

CA/PL 29/99

Orig.: German

Munich, 08.11.1999

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

SUMMARY

Part I of this document outlines the purpose and significance of a central limitation procedure for European patents. Part II sets out the structure of such a procedure and puts forward proposals for its introduction.

PART I

I. BACKGROUND

1. The EPC makes no provision for a limitation procedure. Central re-examination and, where appropriate, limitation of European patents with effect in the designated contracting states is only possible within the framework of opposition proceedings. This was reflected in both practice and case law, which allowed patent proprietors to lodge opposition against their own patents with the aim of limiting them. Departing from the case law established by its decision G 1/84¹⁾ the Enlarged Board of Appeal's decision G 9/93²⁾ of 6 June 1994 deprived them of this option, stating that, should this narrower interpretation of the scope of application of Article 99 EPC give rise to problems in practice, it would be a matter for the legislator to remedy.
2. The Office subsequently investigated existing and envisaged options for limiting patents post-grant in the contracting states and under the 1989 Community Patent Convention (CPC) and raised the issue of the introduction of a central European limitation procedure as part of the 1995 strategy debate. In view of the opinions put forward by the interested circles at the "Hearing 95", the vast majority of which favoured the introduction of such a procedure, the Administrative Council instructed the Committee on Patent Law to look into the matter.
3. The Committee on Patent Law discussed at length the introduction of a European limitation procedure based on CA/PL 11/96 at its 4th meeting (October 1996). A clear majority of the delegations together with the *epi* favoured the introduction of a procedure of this kind (see CA/PL PV 4, points 95-107).
4. Bearing in mind the Committee's discussions and the information forwarded to the Office about the opportunities in some contracting states for re-examination and limitation of granted patents using an administrative procedure, the Office has summarised below the main points in favour of the creation of a central European limitation procedure and drawn up a number of proposals for revising the Convention accordingly. These proposals and comments are contained in Part II.

¹⁾ OJ EPO 1985, 299

²⁾ OJ EPO 1994, 891.

II. PURPOSE AND SIGNIFICANCE OF THE LIMITATION PROCEDURE

5. Limitation proceedings would enable patentees to narrow down the protection conferred by a patent post-grant by means of a simple, quick and inexpensive administrative procedure. For example, it may be necessary to limit a granted patent if, because of prior art which was not known during the examination proceedings or prior national rights not taken into account in these proceedings, the extent of the protection conferred is too great. Using the limitation procedure, patent proprietors may themselves reduce the extent of the protection claimed in a manner which is binding, and thus generally preclude disputes over the validity of a patent. Post-grant limitation is also in the public interest, because it limits the protection claimed by the patentee with effect for the general public. This creates legal certainty and facilitates access by competitors to the freely available prior art.
6. The patent laws in some of the contracting states (AT, CH, DE, DK, IT, UK) reflect these considerations and provide for various options for post-grant limitation of patents (see Info 2/PL 5). The use made of these options differs from state to state. According to the information available, there are around 100 limitation procedures per year in the above-mentioned states. The number would be much higher if the cases of so-called partial surrender which are covered in some states by special provisions were also counted as limitations. Post-grant limitation at national level works very well. The Community Patent Convention (Article 51 ff CPC) also provides for the introduction of a limitation procedure.
7. In contrast, the opportunities for limiting European patents using an administrative procedure are very restricted. Failing opposition proceedings before the EPO (opposition rate: approx. 6.2 %), patent proprietors have to rely on national limitation procedures or, where these do not exist, on partial surrender or non-enforcing agreements. Often the only remaining option is "self-limitation" in national revocation proceedings. This is not only administratively time-consuming and expensive, but also means that European patents granted in accordance with a unitary procedure can be valid in different versions in different contracting states, which makes their legal enforcement on the one hand and the monitoring of protective rights on the other considerably more difficult.
8. It is therefore proposed as part of the forthcoming revision of the EPC to introduce a central limitation procedure for European patents. To this end the following provisions could be incorporated into Part V of the Convention in the form of a separate Chapter II, "Limitation procedure", following on from the provisions on the

opposition procedure. The proposed provisions are set out below together with explanations.

PART II

I. NEW PROVISIONS IN CHAPTER II OF PART V OF THE CONVENTION

PART V

Chapter II

LIMITATION PROCEDURE

Article 105a

Request for limitation

- (1) At the request of the proprietor, a European patent may be limited ex nunc by amending the claims. The request shall be filed with the European Patent Office as prescribed in the Implementing Regulations.
- (2) The request may not be filed while opposition proceedings in respect of the European patent are pending. If a request for limitation of the European patent has already been filed when the opposition is lodged, the European Patent Office shall stay the limitation proceedings until a final decision is given in respect of the opposition.
- (3) The request for limitation shall apply to the European patent in all the Contracting States in which that patent has effect.

