EUROPEAN PATENT ORGANISATION

- Committee on Patent Law -

_____

Info 2

14th meeting (Munich, 03. - 07.07.2000)

Munich, 26.06.2000

Orig.: English

SUBJECT: Revision of the EPC - Comments relating to specific Articles of the EPC

DRAWN UP BY: *epi*

ADDRESSEES: Committee on Patent Law (for information)

_____

This document has been distributed in **English only.**

_____

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

Article 52 – Patentable inventions

The **epi** considers that Article 52(1) EPC should be aligned with the TRIPS wording. Articles 52(2) and 52(3) should be deleted completely.

This would make clear, as already mentioned in the TRIPS Agreement, that inventions can be patented in all technological fields without discrimination.

The **epi** therefore suggests that Article 52 be reworded as follows:

Article 52 – Patentable inventions

(1) European patents shall be granted for any inventions in all fields of technology, which are susceptible of industrial application, which are new and which involve an inventive step.

(2) Unchanged wordingof 52(4).

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

Article 54(5) – Novelty in case of inventions in the therapeutic field

The **epi** recognizes that medical methods can not be patented according to Article 52(4).

However, as already stated in Article 54(5) EPC in its present wording, a product protection in case of a first medical indication can be obtained with a large scope not limited to the specific use disclosed in the patent application (see for example T128/82).

As a matter of fact, such a broad protection presently available is fully justified by the fact it corresponds exactly to the invention made, i.e. that a given product can be used without risk in human or animal therapy, which means that toxicity testing and clinical tests have been made.

At present however, it is difficult to obtain a clear protection in case of a second or further medical indication. The claim wording proposed by the Enlarged Board of Appeal in its decision G06/83 Pharmuka may not be accepted by all national courts of the designated countries.

The **epi** stresses that this situation is unacceptable and considers that Article 54(5) should be amended, so that a clear patent protection could be obtained in case of a second or further medical use. National courts could only recognize this possibility of protection if a specific amendment is made in Article 54.

The best possible amendment should indicate that protection could be obtained by a product claim limited by the specific use corresponding to the second or further medical use.

The **epi** would therefore suggest to add the following paragraph to Article 54:

(6) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52 paragraph 4, provided that its use is not comprised in the state of the art.

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

Article 69 – Protocol on Interpretation (extent of protection)

At the last Committee on Patent Law meeting, it was made clear that an amendment to the Protocol on Interpretation of Article 69 could be made in order to *"strengthen protection by mentioning equivalents and prosecution history estoppel"*.

On equivalency

The definition of what constitutes an equivalent varies from country to country within Europe. Including therefore an harmonized definition of equivalency in the Convention would be extremely difficult. Furthermore, it would be dangerous in view of the fact that freedom should be left to the courts for defining such concept and modifying the definition after some time, if it appears necessary. The possible creation of a new European judicial organization will also probably lead to an harmonization of the definition of equivalents throughout Europe. It would not be advisable to bind the future European courts by a strict definition introduced in the Convention.

Prosecution history estoppel

The **epi** considers that any estoppel should be limited to submissions or declarations made by the applicant or patent proprietor before the European Patent Office. In other words, only the file of the European Patent Office could be used in this regard excluding any submission or declaration made during prosecution or litigation relating to patents in other countries.

The concept of estoppel could therefore be in the last sentence of the Protocol on interpretation of Art. 69, for example by stating:

"taking into consideration any submission or declaration made by the applicant or the patentee before the European Patent Office".

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

New proposed paragraph in Article 69 - Provisional protection when the European patent is maintained amended after opposition

The practice has shown that some difficulties occur when a European patent is maintained amended by a decision of an Opposition Division while a litigation is pending before a national court.

If namely the proprietor of the patent has not requested before the Opposition Division that the European patent be maintained unamended and, if the Opposition Division finally decides to maintain the European patent with amended claims, the proprietor of the patent cannot file an appeal any more to have the European patent reinstated with the claims as granted.

In such a situation, if the opponent files an appeal, a national court could consider that there is an uncertainty of the effective protection of the European patent in the time period between the decision of the Opposition Division and the final decision of the Board of Appeal.

A national court could consider that there is a lack of protection during this period of time, the patent proprietor having in some way renounced to the protection of the granted claims due to the fact that no request to maintain the patent unamended was filed before the Opposition Division.

On the other hand, the filing of an appeal by the opponent has a suspensive effect so that the claims accepted by the Opposition Division are not yet definitive.

In order to clarify this situation, the **epi** feels advisable to clearly indicate, for example in a new paragraph (3) of Article 69, that the effects of the European patent are defined within this period of time by the claims of the patent maintained amended by the Opposition Division.

Of course, when provisional protection requires in a Contracting State a translation in an official language, this translation should also be provided.

The following wording could be adopted for such a new Article 69(3):

For the period up to a final decision of a Board of Appeal, following a decision of an Opposition Division, the extent of the protection conferred by the European patent shall be determined by the claims of the patent maintained as amended if the proprietor of the patent has not requested the maintenane of the European patent as granted. Provisions of Article 67 shall apply.

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

Articles 84 / 100 / 138 – Support of the claims – Grant for opposition - Grant for revocation -

A proposal presented by the UK delegation consists in introducing the lack of support of the claims by the specification as a new ground for opposition (Art. 100) and for nullity (Art. 138).

In the presentation document, the European Patent Office explained the present practice of the European Examiners towards broad claims. According to the guidelines, the scope of the claims must not be broader than justified by the extent of the description and drawings.

According to the Boards of Appeal, the claims must be both consistent and commensurate with the description. Accordingly, a claim which does not contain a feature identified as essential in the description is inconsistent with and not supported by the description.

Art. 83 EPC relates to the disclosure of the invention whilst Art. 84 EPC deals with the definition of the invention by the claims. When assessing whether claims are adequately supported by the description, the Board examines whether it can reasonably be assumed that the technical problem the invention is to solve will be solved by the subject-matter of the claim in its entire scope.

The Boards of Appeal usually combine Art. 83 EPC together with Art. 56 EPC and argue that any subject-matter falling within a valid claim must be inventive. If this is not the case, the claims must be amended so as to exclude obvious subject-matter in order to justify the monopoly (see for example T939/92 "Triazols/AGREVO - OJ 1996, p.309; T694/92 "Modifying plant cells/MYCOGEN - OJ 1997, p.408).

It has been argued that inclusion of Article 84 EPC as a ground for opposition and revocation is not necessary because only unduly broad claims can be attacked on the basis of a combination of Articles 83 and 56 EPC. However, this specific combination does not lead to a clear possibility of attack in many situations. There is a strong risk that national Courts would not be able to make the same time interpretation proposed by the Boards of Appeal of the EPO.

Furthermore, if Article 84 would be a new ground for opposition and revocation, this would increase the quality of the examination at the EPO, the examiner having more possibilities to proceed with a complete examination of the real scope of the claims in view of the description.

For all those reasons, the **epi** is still of the opinion that Article 84 should be introduced as a new ground for revocation and opposition.Patent Office.

epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Ausschuß für europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

Der Vorsitzende . The Chairman . Le Président

Paris, June 9, 2000

Article XX – Provision for future optional protocols

While the **epi** approves the idea of introducing such a new Article to anchor possible future protocols in the EPC, the **epi** nevertheless considers that if a common entity competent to answer to interpretation questions would be created in the future, it would not be appropriate that such common entity would operate within the EPO premises and with supporting staff of the EPO.

As a matter of fact, this could lead to questions concerning the real independence of such a future common entity.

The **epi** therefore proposes to cancel paragraph 2(b) of proposed Article XX.