KADOR & PARTNER

SUPPLEMENT TO

NEWSLETTER

EPC 2000

- The implementation of the EPC 2000
- Consequences for the Practicioner
- Summary of the most important issues

80496 München
Corneliusstraße 15
Phone: +49 89 2015252
Fax: +49 89 2015242
+49 89 2014454
mail@kadorpartner.com

London SWIV 1QL
99 Warwick Way
Phone: +44 20 78348589
Fax: +44 20 76300286
mail@kadorpartner.com

03001 Alicante
Castaños 10 - Atico 3
Phone: +34 965 215758
Fax: +34 965 215758
mail@kadorpartner.com

www.kadorpartner.de

I. ENTRY INTO FORCE AND STATUS OF RATIFICATION

The EPC 2000 will enter into force on December 13, 2007.

As of the time of printing this Newsletter, most of the Member States to the EPC 1973 have already ratified the EPC 2000, and it can be assumed that also the remaining Member States will timely ratify the EPC 2000. Thus, none of the Member States will cease to be party to the EPC 2000 **(Art. 172(4) EPC**) and hence all Member States to the EPC 1973 will also be Member States to the EPC 2000.

Furthermore, **Norway** and **Croatia** will accede the EPC 2000 as of 01.01.2008.

II. PATENTABILITY

Most of the regulations according to Arts. 52 to 57 relating to the basic requirements for patentability remain unchanged. However, Art 52(1) now expressis verbis states that "*European Patent shall be granted … in all fields of technology…"* so that the requirement of technicity of an invention, which had to be fulfilled under the EPC 1978 in accordance with the Case Law of the Boards of Appeal, is now part of the statutory law. Thus, computer programs and business methods as such are still exempt from patentability.

Furthermore, former Art. 52(4) directed to the non-patentability of methods of treatment of the human or animal body by surgery or therapy and diagnostic methods has been transferred to new **Art. 53 c)** for reasons of legal systematics.

Art. 54(4) of the EPC 1973 has been deleted so that now prior unpublished European filings are state of the art under Art 54(3) for a later European application regardless of which Member States had been designated in the prior applications.

New **Art. 54(5)** now opens the possibility to formulate second medical indication claims as product claims in the form: "Substance X for the treatment of disease Y". Such claims may thus be used in addition to or instead of the so-called "Swiss-type claims" which had to be formulated under the EPC 1973 in the form: "Use of a substance X for the production of a medicament for the treatment of disease Y."

III. EXAMINATION ON FILING/ FORMAL REQUIREMENTS

1. Language of the Application

Under the EPC 2000 an EP application may be filied in **any** language. A **translation** into one of the offial languages (DE, EN, FR) must be filed within 2 months of filing the application **(Art. 14(2), R 6(1)).**

2. Filing Date

For assigning a filing date, it is now sufficient that an application contains an indication of the applicant, a description and a request that a European Patent is sought **(Art. 80, R. 40 (1))**. Hence, claims are no longer required in order to obtain a filing date. However, it is highly recommendable to file applications with claims because the later filing of claims will create serious problems, e.g. with regard to Art. 123(2) (added matter), during prosecution and possible opposition procedures.

For filing an application, the applicant may now refer to a previously filed application **(R. 40(1) c))**. The reference means identity of documents and **must not** be supplemented by additional disclosure not forming part of the previously filed application. The filing date, application number and filing office of the previously filed application must be given in the request. This **reference** will replace the description, drawings and optionally claims of the EP application. **(R. 40(2))**. A certified copy of the previously filed application and , if any, a translation into one of the official languages must be filed within 2 months of the filing date **(R. 40(3))**.

3. Sequence Listing

If the EP application does not contain a sequence listing complying with the requirements of the EPC at the filing date, the EPO will request to that such a listing is filed within 2 months of a respective communication together with a **late filing fee** of 200 EURO **(R. 30(3))**. If these requirements are not complied with, the EPO will refuse the application.

IV. PRIORITY

Priority may now be claimed not only on the basis of an earlier application filed within a member state of the Paris Convention, but also filed within a WTO member state **(Art. 87(1))**. As the EPC 2000 enters into force on December 13, 2007, the EPO will accept a WTO priority claimed in a PCT application entering into the EP regional phase only if the PCT application has a filing date of or after December 13, 2007.

The declaration of priority may still be made or corrected within 16 months from the earliest priority date claimed **(R. 52(2)** and **R. 52(3))**.

A translation of the priority application into one of the official languages is only necessary if the validity of the priority claim is relevant for determining the patentability of the EP application. The EPO will invite the applicant or patentee to file such a translation **(R. 53(3))**.

V. SCOPE OF PROTECTION

Art. 69 defining the scope of protection of European Patents has been amended to now read:

"(1) The extent of protection conferred by a European patent or a European patent application shall be determined by the claims."

