

Institutional issues, Priority, Substantive patent law

The revision of the European Patent Convention - The new EPC 2000 -

Third European Meeting of CEIPI 20th - 21st April 2007 in Strasbourg

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20th April 2007



Overview

- EPC 2000: the reasons behind it
- The implementation of EPC 2000
- Institutional issues
- Priority
- Changes in substantive patent law

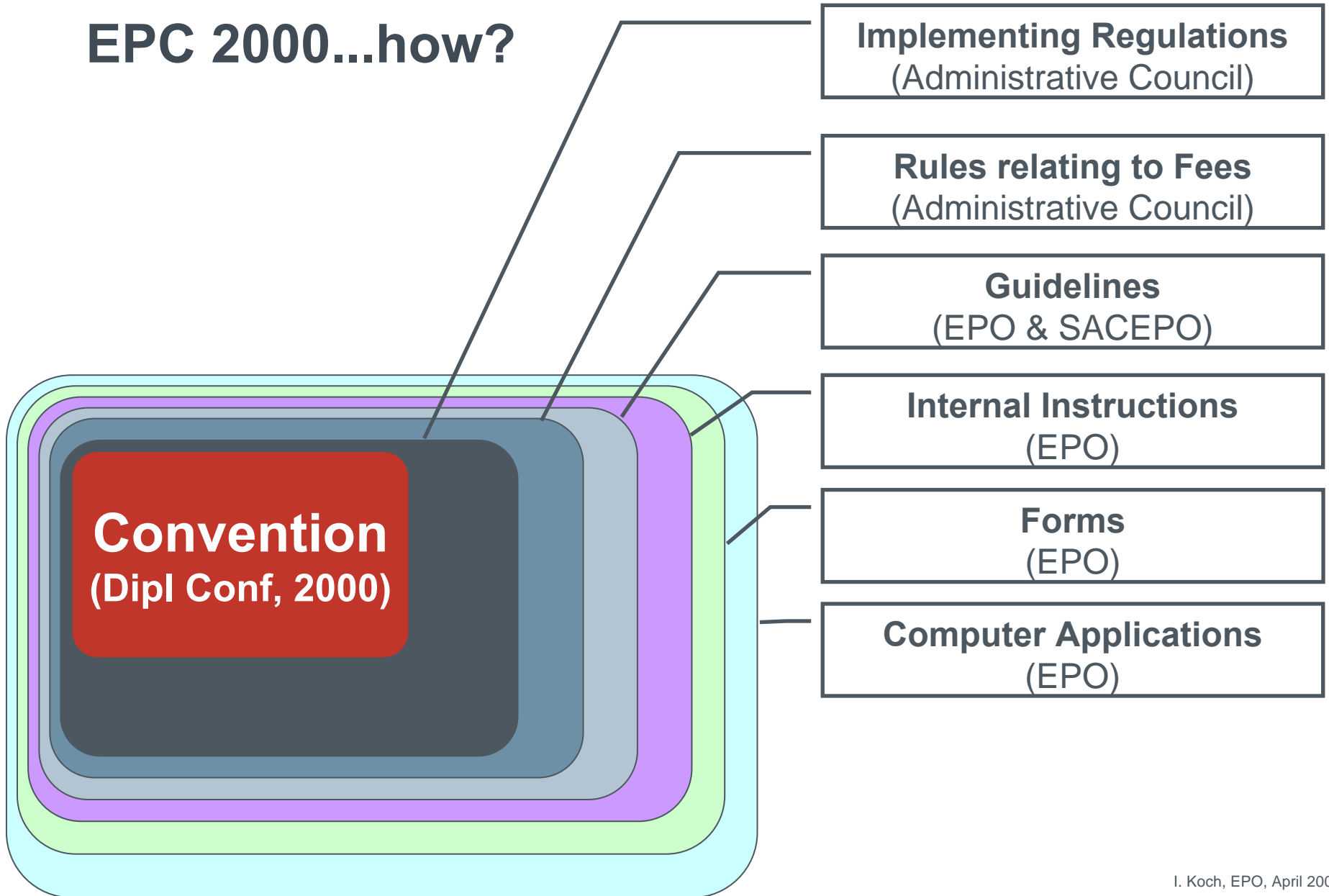
EPC 2000...why?

