

EPC 2000

- Limitation proceedings

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Limitation proceedings (LP)

Art. 105-1105c, Art. 68, R 90 - 96

- Field of application
- Purpose and significance
- Subject of proceedings
- Requirements of request
- Precedence of opposition proceedings
- Examination and decision as to allowability
- Publication/amended European patent specification

Field of application

- Limitation/revocation can be requested for EPs which are
 - **already granted when EPC 2000 enters into force**
 - granted for applications pending at that time or filed subsequently
(Council decision of 28.06.2001, Article 1, point 2)

Purpose and significance

- Central limitation or revocation of EP by administrative procedure is designed to
 - avoid disputes over validity of EP
 - enhance legal certainty
- Central review of EP currently available only in opposition proceedings
 - "self-opposition" by patent proprietor ruled out since G9/93 (OJ EPO 1994, 891)
- National LPs differ and are only provided for in some contracting states (AT, CH, DE, DK, IT, UK)

Subject of proceedings

- EP as **granted** or as **amended** in
 - opposition or
 - limitation proceedings

R 90

before the EPO

 **NO** European LP for versions of EP from national proceedings

Requirements of request

- Only the **patent proprietor** can make a request
- Several or different patent proprietors
 - details of further patent proprietors + evidence of their approval under R 92(2)(c)

Art. 105a, R92(2)(a)

Requirements of request

- Written request to EPO

Art. 105a, R 92(1)

- at any time after grant of EP
- subject to legitimate interest, even after EP has lapsed

Art. 97(3)

- Request not deemed to be made until **fee** is paid

Art. 105a(1)

- limitation fee: € 1 000
- revocation fee: € 450
- possibility of fee reduction under R 6(3) in conjunction with Art. 14(1) RFees, Art. 14(4)

Art.2 No. 10a
RFees

R 6(3)

Contents of request/documents

- Indication of requester R 92(2)(a), R 41(2)(c)
 - and contracting states for which he is patent proprietor
- Number of EP concerned
 - and list of contracting states in which EP has taken effect
- Indication of other patent proprietors R 92(2)(c)
 - and evidence that requester is entitled to act on their behalf
- **Where limitation of EP requested**
 - **complete version of amended claims**
 - as the case may be, amended claims under Rule 138
 - as the case may be, amended description and drawings
- as the case may be, particulars of representative R 92(2)(c)

Responsibility for proceedings

- **Examining Division** decides on limitation or revocation

R 91, Art. 18(2)

- ***ex parte*** proceedings
 - observations by third parties possible under Art. 115

Precedence of opposition proceedings

- **Opposition proceedings pending** at time of filing request

Art. 105a(2), R 93(1)

- request deemed not to have been filed
- reimbursement of limitation/revocation fee

- **LP pending** at time of filing opposition

- LP terminated
- reimbursement of limitation fee and, where applicable, fee for printing

R 93(2)

R 95(3)

- **BUT:** R 93(2) does not apply to revocation of EP

Examination and decision

- Valid request
 - **No**: info to requester that request not valid
- Precedence of opposition proceedings
 - **Yes**: info to requester + reimbursement of fees
- Admissibility of request
 - requirements fulfilled?
 - deficiencies, if any, corrected in due time?
 - **No**: refusal of request as inadmissible

Art. 105a(1)

Art. 105a(2), R 93

R 94, R 92

Examination and decision

- Admissibility of request for **revocation** R 95(1)
 - no separate examination: EP revoked if request admissible
 - communication to requester, indicating date of publication of decision
- Admissibility of request for **limitation** R 95(2)
 - do the amended claims constitute a limitation vis-à-vis the claims as granted/amended?
 - **no limitation** where amendment leads to an *aliud* or is purely for clarification

Examination and decision

- Requirements of **Art. 84, 123(2) and (3)** fulfilled?
 - also, where appropriate, with regard to the description?
- ⊘ **No examination** as to patentability of the residual patent under Art. 52-57
- **Requirements for limitation fulfilled**
 - invitation to file translations of amended claims + payment of publication fee
 - time limit: 3 months + grace period under R 82(3)
 - acts under R 95(3) performed in due time
 - Examining Division decides to limit

R 95(3)

R 95(3)

OTHERWISE: request refused

R 95(4)

Examination and decision

- **Requirements** for limitation **not fulfilled**
 - Examining Division gives requester one opportunity to correct deficiencies and amend claims and, where appropriate, description and drawings
 - time limit: to be set by EPO
 - **requirements fulfilled** after correction of deficiencies/amendment
 - procedure according to R 95(3)

R 95(2)

R 84

OTHERWISE: request refused

R 95(4)

Publication/amended European patent specification

- Revocation or limitation of EP takes effect on publication in European Patent Bulletin
 - *ab initio* effect of revocation or limitation
- amended European patent specification where EP is limited

Art. 105b(3)

Art. 68

Art. 105c, R96, R 73(2), (3), R 74

**Thank you for
your attention!**