



EPC 2000
The Revised European Patent
Convention

+

The London Agreement

2nd edition

INTELLECTUAL PROPERTY

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What is the EPC?

A multilateral treaty (34 contracting states) for a centralised patent grant procedure before a single patent office (EPO).

To modernize the European patent system and adapt it to TRIPS (Agreement on Trade Related Aspects of Intellectual Property Rights) and PLT (Patent Law Treaty), the revised EPC 2000 has entered into force on 12/13/2007.

What is the London Agreement?

A multilateral sub-treaty (14 contracting states) to the EPC for the purpose to save translation costs (see at the end).

EPC 2000: Highlights at first glance (I)

Changes in substantive patent law

- inventions in „all fields of technology“ (adaptation to TRIPS)
 - ↳ no substantial change of current practise
- use-limited product protection for a second or further medical use of a known substance (see example below)
- novelty-destroying effect of subsequently published EP application having an earlier priority date independent of country designation (see examples below)
- strengthening of extent of protection (see below)

EPC 2000: Highlights at first glance (II)

Procedural „innovations“:

- Drastically decreasing requirements for the filing date (adaptation to PLT – see below)
- Re-establishment of rights and corrections in respect of priority claim
- Further processing of an application as standard legal remedy in respect of observing time limits
- Request by patent owner for centralised limitation or revocation of the EP patent
- Introduction of a third instance (Enlarged Board of Appeal) for the case of fundamental procedural defects in appeal proceedings (e.g. violation of the right to be heard)

Protection of compounds for medical use

EXAMPLES		
Claim	Patentable?	EPC 2000
Use of product X for the treatment of melanoma	NO	53(c)
Product X for use as a medicament	YES , first medical use claim	54(4)
Product X for the treatment of cancer	YES , second medical use claim	54(5) expressly providing use – limited product protection for second or further medical use of a known substance *)
Product X for the treatment of hypertension	YES , further medical use claim	54(5) expressly providing use – limited product protection for second or further medical use of a known substance *)

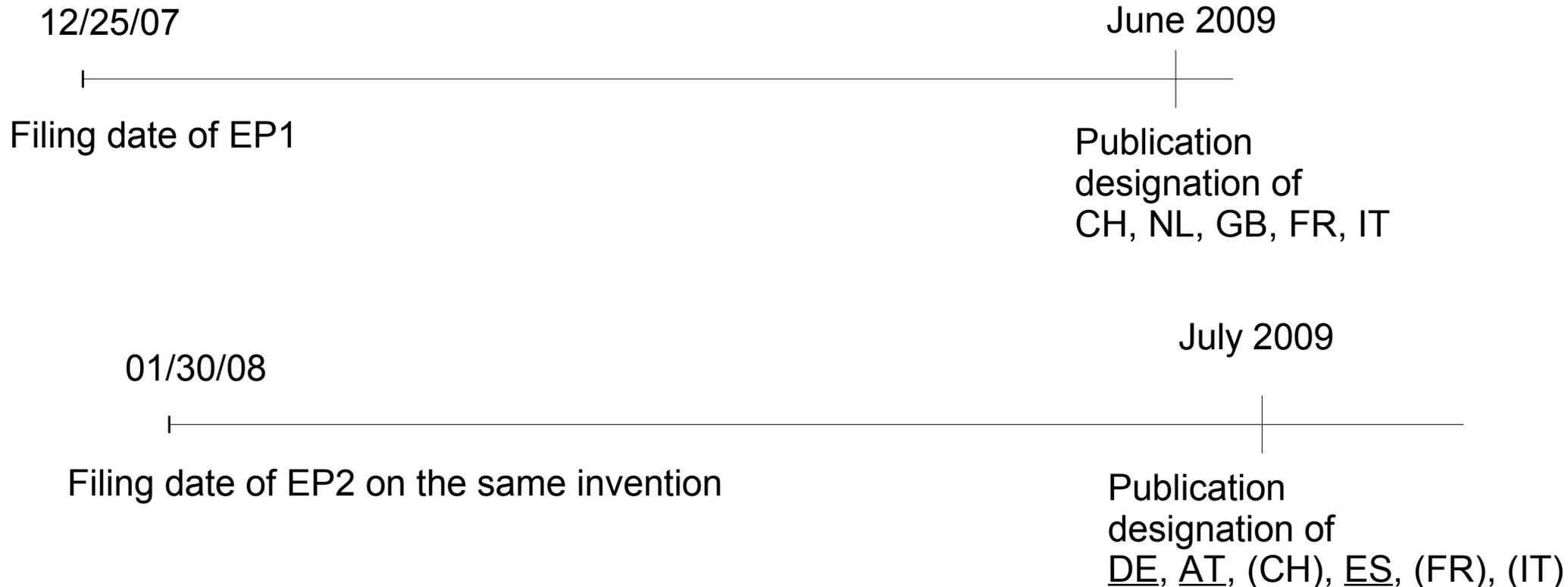
*) also applies for applications pending before 12/13/07

