

CA/100/00 Add. 2

Orig.: German

Munich, 01.09.2000

SUBJECT: Revision of the European Patent Convention

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for opinion)
2. Committee on Patent Law (for information)

SUMMARY

Article 21(3)(a) EPC needs clarifying to specify that appeals against decisions taken by examining divisions in the proposed central limitation and revocation proceedings under Articles 105a -105c EPC will be heard by technical boards of appeal.

ARTICLE 21 EPC

Explanatory remarks

(preparatory documents: none)

1. Requests for limitation or revocation of European patents under Articles 105a - 105c EPC will entail ex parte proceedings requiring a decision by an examining division.
2. Under existing Article 21(3)(a) EPC, a board of appeal consists of two legally qualified members and one legally qualified member (technical board) "when the decision concerns ... the grant of a European patent and was taken by an Examining Division consisting of less than four members". It is thus not absolutely clear whether appeals against decisions by such divisions on requests for limitation or revocation should go to a technical board of appeal or to the Legal Board of Appeal (consisting of three legally qualified members) under Article 21(3)(c) EPC.
3. Since limitation proceedings will focus in particular on compliance with Article 84 (clarity of the claims) and Article 123(2) and (3) EPC (added subject-matter, broader scope), appeals against the resulting decisions should be heard by the technical boards, and Article 21(3)(a) EPC should be supplemented to make this clear.
4. It is already clear, from Article 21(3)(b) EPC as it stands, that appeals against decisions in limitation or revocation proceedings taken by a four-person examining division will be heard by a (five-member) technical board.

Present wording

Article 21

Boards of Appeal

(1) The Boards of Appeal shall be responsible for the examination of appeals from the decisions of the Receiving Section, Examining Divisions, Opposition Divisions and of the Legal Division.

(2) For appeals from a decision of the Receiving Section or the Legal Division, a Board of Appeal shall consist of three legally qualified members.

(3) For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision concerns the refusal of a European patent application or the grant of a European patent and was taken by an Examining Division consisting of less than four members;

(b) three technically qualified members and two legally qualified members, when the decision was taken by an Examining Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires;

(c) three legally qualified members in all other cases.

Revised wording

Article 21

Boards of Appeal

(1) *Unchanged*

(2) *Unchanged*

(3) For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision concerns the refusal of a European patent application or the grant, **limitation or revocation** of a European patent and was taken by an Examining Division consisting of less than four members;

(b) *Unchanged*

(c) *Unchanged*

Present wording

(4) For appeals from a decision of an Opposition Division, a Board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision was taken by an Opposition Division consisting of three members;

(b) three technically qualified members and two legally qualified members, when the decision was taken by an Opposition Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires.

Revised wording

(4) *Unchanged*