

CA/16/98

Orig.: English

Munich, 18.02.1998

SUBJECT: Points for a revision of the European Patent Convention

DRAWN UP BY: President of the European Patent Office

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

SUMMARY

This document contains a provisional, non-exhaustive list of items of an essentially legal or technical nature which should be considered in view of a future revision of the EPC.

The Administrative Council is requested to entrust the Committee on Patent Law with a detailed study of the items outlined in this document.

INTRODUCTION

1. At its 69th meeting, from 2 to 5 December 1997, the Administrative Council, upon considering the proposal from the President of the EPO for an immediate revision of the EPC concerning BEST (CA/156/97) pronounced itself against a two-phased revision of the EPC beginning with a fast-track procedure focusing on BEST (see CA/169/97, point 8) and agreed in principle that all the issues put forth pertaining to a revision of the EPC be dealt with in a single process.
2. This document contains a provisional, non-exhaustive list of items of an essentially legal or technical nature, which should be considered in view of a future revision of the EPC, including the elements put forth in document CA/156/97.

These items have their origins in provisions of the WTO/TRIPs Agreement, the PCT, the draft Patent Law Treaty of 1991 and the new draft Patent Law Treaty, in proposals submitted to the Administrative Council and/or the Committee on Patent Law or communicated to the EPO, emanating from the delegations of Austria, Denmark, the Netherlands, Spain, Sweden, Switzerland and the United Kingdom, in points discussed within the framework of the European Commission's *Green paper on the Community patent and the patent system in Europe*, in suggestions put forth by users of the system, and finally, in discussions within the EPO.

3. The Administrative Council is requested to entrust the Committee on Patent Law with a detailed study of the points outlined in this document, without prejudging the future position of the Administrative Council regarding the points included therein, or any other point which is not.

I. GENERAL AND INSTITUTIONAL PROVISIONS

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

1. Currently, the EPC implies an organisational and geographical division between search and examination. Art. 6(2) provides that the EPO shall be set up in Munich, which may be interpreted as inferring that departments enumerated in Art. 15, which include the examining divisions, should be in Munich unless otherwise expressly provided. On the other hand, Arts. 16 and 17 respectively stipulate that the receiving section and the search divisions shall be located in The Hague, whilst Section I (1) (b) of the Protocol on Centralisation, refers to the taking over of the tasks of the International Patent Institute by the branch located at the Hague. Under the BEST project, both the search and the examination are performed by the same examiner, which may be located in The Hague, Berlin or Munich.

Background: CA/64/97; CA/156/97

Origin: Denmark, Netherlands, Spain, Switzerland; EPO; CA/PL PV 5, § 84

2. Within the context of this BEST revision, it should be considered whether the mentioning of specific organs pertaining to the first instances of the grant procedure could be replaced by a general reference to the EPO where appropriate, and that the EPC be purged of all geographical references unless such a reference is indispensable.

Examples: Arts. 90(1), 91(1), 153(2)

Origin: EPO

* This item has already been the subject of discussions at the 6th meeting of the Committee on Patent Law on 27 January 1998, based on a preliminary draft of proposals for amendment of the EPC contained in CA/PL 2/98.

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

The Administrative Council has unanimously endorsed a declaration confirming that Art. 54 of the Service Regulations which specifies 65 as the age limit for retirement, applies also to the members of the boards of appeal and the Enlarged Board of Appeal. At present, Art. 23(1) EPC sets forth that members of the boards of appeal shall be appointed for a term of 5 years and may not be removed from office during

this term. As the EPC does not contain an express provision mirroring that of the Service Regulations, the President of the EPO and the Administrative Council have been repeatedly asked to conclude exceptional arrangements in individual cases allowing members of the boards of appeal to serve out their term past the age of 65.

To simplify matters, it has been suggested that Art. 23(1) EPC be amended specifying that no member of a board of appeal shall serve beyond his sixty-fifth birthday.