No more need for „swiss type“ claims (use of substance X for manufacturing a drug for the therapeutic application Y).

Novelty – Conflicting EP applications

Example

(only applies for applications)



Filing date of EP1 on or before 12/12/07:
patent grant EP2 for DE, AT + ES only because
Art. 54(4) EPC 1973 still applies for EP patents
and applications before 12/13/07

EPC 2000: novelty destroyed for EP2 for
all countries but possibility for conversion into
a national application (Art. 135) e. g. in Germany:
EP1 is not prior art

EURO-PCT APPLICATIONS AND NOVELTY

Prior and subsequently published PCT application is prior art for later EP applications

only where

- subsequent publication in an EPO language (FR, EN, DE)
and

Art. 153(3)+(4)

- EP application fee being paid (upon entry into European phase)

R 165

Art. 153(3)+(4)

Extent of protection of a European patent

Article 69(1) EPC 2000

The extent of the protection conferred by a European patent or a European patent application shall be determined by the **claims**. Nevertheless, the description and drawings shall be used to interpret the claims.

New Art. 2 in the Protocol on the Interpretation of Article 69 EPC 2000 „Equivalents“

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is **equivalent** to an element specified in the claims.

- also applies for EP patents granted or EP applications pending on or before 12/13/07
- **no** „European“ definition of equivalents available
- **no** prosecution history estoppel applicable (file inspection no tool for interpretation)

Easier obtaining a filing date (Adaptation to PLT 2000)

*New regulations are valid only for
European patent applications filed on
or after December 13, 2007*

EPC 1973

- Indication that a European patent is sought
- Designation of at least one Contracting State
- Information identifying the applicant
- Description
- in approved language
- at least one claim

EPC 2000

- Indication that a European patent is sought
- Designation: **automatically all countries are designated**
- Information identifying the applicant **or allowing the applicant to be contacted**
- description or **reference to a previously filed application**, in any language each
- **claims** – not mandatory, but to be subsequently filed

Art. 14(1) and (2), 80

Art. 14(1), (2), 79(1), 80, R 40

Obtaining a filing date - Reference to a previously filed application

Adaptation to PLT 2000

No corresponding regulations in EPC1973

- ♦ **Indicated** are
 - filing date and number of the previously filed application
 - office of the previously filed application

Reference substitutes

- **description and drawings**
- claims, if any R 57(c)
- ♦ Within 2 months after the filing date the following documents are to be filed:
 - certified **copy** of the previously filed application
 - where necessary a **translation** in one of the official languages of the EPO

Missing parts of description and/or drawings

EPC 2000 Rule 56

- If priority is claimed no re-dating of filing date provided that R 56(3)
 - missing parts are completely contained in the priority application,
 - corresponding request,
 - submission of copy of the priority application,
 - translation in EN, FR, DE where necessary,
 - indication as to where the missing parts are contained in the earlier application and its translation, if any.

