DIPLOMATIC CONFERENCE

TO REVISE THE EUROPEAN PATENT CONVENTION

(Munich, 20 - 29.11.2000)

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DRAWN UP BY: Institute of Professional Representatives before the European Patent Office (*epi*)

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epi

Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près de l'Office européen des brevets

October 30, 2000

Revision of the EPC - Diplomatic Conference
Final comments of the epi

Article 52 - Patentable inventions

The **epi** considers a revision of the EPC necessary in order that the law in Europe precisely conforms with the provisions contained in the TRIPS Agreement.

The **epi** therefore welcomes the proposed amended paragraph 1 in which it is now made clear that protection should be granted by patents for inventions in any field of technology.

The **epi** considers equally necessary to revise the EPC so as to reflect the evolution of the decisions of the Boards of Appeal of the EPO and to open to European industries the same possibilities of patent protection for software related inventions as in the rest of the world.

The **epi** considers that promotion of software protection by the European patent system will strongly benefit the development of the European software industry.

Therefore the **epi** favors a revision of paragraph 2 of Article 52 cancelling the mentioning of computer programs as non patentable inventions.
Such a wording introduced originally in the Convention does not take into account the importance now acquired of the software industry and the need for a stronger protection also in this field of technology.

In conclusion, the **epi** favours a revision of Article 52 clearly defining what is patentable along the lines of the TRIPS Agreement and not containing any exception for the software industry and computer programs.

Article 54(5) - Novelty

The **epi**, acknowledging on the one hand the non patentability of medical methods for treatment and diagnosis of human beings and animals and, on the other hand the broad and justified patent protection of the product or substance used for the first time in such a method (first medical use) considers that a reasonable and clearly defined patent protection should also be allowed in the case such a product is used in another way, for example to cure a disease which was not curable before (second or further medical use).

The Enlarged Board of Appeal in its decision G3/88 already confirmed that the inventor of such a second or further medical use deserved a patent protection for the very simple reason that he had made an invention. In view of the exception of non patentability of medical methods and uses, the Enlarged Board of Appeal decided that a patent protection could only be defined in such a situation, through a somewhat complicated claim wording.

The position of the Enlarged Board of Appeal, now accepted by the examiners and the Boards of Appeal of the EPO has led to the grant of a great number of European patents.

Unfortunately, the national courts of certain Member States have difficulties understanding clearly the decision of the Enlarged Board of Appeal and the validity of the claims granted in accordance with this decision.

The **epi** considers that this unclear situation is highly detrimental to the European industry and to the development of new means for curing diseases.

In conclusion, the **epi** strongly favours the introduction of the proposed additional paragraph 5 to Article 54 which will permit to obtain what is not possible today, i.e. a clear and well delimited patent protection for any product used for the first time in a new specific therapeutic method.

Article 69 - Extent of protection (Protocol on Interpretation)

The **epi** has considered the proposed amendment to the Protocol on interpretation of Article 69.

The **epi** is of the opinion that interpretation of the scope of patent protection, as defined in Article 69 EPC should, for the time being, remain in the hands of the courts.

Introduction of such controversial concepts as equivalency and file history before a complete and large discussion between all interested circles appears premature.

The **epi** considers, particularly for equivalency, that introducing a definition in the Protocol would, at the present time, create more difficulties than assistance to the national courts. In fact, harmonizing the concept of equivalency in patent interpretation throughout Europe should probably be left to a future centralized jurisdiction to be created.

In conclusion, the **epi** is against amending the Protocol on interpretation of Article 69 by the introduction of a legal definition of equivalency and of a file history estoppel.

The **epi** considers that such far reaching amendments should first be carefully studied and discussed among all European interested circles.

Article 101 - Examination for opposition

The **epi** considers important that the overall duration of an opposition procedure (including appeal) is kept reasonable.

The **epi** considers therefore that decisions of the Boards of Appeal remitting the case to the first instance should be exceptional.

In order to achieve this however, it is appropriate that the Opposition Division takes position in its decision on all the grounds presented by the opponent and not only on one of those grounds.

The **epi** considers that the proposed revised Article 101 is not clear in this regard and could lead in the future to more decisions of remittal to the first instance and therefore to an increase of the overall duration of the procedure.

In conclusion, the **epi** is against the proposed amendment of Article 101 EPC.

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