

CA/PL 15/00

Orig.: German

Munich, 30.03.2000

SUBJECT: Revision of the EPC: Articles 99-105
DRAWN UP BY: President of the European Patent Office
ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains proposals to remove a number of details from Part V of the Convention (Opposition procedure) and transfer them to the Implementing Regulations.

I. INTRODUCTION

A. GENERAL

1. The opposition procedure is covered by Articles 99-105 in Part V of the Convention. The Implementing Regulations to this part (Rules 55-63 EPC) contain further details about the procedure. The present proposals for revising the EPC aim to remove a number of details from the Convention and transfer them to the Implementing Regulations, although **the principles of the opposition procedure will remain enshrined in the Convention itself**. Thus Article 100 EPC will remain unchanged. It is also proposed that Articles 99-105 EPC be partly restructured.

B. AMENDMENTS TO ARTICLE 99 EPC

2. In addition to the principle that any person can give notice to the EPO of opposition to a European patent, paragraph 1 of present Article 99 EPC also contains requirements for admissibility. Further requirements for admissible oppositions are currently laid down in Rule 55 EPC. All these requirements should be dealt with uniformly in the Implementing Regulations, especially as the legal consequences of an inadmissible opposition are already dealt with exclusively in Rule 56 EPC.
3. Paragraph 3 of present Article 99 EPC makes it clear that an opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated states. There is no need for this to be in the Convention itself. A similar situation is already covered by Rule 60(1), first half-sentence EPC, which stipulates that, if the European patent has been surrendered or has lapsed, the opposition proceedings may be continued by the European Patent Office on request. It is therefore proposed that paragraph 3 be deleted and incorporated into the Implementing Regulations.

C. AMENDMENTS TO ARTICLES 101 AND 102 EPC

4. Articles 101 and 102 EPC should be combined, partly re-structured and given extra clarification. The details of the opposition procedure covered by the relevant articles (Articles 101(2), 102(3)-(5) EPC) should be incorporated into the Implementing Regulations.
5. **New Article 101(1) EPC** has been amended to make it clear that the opposition division is **not obliged** to consider **all** the grounds for opposition referred to in Article 100 EPC. This clarification reflects the case law of the Enlarged Board of Appeal (G 10/91 (OJ EPO 1993, 420)), on which current practice is based.
6. The other principles relating to the examination of grounds for opposition according to Article 100 EPC as laid down by the Enlarged Board should be incorporated into the Implementing Regulations.

These principles may be summarised as follows:

The opposition division **is obliged** to examine only those grounds for opposition listed in the opponent's statement under Rule 55(c) EPC. In addition to this, the opposition division **may** in accordance with Article 114(1) EPC examine **of its own motion** any grounds for opposition under Article 100 EPC not submitted in the opposition **where said ground is relevant and prejudices the maintenance of the European patent**.

7. **New Article 101(2)(a) and (b) EPC** also contains a clarification. For the European patent to be revoked, it is sufficient for **one** of the grounds for opposition to prejudice its maintenance. The patent is maintained where **none** of the grounds for opposition prejudices its maintenance.
8. **New Article 101(3) EPC** should be given an additional, clarifying point. If the proprietor of the patent requests amendments during the opposition proceedings, the opposition division examines whether, with reference to **all** the provisions of the EPC, the substantive requirements for maintaining the patent are met. If the examination shows that they are, the patent is maintained as amended in accordance with Article 102(3) EPC (present wording). If the requirements of the Convention are **not** met, the opposition division revokes the patent. Article 102(1) EPC (present wording) provides for revocation of the patent only if the grounds for opposition prejudice its maintenance. This means that, strictly speaking, Article 102(1) EPC cannot provide the legal basis for revoking the patent if the patent as amended does **not** meet, for example, the requirements of Articles 84 or 123(3) or Rules 27 or 29 EPC. In such cases it has been the practice at the EPO for many years now to revoke the patent in accordance with Article 102(3) EPC (present wording), even though this provision does not expressly provide for revocation. For the purposes of clarification, it is therefore proposed that new Article 101(3)(b) EPC should contain **express** provision for the revocation of the patent as amended.

D. AMENDMENTS TO ARTICLE 103 EPC

9. The proposed version of Article 103 EPC does not contain any substantive changes. The content of a new patent specification should be laid down in the Implementing Regulations. The wording has been brought into line with that of new Articles 93 and 98 EPC.

E. AMENDMENTS TO ARTICLE 104 EPC

10. Each party to the proceedings must meet its own costs. However, the opposition division may decide on a different apportionment of the costs. Article 104(1), second half-sentence, and (2) EPC should be amended in such a way that the details of the requirements for such a decision and the procedure for fixing costs are transferred to the Implementing Regulations.