Term: two months of the accorded filing date or of an official invitation
 ↓ to remedy *)

R 56(2)

- If these requirements are not fulfilled in time, then re-dating of the filing date R 56(5)

***) Caution: omission of the EPO may not be invoked by the applicant**

CLAIMS SUBMITTED AFTERWARDS ONLY

- No claims necessary to establish a filing date.
- Belatedly filed claims are amendments to the application.
- Problem: The extent of protection is determined by the claims which mostly are broader than the description.

Danger of inadmissible extensions!

(EPO approach to admissibility of added matter is becoming even more strict)

US philosophy as to disclosure of amendments in original application documents:

- no requirement to identify inventive sub-combinations already at the priority date
- with sufficient specification describing the claims features, different combinations of features may be claimed throughout prosecution process
- claiming different sub-combinations is not added/new subject matter
- widespread assumption that a „person skilled in the art“ would have known the sub-combinations that would have worked

European philosophy as to disclosure of amendments in original application documents

→ Priority can be claimed for the „same invention“ only as disclosed in the original and/or priority documents

→ „Same invention“?

★ specific combination of claimed features at least implicitly disclosed as independent invention

★ claimed subject matter derivable directly and unambiguously

→ the claimed subject-matter must be clearly identifiable from the priority application, but identic wording is not required



A public disclosure in the priority interval can be prior art



This can be used in an inventive step attack if a claim in a later EP application is not identical to the disclosure of the priority application

Applications establishing priority rights

Re-establishment of priority rights

EPC 1973

- ♦ Applications effective in or for
 - Paris Convention members **only**

- ♦ Excluded: re-establishment of priority right

Art. 87(1), 122(5)

EPC 2000

- ♦ Applications effective in or for
 - Paris Convention members
 - **WTO members**
 - Taiwan
 - Thailand

- ♦ applies for applications on or after 12/13/07
- ♦ **possible: Re-establishment of rights in respect of 12 months priority term**
 - request to be filed within two months from the expiry of priority term (14 months after priority date)

- ♦ Priority re-establishment also applies for applications on or after 12/13/07 unless the 2-months term for request has expired

Art. 87(1), 122, R 136(1)

Declaration of priority

Adaptation to PLT 2000

EPC 1973

Declaration of priority

- day and state of the previously filed application:
simultaneously when filing the European patent application
- failure to do so – **no legal remedy**
- file number of previous application:
within 16 months after claimed priority

