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SUBJECT: Basic Proposal - Article 69 EPC and Protocol on its interpretation

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

ARTICLE 69 EPC and PROTOCOL ON ITS INTERPRETATION**Explanatory remarks**

(Preparatory documents: none)

The present EPC provisions governing the **extent of protection** conferred by a European patent, ie **Article 69 EPC and the Protocol on its interpretation**, have turned out not to achieve, to the extent desired, the goal they were designed for. In particular, this is the case regarding the treatment of so-called **equivalents** and the importance of **prior statements** made by the applicant for or proprietor of a patent during prosecution before the EPO or during proceedings concerning the validity of the patent.

In applying the relevant EPC provisions in litigation concerning the infringement of European patents, the national courts of the EPC contracting states have since the beginning been trying to develop as harmonised a practice as possible, but are still far from interpreting European patents and assessing their extent of protection according to uniform criteria and tests. This lack of uniformity especially applies to the two important issues referred to above.

In order to strengthen and clarify the extent of protection under Article 69 EPC, and to contribute to a more uniform court practice in Europe, **Article 69 EPC or the Protocol on its interpretation should be supplemented by some rules** addressing these issues **along the lines of the provisions contained in the 1991 WIPO Basic Proposal for a Patent Law Treaty**.

Present wording

Article 69

Extent of protection

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the latest filed claims contained in the publication under Article 93. However, the European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended.

Protocol on the Interpretation of Article 69

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in

Revised wording

New provisions supplementing Article 69 EPC or the Protocol on its interpretation

Equivalents

(1) For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of elements other than those expressed in the claims, which at the time of the alleged infringement are equivalent to the elements expressed in the claims.

(2) An element shall generally be considered as being equivalent to an element expressed in a claim if it would be obvious to a person skilled in the art that such element would achieve substantially the same result as that achieved by means of the element expressed in the claim.

Prior statements ("Prosecution history estoppel")

For the purpose of determining the extent of protection, due account shall be taken of any statement unambiguously limiting the extent of protection made by the applicant for or the proprietor of the patent in the European patent application or during proceedings concerning the grant or the validity of the European patent, in

Present wording

the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

Revised wording

particular where the limitation was made in response to a citation of prior art.