

SUBJECT: Points for a revision of the EPC - summary of comments by
SACEPO members in response to document SACEPO 2/98 Rev. 1

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for information)

SUMMARY

An extraordinary meeting of SACEPO was held at Munich on 11 September 1998 to discuss those points for a revision of the European Patent Convention set out in document SACEPO 2/98 Rev. 1, which corresponds to documents CA/16/98 and CA/16/98 Add. 1.

This paper contains a summary of comments submitted by SACEPO members and some non-governmental organisations in writing in advance of the extraordinary meeting as well as comments made orally during the meeting. Where no consensus existed on a particular point, the view of the majority and the minority is given, together with a short explanation of the reasoning presented by the members.

I. GENERAL AND INSTITUTIONAL PROVISIONS

A. ARTS. 16-18; PROTOCOL ON CENTRALISATION SEC. I: ADAPT TO BEST PROJECT

Broad consensus that the proposal be supported, provided BEST achieved the same quality standards as the existing system of separate search and examination.
Unanimous support for retention of three-man examining divisions.

Minority view: Deutsche Patentanwaltskammer expressed opposition to BEST project and favoured retention of existing system of separate search and examination.

B. ART. 23(1): INTRODUCE MAXIMUM AGE LIMIT FOR MEMBERS OF THE BOARDS OF APPEAL

Unanimous agreement to proposal.

C. ART. 23(3): INDEPENDENCE OF THE MEMBERS OF THE BOARDS

Unanimous disagreement with proposal.

D. ART. 142(1): SPECIAL AGREEMENTS

No discussion.

II. SUBSTANTIVE PATENT LAW

A. ART. 52(2): TREATMENT OF COMPUTER PROGRAMS AND OTHER EXCEPTIONS

Unanimous support for proposal that at least computer programs should be deleted from Art. 52(2) EPC.

B. ART. 53(a): BRING INTO LINE WITH THE TRIPS AGREEMENT

Broad support for the proposal and suggestion that question of publishing offensive material should be looked into further, i.e. whether a broader provision should be introduced than Rule 34 EPC, which only permits deletion of certain statements/elements in European Patent applications but does not authorise suppression of the entire application even in cases where this might be appropriate.

C. ART. 54: CONSIDER THE INCLUSION OF A PROVISION ON SELF-COLLISION

Clear majority against proposal:

- (i) Would create legal uncertainty.
- (ii) Proposal should be only considered within context of overall novelty grace period under auspices of EU or WIPO.

Minority view: would favour anti-collision provision but this should be linked to the **Applicant** not the inventor because the inventor may change employment in between the earlier and subsequent filings and this could cause uncertainty.
(Mr Bardehle)

FICPI wished to reserve its position pending further consideration.

D. ARTS. 52(4) AND 54(5): TREATMENT OF MEDICAL METHODS

This concerns an *epi* proposal to study possible amendment to the EPC to render a method for treatment of the human/animal body patentable so long as this involved an invention which solved a technical problem. It was expressly supported by FICPI, Mr Vieillefosse and CIPA/APTA.

E. ART. 53(b): DELETE AND/OR REFLECT THE EC BIOTECHNOLOGY DIRECTIVE

Support for clarification to the effect that genetically modified plants and animals may be patented and appropriate steps be taken to align the EPC to the EU biotechnology directive. Acknowledgement that EPC revision would be a lengthy process and a useful first step would be to make appropriate changes to the EPC implementing regulations (*epi*, UNICE).

III. PROCEDURAL AND TECHNICAL PROVISIONS

A. ARTS. 33 AND 95: TIME LIMIT FOR FILING THE REQUEST FOR EXAMINATION

No consensus - views evenly split.

In favour of proposal: CIPA/APTA, FICPI, provided that this would not be a back-door to a deferred examination system.

Against proposal: *epi*, UNICE - too much risk of introducing a deferred examination system.

B. ART. 61(1): EUROPEAN PATENT APPLICATIONS FILED BY PERSONS NOT ENTITLED

Unanimous support for clarification in light of decision G3/92. Some members would favour combining all three alternatives, while others expressed support for solution 3 (CIPA/APTA). All members agreed that the proposal should be studied further.

C. ART. 76(1): INTRODUCTION OF NEW SUBJECT-MATTER IN DIVISIONAL APPLICATIONS

Majority against proposal: (i) would introduce legal uncertainty (Mr Giugni, *epi*). (ii) Resembles US continuation in part system with undesirable consequences (Mr Körber).

A minority favoured including this item on the revision agenda for further study (Mr Parkes, Mr Quintelier, Mr Martin, Mr Raffnsøe).

D. ART. 87(1): CLAIMING OF PRIORITY RIGHT

Unanimous support for proposal.

E. ART. 88(1): FILING OF PRIORITY DOCUMENTS

With exception of *epi* no objections raised to transferring formal requirements to implementing regulations but concern was expressed by FICPI, UNICE and CIPA/APTA about any move to require the priority document only when considered necessary by the EPO: access to the priority document and, where necessary, a translation thereof should be retained in order to satisfy third party interests/opponents. No objection however if this could be achieved by electronic storage of the document without the need for filing a paper copy, but translations should continue to be available, at least in the form of an abstract, possibly provided by the home patent office (Mr Bardehle).