EPC 2000

Declaration of priority

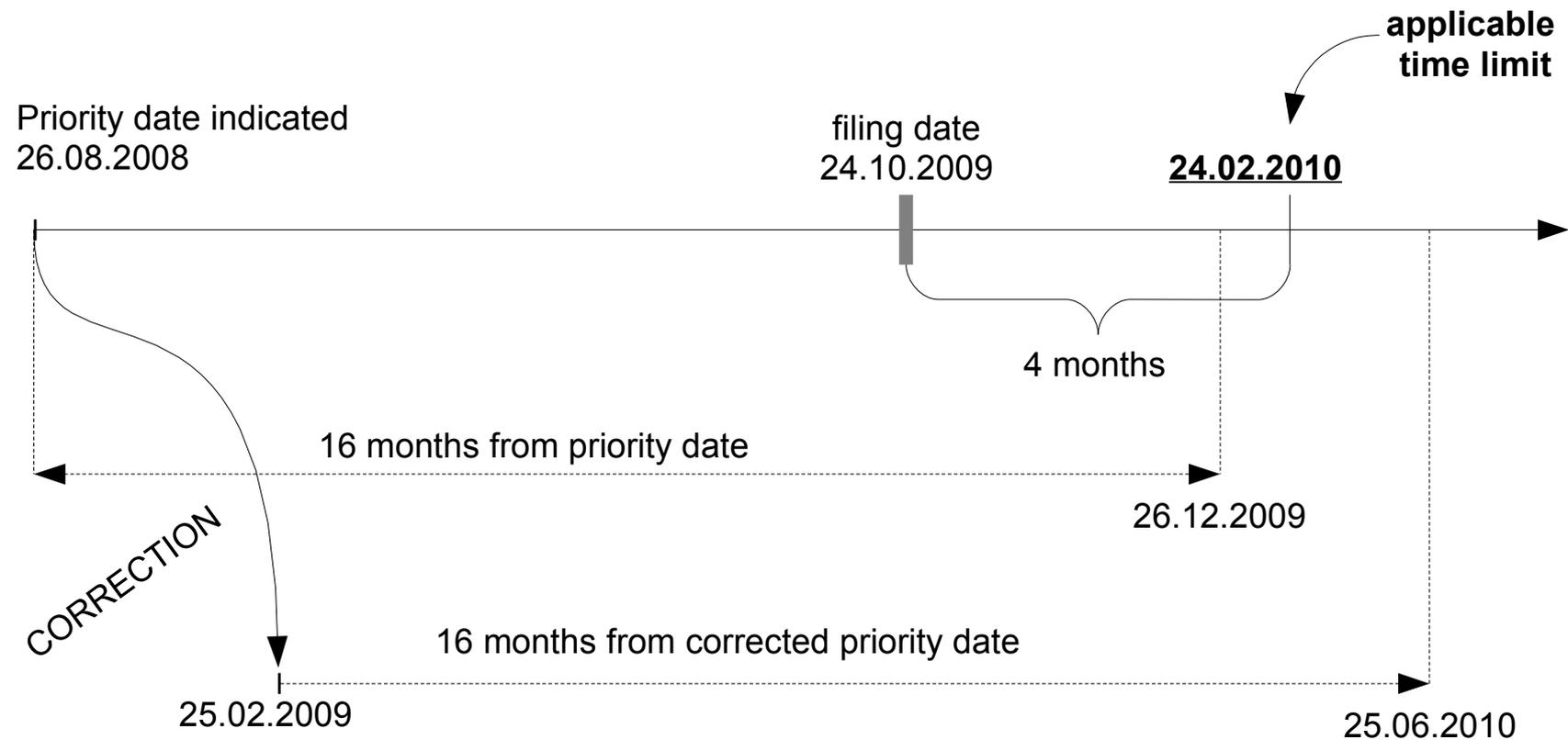
- filing still possible **within 16 months after earliest priority day**
- **declared** or
- **corrected**
- Correction can be requested within 4 months after filing date (R52(3) ≈ R26bis.1 PCT)
- not possible any more after request for earlier publishing according to Art. 93(1)b!

