

SUBJECT: Revision of the EPC: Article 53(a) EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document begins by examining the legal mechanism which enables the European Patent Office to prevent the publishing or patenting of an invention whose publication or exploitation would be contrary to "ordre public" or morality. This legal mechanism, although not without its weak points, generally appears to be satisfactory, and in practice, no difficulties have so far arisen in this area. As a result, the problems which might arise, particularly if it were to prove impossible to prevent the publication of an application contrary to "ordre public" or morality, do not appear to justify the creation of a complex and unwieldy verification procedure, simply as a precautionary measure.

The present document goes on to put forward a proposal to amend Article 53(a) EPC with a view to bringing it into line with the wording of Article 27.2 of the TRIPS Agreement. An amendment of this kind would make it easier to define the EPO's role and determine the stage at which it could take effective action with a view to preserving "ordre public" and morality.

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I. INTRODUCTION

1. The problems posed by inventions which are contrary to "ordre public" or morality have, for several years now, been the focus of renewed attention. A document submitted by the Belgian delegation¹ at the eighth meeting of the Committee on Patent Law describes the problems caused by inventions relating to anti-personnel mines and urges that efforts be made to analyse closely the legal means available to the EPO to prevent the publication and patenting of an invention contrary to "ordre public" or morality.

II. PREVENTING THE PUBLISHING AND PATENTING BY THE EPO OF AN INVENTION CONTRARY TO "ORDRE PUBLIC" OR MORALITY

2. Several checks are carried out in succession:
 - European patent applications are checked **prior to publication** in order that any elements and drawings contrary to "ordre public" or morality may be omitted at the time of publication;
 - inventions are checked **during the examination procedure** in order to exclude from patentability those inventions whose exploitation would be contrary to "ordre public" or morality.

A. CHECKING OF PATENT APPLICATIONS PRIOR TO PUBLICATION

(a) An initial check is carried out by the national offices and the International Bureau of WIPO

3. It is important to begin by stressing that most patent applications received by the EPO have been the subject of a preliminary check by the national patent offices or by the International Bureau of WIPO. National applications which subsequently become European applications, European applications filed with national offices, and PCT applications filed with national offices or with the International Bureau undergo a more or less thorough examination².
4. In principle, during this preliminary check of applications, a formalities officer and, in some cases, a technically qualified examiner look at the content of the applications. Even if this check does not always specifically aim to identify those inventions - or the elements of and drawings in the applications - which are contrary to "ordre public" or morality, it appears to have served as a very efficient preliminary "screening" process hitherto.

¹ CA/PL 20/98.

² Applications are checked with regard to certain formal requirements; examined by national security services; and, in some cases, form the basis of a national search report.

(b) Checking of applications by the EPO

5. In the same way as direct European applications and PCT applications filed with the EPO, applications forwarded to the EPO are checked again by the EPO. The EPO applies the legal mechanism put in place by the EPC - for European patent applications - and by the PCT - for PCT applications.
6. Rule 34 EPC provides that a European patent application "shall not contain statements or other matter contrary to "ordre public" or morality" and that the EPO must omit such prohibited matter when publishing the application. The Guidelines for Examination in the EPO specify the action to be taken by the Receiving Section and the search divisions.

The formalities officer in the Receiving Section has to carry out a "preliminary check" of the description, claims and drawings in order to ensure that elements or drawings contrary to "ordre public" or morality are not contained in the application (EPO Guidelines A-III, 1.2 and 8.1; C-II, 7.4). If the formalities officer finds such elements or drawings, he may decide to omit them when the application is published (Rule 34(2) EPC).

The search examiner must study the content of the application with a view to classifying it and, if he has sufficient time to do so before publication of the application, draw up the European search report. If, in the process, he notes that the application contains elements or drawings which are contrary to "ordre public" or morality, he "draws" this to the Receiving Section's "attention" (EPO Guidelines B-IV, 1.2; A-III, 8.1). The Receiving Section must then decide whether this matter should be omitted at the time of publication (Rule 34(2) EPC).

7. The PCT contains two provisions, the content of which closely resembles that of Rule 34(2) EPC. Under Rule 9.1(i) and (ii) PCT, "the international application shall not contain expressions or drawings contrary to morality ... or ... to public order"; according to Article 21(6) PCT, the International Bureau may omit "expressions or drawings which ... are contrary to morality or public order" from its publications of PCT applications. The PCT Guidelines and the Administrative Instructions under the PCT provide for the EPO to take action in its capacity as a receiving Office and as an International Searching Authority (ISA).