Article 105b

Examination of the request, rejection of the request or limitation of the European patent

- (1) If the request for limitation is admissible, the European Patent Office shall examine in accordance with the Implementing Regulations whether the requested amendment to the claims limits the protection conferred by the European patent, whether the subject-matter thus limited is clearly not patentable under Articles 52 to 57 and whether it does not extend beyond the content of the application as filed.

- (2) If the European Patent Office is of the opinion that the requested amendment to the European patent does not meet the requirements of paragraph 1, it shall reject the request.
- (3) If the European Patent Office is of the opinion that the requested amendment to the European patent meets the requirements of paragraph 1, it shall decide to limit the European patent provided that, in accordance with the provisions of the Implementing Regulations:
 - (a) a translation of the amended claims is filed, and
 - (b) the fee for printing the supplementary European patent specification has been paid.
- (4) If the translation is not filed in due time or the fee for printing is not paid in due time, the request for limitation of the European patent shall be deemed to be withdrawn.
- (5) The decision to limit the European patent shall take effect on the date on which the European Patent Bulletin mentions the decision.

Article 105c

Publication of a supplementary European patent specification

If the European patent is limited under Article 105b, paragraph 3, the European Patent Office shall publish a supplementary European patent specification containing the amended claims and the prescribed translations.

II. EXPLANATIONS

The essential features of the proposed limitation procedure

9. The procedure as proposed in the above provisions comprises elements of partial surrender and of a "genuine" limitation procedure. According to the proposal, a European patent may be limited ex nunc at the request of the proprietor. Limitation takes the form of deleting individual claims and/or amending the wording of claims. It may be requested at any time, although precedence must always be given to opposition proceedings. The EPO examines whether the requested amendment actually limits the protection conferred by the patent and, where appropriate,

decides to limit the patent accordingly. The limitation comes into force in all the designated contracting states on publication in the European Patent Bulletin.

10. Making the limitation procedure *ex parte* as proposed and doing away with a full examination of the patentability of the residual patent ensures that the procedure will be quick and efficient. Patentees will thus be able to react rapidly to newly revealed prior art and to preclude any impending opposition or revocation proceedings. In contrast to opposition and revocation proceedings, the effect of the limitation is exclusively *ex nunc*. This is in line with the partial surrender component in this procedure and takes account of the fact that, in practice, claims arising out of the original patent which extend beyond the limitation will usually in any case no longer be enforced or prosecuted further.

Article 105a: Request for limitation

11. According to **Article 105a(1)**, a European patent may be limited at the request of the proprietor. The requirements governing the admissibility of such requests will have to be set out in the Implementing Regulations. They provide, in particular, that the request must be made in writing, that it is not deemed to have been filed until the fee for limitation has been paid, and that it can only be filed jointly by all the owners of the European patent. The Implementing Regulations must also stipulate what should be filed with the request, for example the text of the new version of the claims as requested.
12. As the extent of the protection conferred by a European patent is determined by the terms of the claims (Article 69(1) EPC), a patent may only be limited by amending the claims. The wording proposed in Article 105a(1) reflects this. The Implementing Regulations should also state that the deletion of individual claims must also be understood as an amendment within the meaning of the present provision (see also point 9 above).
13. The limitation procedure does not comprise any provision for adapting the description. As the subject-matter of the limited patent may not contain any new elements not present in the patent as originally granted, it must be supported in the original description, which is thus perfectly suitable for the purposes of interpreting the new claims. The extent of the limitation can thus readily be understood by third parties as well.

14. **Article 105a(2)** governs the relation between the limitation procedure and European opposition proceedings. The priority it gives to opposition proceedings prevents the occurrence at European level of parallel proceedings relating to amendments to a European patent. As an inter partes procedure with comprehensive powers of examination and decision-making (revocation, limitation or maintenance of a patent), opposition must take precedence. Since validly initiated opposition proceedings already afford patent proprietors the opportunity for "self-limitation", there is no justifiable need for a concurrent limitation procedure.
15. National proceedings, in particular those involving partial surrender, limitation or revocation, should not however take precedence over the European limitation procedure. Where parallel cases do occur (for example, when European opposition proceedings are pending), it would be advisable to consider staying the national proceedings in accordance with the provisions of the relevant national law, since once a European patent has been limited before the EPO only this limited version will be the subject of national proceedings. This is in line with principles of procedural economy and, in view of the expected short duration of the European limitation procedure, would not unduly delay national proceedings.
16. **Article 105a(3)** is modelled on Article 99(2) EPC and stipulates that a request for limitation applies to the European patent in all the contracting states in which that patent has effect. If, however, prior European or national rights are cited during the limitation procedure in respect of certain contracting states, the patent may be limited for these states in accordance with Rule 87 EPC by means of a separate set of claims. This is particularly important for contracting states which do not have a national limitation procedure.

