

SUBJECT: Revision of the EPC: limitation procedure (Articles 105a-c, 68 EPC)

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

---

#### SUMMARY

Part I of this document contains the Office's proposed provisions relating to a European limitation procedure for inclusion in Part V of the Convention. The resulting amendments to Article 68 EPC are given in Part II.

---

## I. INTRODUCTION

1. The introduction of a central European limitation procedure is a long-standing demand on the part of users (see, for example, "Hearing '95"). The Committee on Patent Law discussed the subject at length at its 4th meeting (October 1996, on the basis of CA/PL 11/96) and at its 11th meeting (November 1999, CA/PL 29/99). A clear majority of the delegations, together with the *epi* and UNICE, favoured the introduction of a procedure of this kind. For details of these discussions and the fundamental importance of the limitation procedure, see the above-mentioned documents and the minutes of the meetings (CA/PL PV 4, CA/PL 30/99).
2. Bearing in mind the Committee's discussions, the Office has revised and amplified its proposals. In particular, the new proposals make provision for patent proprietors to request not only the limitation of their European patents, but also their revocation. In other words, patent proprietors have regained the legal options with regard to abandoning or amending at the post-grant stage the rights conferred by their European patents that they had prior to the Enlarged Board of Appeal's decision of 6 June 1994 (G 9/93)<sup>1</sup> relating to the inadmissibility of so-called "self-oppositions". Moreover, limitation and revocation will now be effective *ab initio*, as in opposition proceedings (Article 68 EPC), the description may be adapted to bring it into line with the restricted claims and, as far as translations of the amended European patent specification are concerned, the general provisions of the Convention apply, in particular Articles 14(7) and 65(1).
3. The new provisions are set out in Part I below, together with explanations. They are intended for inclusion in 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 amendments to Article 68 EPC proposed with a view to the introduction of a European limitation procedure are set out in Part II.

---

<sup>1</sup>

OJ EPO 1994, 891.

PART I

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

**PART V**

**Chapter II**

**LIMITATION PROCEDURE**

***Article 105a***

**Request for limitation or revocation**

- (1) A European patent may be limited or revoked at the request of the proprietor. 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.**

***Article 105b***

**Examination of the request, revocation or limitation of the European patent**

- (1) The European Patent Office shall examine whether the requirements laid down in the Implementing Regulations for limiting or revoking the European patent have been met.**
- (2) If the European Patent Office considers that the request for limitation or revocation of the European patent meets these requirements, it shall decide to limit or revoke the European patent in accordance with the Implementing Regulations. Otherwise, it shall reject the request.**
- (3) The decision to limit or revoke the European patent shall apply to the European patent in all the Contracting States in respect of which it has been granted. It shall take effect on the date on which the European Patent Bulletin mentions the decision.**

## **Article 105c**

### **Publication of an amended European patent specification**

**If the European patent is limited under Article 105b, paragraph 2, the European Patent Office shall publish an amended European patent specification together with the mention of the decision regarding limitation.**

## **III. EXPLANATIONS**

### **A. ESSENTIAL FEATURES OF THE PROPOSED LIMITATION PROCEDURE**

4. Under the extended limitation procedure proposed in this document, and to be set out in detail in the Implementing Regulations, the European patent may be limited or revoked ab initio (Article 68 EPC - see Part II below) at the request of the patent proprietor. Limitation or revocation may be requested at any time, although precedence must always be given to opposition proceedings. Making the limitation procedure ex parte and doing away with an 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 effectively preclude any impending opposition or revocation proceedings.
5. Limitation takes the form of deleting individual claims and/or amending their wording. The Office will adapt the description and drawings at the patent proprietor's request if he submits an amended text. The EPO examines whether the requested amendment actually limits the protection conferred by the patent and, where appropriate, decides to limit it accordingly. If revocation has been requested, the Office examines whether the request is admissible, in particular whether the requester is entitled to make the request, and, where appropriate, decides to revoke the European patent. The limitation or revocation takes effect in all the contracting states in which the patent is or was in force on publication of the decision in the European Patent Bulletin.