When checking for irregularities in the PCT application, the EPO may check the application for expressions or drawings contrary to public order or morality (PCT Receiving Office Guidelines, point 157). If the EPO finds that the application contains matter of this kind, it may "note" this and "suggest to the applicant that he voluntarily correct his international application accordingly" (Rule 9.2 PCT; PCT Receiving Office Guidelines, point 158).

Similarly, when classifying the PCT application and conducting the international search, the EPO may "note" that the application contains matter contrary to "ordre public" or morality and "suggest to the applicant that he voluntarily correct his ... application" (Rule 9.2 PCT; PCT Search Guidelines, Chapter IV, 1.2).

8. Whether acting as a receiving Office or as an ISA, the EPO must inform the International Bureau that, pursuant to Rule 9.2 PCT, it has noted matter of the above kind. If the applicant submits corrections, the EPO must keep a copy of the corrections in its files and enclose the corrections with the PCT application (on one or more replacement sheets) (PCT Receiving Office Guidelines, point 159; PCT Search Guidelines, Chapter IV, 1.2; Administrative Instructions under the PCT, Section 325(c) and Sections 501 and 511).

Nevertheless, it is for the International Bureau to decide if, upon publication of the PCT application, expressions or drawings contrary to public order or morality should be omitted (Article 21(6) PCT).

B. CHECKING OF INVENTIONS DURING THE EXAMINATION PROCEDURE

9. Figuring amongst the EPC provisions concerning patentability requirements, Article 53(a) EPC implies that the EPO examining divisions should ensure that a European patent is not granted for an invention the exploitation of which would be contrary to "ordre public" or morality. The administrative instructions for EPO examiners specify the methods by which this is to be achieved.
10. First, it is the responsibility of the examining divisions to **remove** any elements or drawings contrary to "ordre public" or morality which have not been recognised by the Receiving Section (EPO Guidelines C-II, 7.4).

Secondly, the examining divisions are competent to **refuse** a European patent application relating to an invention which is contrary to "ordre public" or morality. In "rare and extreme cases" like these, the examiner must invoke Article 53(a) EPC and thereby exclude such inventions from patentability (EPO Guidelines C-IV, 3.1).

11. Two staff notices from Directorate-General 2 (Examination/Opposition) at the EPO serve to explain the practical application of Article 53(a) EPC by the examining divisions:

Staff Notice 6/92 lists six criteria³ which the examining divisions should follow when deciding whether to raise an objection under Article 53(a) EPC.

Staff Notice 8/98-IV draws the examiners' attention to the problems which might be posed by certain inventions in the field of landmines or genetic engineering. In particular, detailed instructions are given for ensuring that any invention relating to anti-personnel mines is excluded from patentability if the invention *per se* allows no other possible use. An invention of this kind, as well as processes for cloning human beings and certain processes for modifying the genetic identity of animals⁴, are considered to be contrary to the ethical standards prevailing in the contracting states of the European Patent Organisation, and applications for European patents for inventions of this kind will be refused⁵.

III. EVALUATION OF THIS LEGAL MECHANISM

12. The foregoing study shows how a set of provisions found in national patent law, the EPC and the PCT as well as the relevant administrative instructions have served to put in place a succession of checks aimed at preventing the publication or patenting of an invention - or an element or drawing contained in an application - which is contrary to "ordre public" or morality.

A. A MECHANISM WHICH ON THE WHOLE IS SATISFACTORY

13. In the light of the experience gained during the first 20 years of the EPO's existence, this legal mechanism appears, on the whole, to be satisfactory.
14. First - and this must continue to be the most important point - the check carried out during the examination procedure ensures that every European patent application relating to an invention the exploitation of which would be contrary to "ordre public" or morality is refused by the EPO.

³ Does the invention offend against human dignity? solely aim at facilitating criminal acts? violate international conventions? involve badly controllable risks? involve cruelty (to) animals? lead to a genetic change of the human germ line?

⁴ Staff Notice 8/98-IV for the most part repeats the non-limitative list contained in Article 6.2 of Directive 98/44/EC on the legal protection of biotechnological inventions. For the implementation of this Directive under European patent law, see CA/PL 3/99.

⁵ Answer to question (1) addressed to the EPO in CA/PL 20/98 by the Belgian delegation.