Article 105b: Examination of the request, rejection of the request or limitation of the European patent

17. The limitation procedure requires the European Patent Office, under **Article 105b(1)**, to examine whether the requested amendment of the claims actually limits the patent and whether the subject-matter of the limited patent is clearly not patentable under Articles 52 to 57. However, it must not examine the extent to which the aim of the limitation - eg delimitation with respect to a particular prior art - is actually achieved.

18. The proposal to restrict what is examined by the EPO is in the interests of a simple and rapid procedure. In contrast to the arrangements under the 1989 CPC, it is based on the procedures used in AT, CH and DE, which dispense with an examination of the patentability of the residual patent. However, it cannot be applied in all cases. If the residual patent is clearly not patentable, the EPO will reject the request for limitation. Restricting what is examined has not caused any problems in the above-mentioned contracting states, primarily because patent proprietors are normally interested in obtaining a valid residual patent and the limitation procedure is carried out on examined patents. They can thus reliably gauge whether the subject-matter now claimed will still be patentable after the proposed limitation.
19. Moreover, the EPO has to apply the Convention's relevant general rules of procedure equally to the limitation procedure, including in particular those of Article 123(2) EPC. Accordingly, additional features may only be added to a claim in the limitation procedure if they are sufficiently disclosed in the application as originally filed. Article 105b(1) states this explicitly and obliges the Office to examine whether the limitation would infringe Article 123(2).
20. The practical implementation of such a procedure could be assigned to the examination divisions. Further details will be laid down by the President under his powers to direct the EPO (Article 10, Rule 9 EPC).
21. **Article 105b(2)** corresponds in both structure and content to the provision in Article 97 EPC covering the proceedings for grant. According to Article 105b(2), the requested amendment must be rejected if it does not lead to a limitation of the European patent concerned, if the residual patent is clearly not patentable, or if the limitation infringes Article 123(2) EPC.
22. Where the requirements for limiting a European patent are met, the patent is limited by a decision of the EPO provided the conditions in Article 105b(3) - filing of the prescribed translation and payment of the fee for printing - have been fulfilled.

23. With regard to the restricted scope of examination the patent is limited - provided the limitation is admissible in substance - in accordance with the revised version of the claims requested by the patent proprietor. The communication notifying the patent proprietor that the request for limitation can be allowed invites him to file a translation of the amended claims and to pay the fee for printing. He thus has the opportunity to check the version of the claims intended for publication. Any obvious mistakes or typing errors may be rectified at his request. On the other hand, he may no longer make any substantive amendments to the claims, as the request for limitation has already been examined and allowed. If, however, he wishes to make such amendments, he may do so only by withdrawing the pending request for limitation and filing a new one.
24. The Implementing Regulations will lay down what, if any, translations are to be filed under Article 105b(3). It would not be necessary to file a translation in cases where the European patent has been limited by deleting one or more claims. Where the claims have been amended, provision should be made with regard to Article 14(7) EPC for the filing of a translation of the amended claims into the official languages of the EPO other than the language of proceedings.

Provision could also be made for the filing of translations into the official languages of those contracting states in which the European patent concerned is in force. This would have the advantage that the revised claims would be available in the languages of all these states at the same time as the limitation came into force. Such a solution would be attractive to patent proprietors because they could then complete the limitation procedure before the EPO in one operation. Moreover, there would be no need to adapt Article 65 EPC or to enact national provisions on the filing of translations of the limited claims.

25. According to **Article 105b(4)**, a request for limitation of a European patent is deemed to be withdrawn if the patent proprietor does not fulfil the requirements of paragraph 3 in due time.
26. When the decision to limit the European patent in accordance with **Article 105b(5)** is published, the rights conferred by the patent as originally granted which extend beyond the scope of the patent as limited shall expire ex nunc.

Article 105c: Publication of a supplementary European patent specification

27. When it publishes the decision to limit the European patent the EPO will publish a supplementary European patent specification containing the new version of the claims and a translation thereof into the official languages of the EPO other than the language of proceedings. Translations into other languages will be included in the patent specification where this is provided for in the Implementing Regulations.
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