3) EPC is under the present regime also a source of uncertainty. Indeed, according to the Guidelines for examination before the EPO (E-VIII, 1.8) which reflect the case law of the Enlarged Board of Appeal (G 12/91, OJ EPO 1994, 285), if a particular time limit is not complied with and no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit but before the decision is handed over to the EPO's internal postal services for transmittal to the parties are to be regarded

in the rest of the proceedings as if they had been received in time. As a consequence of the lack of a specific legal sanction in the EPC, no communication informing applicants about the failure to observe the time limit under Rule 53(3) EPC is issued as prescribed by Rule 135(1) EPC. Accordingly, the two-month time limit for requesting further processing is not triggered with the consequence that the request and the missing translation may be filed until a decision on the application is issued.

14. According to the current practice, the invitation to file the translation of the previous application from which priority is claimed is commonly despatched as an annex to the extended European search report. This derives from the fact that intervening state of the art or potential state of the art according to Article 54(3) EPC is often revealed in the search. This practice leads to the situation in which applicants have to incur the costs for the translation before having to file the request for examination or to indicate whether they wish to proceed further with the application in cases where the request for examination has been filed before the European search report has been issued. With the introduction of a specific legal sanction, the necessity to adjust the period for filing the translation becomes then essential in order to avoid a premature loss of right. For this reason the period for filing the translation under Rule 53(3) EPC should coincide with the periods provided for in Rule 70(1) EPC or, where applicable, in Rule 70(2) EPC. This could be achieved by issuing the invitation pursuant to Rule 53(3) EPC simultaneously to the communication according to Rules 69 and 70a(1) EPC (information as to the publication date of the search report and invitation to reply to the extended European search report) or, where confirmation of the request for examination is necessary, to the communication issued according to Rules 70(2), 70a(2) and 39 EPC.
15. The proposed amendment to Rule 53(3) EPC would therefore not only help to ensure consistency of the Implementing Regulations with the EPC but is in any case called for to achieve legal certainty and to secure the imperative of procedural efficiency and the public interest in a speedy and streamlined procedure.

III. IMPLEMENTATION

16. The envisaged date of entry into force of the provisions as amended is 1 April 2013.

17. Rule 53 EPC as amended should apply to European and Euro-PCT applications as well as to European patents in respect of which an invitation under Rule 53(3) EPC has not yet been issued by the date of entry into force of the amended provision.

IV. FINANCIAL IMPLICATIONS

18. Not applicable.

V. LEGAL BASIS

19. Article 33(1)(c) EPC.

VI. DOCUMENTS CITED

20. CA/PL 17/98, CA 100/00, Guidelines for Examination before the EPO, G 12/91.

VII. PROPOSED CHANGES

Present wording

Rule 53 EPC Priority documents

(1) An applicant claiming priority shall file a copy of the previous application within sixteen months of the earliest priority date claimed. This copy and the date of filing of the previous application shall be certified as correct by the authority with which that application was filed.

(2) The copy of the previous application shall be deemed to be duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions determined by the President of the European Patent Office.

(3) Where the previous application is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned, the European Patent Office shall invite the applicant for or proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 2 shall apply *mutatis mutandis*.

Proposed wording

Rule 53 EPC Priority documents

(1) *unchanged*

(2) *unchanged*

(3) Where the previous application is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned, the European Patent Office shall invite the applicant for or proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 2 shall apply *mutatis mutandis*. **If a requested translation of a previous application is not filed in due time, the right of priority for the European patent application or for the European patent with respect to that application shall be lost. The applicant for or proprietor of the European patent shall be informed accordingly.**

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
amending Rule 53 of the Implementing Regulations
to the European Patent Convention

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention (hereinafter referred to as "EPC") and in particular Article 33(1)(c) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

Article 1

1. Rule 53 of the Implementing Regulations to the EPC shall be amended as follows:

Paragraph 3 shall read as follows:

"(3) Where the previous application is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned, the European Patent Office shall invite the applicant for or proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 2 shall apply mutatis mutandis. If a requested translation of a previous application is not filed in due time, the right of priority for the European patent application or for the European patent with respect to that application shall be lost. The applicant for or proprietor of the European patent shall be informed accordingly."

Article 2

(1) This decision shall enter into force on [...].

(2) Rule 53 EPC, as amended by Article 1 of this decision, should apply to European and Euro-PCT applications as well as to European patents in respect of which an invitation under Rule 53(3) EPC has not yet been issued by the date of entry into force of the amended provision.

Done at Munich, [date of decision]

For the Administrative Council
The Chairman

Jesper KONGSTAD