F. ARTS. 100 AND 138: GROUNDS OF OPPOSITION AND REVOCATION

No consensus.

In favour: Mr Ramon, Mr Martin, Mr Lück and *epi*.

Against: UNICE, FICPI, Deutsche Patentanwaltskammer, Mr Bardehle, Mr Brown - not necessary in light of EPO Board of Appeal jurisprudence in this area.

Alternative proposal - delete Article 84 requirement that claims must be supported by description: in favour: Mr Brown. Against: *epi*.

G. ART. 114: EXAMINATION BY THE EPO OF ITS OWN MOTION

No consensus.

In favour: CIPA/APTA, UNICE.

Against: *epi*, Deutsche Patentanwaltskammer - present practice is satisfactory but the *epi* would favour a change to the rules of procedure of the Boards of Appeal to provide for a preliminary notice to the parties in advance of oral proceedings setting out initial reaction/points considered relevant.

H. ART. 116: ORAL PROCEEDINGS

Limited support for first proposal - removal of right to oral proceedings before Receiving section (CIPA/APTA UNICE).

The second element of the proposal, namely to give the Examining and Opposition Divisions as well as the Boards of Appeal discretion to refuse to hold oral proceedings where these were considered unnecessary, was unanimously opposed.

I. ART. 117: TAKING OF ORAL EVIDENCE

Unanimous opposition.

J. ART. 120: TIME LIMITS

Discussion postponed.

K. ARTS. 121 AND 122: FURTHER PROCESSING AND RESTITUTIO IN INTEGRUM

In principle, unanimous support for proposal. Further study to ensure adequate safeguards for third parties should be carried out (CIPA/APTA, FICPI).

L. ART. 123: AMENDMENTS

Broad support for "footnote solution" (*epi*, Deutsche Patentanwaltskammer, CIPA/APTA, UNICE, Mr Lück). UNICE requested further study particularly take account of third party interests. Limited support to consider also reissuance (*epi*). Mr Brown opposed any revision at all.

M. ART. 129: PERIODICAL PUBLICATIONS

Unanimous support.

N. ARTS. 154(3) AND 155(3): PROTEST PROCEDURE UNDER THE PCT

No consensus. In favour: CIPA/APTA, UNICE, Against: *epi*, Deutsche Patentanwaltskammer.

O. STAY OF PROCEEDINGS

Broad support provided stay was by consent of all parties, (CIPA/APTA, *epi*, Deutsche Patentanwaltskammer, UNICE).

P. ARTS. 79 AND 80: DESIGNATION OF CONTRACTING STATES AND REQUIREMENTS FOR OBTAINING A FILING DATE

Broad support for proposal.

Q. ART. 96: EXAMINATION OF THE EUROPEAN PATENT APPLICATION

This *epi* proposal was supported by Mr Nissen and Mr Holzer. CIPA/APTA would favour the deletion of Article 96(1) EPC altogether. The need for any invitation under Article 96(1) EPC would not exist and, if such invitation continued to be issued, then if the applicant ignored it, the file should proceed to substantive examination.

R. CENTRAL LIMITATION PROCEEDINGS AND SURRENDER BEFORE THE EPO

Broad support.

IV. GENERAL

A. DEREGULATION

Consensus that specific proposals made during the course of the systematic review of EPC provisions would be supported where appropriate.

B. TRANSFER EPC REQUIREMENTS TO IMPLEMENTING REGULATIONS WHEREVER POSSIBLE

Consensus that greater flexibility would be positive (UNICE, CIPA/APTA). However, substantive law provisions should remain in the EPC itself (FICPI, *epi*).

V. HOUSEKEEPING AMENDMENTS

A. ELIMINATE DIVERGENCES BETWEEN THE ENGLISH, FRENCH AND GERMAN VERSIONS OF THE EPC, AS WELL AS INCONSISTENCIES IN TERMINOLOGY

Consensus in favour of proposal but care should be taken in implementing the details, no changes as to substance should be effected under this heading (UNICE, FICPI, *epi*).

B. ARTS. 159-163 AND 167: TRANSITIONAL PROVISIONS AND RESERVATIONS

Broad support.

VI. ADDITIONAL SUGGESTIONS

The following items were proposed in addition to those mentioned in SACEPO 2/98 Rev. 1:

- (i) *epi*: consideration should be given to introducing a *protocol on litigation of European patents* in order to harmonise the interpretation of the validity and scope of European patents and their enforcement in the EPC contracting states. This could possibly be combined with a centralised limitation procedure at the EPO.

- (ii) FICPI: Introduction of a novelty grace period in Europe, decentralisation of specific tasks from the EPO to national patent offices.
 - (iii) CIPA/APTA: Introduce measures to ensure prompt publication of European search reports.
 - (iv) UNICE: Deletion of Article 54(4) EPC, Rule 23(a) EPC, amendment of Article 133(3) EPC to allow an authorised employee of a legal entity based in an EPC contracting state and forming part of a group of companies to represent other members of the group, even where these are based outside Europe.
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