- Adaptation to, and harmonisation with international patent law (in particular TRIPs Agreement, PLT)
- Deregulation
- Enhancing flexibility
- User needs
- EPO needs (BEST)

EPC 2000...when?

- EPC 1973 revised at a Diplomatic Conference (Munich, **20th - 29th November 2000**)
- Ratification and accession by EPC contracting states required for entry into force
 - Greece was the 15th contracting state to ratify (**13th December 2005**)
- EPC 2000 will enter into force on **13th December 2007** at the latest

EPC 2000...how?



Extent of changes

- No major changes in substantive patent law
- Structure of grant, opposition and appeal procedures unchanged
- New features are, in particular:
 - date of filing requirements in conformity with PLT
 - central limitation/revocation & petition for review
 - further processing as standard remedy if time limits not observed
- Substance of the Articles transferred into the Rules



The Rules have been **renumbered**:
R. 51(4) EPC 1973 is now R. 71(3) EPC 2000



Institutional provisions (1)

Amendments to Articles 16 – 18 and to the Protocol on Centralisation, Section I:

- Geographical indications deleted
- Provisionally applicable
 - Art. 25(1)(a) Vienna Convention on the Law of Treaties

Institutional provisions (2)

Protocol on the Staff Complement of the European Patent Office at The Hague:

- The Organisation shall ensure that the proportion of Office posts assigned to the duty station at The Hague as defined under the 2000 establishment plan and table of posts remains substantially unchanged
- Any change in the number of posts resulting in a deviation of more than 10 % shall be subject to a decision of the AC

Institutional provisions (3)

New Rule 10:

Responsibility of the Receiving Section and the Examining Division:

- The **Receiving Section** shall be responsible on filing and the examination as to formal requirements **up to the time when the Examining Division become responsible**
- The **Examining Division** shall be responsible for the examination from the time **when a request for examination is filed**
 - when **the applicant reacts to pursue the application further** under new Rule 70(2) or
 - when the **search report is transmitted to the applicant**, where the **applicant waives his right** to the communication under new Rue 70(2)

Institutional provisions (4), BEST - EESR (1)

- Implementation of **BEST**: (**B**ringing **E**xamination and **S**earch **T**ogether):
 - Office-wide immediately from 29th November 2000 onwards
- **New Rule 62 (= Rule 44a EPC 1973):**
- **EESR (Extended European search report)**
- for **all** European search reports including supplementary European search reports
- **mandatory from 1st July 2005 onwards**

Institutional provisions (5), BEST - EESR (2)

New Rule 62 (= Rule 44a EPC 1973):

- "The European search report shall be accompanied by an **opinion on whether the application and the invention to which it relates seem to meet the requirements of the EPC, unless a communication under Rule 71, paragraph 1 or 3, can be issued.**"

Institutional provisions (6), BEST - EESR (3)

No examination fee paid or examination fee paid without waiver:

- **European search report + opinion of the search division**
 - not legally binding
- **Examination fee paid + waiver to receive new Rule 70(2) communication:**
- **European search report + first examination report or new Rule 71(3) communication**
 - **no opinion, i.e. no EESR**
 - legally binding

Institutional provisions (7), AC (1)

Amendments to Article 33(1)(b):

- **Administrative Council** may **amend the Convention** to bring it into line with an international treaty or EC legislation

Institutional provisions (8), AC (2)

Amendments to Articles 33 and 35:

Requirements:

- Entry into force of an international treaty
- Expiry of period for implementation of EC legislation
- Unanimity
- All contracting states to be represented at the AC
- Period of 12 months

Institutional provisions (9)

New Art. 4a:

Conference of ministers of the Contracting States:

- to discuss issues pertaining to the Organisation and to the European patent system
- at least every 5 years

Institutional provisions (10)



New Art. 134a(1) - (2):

Representations:

- Anchors the existence of the epi (Institute of Professional Representatives before the EPO) in the Convention

Priority (1)

Amendments to Art. 87(1):

