

## Revised European Patent Convention - EPC 2000

The revised European Patent Convention came into force on 13th December 2007. This briefing note highlights the key changes in the Convention and discusses best practice under the revised provisions.

### Background

The revisions made to the European Patent Convention (EPC) were designed to enhance the flexibility of the EPC, streamline some procedures and align the EPC with TRIPS and PLT 2000.

No major changes were made to the substantive patent law, although many provisions of the EPC were re-drafted to some degree. The content of many of the Articles of the EPC 1973 was transferred into the Implementing Regulations and, as a result, the Implementing Regulations were completely re-numbered. A concordance table may be found at: Concordance Table .

References to the Rules and Articles herein are to EPC 2000 unless otherwise stated.

### Main features at a glance

- New rules for date of filing in conformity with PLT (see section 1 below).
- Amendment of priority provisions (see section 2 below).
- Non-unity and entry into European phase of PCT applications (see section 3 below).
- Further processing more widely available (see section 4 below).
- Amendment in the protection of compounds for medical use (see section 5 below).
- New central limitation and revocation procedure (see section 6 below).
- Revision of Article 69 EPC and the Protocol on Interpretation (see

section 7 below).

- Limited review of Board of Appeal decisions by the Enlarged Board of Appeal (see section 8 below).

### 1 Date of filing

Rule 40 implements Article 5 PLT and provides that, for a date of filing to be allocated, the following are required:

- An indication that a European patent is sought;
- Information identifying the applicant or allowing the applicant to be contacted; and
- A description or a reference to a previously-filed application.

Thus, claims are no longer an essential requirement of an application in order to obtain a date of filing. However, the **strict requirement** of Article 123(2) **must still be met** in relation to any subsequently filed claims. It is therefore strongly recommended to continue to file applications with claims.

The application may be filed **in any language** and a translation filed within two months (Rule 6(1)). This may be a useful provision, because any errors made in the translation of the originally filed application may be corrected at any time. However, if the translation itself is used as the text of the application, any errors in translation may be corrected only in limited circumstances.

Instead of a description, a reference to a previously filed application may be filed (Rule 40(2)). The reference may opt to include the claims of the previous

application (Rule 57(c)). A "previous application" may include a priority application or a parent application in respect of a divisional application. In the latter case, it is recommended to file specific claims, rather than include the claims of the previous application by reference.

### 2 Amendment of priority provisions

Although it is strongly recommended to continue to include any claim to priority on filing, Rule 52(2) provides for the declaration of priority to be made after filing up to 16 months from the earliest priority date claimed.

The priority declaration may be corrected under Rule 52(3) up to 16 months from the earliest priority date claimed.

Re-establishment of rights under Article 122 is available, under exceptional circumstances, in respect of the *priority period*.

A translation of the priority document is no longer requested as routine. A translation is only required if it is considered that it is necessary in order to assess patentability (Rule 53(3)).



Article 87(1) now allows priority to be claimed from WTO Member States which are not party to the Paris Convention, such as Thailand and Taiwan.

### 3 Non-unity and entry into European phase of PCT applications

For PCT applications entering the EP Regional Phase, **the applicant no longer receives an invitation to pay additional fees for unsearched inventions.** The opportunity to have multiple inventions searched is limited to the International Phase. Any supplementary search conducted by the EPO on entry into the EP Regional Phase under Article 153(7), can be conducted on the first mentioned invention only. The application must be limited to the invention covered by the ISR or, where a supplementary search report is drawn up, by that report. Any further inventions must be pursued in divisional applications (Article 153 and Rule 164).

### The communications formerly issued under Rule 112 EPC 1973 have *no counterpart* in EPC 2000.

It is therefore important to ensure that the claims of an application entering the EP Regional Phase are ordered such that the claims on which any supplementary search report under Article 153(7) is to be conducted are listed first. Furthermore, to avoid unnecessary payment of excess claim fees, any claims relating to unsearched subject matter should be deleted, either on entry into the EP Regional Phase or in response to the communication under Rule 161 (which corresponds to Rule 109 EPC 1973).

### 4 Further processing

Further processing is the standard remedy if time limits are not observed

(Article 121 EPC; Rule 135). Further processing is available for **all** time limits to be observed by the **applicant vis-à-vis** the EPO (unless specifically excluded).

However, further processing is not available for either patent proprietors or opponents.

Further processing is available for both total and partial loss of rights.

Further processing is available for all patent applications pending when EPC 2000 enters into force.

### 5 Protection of compounds for medical use

The prohibition on the patenting of methods of treatment, surgery, therapy and diagnosis under Article 52(4) EPC 1973 was transferred to Article 53(c) in EPC 2000.

Article 54(5) EPC 1973 was transferred to Article 54(4) in EPC 2000, which provides use-related product protection for the **first medical use** of a known substance.