This also applies for applications already pending on December 13, 2007

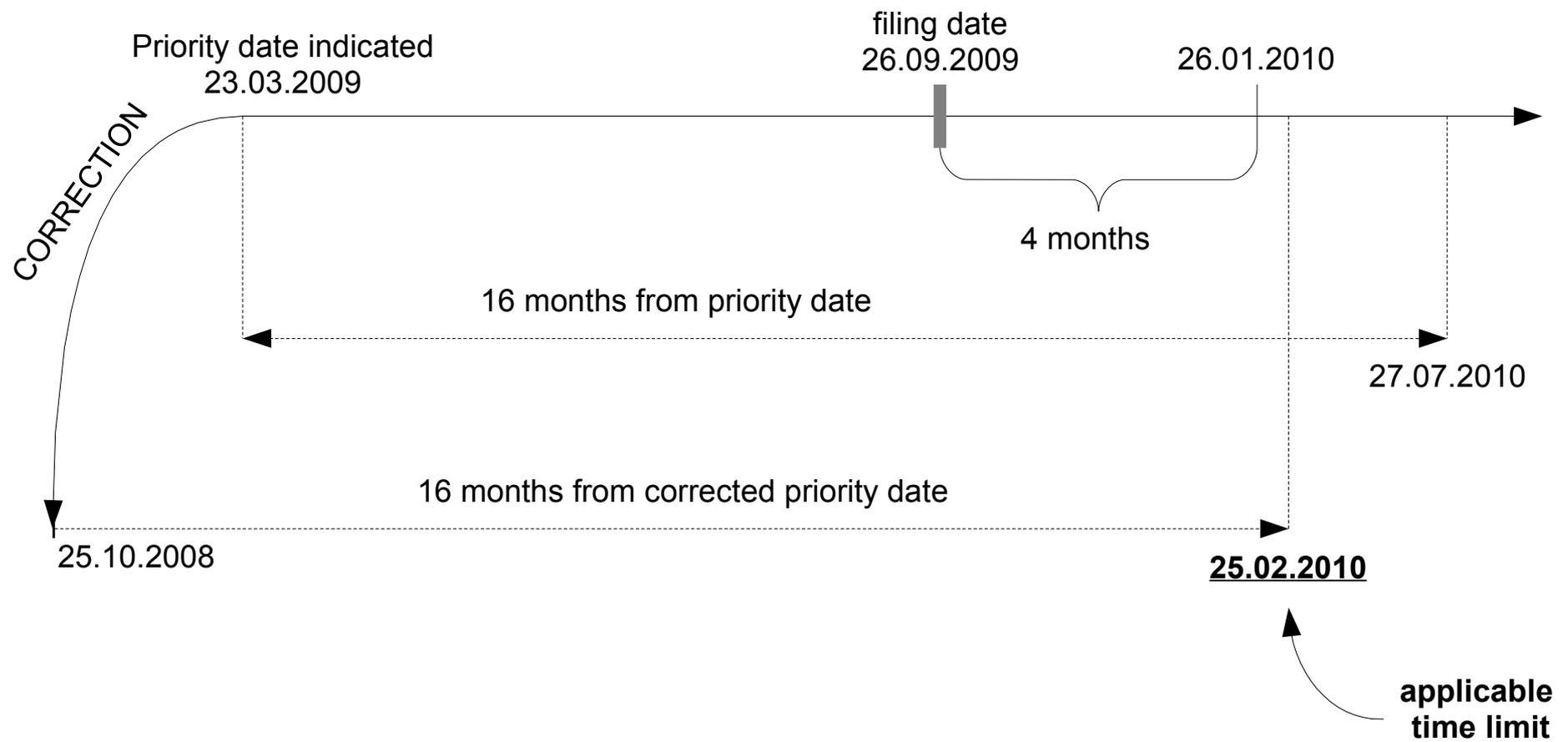
Art. 88(1), R 38

Art. 88(1), R 52

Correction of priority claim – Rule 52 (3)



Correction of priority claim – Rule 52 (3)



Decision of the President of the European Patent Office dated 12 July 2007 on the filing of priority documents

Article 1

Inclusion of a copy of the previous application in the file of a European patent application

The European Patent Office shall include free of charge in the file of a European patent application a copy of the previous application from which priority is claimed if the previous application is:

- a) a European patent application;
- b) an international application filed with the European Patent Office as receiving Office under the Patent Cooperation Treaty (PCT);
- c) a Japanese patent or utility model application;
- d) an international application filed with the Japanese Patent Office as receiving Office under the PCT;
- e) a Korean patent or utility model application;
- f) a United States provisional or non-provisional patent application.