- Priority also from WTO members who are not party to Paris Convention
- e.g. Thailand, Taiwan

Priority (2)

New Rule 52:

- **Para. 2:** Declaration of priority can be made after filing
 - 16 months from the earliest priority date claimed
- **Para. 3:** Correction of priority declaration
 - 16 months from the earliest priority date claimed
(minimum of 4 Months after filing)

Priority (3)

Amendments to Art. 122 and new Rule 136(1):

- Re-establishment of rights in respect of the priority period
- 14 months from the priority date

Priority (4)

New Rule 53(3):

- Translation of priority document only required if relevant to assessing patentability
- May be for the first time even during an opposition procedure

Amendments to Art. 52(1) = Art. 27(1), first sentence TRIPs Agreement:

- Art. 52(1) patents granted for inventions **"in all fields of technology"**
 - "European patents shall be granted for any inventions **in all fields of technology**, provided that they are new, involve an inventive step and are susceptible of industrial application."

New Art. 53(c) \approx Art. 52(4) EPC 1973 = Art. 27(3)(a) TRIPs Agreement

- **Methods of treatment, surgery, therapy and diagnosis** under Art. 52(4) EPC 1973 have been transferred to **Art. 53(c) EPC 2000** as a **new exception to patentability**

Amendments to Art. 53(a) =

Art. 27(2) TRIPs Agreement:

- The exception related to **publication** has been deleted from Art. 53(a)
- An invention falls under Art. 53(a) only if its **commercial** exploitation is contrary to ordre public or morality
 - "European patents shall not be granted in respect of a) inventions the **commercial exploitation** of which would be contrary to *ordre public* or morality; such exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting states;"

Conflicting applications

Amendments to Art. 54(3):

- Validly published earlier European patent applications constitute state of the art for a later application:
- for **all** EPC contracting states
- **regardless** of designations

Transitional provision: old Art. 54(4) EPC 1973 will still be applicable to applications filed before the date of entry into force of EPC 2000 → check for common designations

Protection of compounds for medical use

Amendments to Art. 54(4):

- Use-related product protection for the **first medical use** of a known substance = Art. 54(5) EPC 1973

New Art. 54(5):

- Use-related product protection for an invention relating to a **further medical use** of a substance already known to be usable in medicine (**second or further medical use**).
- **No "Swiss-type" claims** required anymore

Protection of compounds for medical use (2)

EXAMPLES		
Claim	Patentable?	Art. EPC 2000
Use of product X for the treatment of melanoma	NO	53(c)
Product X for use as a medicament, suitable especially for combating cerebral insufficiency and improving intellectual ability	YES , first medical use claim type, patentable	54(4)
Product X for the treatment of cancer	YES , second medical use claim type	54(5)
Product X for the treatment of tooth decay	YES , further medical use claim type	54(5)

Protocol on interpretation of Art. 69

New Article 2:

- **"Equivalents**
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."**

Request for information

Amendments to Art. 124 and new Rule 141:

- The applicant may be invited by the Office 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

Attorney evidentiary privilege

Amendments to Article 134a(1)(d) and new Rule 153:

Professional secrecy:

- A professional representative 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
- = US attorney-client privilege

Transitional provisions

General rule:

- EPC 2000 applicable not only to
 - patent applications filed after date of entry into force
 - patents granted in respect of such applications
- but also to...
 - patent applications pending at the date of entry into force
 - patents already granted at that date
- but beware that..
 - **exceptions apply!**

See: Official Journal, Special Edition No. 1 of 2007, p. 196 - 198, and Annex II, p. 217 - 228

Additional information

For the basic legal texts:

See **Special Edition No. 1, Official Journal of 2007**

For a self-tutorial:

Visit the European Patent Academy page on the EPO website: EPO web resources >

"European Patent Academy" >

"EPC 2000 e-learning module"

http://academy.epo.org/e_learning/epc_2000/player.html

For additional legal texts and information:

Consult the EPO website: Focus > "EPC 2000"

<http://patlaw-reform.european-patent-office.org/epc2000/index.en.php>



Thank for your attention

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20th April 2007