### **B. ARTICLE 105a: REQUEST FOR LIMITATION**

6. Under **Article 105a(1)**, a European patent may be limited or revoked at the request of the proprietor. The Implementing Regulations will make it clear that limitation should primarily take the form of an amendment of the claims, that the deletion of individual claims is also understood as an amendment, and that the description will

only be adapted at the express request of the proprietor and provided he submits appropriate documentation. The requirements governing the admissibility of such requests will also have to be set out in the Implementing Regulations. These will 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 as a rule it can only be filed jointly by all the owners of the European patent. They must also stipulate what information the request should contain and what should be filed with it (eg the text of the desired new version of the claims).

7. **Article 105a(2)** governs the relation between the limitation procedure and opposition proceedings. The priority it gives to opposition proceedings prevents limitation procedures occurring where opposition has already been lodged. Since validly initiated opposition proceedings already afford patent proprietors the opportunity for "self-limitation" (Articles 102(3), 113(2) EPC) or revocation, there is no justifiable need in such cases for a concurrent limitation procedure. The procedure to be followed where opposition proceedings are initiated following the valid lodging of a request for limitation or revocation is to be laid down in the Implementing Regulations.
8. National proceedings, in particular those involving 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 may be advisable to stay the national proceedings in accordance with the provisions of the relevant national law, since revocation or limitation of the European patent can have a direct effect on the course and outcome of these proceedings. In view of the short duration of the European limitation procedure, this would not unduly delay national proceedings.

**C. ARTICLE 105b: EXAMINATION OF THE REQUEST, REJECTION OF THE REQUEST OR LIMITATION OF THE EUROPEAN PATENT**

9. The limitation procedure requires the European Patent Office, under **Article 105b(1)**, to examine whether the requirements laid down in the Implementing Regulations for a requested limitation or revocation have been met. With regard to limitation, this means in particular establishing whether the requested amendment of the claims actually limits the patent and whether the requirements of Article 84 EPC are met. Here too, moreover, the EPO has to apply the Convention's relevant general rules of procedure, and 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. The EPO does not examine whether the aim of the limitation - eg delimitation with respect to a particular prior art - is achieved, or whether the subject-matter of the limited patent is patentable under Articles 52-57 EPC.

10. 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. It has been shown in practice in these contracting states that patent proprietors are always interested in obtaining a valid residual patent and carefully gauge whether the subject-matter claimed will still be patentable after the proposed limitation.
11. 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).
12. Under **Article 105b(2)**, the European patent is limited or revoked by a decision of the EPO provided the prescribed conditions are met. Otherwise the request must be rejected. The procedure to be followed is to be laid down in detail in the Implementing Regulations. In particular, limitation should normally be based on the revised version of the claims submitted by the proprietor. The communication notifying the patent proprietor that the request for limitation can be allowed will invite 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 on 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.
13. Decisions of the examining divisions in limitation proceedings are subject to appeal in accordance with Articles 106 ff EPC.
14. When the decision to revoke or limit the European patent in accordance with **Article 105b(3)** is published, the effects of the European patent are cancelled ab initio (Article 68 EPC - see Part II below) in respect of all the contracting states in which it is or was valid. 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.

#### D. ARTICLE 105c: PUBLICATION OF AN AMENDED EUROPEAN PATENT SPECIFICATION

15. When it publishes the decision to limit the European patent the EPO will publish an amended European patent specification containing, in accordance with the Implementing Regulations, the new version of the claims, a translation thereof into the official languages of the EPO and, where appropriate, the description and drawings as amended. Translations into other languages will be included in the patent specification where this is provided for in the Implementing Regulations.

### PART II

#### IV. PROPOSED AMENDMENT OF ARTICLE 68 EPC

Present wording	Proposed wording
<b>Article 68*</b> Effect of revocation of the European patent	<b>Article 68*</b> Effect of revocation <b>or limitation</b> of the European patent
The European patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in Articles 64 and 67, to the extent that the patent has been revoked in opposition proceedings.	The European patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in Articles 64 and 67, to the extent that the patent has been revoked <b>or limited</b> in opposition <b>or limitation</b> proceedings.

#### V. EXPLANATIONS

16. The proposed new version of Article 68 EPC follows from the introduction of the limitation procedure with ab initio effect as set out above. The amendment incorporates the limitation procedure into the provisions governing opposition proceedings, whereby the European patent application and the resulting patent are deemed not to have had effect, as from the outset, to the extent that the patent has been revoked or limited.