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SUBJECT: Revision of the EPC: Article 138
DRAWN UP BY: President of the European Patent Office
ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document proposes clarifying amendments to Article 138 EPC.

I. INTRODUCTION

1. Under Articles 2(2) and 138 EPC, a European patent may be revoked under the law of a contracting state and with effect for its territory only on strictly defined grounds. Revocation may be considered only if one of the grounds for revocation listed exhaustively in Article 138(1) EPC applies. Where these grounds only affect the patent in part, Article 138(2) EPC restricts the contracting states' power to revoke the European patent. In such cases, only a partial revocation may be pronounced in the form of a limitation of the patent.
2. Thus in terms of substantive law, the requirements and procedures for revoking a European patent in national proceedings are the same (barring the special grounds of inadmissible extension of protection and non-entitlement of the patent proprietor) as the Convention's grounds for revocation of the patent in full or in part in European opposition proceedings (see Articles 100 and 102). In terms of procedural law as well, review of European patents is based on largely harmonised principles both in opposition proceedings before the EPO and in revocation proceedings before national courts.
3. Thus in European opposition proceedings and for most national revocation proceedings it is accepted that a patent proprietor faced with objections to the validity of his European patent may limit it to those parts which are not affected by the objections raised. For opposition proceedings, Article 102(3) EPC makes express provision for such self-limitation. For national revocation proceedings, this option is as a rule derived from general principles of procedural law, according to which decisions in such proceedings must be based purely on the requests submitted by the parties.
4. At its second meeting (Berlin, 25 to 27 January 2000), the Working Party on Litigation set up by the French intergovernmental conference agreed that these principles of self-limitation for the patent proprietor in opposition and revocation proceedings should be expressly enshrined in the future Protocol on Litigation. In the same context it was suggested that this was a matter for clarification during revision of the European Patent Convention.
5. The EPO has taken up this suggestion and proposes the amendment to Article 138(2) EPC set out in Part II. In this context the Office has also examined proposals for clarifying the wording of the first half-sentence of Article 138(1), likewise set out and explained in Part II.

II. PROPOSED AMENDMENT TO ARTICLE 138 EPC

Present wording	Proposed wording
Article 138 Grounds for revocation	Article 138 Grounds for revocation
(1) Subject to the provisions of Article 139, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:	(1) Subject to the provisions of Article 139, a European patent may [...] be revoked [...] with effect for a Contracting State only on the following grounds:
(a) if the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;	(a) <i>Unchanged</i>
(b) if the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;	(b) <i>Unchanged</i>
(c) if the subject-matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed;	(c) <i>Unchanged</i>
(d) if the protection conferred by the European patent has been extended;	(d) <i>Unchanged</i>
(e) if the proprietor of the European patent is not entitled under Article 60, paragraph 1.	(e) <i>Unchanged</i>

(2) If the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

(2) If the grounds for revocation only affect the European patent in part, **the patent shall be revoked in part by means of a corresponding limitation taking into consideration the amendments made by the proprietor of the patent during the revocation proceedings. [-]**

EXPLANATIONS

6. The proposed amendment to **Article 138(1) EPC** is intended to eliminate the present redundancy in its formulation in relation to Article 2(2) EPC and to make it clear that Article 138 EPC, rather than establishing the contracting states' power to adopt special provisions for the revocation of European patents, actually restricts the power conferred by Article 2(2). This clarification makes implementation of the EPC easier for newly acceding states and allows reference to be made to Article 138 EPC in other legal instruments such as the future Protocol on Litigation.
7. The proposed amendment to **Article 138(2)** is derived from the provisions applicable to European opposition proceedings, and means that the proprietor's limitation of the European patent in national revocation proceedings must also be taken into consideration. This establishes self-limitation by the patent proprietor as a recognized practice in the national revocation proceedings of most contracting states and safeguards the degree of harmonisation achieved in that respect. This is necessary above all in view of the forthcoming accession of new contracting states, but it is also appropriate for the sake of uniformity with the revocation proceedings envisaged for Community patents (see Article 52(3) CPC 1989).
8. As the form of national revocation proceedings - outside the boundaries drawn by Article 138 EPC - is in any case subject to national law, there is no need for a provision explicitly stating that this also applies to the form of a limitation in national revocation proceedings. It is therefore proposed that Article 138(2), second sentence, EPC be deleted.