Background: Service Regulations
Origin: Netherlands, Spain; EPO

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

At present, pursuant to Art. 23(3), the members of the boards are bound solely by the provisions of the EPC. It has been suggested that in addition, the members of the boards should be bound by the TRIPs Agreement as well as by the European Convention for the Protection of Human Rights and Fundamental Freedoms.

Origin: Netherlands

D. ART. 142(1): SPECIAL AGREEMENTS

It has been queried whether the "special agreements" mentioned in the title of Part IX and Art. 142(1) should be replaced by a broader legal notion.

Origin: Netherlands

II. SUBSTANTIVE PATENT LAW

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

Article 52(2) contains a list of items which shall not be considered to constitute an "invention" such as, in particular, programs for computers. It has been argued that Art. 27(1) TRIPs requires that computer programs be protected *per se*, and therefore suggested that in Art. 52(2) at least computer programs be deleted.

Background: TRIPs Art. 27(1); *Green Paper*
Origin: Austria, Spain, Sweden, Switzerland; users of the system

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

Article 53(a) excludes from patentability inventions the **publication** of which would be contrary to "ordre public" or morality. Under the TRIPs Agreement, Members may only exclude from patentability inventions, the **exploitation** of which would be contrary to "ordre public" or morality. Thus, the removal of the aforementioned clause has been argued to be desirable to bring Art. 53(a) into line with the TRIPs Agreement. It may be noted that this clause has had no practical significance so far.

Background: TRIPs, Art. 27(2)

Origin: Spain, Switzerland; EPO

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

Under Art. 54(3), all applications filed prior to the priority date of a later application and published on or after that date are comprised in the state of the art for the purpose of determining novelty. This entails that where an earlier application anticipates a later one, it will have novelty-destroying effect even if the two applications have been filed by the same person. It has been suggested that a provision preventing such self-collision could be introduced into the EPC, balanced by a clause to the effect that only one patent may validly be granted by the EPO for the same invention.

Background: Draft PLT 1991, Art. 13(4)

Origin: users of the system

III. PROCEDURAL AND TECHNICAL PROVISIONS

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

The EPC is rigorous with respect to the time limit for filing the request for examination under Art. 94. Whilst the Administrative Council is competent to amend the time limits laid down in the EPC, it may only extend the period for filing the request for examination if the conditions of Art. 95 are met, *i.e.* if applications cannot be examined in due time, due to backlog or any other contingency.

Greater flexibility of the EPC in this respect may be needed in the future, particularly in view of the evolution of the PCT. It is to be stressed that the purpose of any such

amendment would not be necessarily to introduce deferred examination, which remains a point of contention amongst users of the system.

Origin: users of the system

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

In decision G 3/92 (OJ 1994, 607), the Enlarged Board of Appeal set forth that where an application has been filed by a person not entitled to the patent, it was not required that the first application still be pending for the inventor or his successor in title to file a new European application pursuant to Art. 61(1)(b). The protection of third parties who may have commenced activities based on published information concerning a first application which is withdrawn or deemed to be withdrawn, was a matter for national law. This may lead to undesirable differences in treatment depending on the contracting state involved.

Three solutions may be envisaged with respect to new applications filed under Art. 61(1)(b):

1. Art. 61(1) could be clarified to render pendency a requirement for such a new filing;
2. A deadline for the filing of the new application could be introduced, similar to that contained in Art. 122(2);
3. A provision protecting the rights of third parties could be inserted, similar to that of Art. 122(6).

Origin: EPO

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

Pursuant to Art. 123(2), amendments introducing into an application subject-matter extending beyond the contents as originally filed are prohibited. Divisional applications may only be filed with respect to subject-matter which does not extend beyond the contents of the earlier application as filed. Thus, the only way to obtain protection on added matter is to file a new application. Often, this will be precluded by the fact that the new matter may not be patentable on its own, or it may be anticipated by the earlier application. This approach is quite strict.

Many systems allow the inclusion of new subject-matter in divisional or similar types of applications, with new matter being accorded a new filing date, and the term of the patent running from the filing date of the parent application (see also the US practice of "terminal disclaimer".) The possibility of introducing this practice into the EPC might be discussed.