F. AMENDMENTS TO ARTICLE 105 EPC

11. It is likewise proposed that the details relating to intervention be transferred to the Implementing Regulations and that paragraph 1 be re-structured.

II. PROPOSED AMENDMENTS

Present wording	Proposed wording
Article 99 Opposition	Article 99 Opposition
(1) Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid.	(1) Any person may give notice to the European Patent Office of opposition to a European patent in accordance with the Implementing Regulations. [...]
(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.	(2) <i>Unchanged</i>
(3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.	(3) Delete
(4) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.	(4) becomes (3) <i>Wording unchanged</i>
(5) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. By derogation from Article 118, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request.	(5) becomes (4) <i>Wording unchanged</i>

Article 100

Grounds for opposition

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Article 101

Examination of the opposition

(1) If the opposition is admissible, the Opposition Division shall examine whether the grounds for opposition laid down in Article 100 prejudice the maintenance of the European patent.

(2) In the examination of the opposition, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Opposition Division shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself.

Unchanged

Article 101

Examination of the opposition Revocation or maintenance of the European patent

(1) If the opposition is admissible, the Opposition Division shall examine **in accordance with the Implementing Regulations** whether [...] **a ground for opposition under Article 100 prejudices** the maintenance of the European patent.

(2) If the Opposition Division is of the opinion that

(a) a ground for opposition under Article 100 prejudices the maintenance of the European patent, it shall revoke the patent;

(b) no ground for opposition under Article 100 prejudices the maintenance of the European patent [...], it shall reject the opposition.

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates

(a) meet the requirements of this Convention, it shall decide in accordance with the Implementing Regulations to maintain the patent as amended;

(b) do not meet the requirements of this Convention, it shall revoke the patent.

Article 102

Revocation or maintenance of the European patent

Delete

- (1) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 prejudice the maintenance of the European patent, it shall revoke the patent.
- (2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 do not prejudice the maintenance of the patent unamended, it shall reject the opposition.
- (3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that:
- (a) it is established, in accordance with the provisions of the Implementing Regulations, that the proprietor of the patent approves the text in which the Opposition Division intends to maintain the patent;
- (b) the fee for the printing of a new specification of the European patent is paid within the time limit prescribed in the Implementing Regulations.
- (4) If the fee for the printing of a new specification is not paid in due time, the patent shall be revoked.

(5) Provision may be made in the Implementing Regulations for the proprietor of the patent to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings. If the translation has not been filed in due time the patent shall be revoked.

Article 103

Publication of a new specification of the European patent

If a European patent is amended under Article 102, paragraph 3, the European Patent Office shall, at the same time as it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form.

Article 104

Costs

(1) Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or Board of Appeal, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings.

Article 103

Publication of a new specification of the European patent

If a European patent is **maintained as** amended under Article [...] **101**, paragraph 3(**a**), the European Patent Office shall [...] publish a new specification of the European patent [...], **when** the mention of the opposition decision **is published in the European Patent Bulletin**.

Article 104

Costs

(1) Each party to the **opposition** proceedings shall **bear** the costs it has incurred unless **the** decision of **the** Opposition Division [...] orders, in accordance with the Implementing Regulations, a different apportionment of costs[...].

(2) On request, the registry of the Opposition Division shall fix the amount of the costs to be paid under a decision apportioning them. The fixing of the costs by the registry may be reviewed by a decision of the Opposition Division on a request filed within the period laid down in the Implementing Regulations.

(3) Any final decision of the European Patent Office fixing the amount of costs shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of such decision shall be limited to its authenticity.

Article 105

Intervention of the assumed infringer

(1) In the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. The same shall apply in respect of any third party who proves both that the proprietor of the patent has requested that he cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent.

(2) **The procedure for fixing costs shall be laid down in the Implementing Regulations.**

(3) *Unchanged*

Article 105

Intervention of the assumed infringer

(1) In the event of an opposition to a European patent being filed, any third party [...] may, after the opposition period has expired **and in accordance with the Implementing Regulations**, intervene in the opposition proceedings if **that third party [...]** proves

(a) that proceedings for infringement of the same patent have been instituted against **it**, [...] **or**

(b) that, **following a request of the proprietor of the patent to** cease alleged infringement, **it** has instituted proceedings for a court ruling that **it** is not infringing the patent.

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid. Thereafter the intervention shall, subject to any exceptions laid down in the Implementing Regulations, be treated as an opposition.

(2) [...] **An admissible** intervention [...] shall [...] be treated as an opposition.