

SUBJECT: Revision of the EPC: transitional provisions

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document gives details of the transitional provisions for the revised version of the Convention. Part II contains a draft decision of the Administrative Council under Article 7 of the Revision Act.

CA/PL 3/01 Rev. 1 supersedes CA/PL 3/01 of 29 March 2001. The amendments were agreed at the 15th meeting of the Committee on Patent Law on 3 May 2001 and are marked accordingly.

PART I

I. INTRODUCTION

1. Article 7 of the Act revising the European Patent Convention of 29 November 2000 contains transitional provisions for those provisions in the revised version of the EPC which concern European patent applications and European patents. Article 7(1), first sentence, states that the revised version shall apply to all European patent applications filed after its entry into force, and to all European patents granted in respect of such applications. However, the new provisions are not to apply to European patents already granted at the time of their entry into force, or to European applications pending at that time, unless otherwise decided by the Administrative Council (Article 7(1), second sentence, Revision Act). Under Article 7(2) Revision Act, such a decision must be taken by 30 June 2001.
2. The transitional provisions of Article 7 do not apply to the purely organisational and institutional provisions of the revised version (see point 13 below). The applicability of these provisions is governed by general principles of international treaty law, in particular by the principle of "non-retroactivity" (see Article 28 Vienna Convention). This means that they can only be applied to measures taken after their entry into force. For provisions which may be applied provisionally under Article 6 of the Revision Act, the date of adopting the Revision Act, ie 29 November 2000, is decisive.
3. Transitional rules are basically unnecessary for the provisions deleted from the EPC in the Revision Act, which, in accordance with general principles of law, are no longer to be applied from the date of entry into force of the revised version.

A. TRANSITIONAL PROVISIONS UNDER ARTICLE 7(1), SECOND SENTENCE, REVISION ACT

4. The draft Council decision in Part II concerning Article 7(1), second sentence, Revision Act lays down special transitional arrangements for extending the applicability of the provisions specified in the decision to European patents and European patent applications which have already been granted or are pending at the time of entry into force of the revised version.
5. These transitional arrangements are designed to ensure that, after the entry into force of the revised version of the EPC, the provisions applied in proceedings before the European Patent Office are as uniform as possible, and that the provisions will quickly take effect in practice. The use of different versions of the EPC over a prolonged period is to be avoided. This is equally important to the Office and to users of the European patent system.

6. **Article 1, point 1**, of the draft decision lists all the provisions concerning applications and patents which are to apply without further qualification to patents already granted at the time of their entry into force and to applications still pending at that time. The provisions in question are, above all, those of a substantive and procedural nature which the Office has to apply in the grant procedure.
7. Point 1 includes institutional provisions which also relate to applications or patents - for example, Articles 14(1), 51, 88, 90, 92-94, 129 and 135. Where these provisions allow for details to be laid down in the Implementing Regulations - eg in the case of Article 51(2), regarding the fixing of time limits for the payment of fees - the Administrative Council will have to decide, for matters on which it chooses to exercise such authority, on separate transitional provisions. In order for the future implementing provisions to be made applicable to applications already pending, the enabling provisions contained in the revised text of the Convention must also be made applicable to such applications.
8. The provisions to be applied to patents already granted at the time of their entry into force are listed in **Article 1, point 2**, of the draft decision. They concern opposition, limitation and revocation proceedings. For limitation and revocation cases, the applicability of the new provisions to patents already granted is particularly important, so that the relevant improvements to the European patent system can take effect quickly, as requested by users. For the amendments concerning the opposition procedure - which are mainly for clarification purposes - this is necessary to maintain the unity of the provisions governing the procedure.
9. **Article 1, point 3**, of the draft decision provides for the new Article 54(5) to be applied to pending applications in cases where the decision on the grant of the European patent (Article 97(2), Rule 51(11) EPC) has not yet been taken at the time of entry into force of the revised version. This prevents the new provision from being applied to proceedings which have already been concluded, while at the same time ensuring that pending applications, as well as later applications, can benefit from purpose-related substance protection for further medical uses.
10. **Article 1, point 4**, provides that the new procedure for reviewing decisions of the boards of appeal applies to all decisions taken after the entry into force of the new Article 112a. This makes it quite clear that the provision is also to be applied to decisions concerning patents granted or applications filed before its entry into force.