Origin: EPO; users of the system

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

Currently, Art. 87(1) EPC is framed so as to automatically afford a priority right to applications filed in or for any state party to the Paris Convention. In the wake of the TRIPs Agreement, most of the EPC contracting states have extended that effect to applications filed in a WTO member state.

Hence, it is proposed that Art. 87(1) be extended to afford a priority right to applications emanating from WTO countries. Art. 87(5) should be amended accordingly, but be retained in order to deal with countries not party to the Paris Convention or the WTO bestowing priority rights on first filings at the EPO on the basis of a bilateral agreement.

Accessorily, the reference to inventor's certificates in Art. 87(1) should be deleted.

Background: TRIPs Arts. 2(1) and 4; CA/PL 3/97

Origin: Austria, Spain, Switzerland; European Commission; EPO

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

At present, pursuant to Art. 88(1) and Rule 38, applicants wishing to rely on a priority right are required to file a declaration of priority, a copy of the previous application and, where the latter is in another language than one of the official languages of the EPO, a translation of the previous application into one of the EPO official languages.

It is proposed that the the formal requirements for claiming priority should be moved to the EPC Implementing Regulations with the following in mind:

(1) The obligation to file systematically both the copy of the previous application and its translation be removed. Such documents should only be required to be filed upon invitation by the EPO where deemed necessary. This would simplify application formalities, reduce costs, and bring Art. 88 in line with international standards under the new draft PLT.

(2) In view of the development of electronic exchange of priority documents between patent offices, provision should be made for such electronic exchange so that where a priority document filed with another office is deemed necessary, the EPO could obtain it without the intervention of the applicant. This would simplify matters and reduce costs not only for the applicant but also for the EPO.

Background: New draft PLT, Art. 5(6); Trilateral Project A2c
Origin: Spain, Switzerland; EPO; users of the system

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

1. Article 83 (enabling disclosure) forms a ground of opposition, whereas Art. 84, stipulating that the claims must be supported by the description, does not. Although the case law has developed in such a manner that overly broad claims can be successfully challenged on the ground of insufficiency of disclosure, and some cases may be disposed of by invoking lack of inventive step under Art. 56, it has been proposed to make lack of support of the claims a ground for opposition/revocation under Arts. 100 and 138.

Background: CA/PL 12/95; CA/PL 4/96; CA/PL 6/96; CA/PL 8/96; Info4/PL3
Origin: United Kingdom

2. Alternately, consideration might be given to removing the essentially formal requirement contained in Art. 84 that the claims must be supported by the description.

Origin: EPO

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

Following the practice of the boards of appeal, a legal basis should be provided for the exclusion of late filed amendments or late submission of facts or evidence, where the party carries the burden of proof, once the case is ready for a decision. This should not exclude the possibility to resume the proceedings if facts come to light which, if disregarded, would render the envisaged decision incompatible with the EPC.

Origin: EPO

H. ART. 116: ORAL PROCEEDINGS

1. It is suggested that the possibility of oral proceedings being held before the Receiving Section as provided by Art. 116(2) be eliminated. It appears that oral proceedings have never actually taken place in front of the Receiving Section. Due to the degree of legal difficulty involved in conducting such a procedure, requests for oral proceedings with regard to decisions made by formalities examiners in DG2 usually take place in front of a complete examining division enlarged by a legally qualified member, and cannot simply be delegated to a formalities examiner.
2. It might also be considered whether the other instances of the EPO, *i.e.* the examining division, the opposition division and the boards of appeal could not be given discretion to refuse the holding of oral proceedings where the latter are clearly unnecessary or abusive.

Origin: EPO

I. ART. 117: TAKING OF ORAL EVIDENCE

1. Nowhere is there a provision for the EPO to take oral evidence under oath in any of its proceedings. It might be considered whether Art. 117(1)(d) should not be amended to provide that, where deemed necessary, witnesses may be heard under oath.
2. Under Art. 117(4), a party, witness or expert summoned before the EPO may request to be heard by a court in the country of residence, or the EPO may request the competent court to hear the person concerned, which is onerous and time consuming. It might be considered whether Art. 117(3)(b) and (4) could be deleted, and a Rule inserted in the Implementing Regulations allowing such a hearing before a national court only under exceptional circumstances.