### Examples

Claim	EPC 2000 Patentable?	EPC 1973 Patentable?
Use of product for the treatment of melanoma.	No (Art.53(c)).	No (Art. 52(4) EPC 1973).
Product X for use as a medicament.	Yes; first medical use claim type (Art. 54(4)).	Yes (Art. 54(5) EPC 1973).
Product X for the treatment of cancer	Yes; second medical use claim type (Art. 54(5)).	No*
Product X for the treatment of tooth decay	Yes; further medical use claim type (Art. 54(5)).	No*

\* Such claims had to be drafted as "Swiss-Type" claims (use of product X in the manufacture of a medicament for treatment of Y) under EPC 1973.

Article 54(5) in EPC 2000 specifically provides for use-related product protection for a **further medical use** of a substance already known to be usable in medicine (second or further medical use).

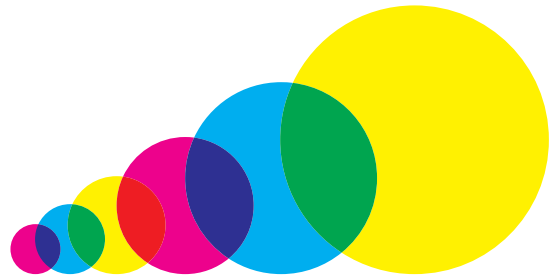
### 6 New central limitation and revocation procedure

Articles 105a to 105c and Rules 90 to 96 provide a new central limitation and revocation procedure.

Limitation/revocation can be requested centrally for EP patents which:

- were already granted when EPC 2000 came into force;
- are granted on applications pending on, or filed after, the date when EPC 2000 came into force;
- are no longer in force; or
- have already been limited.

This procedure is relatively quick and is handled by the Examining Division of the EPO. The Examining Division considers only whether the request is a legitimate request for limitation and not, for example, for a mere clarification.



The Examining Division also examines whether the requirements of Article 84 EPC (Clarity) and Article 123 EPC (Added Subject Matter) have been met.

**There is no examination as to patentability of the amended patent.**

There is no requirement to provide an explanation as to why the limitation/revocation is requested.

The claims of the patent must be amended. It is not possible simply to amend the description, even if this arguably results in a limitation of the scope of protection.

Central limitation is an extremely useful tool to allow post-grant amendment of a patent in view of newly discovered prior art.

Note, however, that opposition proceedings take precedence over limitation proceedings. Limitation may not be requested whilst opposition proceedings are pending. It is nevertheless possible to request revocation during opposition proceedings. Any limitation proceedings pending when an opposition is filed will be terminated and the limitation fee reimbursed.

## 7 Revised Article 69 EPC and protocol on interpretation

Article 69 was amended to state:

**The extent of protection conferred by a European patent or a European patent application shall be determined *by the claims*. Nevertheless, the description and drawings shall be used to interpret the claims.**

The Protocol on Interpretation of Article 69, Article 2, states:

**For the purpose of determining the extent of protection conferred by a European patent, *due account* shall be taken of any element which is *equivalent* to an element specified in the claims.**

Note:

- There is no definition of the term “equivalent”; and
- There is no “prosecution history estoppel/file wrapper estoppel”.

These amendments apply to patents already granted when EPC 2000 came into force.

## 8 Review of Board of Appeal decisions by the Enlarged Board of Appeal

EPC 2000 provides (under Article 112a and Rule 104) the possibility for a limited judicial review of Board of Appeal decisions. The appeal proceedings must have been marred by a **fundamental procedural defect** and/or evidence must be provided from a competent court that a **criminal act** (such as bribery or forgery of evidence/documents) occurred which may have had an impact on the decision of the Board of Appeal.

**Such a petition has *no* suspensive effect.**

This procedure does not provide the opportunity to review the application of substantive law by the Board of Appeal. The procedure only applies to Board of Appeal decisions made after EPC 2000 came into force.

## 9 Other changes

### Duty of disclosure

Amended Article 124 and new Rule 141 provides that the applicant **may** be invited by the EPO to provide information on prior art considered during examination of national or regional patent applications concerning the invention to which a given European patent application relates.

### Missing parts

Missing parts of the description or drawings may be filed within 2 months of filing or from an invitation from the EPO (Rule 56(1),(2)). The application is re-dated **unless** missing parts are **completely contained** in the priority application (Rule 56 (2), (3)).

### Attorney evidentiary privilege

Amendment to Article 134a(1)(d) and new Rule 153 provides that a professional representative, when conducting proceedings before the EPO, 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. Correspondence between a person and his UK patent agent continue to be privileged from disclosure in legal proceedings via Section 280 [Copyright Designs and Patents Act 1988].

## Need advice?

Please do not hesitate to contact us for more detailed advice at: [email@carpmaels.com](mailto:email@carpmaels.com).

Carpmaels & Ransford is a leading firm of European patent attorneys based in London. For more information about our firm and our practice, please visit our website.

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