

EPC2000: A REVISION OF THE EUROPEAN PATENT CONVENTION

A complete revision of the European Patent Convention, known as EPC2000¹, will enter into force no later than 13 December 2007². Many changes to the Convention are to be introduced, of which the following are among the more significant.

This is an expanded and annotated version of the alerting newsletter that we sent to our clients in April 2007.

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. An application under EPC2000 can be filed in any language³. A translation will, however, still be required, within two months of the filing date⁴.

Patentability

The exclusion of inventions the publication or exploitation of which would be contrary to *ordre public or* morality will be narrowed to provide for exclusion only where their commercial exploitation would be contrary to *ordre public/morality*⁵.

Sequence Listings

A fee for the late furnishing of sequence listings will be introduced⁶. We suggest that you start to send us the sequence listing data together with your instructions for any new patent application.

Novelty

Currently, European applications which have an earlier effective filing date than the subject application but which were published after this date are treated as prior art for the purposes of assessing novelty⁷. The application of this principle is limited to the extent that the valid designations are the same. As such, the full impact of such a document does not become apparent until the designations fees are paid. This requirement will be removed under EPC2000. Previously published European applications will become prior art as soon as the European filing fee is paid, regardless of the eventual designated states⁸. This change will have effect for applications filed after EPC2000 comes into force.

¹ Full text and associated Regulations and Guidelines are available from the EPO website, at <http://www.epo.org/patents/law/legislative-initiatives/epc2000.html>

² The entry into force date may be earlier, depending on when the last member ratifies the Convention.

³ Article 14 EPC2000

⁴ Rule 6 EPC2000

⁵ Article 53 EPC2000

⁶ Rule 30(3) EPC2000; Rules relating to Fees, Article 14a

⁷ Article 54(3) EPC

⁸ Rule 165 EPC2000

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.

Divisional Applications

All states designated in the parent application will be automatically deemed to be designated for the divisional application under EPC2000⁹, as opposed to the current situation where it is not necessary to designate all the countries designated for the parent in the divisional.

In addition, the divisional application will be required to be filed in the language of the parent.

Designations

All contracting states will be deemed designated in the request for grant¹⁰. It will, of course, still be possible to positively withdraw designations or allow these to be deemed withdrawn through failure to pay the designation fee, although this will not affect the status of the application for prior art purposes (see above).

Filing Date

In order to be allocated a filing date under EPC2000 it will be necessary to provide¹¹:

- An indication that a patent is sought;
- Information sufficient to identify and contact the applicant; and
- A description in any language or reference to an earlier application.

Accordingly, claims will not be required at the time of filing. However, we strongly suggest that all patent applications should contain the claims on filing.

In order to file by reference to an earlier application, it will be necessary to supply the date, number and office of the application¹². A certified copy must be supplied within two months of the date of filing the European application, and be accompanied by a translation if necessary¹³. In practice, if either document is not filed in time, the EPO will issue an invitation to comply with the deadline. This will set a two month deadline before the application is deemed to be withdrawn.

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 claim¹⁴, rather than only parties to the Paris Convention, as at present.

⁹ Article 76 EPC2000

¹⁰ Article 79 EPC2000

¹¹ Rule 40 EPC2000

¹² Rule 40(2) EPC2000

¹³ Rule 40(3) EPC2000

¹⁴ Article 87 EPC2000

However, this affects very few countries (Angola, Brunei Darussalam, Dominican Republic, Fiji, Kuwait, Republic of Myanmar, Maldives, Namibia, Pakistan, Solomon Islands and Thailand).

The requirement that a priority document must be translated into a language of the office before grant will be removed. In future a translation will be required only if the examiner deems that the content of the priority document is likely to be relevant to the prosecution of the application¹⁵.

Provisions will be introduced for making a late declaration of priority up to the earlier of:

- 16 months from the priority date to be claimed; and
- the making of a request for early publication.

It will also be possible to correct a priority claim up to the earlier of:

- 16 months from the recorded earliest claimed priority;
- 16 months from the corrected earliest priority date;
- 4 months of filing; and
- the making of a request for early publication.

Limitation and Revocation

A new limitation and revocation procedure will be introduced¹⁶. 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 patent¹⁷.

Petition for review by Enlarged Board

This new procedure¹⁸ 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, 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; another fundamental defect defined in the regulations occurred; or a criminal act may have 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.

Further processing

The 'further processing' procedure, whereby a lapsed patent application can be restored as of right, will be applicable in situations where, at present, only the more stringent *restitutio in integrum* procedure is available.

¹⁵ Rule 53 EPC2000

¹⁶ Articles 105a-c EPC2000

¹⁷ Rules 92, 93 EPC2000

¹⁸ Article 112a EPC2000

Re-establishment of rights

Restitutio in integrum will instead be termed re-establishment of rights¹⁹, but will be otherwise unchanged except for certain exclusions. These include any period for which further processing is available and the deadline for requesting re-establishment itself²⁰.

Requests for information

The EPO will be able to request information on prior art taken into consideration in non-EPO patent applications (i.e. relied upon by the examiner in those other jurisdictions)²¹. It appears, however, that there will be no sanctions for failing to comply with this.

Attorney-client privilege

Where advice is sought from a professional representative in his capacity as such, communications between the representative and his client or any other person relating to that purpose will be privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client²². Although UK patent attorneys' communications with their clients are (in appropriate circumstances) privileged anyway, this new provision is intended to ensure that continental European Patent Attorneys' communications (concerning EPO applications) are similarly privileged.

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 report²³. This is intended to bring the Euro-PCT procedure into line with the procedure applicable to applications filed directly into the EPO by limiting the opportunity to have multiple inventions searched.

The introduction of this new procedure will mean that an applicant will 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 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.

© Eric Potter Clarkson LLP 2007

N:0121a/cld/rsb/lc

4 May 2007

Park View House · 58 The Ropewalk · Nottingham · NG1 5DD · UK

Tel: +44 (0)115 955 2211

Fax: +44 (0)115 955 2201

E-mail: epc@eric-potter.com

Website: www.eric-potter.com

¹⁹ Article 122 EPC2000

²⁰ Rule 136 EPC2000

²¹ Rule 141 EPC2000

²² Rule 153 EPC2000

²³ Rule 164 EPC2000