In contrast, Art. 69 of the EPC 1973 prescribed that: "*(1) The extent of protection … shall be determined **by the terms** of the claims."*

It remains to be seen how this amendment in wording will be interpreted by the national courts responsible for infringement proceedings and hence for the determination of the scope of protection of European Patents.

However, as far as Germany is concerned it is expected that the amendment will not affect the existing jurisdiction so that the previous case law may also be applied to future cases.

Furthermore, a second paragraph has been added to the Protocol on interpretation of Art. 69 EPC:

"*(2) 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".*

As the protocol to Art. 69 is integral part to the EPC, it is now expressis verbis required from infringement courts in all member states of the EPC to include equivalents of the claimed subject-matter into the scope of protection. This has been long-standing case law in Germany.

VI. LIMITATION PROCEDURE

The patentee has now the opportunity to request limitation or even revocation of his patent **(Arts. 105a, 105b)**. The limitation procedure is an ex-parte procedure, submissions of a third party are possible. The patentee has to file amended claims to limit the patent **(R. 92(2) d))**. The Examining Division will decide whether the amended claims constitute a limitation vis-à-vis the granted claims and whether the claims are clear **(Art. 84)** and do not violate **Art. 123(2) and (3) (R. 95(2) EPC)**. Other requirements of the EPC are not examined. The EPO will issue a new EP specification after payment of publication fee and translation of the amended claims into the official languages by the patentee. **(R. 95(3) EPC)**. The amended specification must be translated, if the respective contracting state so requires **(Art. 65(1) EPC)**.

Limitation request may not be filed if opposition proceedings are pending **(Art. 105a(2), R. 93(1) EPC)**. The limitation procedure will be terminated as soon as an opposition is filed with respect to the European patent and the **limitation fee** (€ 1000.-) is reimbursed. If the patentee has requested revocation of its patent, the request has, however, priority vis-à-vis an opposition proceedings.

The limitation will take effect ab initio in all contracting states and may overrule a limitation in a national nullification proceedings, in case the scope of the EP after the limitation procedure is

narrower than the scope according to the national nullification proceedings.

VII. PETION FOR REVIEW BY THE ENLARGED BOARD OF APPEAL

A party to an appeal proceedings may have the decision by the Appeal Board reviewed by the Enlarged Board of Appeal based on quite restricted grounds **(Art. 112a(1) and (2))**. Admissible grounds are fundamental procedural defects **(Art. 112a(2) d) and R. 104)**, fundamental violation of the right to be heard **(Art. 113)**, a criminal act had impact on the contested decision **(R. 105)** or wrong composition of the Board of Appeal issuing the contested decision **(Art. 112a(2) a) and b))**.

Any person who, in a designated Contracting State has in good faith used or made effective and serious preparations to use the patented invention between publication of an Appeal Board decision and the publication of the decision on the petition may without payment continue such use in the course of his business or for the needs thereof (Art. 112a(6))

VIII. FURTHER PROCEDURAL LAW

The possibility of requesting **further processing** after failure of the applicant to observe a time limit vis-à-vis the EPO has been extended **(Art. 121(1))**. Further processing is in various but not in all circumstances now also applicable in case the applicant has failed to observe a legal time limit vis-à-vis the EPO. In case of late payment of a fee, the fee for further processing is 50% of the respective fee, in all other case € 210.-.

The **attorney-client priviledge** has been implemented in **Art 134a(1) d), R. 153**. Accordingly, the representative has the right in proceedings before the EPO to refuse to disclose communications to his clients which might constitute confidential information.

IX. PCT-EP APPLICATIONS

Before the EPO as designated office in case of **non-unity** an application must be restricted to an invention which was searched either in a supplementary Search Report drawn up by the EPO or in the International Search Report drawn up by the PCT Search Authority. **The EPO no longer invites the applicant to pay additional search fee(s)**. Non searched inventions can only be prosecuted in a divisional application.

X. TRANSITIONAL PROVISIONS

The EPC 2000 will apply to all applications filed after its entry into force, i.e. to all applications as file on or after December 13, 2007.

However, the provisions of the EPC 2000 will apply also to pending applications filed before December 13, 2007 and granted patents wherever possible.

For example, Art 54(5) EPC 2000 giving the possibility to formulate second medical indication claims as product claims is applicable also to pending applications, so that such claims may be included during the examination procedure.

A detailed list which provisions (that of the EPC 1973 or the EPC 2000) apply to applications filed before December 13, 2007 and further useful information on the EPC 2000 is given in:

Special edition No. 1 Official Journal (OJ) EPO, 2007, pages 221 to 224,

which is available on-line under:

http://www.european-patent-office.org/epo/pubs/oj007/ 01_07/special_edition_1_epc_2000.pdf