11. **Article 1, point 5**, concerns the revised provisions on further processing and re-establishment of rights. These are to be applied to patents granted and applications pending at the time of their entry into force, provided that the relevant time limits for making such requests have not expired.
12. **Article 1, point 6**, establishes that the revised Articles 150 to 153 are also to be applied to international applications pending at the time of their entry into force. The new provisions replace the previous Articles 150 to 158, but do not introduce any substantive changes. However, the deleted provisions of Articles 154(3) and 155(3) will continue to apply to international applications which are already pending: ie, for these applications, the boards of appeal will remain responsible for deciding on PCT protests.

B. SUMMARY

13. The transitional provisions arising from the revised version of the Convention can be summarised as follows:
 - Pursuant to Article 7(1), second sentence, of the Revision Act and the decision of the Administrative Council, the provisions of the revised Convention listed in Article 1, points 1 to 6, of the decision are to be applied also to European patents already granted at the time of their entry into force and to European and international applications pending at that time.
 - Under Article 7(1), first sentence, of the Revision Act, Articles 14(2), 75, 76, 77, 78, 79, 80 and 87 of the revised version are only to be applied to European patent applications filed after their entry into force.
 - Particular transitional arrangements are not necessary for the organisational and institutional provisions of the revised version (see point 2 above), ie Articles 4a, 11, 16, 17, 18, 21, 22, 23, 33, 35, 37, 38, 42, 50, 130, 134, 134a, 140, 149a and 164, together with the new Protocol on the Staff Complement and the reworded Section I of the Protocol on Centralisation. These are applicable upon entry into force of the revised version; under Article 6 of the Revision Act, Articles 16 to 18, 37, 38, 42 and 50, the Protocol on the Staff Complement and Section I of the Protocol on Centralisation are provisionally applicable with effect from 29 November 2000.
 - With the exception of Articles 154(3) and 155(3), (see point 12 above), the EPC provisions deleted in the Revision Act, ie Articles 91, 95, 96, 102, 126, 136, 154 to 163, and 167, are no longer to be applied after the entry into force of the revised version (see point 12 above). Article 167(5) remains unaffected.

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
on the transitional provisions under Article 7 of the
Act revising the European Patent Convention
of 29 November 2000

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to Article 7, paragraph 2, of the Act revising the European Patent Convention of 29 November 2000 ("Revision Act"),

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

Article 1

In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below:

1. Articles 14(1) and (3) to (6), 51, 52, 53, 54(3) and (4), 60, 61, 67, 68 and 69, the Protocol on the Interpretation of Article 69, and Articles 70, 86, 88, 90, 92, 93, 94, 97, 98, 106, 108, 110, 115, 117, 119, 120, 123, 124, 127, 128, 129, 133, 135, 137 and 141 shall ~~be applied~~ apply also to European patents already granted at the time of their entry into force and to European patent applications pending at that time. However, in the case of Article 54(4) the previous version of the Convention shall continue to be applied to these applications and patents.
2. Articles 65, 99, 101, 103, 104, 105, 105a-c and 138 shall ~~be applied~~ apply also to European patents already granted at the time of their entry into force and to European patents granted in respect of European patent applications pending at that time.
3. Article 54(5) shall ~~be applied~~ apply also to European patent applications pending at the time of its entry into force, in so far as a decision on the grant of the patent has not yet been taken.

4. Article 112a shall ~~be applied~~ apply to decisions of the Boards of Appeal taken after its entry into force.
5. Articles 121 and 122 shall ~~be applied~~ apply to European patents already granted at the time of their entry into force and to European patent applications pending at that time, in so far as the time limits for requesting further processing or re-establishment of rights have not yet expired at that time.
6. Articles 150 to 153 shall ~~be applied~~ apply also to international applications pending at the time of their entry into force. However, in the case of Articles 154(3) and 155(3), the previous version of the Convention shall continue to be applied to these applications.

Article 2

This decision shall enter into force upon entry into force of the revised text of the Convention in accordance with Article 8 of the Revision Act.

Done at Munich, [date of decision]

For the Administrative Council
The Chairman

Roland GROSSENBACHER