

**CA/110/99**

Orig.: English

Munich, 07.12.1999

SUBJECT: Revision of the EPC

DRAWN UP BY: Chairman of the Administrative Council

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

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#### SUMMARY

This document shows in Part I a complete list of revision points which have arisen to date and in Part II proposals for further work and an outline timetable leading to a revision conference.

The approval of the Council to referring points 30 to 34 in paragraph 3, Part I to the Committee on Patent Law is requested.

The Council's approval is also requested for the timetable and proposals in Part II.

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## **PART I**

### **CURRENT STATE OF PREPARATIONS FOR THE REVISION OF THE EPC**

#### **1. Points for revision already dealt with by the Committee on Patent Law**

<b>No.</b>	<b><i>EPC Articles</i></b>	<b><i>Proposal</i></b>	<b><i>CA/PL</i></b>		
			<b><i>meeting</i></b>	<b><i>document</i></b>	<b><i>outcome</i></b>
1	16-17, CentProt	Adapt to allow office-wide implementation of BEST	7	10/98	<b>approved</b>
2	23(1)	Introduce age limit for Board of Appeal members	7	11/98	<b>approved</b>
3	23(3)	Provide for Boards of Appeal to be bound by other agreements such as TRIPs	9	5/99	<b>disapproved</b>
4	52(1)-(3)	Bring into line with TRIPs and delete at least computer programs in 52(2)	9	6/99	<b>approved in principle</b>
5	52(4)	Delete provision so as to allow patenting of medical methods	9	7/99	<b>disapproved</b>
6	53(a)	Bring into line with TRIPs	9	8/99	<b>approved</b>
7	54(4)	Delete provision so as to provide for Europe-wide prior art effect of EP applications	10	17/99	<b>approved</b>
8	87(1)	Extend priority right to filings in any WTO country	8	16/98	<b>approved</b>
9	87(5)	Simplify mechanism for reciprocal recognition of priority rights	8 + 9	16/98 + 9/99	<b>to be reviewed</b>
10	88(1)	Refer formal requirements for claiming priority to the Implementing Regulations	8	17/99	<b>approved</b>

No.	EPC Articles	Proposal	CA/PL		
			meeting	document	outcome
11	100, 138	Make lack of support under Art. 84 a ground for opposition and revocation	11	27/99	disapproved
12	121, 122	Extend further processing to all time limits to be observed in grant proceedings	10	19/99	approved in principle
13	123(2) and (3)	Remove the "inescapable trap"	11	26/99	disapproved
14	129(a)	Unbundle EP Register and Bulletin	8	19/98	approved
15	134 (163)	Integrate into Art. 134 the requirements under Art. 163 for national representatives of newly acceded contracting states to be entered on the list of professional representatives	8	18/98	approved (subject to review in light of further <i>epi</i> suggestions)
16	154(3), 155(3)	Delete the provisions so as to relieve Boards of Appeal from review in PCT protest cases	7	12/98	approved
17	159-163, 167	Delete obsolete transitional provisions	8	18/98	approved
18	New provisions	Provide for central limitation procedure before EPO	11	29/99	approved in principle

## 2. Points for revision yet to be dealt with by the Committee on Patent Law

No.	EPC Articles	Contemplated Proposal
19	54(5)	Improve protection for second and further medical uses of known substances
20	79	Remove requirement for EPC countries to be designated in EP application
21	80	Refer requirements for a filing date to the Implementing Regulations and adapt them to Patent Law Treaty 2000

<b>No.</b>	<b>EPC Articles</b>	<b>Contemplated Proposal</b>
22	85	Upgrade function of the abstract to serve as a basis for disclosure
23	94, 95	Create a more flexible regime regarding the time limit for requesting examination
24	96	Review examining procedure and/or refer details to the Implementing Regulations
25	142ss	Review provisions in light of EUC's proposal for a Community patent regulation
26	New provisions	Provide for central surrender of EP before EPO
27	"Deregulation"	Eliminate unnecessary or burdensome requirements
28	"Unload the EPC"	Review all EPC Articles with a view to referring any details to the Implementing Regulations
29	"House-keeping"	Review and edit the texts of the EPC

**3. Further points which the Administrative Council is requested to refer to the Committee on Patent Law**

<b>No.</b>	<b>EPC Articles</b>	<b>Contemplated Proposal</b>
30	11 (160(2))	Make participation of national judges in proceedings before the Enlarged Board of Appeal a permanent opportunity (see CA/106/99)
31	33, 35	Enable the Administrative Council to amend the EPC to comply with EC legislation and international treaties (proposal emanating from CA/PL)
32	55	Examine opportunity to introduce a more general "grace period" (subject of an expert opinion to be delivered by Mr Galama and Straus)
33	69	Strengthen the protection of EPs by clarifying extent of protection (equivalents, prosecution history estoppel)
34	112	Enable parties to appeal proceedings to have the case reviewed by the Enlarged Board of Appeal

**PART II**

**PROPOSALS FOR FURTHER WORK AND OUTLINE TIMETABLE  
LEADING TO A REVISION CONFERENCE**

1. The Administrative Council in Dublin will convene a Diplomatic Conference to take place from 20 to 29 November 2000, with the option to be continued and terminated in spring 2001.
  2. The London Intergovernmental Conference (follow-up to the Paris IGC) will be convened shortly before.
  3. Before the end of 1999 the Office will set up a properly staffed task force so that the tight time-frame can be met.
  4. The Committee on Patent Law will deal expeditiously with all outstanding revision points, working where necessary in long intensive session.
  5. If necessary, the Administrative Council will decide to make budgetary provisions for the above measures.
  6. A preparatory meeting for the Diplomatic Conference at the level of the Administrative Council will be arranged ideally in June 2000, or if not then in a subsequent special meeting.
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