CA/16/98 Add. 1

Orig.: English

Munich, 12.08.1998

SUBJECT: Points for 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)

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SUMMARY

This addendum to CA/16/98 contains further points of an essentially legal or technical nature which should be considered in view of a future revision of the EPC emanating from the President of the European Patent Office and *epi*.

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

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II. SUBSTANTIVE PATENT LAW

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

Regarding the proposal in CA/16/98 to remove the "publication" clause in Art. 53(a) EPC, the *epi* queries what the responsibility of the EPO would be if it published an invention contrary to "ordre public" or morality. Would the EPO as an international organisation be condemned before a penal court for publication of a document which is contrary to "ordre public" or morality, as is the case for example for racist publications or similar books? This question should be looked into.

Origin: epi

D. ARTS. 52(4) AND 54(5): TREATMENT OF MEDICAL METHODS

(a) Deletion of Art. 52(4)

Article 52(4) provides that surgical, therapeutic and diagnostic methods practised on the human or animal body are not regarded as patentable inventions.

In view of the difficulties relating to the interpretation of the decision of the Enlarged Board of Appeal in matters of second medical indication (G06/83), *epi* suggests that a study be made as to whether it would be appropriate to amend the EPC so that a method for the treatment of the human or animal body would be patentable like any other method, as long as the invention effectively solves a technical problem (as in the case for inventions in the computer field). A claim to such a method or use of a product for treating the human or animal body should also include the technical (therapeutic) effect obtained as disclosed in the description.

It has also been suggested that Art. 52(4) be removed, but an exemption from liability be introduced similar to the one contained in Art. 27(c) CPC, for acts performed by the medical or veterinary profession in practicing such methods. This approach has been enacted recently in the US (35 USC 287 (c)).

Background: TRIPs, Art. 27(3)
Origin: epi; users of the system

(b) First and further medical uses

Art. 52(4) further specifies that the exception concerning medical treatment shall not apply to products for use in such methods, and under Art. 54(5) a product may be patented for its first medical use, even where that product is comprised in the state of the art.

Second medical applications are only patentable in the form of Swiss-type claims, *i.e.* where the use of a substance is claimed for the manufacture of a product used in a medical method (see G05/83, OJ EPO 1985, 64). Should Art. 52(4) be retained, the distinction drawn between the first and further medical uses of a known substance should be reviewed and possibly eliminated.

epi suggests that a claim to a pharmaceutical product might be limited to the therapeutic effect disclosed in the description, even in the case of a first medical use. The European patent system would then be more in line with the US and JP patent systems in this field.

Origin: Austria, Netherlands; epi; users of the system

E. ART. 53(b): DELETE AND/OR REFLECT THE EC BIOTECHNOLOGY DIRECTIVE

Article 53(b) excludes from patentability plant or animal varieties or essentially biological processes for the production of plants or animals. Interested circles have repeatedly expressed their desire for Art. 53(b) to be deleted. The *epi* suggests it should be made clear in the EPC that genetically modified plants or animals may be patented and do not fall within the exclusion of plant or animal varieties.

Now that the EC Biotechnology Directive has entered into force, it will be necessary to assess whether Art. 53(b) as interpreted by the boards of appeal is in conformity with its prescriptions. Pursuant to the Plant cells/PGS decision (T356/93, OJ EPO 1995, 545), plants cannot be claimed *per se* at least if they comprise plant varieties. However, this crucial question has been referred to the Enlarged Board of Appeal, and it remains to be seen whether EPO practice on this point will evolve once the Enlarged Board of Appeal will have dealt with this matter (T1054/96; OJ EPO 1997, 551).

Background: EC Biotechnology Directive
Origin: Denmark, Netherlands, Switzerland; EPO; epi; users of the system

III. PROCEDURAL AND TECHNICAL PROVISIONS

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

The *epi,* supporting proposal No. 1 put forth under this item in CA/16/98, is in favour of replacing the present system of *restitutio in integrum* by a system where re-establishment may be obtained on payment of a fee within a prescribed period.

P. ARTS. 79 AND 80: DESIGNATION OF CONTRACTING STATES AND REQUIREMENTS FOR OBTAINING A FILING DATE

Under Art. 80, in order to obtain a date of filing, the documents filed by the applicant must contain, *inter alia* the designation of at least one contracting state and one or more claims. The description and claim(s) must be in an admissible language under Art. 14(1) or (2).

Under the new draft PLT, claims would no longer be required and the description and claims could be drawn up in any language. It is suggested that Art. 80 be adjusted accordingly. The requirement of translation (see Art. 14(2), Rule 6 EPC) would, of course, be retained. In addition, EPO practice has changed, in that application forms now have a pre-crossed box designating all contracting states, so that the requirement that at least one contracting state be designated should be eliminated as well.

Furthermore, Art. 79(1) requiring that the request for grant designate the contracting states has become superfluous and should be amended accordingly (see also decision J 25/88, OJ 1989, 486).

Background: New draft PLT, Art. 4(1); Info 2/PL 3
Origin: Austria, Switzerland; EPO; users of the system

Q. ART. 96: EXAMINATION OF THE EUROPEAN PATENT APPLICATION

Article 96(1) provides that if an applicant has made a request for examination before the European search report has been transmitted to him, the EPO shall invite him to indicate whether he desires to proceed further with the application. If the applicant fails to reply to the invitation in due time, the application shall be deemed to be withdrawn (Art. 96(3)).

The *epi* submits that since in the majority of cases the applicant wishes to proceed, the current procedure results in unnecessary work in many cases, including the noting and monitoring of the deadline for response. It can result in a trap for the applicant who may suffer a withdrawal of the application if he fails to reply. This seems an unnecessary risk.

The *epi* therefore suggests that Art. 96(3) be amended to provide that if the applicant fails to reply in due time to an invitation under Art. 96(1), the application should proceed to examination.

Origin: epi

R. CENTRAL LIMITATION PROCEEDINGS AND SURRENDER BEFORE THE EPO

1. Prior to the decision of the Enlarged Board of Appeal G9/93 (OJ EPO 1994, 891), patentees could lodge an opposition against their own patents and thus limit the patent or have it revoked for all designated states in a centralised manner, *e.g.* to deal with prior art which emerged after the grant of the patent. This avenue has been closed, so that there are no central post-grant limitation proceedings in front of the EPO, forcing patentees to resort to national proceedings where available. Where limitation proceedings are not provided for under national law, the patent may be unenforceable in practice.

   It has therefore been proposed that in addition to the option of national proceedings, a **centralised limitation procedure** in front of the EPO be instituted. This has met with a generally positive response within the Patent Law Committee.

   Background: CPC, Arts. 51-54; CA/PL 11/96; CA/PL 13/96
   Origin: Austria, Sweden, Switzerland; EPO

2. In addition, there is no procedure under the EPC allowing the central surrender of patents in front of the EPO. Thus, it should be considered whether a mechanism for the **central surrender** of patents at the EPO could be set up (see also Art. 99(3) EPC). The EPO would then notify national patent offices of patents thus surrendered.

   Origin: EPO

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