

## **EPC2000: A REVISION OF THE EUROPEAN PATENT CONVENTION**

A complete revision of the European Patent Convention, known as EPC2000, will enter into force no later than 13 December 2007. Many changes to the Convention are to be introduced, of which the following are among the more significant, in terms of possibly requiring our clients to alter their current practice. A fuller analysis is available on our website.

### ***Language Requirements***

At present, European applications must be filed in one of the three official languages (English, French and German), except in the case of applicants who are residents in, or nationals of, an EPC country with a different official language. This requirement will be relaxed such that an application can be filed in *any* language. A translation will still be required, within two months of the filing date.

### ***Sequence Listings***

A fee for the late furnishing of sequence listings will be introduced. We suggest that you start to send us the electronic sequence listing data together with your instructions for any new patent application.

### ***Second Medical Use***

Protection for a second (or subsequent) medical use of a compound will continue to be possible, but via the 'first medical use' claim format instead of (or possibly as well as) the current "Swiss style" claiming. A separate newsletter has been prepared on this issue. We are recommending that both formats be included from now on.

### ***Designations***

By default, all contracting states will be deemed designated on filing (provided that any necessary fees are paid). Hence, once EPC2000 comes into force, it will no longer be necessary to tell us which states to designate. It will, however, be necessary to tell us about any *extension states* that you wish to be covered, or any contracting states that you wish positively *not* to cover.

### ***Filing Requirements***

In order to be allocated a filing date it will be necessary to provide only:

- an indication that a patent is sought;
- information sufficient to identify and contact the applicant; and
- a description in any language *or* a reference to an earlier application (identifying its date, number and patent office).

The new rules may be useful in the (hopefully rare) situation in which you are unable to transmit a specification to us and can only identify an earlier application.

### ***Priority Claims and Documents***

Applications filed in states that are either a party to the Paris Convention or member of the World Trade Organisation (or both) will be able to form the basis of a priority claim, rather than only parties to the Paris Convention, as at present. This affects applicants in only a few countries, including Pakistan, Brunei and Myanmar.

A translation of the priority document will be required only if the examiner deems that its content is likely to be relevant to the examination of the application.

### ***Limitation and Revocation***

A new 'limitation and revocation' procedure will be introduced. This will provide a way for the proprietor of a European patent to limit the claims at any time after grant. It will not be necessary to explain why the amendment is sought. The EPO will not examine the amendment for patentability and will not have discretion to refuse the limitation, provided that the claims are clear and supported, and the amendment does not add subject matter or extend the scope of protection afforded by the patent.

### ***Petition for review by Enlarged Board***

This new procedure will provide a way for a party adversely affected by a decision of an EPO Board of Appeal to have the decision reviewed by the Enlarged Board of Appeal, but *only* on the grounds that: a Board member was partial or unappointed; there was a fundamental violation of the applicant's right to be heard; some other fundamental defect defined in the regulations occurred; or a criminal act had an impact on the decision. Hence, it will not be possible effectively to file a further appeal simply on the basis that the Board got its decision wrong in law or on the facts of the case. We think that very few such petitions will be successful.

### ***Information from parallel applications elsewhere***

In line with global trends for patent office practice, the EPO will be able to request information on prior art taken into consideration in non-EPO patent applications (i.e. prior art that has been relied upon by the examiner in those other jurisdictions). It appears that there will be no sanction for not complying with this.

### ***Unity of invention for Euro-PCT applications***

The EPO will only examine inventions covered either by an international search report or by a supplementary search report. At the EPO, an applicant will therefore only be able to have a further invention searched and examined by filing a divisional application. It may, however, still be possible to have multiple inventions searched on a PCT application, depending on the international searching authority.

Please ask your usual contact at Eric Potter Clarkson LLP for further information.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at [www.eric-potter.com](http://www.eric-potter.com).

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