Origin: EPO

J. ART. 120: TIME LIMITS

Under Art. 120, the EPO may extend time limits in certain circumstances, *inter alia* where there is a general interruption or subsequent dislocation of postal services.

This provision is arguably unduly restrictive, as is reflected by the provisions of Rule 85. It should be amended to render it more flexible. This would permit the

adoption of a system dealing with mail irregularities similar to that of the PCT, whereby the delay in arrival of a document will be excused where the interested party offers evidence that he has mailed the document in question at least five days prior to the expiration of the time limit.

Background: PCT, Rule 82

Origin: EPO

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

The EPC provides two mechanisms in order to deal with failure to act within a time limit. Where the applicant fails to meet **a time limit set by the EPO**, pursuant to Art. 121, he may perform the omitted act, pay the prescribed fee and request further processing of the application within the prescribed period. The non-observance of **time limits set by the EPC** (and also those set by the EPO) may be remedied by way of *restitutio in integrum* under Art. 122, a procedure involving the production and weighing of evidence of the exercise of due care by the applicant. Art. 122(5) removes certain deadlines from the ambit of the provision: those for claiming priority, paying the filing, search and designation fees, filing the request for examination, and applying for *restitutio in integrum* itself.

Regarding tardiness in the payment of fees or in filing a request for examination, the strictness of the system has already been eased by the adoption of Rules 85(a) and 85(b), which in substance provide a mechanism of further processing. However, as far as the remaining time limits are concerned, no possibility exists to salvage the applicant's rights, even in cases of either human error beyond the control of the applicant or *force majeure*. Two alternate proposals have been put forth:

1. All time limits might be rendered eligible for further processing under Art. 121 against payment of a penalty fee. Guidance could be taken here from the recent Swiss approach to further processing and re-establishment of rights.
2. It should at least be considered whether to amend Art. 122(5) so as to broaden the applicability of *restitutio in integrum* to some time limits set by the EPC which are presently excluded, including in particular that concerning the period for claiming priority.

Background: New draft PLT, Arts. 13, 14 and 15; Info 2/PL 3

Origin: Austria, Switzerland; EPO; users of the system

L. ART. 123: AMENDMENTS

Article 123(2) prohibits amendments introducing subject-matter going beyond the contents of the application as filed, whereas under Art. 123(3), the claims of a European patent may not be amended in opposition proceedings in such a manner as to extend the protection conferred (see also Art. 138(1)(d)).

The combination of these rules may result in a trap for the patentee (see T231/89, OJ EPO 1993, 13). Where an amendment is made prior to grant adding a limiting feature to the claims which was not originally disclosed, the patent cannot be maintained in opposition proceedings as it would contravene Art. 123(2). However, striking the limiting feature is not permissible since it would result in a broadening of the claim, contrary to Art. 123(3). According to the Enlarged Board of Appeal (G1/93, OJ EPO 1994, 541), this trap can only be avoided in very rare cases.

As a possible solution, it might be considered whether Art. 123(2) could be amended to remove this trap and incorporate into the EPC an approach similar to that developed under German national law (sometimes referred to as the "footnote solution"). § 38 of the German Patent Act reads: "Up to the time of the decision to grant the patent, alterations in the contents of the application shall be permissible which do not broaden the scope of the subject-matter of the application; [...]. *No rights may be derived from alterations which broaden the scope of the subject matter of the application.*"

If this solution were to be adopted, an inadmissible amendment adding new matter to the application would remain in the claim in order to comply with Art. 123(3), but a statement would be added to the specification earmarking the inadmissible amendment. No account would be taken of the new matter thus introduced for the purpose of testing the patentability of the invention in a subsequent suit. However, the limiting feature inadmissibly added would be considered in assessing the extent of protection for purposes of determining infringement.

