

New EPC 2000

In November 2000, a conference was held to discuss possible amendments to the European Patent Convention (EPC). This was the first major review of the EPC since it was concluded in 1973, and the outcome of the conference was the formulation in a Resolution of fairly extensive amendments to the EPC. The new law, including these amendments, is known as “EPC 2000”.

Entry into force

EPC 2000 came into force on 13th December 2007 and applies to new European patent applications filed after this date. Depending on the circumstances, some parts of EPC 2000 also apply to applications pending or granted on 13 December 2007.

Amendments

As mentioned above, the amendments made were fairly substantial and some of the most significant changes are discussed below.

Languages of the EPO (Article 14)

The requirement that a European patent application must be filed in English, French or German has been removed for applications filed after the new EPC provisions came into force. If a European patent application is filed in any other language, it must be translated into English, French or German in accordance with the Implementing Regulations. The time limit for filing the translation is two months from filing the application. If the translation is not filed within one month, the EPO will issue an invitation setting a two month grace period during which the translation must be filed. If the required translation is not filed in due time, the application shall be deemed to be withdrawn.

Date of Filing (Article 80)

A new rule (Rule 40) specifies that, in order to obtain a European filing date, all that is required is:

- a) an indication that a European patent is sought;
- b) identification of the applicant; and
- c) a description or a reference to a previously filed application (including filing date, number and Office at which it was filed).

When a reference to a previously filed application is used in place of a description, a copy of the previously filed application (and translation if necessary) must be filed within two months of the filing date.

Examination on Filing (Article 90)

A new rule (Rule 56) has been added which allows the applicant of European patent applications undergoing examination on filing after the amendments came into force to correct (within two months of the date of filing or of a notification from the EPO) any deficiencies in the description and/or drawings. If the deficiencies are rectified, the application will be re-dated to the filing date of the missing parts unless the applicant withdraws the late filed description/drawings within one month of filing them, or the application claims priority and the missing description/drawings were completely contained in the priority application. In which case the application will keep its filing date (provided the applicant so requests and files a copy (and translation if necessary) of the priority application and identifies the missing parts for the EPO).

Designation of Contracting States

The amended EPC states that at the time of filing of a new application, all Contracting States shall be deemed to be designated. The relevant Article (Article 79) then states that the designation of a Contracting State may be subject to the payment of a designation fee. It therefore seems possible that designation fees may eventually be eliminated and possibly replaced with a single fee, but this is not yet provided for in the amended Implementing Regulations, so payment of designation fees is still required.

Priority (Article 87)

It is now possible to claim a priority right in new applications if a relevant application is filed in or for any Member of the WTO in addition to the usual Paris Convention provisions.

Under the new Implementing Regulations, it is possible to add or correct a priority claim up to 16 months from the earliest priority date (provided early publication has not been requested).

Restitutio (re-establishment of rights) is possible if, despite all due care having been taken, the priority time limit is missed, provided that an application for restitutio is made within two months of the priority time limit expiring.

Relevance of Prior Art (Article 54(3))

Under the old EPC an intervening European patent application, i.e. an earlier application filed before but published after the priority date of a later application, was prior art (for novelty purposes only) only in so far as a contracting state designated in respect of the later application was also designated in the earlier application as published.

The requirement for overlapping states has now been removed for all applications filed after 13 December 2007, so the intervening European patent application is relevant to all states designated in the later application (but still for novelty purposes only). The old requirement for overlapping states continues to apply to any applications pending when the changes were implemented.

Subsequent medical use claims

Under the old EPC it was only possible to claim a second medical use of a substance by using what is called “Swiss-type” claim wording, resulting in what is essentially a process claim. Under EPC 2000, it is possible to claim subsequent medical uses as product claims provided that the claim is directed to a product for a specific medical use. This applies to any application filed after 13 December 2007, and to applications that were pending and on which a decision to grant a patent had not yet been issued on that date.

Information on Prior Art (Article 124)

The EPO is now entitled to invite the applicant to provide information on prior art found in other national or regional application proceedings. This applies to all pending patent applications and granted patents as well as to new applications filed after the new provisions came into force. Failure to provide such information could lead to withdrawal of the application. This appears to be a first step towards US-style disclosure statements.

“Further processing” (Article 121)

The provisions relating to “further processing” have been vastly expanded in scope. New Article 121(1) reads “*If an applicant fails to observe a time limit vis-a-vis the European Patent Office, he may request further processing of the European patent application*”. Thus, further processing now relates to any time limit rather than just those set by the EPO, and the requirement that the failure to observe the time limit results in the refusal or withdrawal of the application is removed. These provisions apply to all patent applications, whether or not they were filed before EPC 2000 was implemented, as long as the time limit for requesting further processing had not expired on 13 December 2007.

The exceptions which are not subject to further processing are the priority time limit, the time limit for filing an appeal and the time limit for filing a petition seeking a review of a decision of a Board of Appeal. There are further exceptions mainly relating to time periods for which a grace period or some other legal remedy applies, e.g. the six month grace period for the payment of renewal fees.

Post-grant central amendment (new Article 105a)

Under the old EPC, it was not possible to amend a European patent as a whole. If a new piece of relevant prior art came to light after the European patent was granted, it was necessary to amend the European patent nationally in each of the states in which it was in force. This was time consuming and very expensive.

It is now possible for the proprietor to request amendment of the claims (called “limitation”) or revocation of a granted European patent centrally at the European Patent Office (EPO), the amendments being effective for all states in which the patent is in force. Requested claim amendments are examined for clarity (Article 84), added subject matter (Article 123(2)) and extension of protection (Article 123(3)) requirements, and a single opportunity is given to correct any deficiencies under these provisions. If the amendment is allowed, the European patent will be republished in its amended form. There is no set time limit within which amendment or revocation must be requested. The new amendment or revocation process is available for both new patents and those granted before the EPC amendments came into force.

Protocol on the Interpretation of Article 69: Equivalents

The protocol on the interpretation of Article 69 (which relates to extent of protection) has been amended to include a new Article which relates to equivalents and reads “*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*”.

This means that during infringement proceedings “account” will be taken of elements that may not fall directly within the claim if the element is an equivalent to a claimed feature. This applies to both new patents and those granted before the amendments came into force.

The proposals to introduce (1) a definition of the term “equivalents”, (2) a reference to the point in time at which equivalency should be determined and (3) a reference to file wrapper estoppel were abandoned, which was welcomed by the UK delegates but leaves the new Article somewhat unclear in meaning.

Petition for Review by the Enlarged Board of Appeal (new Article 112A)

In the event that a party to appeal proceedings is adversely affected by the decision of the Board of Appeal, they are now able to file a petition for review of the decision by the Enlarged Board. However, this may only be done under fairly restricted circumstances, for example if the Board of Appeal included a person not appointed as a member of the Appeal Boards, or the decision was affected by a “criminal act” as established by a competent court or authority or a fundamental procedural defect has occurred. This petition is available on all Board of Appeal decisions issued after 13 December 2007.

Unity of invention

Significant changes have also been made to the way in which the EPO will assess unity of invention for PCT applications entering the EP regional phase. See our separate information sheet about this.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com.

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