15. Secondly, there is no doubt that the successive checks carried out **prior to** publication, very often by several offices and always by **at least one** formalities officer and **one** technically-qualified examiner, should make it possible to identify those elements or drawings which are contrary to "ordre public" or morality.

B. SITUATIONS WHERE PROBLEMS MIGHT ARISE

16. Nevertheless, it is unquestionably the case that the legal mechanism put in place for checking patent applications **prior to publication** is not without its weak points.
17. First, the EPO cannot prevent the publication of a European patent application **in its entirety** on the grounds that to publish it would be contrary to "ordre public" or morality. In fact the sole purpose of Rule 34(2) EPC is to enable the Receiving Section, when publishing the application, to omit words, passages or drawings from an application; Rule 34(a) EPC does not provide an adequate legal basis for refusing to publish an application in its entirety. This rule cannot be interpreted to mean that the Receiving Section may prevent the publication of an application in its entirety or, *a fortiori*, to refuse the application.
18. Secondly, it is impossible to ensure **in all cases** that an element or drawing contrary to "ordre public" or morality is identified early enough by the EPO to be omitted at the time of publication. In fact, the formalities officer who carries out the examination as to formal requirements is not qualified in technical matters to university level: as a result, he would find it difficult to identify those patent applications which contained technical information contrary to "ordre public" or morality. Moreover, the work involved in classifying applications and conducting searches is generally done under pressure of time: the examiner can hardly be expected, at this stage in the procedure, to be able to concentrate on identifying possible elements or drawings contrary to "ordre public" or morality.
19. Thirdly, in its capacity as a receiving Office and an ISA the EPO can only "note" the existence of elements or drawings contrary to "ordre public" or morality and "suggest" that the applicant correct his application. Pursuant to Article 21(6) PCT, it is for the International Bureau to decide whether to omit from the publication any expressions or drawings contrary to morality or public order; the International Bureau is no more competent than the EPO to prevent the publication in its entirety of a PCT application which is contrary to "ordre public" or morality.

C. DIFFICULTIES ASSOCIATED WITH REMEDYING THIS SITUATION

20. Several difficulties quickly emerge when considering legislative or practical measures to remedy this situation.

21. It is not possible, by simply amending the Implementing Regulations to the EPC, to confer on the Receiving Section competence to refuse the publication of a European patent application in its entirety. A revision of the EPC - possibly involving the creation of a special body responsible for checking systematically all European patent applications as well as entailing the reorganisation of the entire first stage of the procedure before the EPO - would be necessary in order to ensure that the EPO did not publish European patent applications which were, either wholly or in part, contrary to "ordre public" or morality.
22. The problems faced by the formalities officer (no technical training) and the search examiner (lack of time) in identifying those inventions - or elements or drawings - which are contrary to "ordre public" or morality can only be overcome by introducing measures of a certain magnitude, such as providing training for formalities officers or increasing the numbers of search examiners.
23. The EPO checks PCT applications in accordance with the provisions of the PCT and the Administrative Instructions under the PCT. This legal framework may only be amended by the PCT bodies. Therefore any move to reinforce the checking of PCT applications and to prevent the publication of PCT applications which are contrary to "ordre public" or morality may only be taken by these bodies.

D. DOUBTS CONCERNING THE NEED FOR AND EFFECTIVENESS OF REVISING THE EPC

24. The difficulties mentioned above make it necessary to question the need for - and, ultimately, the effectiveness of - any legislative measure designed to remedy the current situation.
25. It is necessary, first of all, to emphasise once again the marginal nature of the problems raised in this document: at no time during the first 20 years of its existence has the EPO been compelled to reject an application because the invention concerned was contrary to "ordre public" or morality; moreover, the Receiving Section has had to apply Rule 34 EPC only on very rare occasions. Given these circumstances, it would seem excessive to create, purely as a precautionary measure, an unwieldy and complex checking procedure for all the applications received by the EPO.
26. The preliminary check carried out by the national offices or by the International Bureau has certainly helped to limit the very small number of applications which might be contrary to "ordre public" or morality received by the EPO. If, during the first stage of the procedure before the national offices and the EPO, certain "sensitive" technical fields were monitored more carefully, this might well prove more effective than undertaking a complex revision of the EPC.
27. After all, a revision of the EPC would only have limited effect for as long as PCT applications were published by the International Bureau, following the less stringent

check provided for under the PCT mechanism; yet, a revision of the PCT aimed at remedying the situation examined in this document does not appear to be feasible.