Background: Enlarged Board of Appeal decision G9/93 (OJ EPO 1994, 891)
Origin: EPO

M. ART. 129: PERIODICAL PUBLICATIONS

The EPC presently prescribes the content of the periodical publications of the EPO and specifies *inter alia* that the European Patent Bulletin shall contain the entries made in the Register of European Patents. It is suggested that Art. 129 should be

redrafted so as to unbundle the Register and the Bulletin. It is sufficient for the Convention to refer to these publications, and have their respective content defined either in the Implementing Regulations or by the President of the EPO.

Origin: EPO

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

Following a decision of the Administrative Council of June 1992, the President of the EPO set up a review panel for the protest procedure under the PCT (OJ EPO 1992, 547) which is completely in line with the relevant PCT provisions. However, Arts. 154(3) and 155(3) provide final jurisdiction in such matters to the boards of appeal. This procedure was misconceived from the very beginning, and the EPO is the only PCT authority which provides such a mechanism of judicial review in the international phase. These provisions should be deleted as the procedure they create is unjustified, work-intensive and costly.

Background: CA/7/92 and CA/PV 44, § 66

Origin: EPO

O. STAY OF PROCEEDINGS

The pending of a case on a point of law in front of the Enlarged Board of Appeal does not have a suspensive effect on other ongoing proceedings before the EPO which might be affected by the outcome of the decision and no stay of proceedings is available under the EPC. Thus, it is suggested that in such cases, the EPO be given the discretion to stay proceedings.

Origin: EPO

IV. GENERAL

A. DEREGULATION

Patent legislation is often forged with the efficiency of the system and the operation of the patent office in mind rather than the needs of the users, resulting in a plethora of prescriptions which in some cases may become an unnecessary burden on the users. The purpose of this exercise would be to simplify legislation and reduce the regulatory burden to an extent consistent with the efficient and safe operation of the system. Such an exercise would entail an exhaustive and systematic review of the provisions of the EPC and its Implementing Regulations in order to identify

appropriate amendments. Concrete proposals would have to be developed respecting the balance of the system. Ultimately, costs for the users should be reduced.

Origin: United Kingdom; EPO

B. TRANSFER EPC REQUIREMENTS TO IMPLEMENTING REGULATIONS WHEREVER POSSIBLE

The EPC contains many provisions which may be subject to change for a number of reasons. Transferring these provisions to the Implementing Regulations whenever possible would allow the EPO to retain a maximum amount of flexibility by enabling the Administrative Council to respond quickly to such needs for change. Such flexibility will become of increasing importance as the number of contracting states rises.

For example, as the inexorable trend towards electronic filing, digital data processing and office automation continues, it is increasingly anachronistic to have references in the EPC to written documents, *e.g.* Arts. 99(1); 108; 115(1). These clauses might cause considerable legal difficulty in the further implementation of many modern communication and working methods, and therefore, it is suggested that they be moved from the EPC to the Implementing Regulations, where they will be easier to adapt to new developments.

Further examples: Art. 79(2); 91(5) and (6); 92(2); 94(1); 97(4) and (5).

Background: Recent trends in treaty drafting. Reference is made to the structure of the PCT, the EAPC and the new draft PLT.

Origin: Switzerland; EPO

V. "HOUSEKEEPING" AMENDMENTS

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

Some Articles and Rules show slight divergences in their English, French and German versions. Furthermore, some terminology is inconsistently used throughout the EPC. These discrepancies should be eliminated for the sake of clarity.

Origin: Netherlands; EPO

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

These provisions for the most part are obsolete and should be deleted, with the following proviso:

The substance of Art. 163(6) pertaining to the entering on the list of professional representatives, of persons having their place of business or employment in a newly acceded state, should be added to Art. 134.

Any reservation made under Art. 167(2) has now expired and further reservations may not be made by newly acceding contracting states. However, Art. 167(5) would continue to apply to European applications filed and patents granted during the period when a reservation was still in effect.

Origin: Netherlands; EPO