Legal remedy of
Further Processing (FP)

Art. 121, R 135

- applicable range
- procedure
- fees
- effect

Applicable range

- ♦ **Standard legal remedy for applicants only** where loss of right due to failure to comply with the time limit determined by the Office and (now) also by the EPC

Art. 121(1)

- no FP for patent owner (after grant!), opponents

Simple procedure:

- request, no reasoning necessary
- 2-months term, only running from official communication informing of right loss or failure
- completion of omitted act

Effect:

The legal consequence for the failure shall not ensue or shall be retracted

Some terms excluded from FP:

According to Art. 121(4)

- priority term (instead of re-establishment of rights)
- term for appeal
- term for petition for review by the Enlarged Board of Appeal
- terms for FP and re-establishment of rights

Art. 87(1)

Art. 108

Art. 112a)

According to R 135(2)

- no FP subsequent filing/correction of the priority declaration
- no FP subsequent filing of missing parts of the description

R52(2), (3)

R 56

Further terms excluded from FP:

- Payment of 2nd, 3rd ... search fee in case of lack of unity of invention

R 64

- payment of renewal fees

R 51(2)-(5)

- terms in context with

* reference to a previously filed application (instead of filing a description)

R 40(3)

* examination by Receiving Section

R55

* correction of deficiencies during examination as to formal requirements

R 58, 59

Important terms for which FP is applicable

- 1-month-term for payment of the application and search fees (EPC2000 only) R 38, 39
- 6-months-term for payment of the examination and country designation fees (EPC2000 only) Art. 94, R 70(1)
- Term for reply to the examiner (as under EPC1973)
- Terms for entry of a PCT application into the European phase i.e. 31 months time-limit

Fees for FP

Art 2 Nr 12 Rules Relating to Fees

- where belated fee payment:
50 % of the relevant fee
- in all other cases inclusive of belated payment
of grant and printing fee **€ 210,00**

R 45

Claims fees?

- € 45,00 for 11th and each subsequent claim
- to be paid within one month of filing of the first set of claims
- FP possible (50 % of the claims fees in addition)

Art. 121, R 135

as from April 1, 2008:

- € 200,00 for 15th, 16th ... claim

Tip: Transfer of the text of the claims into the general/introductory part of the description

Important terms for which re-establishment of rights is applicable now

- **priority term**

Art. 87(1)

- **term for further processing (FP)**

R135(1)

- **term for appeal**
(only for applicant and patent owner)

Art. 108

- also available for EP patents and applications already pending on 12/13/07

Re-establishment ruled out:

for any term for which FP is available

R136(3)

Further procedural changes

Art. 124, R 141

- EPO can require **information** on **prior art** from the applicant taken into account in **national patent proceedings**.

ATTENTION:



- In case of failure to reply (completely) in due time, **the European patent application shall be deemed to be withdrawn**.

EURO-PCT APPLICATIONS

Lack of unity in the European phase (R 164)

- Supplementary European search report and examination only for that invention which is **first mentioned** in the claims.
- When lack of unity, invitation to restrict the application to the one invention which has been searched for in the international or the supplementary search report.
- However, no more invitation to pay further search fees.

RESULTS:

- application must be restricted to the single invention which has been searched for
- further inventions can be prosecuted in divisional applications **only**.
- Possibility to get, within one application, a plurality of inventions being searched only in the international phase or for an originally EP application

London Agreement (LA):

Substantial savings of translation costs for the national phases of a EP patent after grant

How?

The contracting states to LA waive the requirement of translating the patent description at least into the respective national languages (claims would still to be translated) if an English translation of the complete EP patent specification is available.

Contracting States

14 European countries, including Germany, France, UK, The Netherlands, Sweden, Denmark and Switzerland (ratification of some still delayed) since October 2000.

Entry into Force?

4th Month after the deposit of France`s instrument of ratification (already passed both chambers of French parliament in autumn 2007) in Germany.

Also the French president gave approval. Next step: Formal submission of ratification instrument to German authorities.

Impact on costs:

Reduction of the average overall cost of an European patent containing 20 pages from 51.000 US \$ to 31.000 US \$ (7 designated States to be validated, reduction effects can vary depending on number of states to be covered, volume of patent specification)



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**Thank you for
your attention!**

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