28. In conclusion, it would hardly be advisable to revise the EPC and create a new procedure aimed at preventing the publication of patent applications contrary to "ordre public" or morality; publication of such applications cannot be avoided in any case if the applicant chooses the PCT route. In the light of the experience gained since 1978, the risk posed to the EPO by publishing a European patent application concerning an invention the mere publication of which would be contrary to "ordre public" or morality is purely hypothetical and therefore could not justify introducing an expensive and rather inefficient checking procedure.

IV. PROPOSAL TO AMEND ARTICLE 53(a) EPC

29. In view of the problems examined in this document, consideration should be given to the proposed amendment to Article 53(a) EPC contained in the list of points which the Committee on Patent Law was instructed to examine in detail⁶.
30. This amendment would make it possible not only to eliminate any ambiguous wording as to when the EPO may intervene effectively in order to preserve "ordre public" and morality but would make it possible also to ensure, in this respect, the conformity of the EPC with the TRIPS Agreement.

A. CLARIFYING THE ROLE OF THE EXAMINING DIVISIONS

31. The foregoing study has described the action taken by the EPO bodies. Nevertheless, the use of the word "publication" in Article 53(a) EPC is somewhat ambiguous.
32. The competence conferred on the examining division to refuse a European patent application on the grounds that the **publication** of the invention is contrary to "ordre public" or morality means little in the context of the European patent grant system where the invention is almost always published **before** the examining division has begun to examine the invention. If the examining division were to refuse the application on the above grounds - when the invention had already been published - its decision would appear inconsistent and contradictory and might cause legal difficulties before the EPO boards of appeal.
33. The amendment of Article 53(a) EPC would make it possible to eliminate any ambiguity with regard to the EPO's role in the examination procedure. It cannot be the examining division's role to check whether the **publication** of the invention - which has already taken place - was contrary to "ordre public" or morality. Its role is

⁶ See CA/16/98, II.B, and CA/16/98 Add. 1, II.B.

much rather to check that the **exploitation** of the invention is not contrary to "ordre public" or morality.

34. This is confirmed by two decisions of the technical boards of appeal which examined the concepts of "ordre public" and "morality". Decisions T 19/90, Onco-mouse/Harvard, OJ EPO 1990, 476, point 5, and T 356/93, Plant cells/Plant Genetic Systems, OJ EPO 1995, 545, points 5 to 7, show that it is the **exploitation** of an invention which can prove contrary to "ordre public" or morality, whereas the **publication** of the invention does not give rise to any particular considerations.

B. ENSURING THE CONFORMITY OF THE EPC WITH THE TRIPS AGREEMENT

35. Amending Article 53(a) EPC by removing the word "publication" would also be beneficial in that it would bring the wording of the article into line with that of two international texts of importance for European patent law. Although the TRIPS Agreement and Directive 98/44/EC on the legal protection of biotechnological inventions are directed at those states which have ratified the TRIPS Agreement and which are members of the European Union, the EPO believes that it should take account of certain provisions contained in these texts when revising the EPC⁷.
36. However, both Article 27.2 of the TRIPS Agreement, as well as Article 6.1 of the EC Directive, exclude from patentability only those inventions the "commercial exploitation" of which would be contrary to "ordre public" or morality. Neither text provides that "publication" alone of a patent application could serve as grounds for excluding an invention from patentability.
37. Several delegations, as well as interested circles and the EPO, have expressed support for bringing the EPC into line with the TRIPS Agreement, thereby ruling out any likelihood of the two texts being applied differently.

C. CONCLUSION

38. It is therefore proposed that the words "publication or" be removed from Article 53(a) EPC and that the wording of this article be brought further into line with Article 27.2 of the TRIPS Agreement and with Article 6.1 of the EC Directive.

⁷ The proposals for amending the Implementing Regulations to the EPC with a view to taking into account Directive 98/44/EC on the legal protection of biotechnological inventions were submitted to the Committee on Patent Law in CA/PL 3/99.

V. PROPOSED AMENDMENT

Current text

**Article 53
Exceptions to patentability**

European patents shall not be granted in respect of:

(a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(b) ...

Proposed text

**Article 53
Exceptions to patentability**

European patents shall not be granted in respect of:

(a) inventions the [...] **commercial** exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(b) unchanged