

15 June 2007


Briefing Note on EPC2000

In the year 2000, an amended version of the European Patent Convention ("EPC") was agreed, and this became known as "EPC2000". The new law must take effect by 13 December 2007 and is expected to enter into force exactly on that date, although there is a possibility that it will take effect before this date, depending on when the final EPC contracting state adopts the treaty into its national law. The EPC2000 will apply to all European patents granted at the date the EPC 2000 takes effect and retrospectively to all European patent applications pending at the time.

The driving forces behind the changes included the need to update the EPC to take into account developments in international law e.g. TRIPS and the Patent Law Treaty and also the desire to streamline the articles of the EPC by transferring many of the provisions to the Implementing Regulations. There were also several substantive changes to the provisions.

Executive Summary

- Central limitation and revocation of granted European patents at the European Patent Office ("EPO")
- Restriction of number of searches available for Euro-PCT applications
- Opportunity in limited circumstances to petition for a review of Board of Appeal decisions by the Enlarged Board of Appeal
- Expanded availability of "further processing" with corresponding reduction in availability of re-establishment of rights
- Authority for the EPO to request details of prior art relied upon in other jurisdictions
- Affirmation of the allowability of second medical use claims and simplification of claim form



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Important Changes

Many of the provisions of the EPC will for practical purposes remain unchanged. However, the most significant changes are summarised below:


Central Limitation and Revocation

(Articles 105(a), (b) and (c), Rules 90 to 96 EPC)

Currently, post-grant amendment can only be carried out at national Patent Offices, each of which has differing requirements. A new procedure has been introduced which will allow a granted European patent to be limited or revoked ab initio at the request of the proprietor. The European Patent Office ("EPO") will examine limitation requests to ensure that they do actually limit protection, are clear and do not add matter over the application as filed, but there will be no examination of patentability of the amended claims. Requests for limitation or revocation may not be filed if an opposition is pending and requests may be stayed if an opposition is filed after a request for limitation.

Restriction of EURO-PCT supplementary searches to a single invention (Rule 164 EPC)

Currently, the Applicant of a Euro-PCT application which is deemed to include multiple inventions has the option of requesting additional searches to ensure a supplementary European search report will be drawn up on any claimed invention. Under EPC2000, European supplementary search reports drawn up in respect of Euro-PCT applications not searched by the EPO in the international phase will be restricted to the first mentioned invention in the claims. Claims relating to all other inventions will have to be placed in divisional applications to be searched. This represents a severe limitation in comparison to previous procedure and will force Applicants to either file multiple International applications or multiple divisional applications. If an early indication of the patentability of all claims is desired, the EPO shall be considered as the International Searching Authority the necessary search fees paid to ensure several groups of inventions and searched in the International phase. A decision as to which group is pursued in the European phase can then be taken at the time of entry into the regional phase.



Petition for Review by the Enlarged Board of Appeal (Article 112a and Rules 104-110)

A further new procedure introduced by EPC2000 is the petitioning for review of appeal decisions by the Enlarged Board of Appeal, in the event of a fundamental procedural defect or the occurrence of a criminal act which may have had an impact on the decision. Cited examples of fundamental defects include failure to arrange requested oral proceedings or a failure to decide on a relevant request. We expect this provision to give rise to a large body of case law over time as unsuccessful applicants explore the boundaries of the meaning of a fundamental violation.

Enlarged Applicability of Further Processing/ Reduced Applicability of Re-establishment of rights (Article 121, Rule 135 EPC)

The automatic further processing procedure will become the standard legal remedy for failure to observe time limits. Further processing will be allowed in the event of failure to observe time limits such as payment of filing fees, search fees (although not for payment of further search fees in the case of non-unity) and request for examination. Time limits which are excluded from further processing e.g. non-observation of the time limit for paying renewal fees will be listed in the Implementing Regulations.

A consequence of the expansion of further processing is that the discretionary re-establishment of rights has been limited considerably to only those time limits for which further processing is not permitted. Re-establishment of rights has been extended to the deadline for filing an application claiming priority and it will now be possible to file an application with a claim to priority up to 14 months from the filing date of the earliest priority claim, provided it can be shown that all due care was exercised in attempting to meet the standard 12 month deadline.

Priority (Article 87)


A provision has also been included in EPC2000 which aligns it with TRIPS by extending a priority right to first filings in any WTO state. In addition, the EPC has also been amended to allow late claiming of priority or correction of priority information, provided that the correction or addition of the priority claim is filed within sixteen months from the priority date claimed.

Obtaining a Filing Date (Rule 40 EPC, Rule 56 EPC)

The requirements for obtaining a filing date have been moved from previous Article 91 to the Rules, so enabling the EPO to have more flexibility in the future regarding the content and form of applications. EPC2000 will abolish the requirement to file a description on filing; a reference to a previous application will suffice to obtain a filing date. It will not be necessary to include claims in the application to obtain a filing date, although they will have to be filed within two months of the filing date. A certified copy of the previous application will have to be filed within two months, together with a translation of the earlier application if it is not in one of the official languages of the EPO.

Information on Prior Art (Article 124(1) and Rule 141 EPC)

EPC2000 has introduced for the first time a "duty of disclosure". The EPO will be entitled to ask for information on prior art taken into consideration in the examination of national or regional patent applications. This provision shall apply to European patent application pending at the time of EPC2000 entry and to European patents already granted at this time. If the information is not provided within a deadline set by the EPO, the application will be refused. It is not yet apparent if and how the EPO will request such information or whether this will be applied on a continuing basis. It is also not clear how the provision will interact with corresponding overseas requirements. For example, there is presently no information as to whether all prior art contained in an IDS of a US application will be required or simply those pieces of prior art relied upon in US Office Actions.



Second medical use claims - allowability affirmed

Previously, further medical uses of known products could only be protected using so-called "Swiss-type" claims. EPC2000 has affirmed the allowability of claims to further medical uses of known products and has simplified the situation by allowing claims in the form "Product X for use in treating Y". This will be applicable to all European applications pending when EPC2000 comes into force.

Determination of protection conferred by the claims (Article 69 EPC)

The Protocol on Interpretation of Article 69 has been amended to make explicit that equivalents of elements specified in the claims should be considered when considering the scope of the protection conferred by the claims. The amendment of the Protocol is an attempt to harmonise claim interpretation across Europe although ultimately interpretation will remain an issue for national courts.

Prior Art Effect of so-called "intermediate" European applications (Article 54(3))

European practice includes a concept of "novelty-only" prior art whereby a European patent application which has an earlier priority or filing date but which is unpublished on the filing date of a later European application is citable against the novelty of the later application. Under the previous EPC, the earlier application was prior art only in designated EPC states which were overlapping with the later application. Currently, the overlap of states can depend on whether designations of states are withdrawn. This led to situations in which claims of differing scope were granted for different EPC states. Once EPC2000 comes into force, every European application will automatically be considered to cover all EPC contracting states on filing and therefore will have the capacity of acting as "novelty-only" prior art against a later filed application for all EPC contracting states. It will also retain its prior art status regardless of how many designation fees are paid or whether any states are withdrawn.

Late Furnishing Fee for sequence listings

EPC2000 has amended the provisions for late furnishing of sequence listings to bring them into line with the PCT. If a sequence listing is not filed with the application, the EPO will ask the Applicant to furnish it and pay a late furnishing fee within two months. The sanction for not doing so is refusal of the application.

If you have any further questions regarding the implementation of EPC2000, please contact Jonathan Atkinson on +44 (0) 113 233 0100 or email jatkinson@hgf.com

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