
Revised European Patent Convention Enters into Force in December 2007

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On December 13, 2005, Greece became the fifteenth contracting state to ratify or accede to the revised European Patent Convention (the EPC 2000). The EPC 2000 shall now enter into force no later than December 13, 2007.

European Patent Convention (EPC)

The EPC is a multilateral treaty. Adopted in October 1973, the European Patent Convention of 1973 (the EPC 1973) established the autonomous European Patent Office (EPO) and "a system of law...for the grant of patents for invention" that is common to each of its Contracting States.

A patent granted under this system is known as a European patent. Once granted, a European patent has "the effect of and [is] subject to the same conditions as a national patent" in each of its designated Contracting States.

When the first patent applications were filed in the EPO in June 1978, there were just six Contracting States. At present, there are 31, and an additional five countries have signed extension agreements allowing them to be designated in European patent applications.

EPC 2000

The EPC 2000 represents the first major revision of the EPC 1973. It takes into account both the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) and the Patent Law Treaty--two treaties not in force at the inception of the EPC 1973. A number of provisions have also been shifted from the Articles to the Implementing Regulations of the EPC 2000, affording the EPO greater flexibility for procedural revision in the future.

EPC 2000: Important Revisions

Affirmed Patentability of Second Medical Use Claims. Methods of treatment or diagnosis are now listed as exceptions to patentability. Previously, they were excluded as lacking industrial applicability. This prohibition does not, however, apply to "products, in particular substances or compositions, for use in any of these methods." The EPC 2000 therefore formalizes the patentability of a known

pharmaceutical for a new specific use.

Introduction of Central Limitation at the EPO. Once any opposition proceedings have ceased, a patentee can now request that the EPO revoke or limit a European patent "by an amendment of the claims." The EPO shall examine any proposed amendment for novelty, inventive step and clarity. Any decision then made shall "apply to the European patent in all the Contracting States in...which it has been granted," with effect from the date of publication in the *European Patent Bulletin*. This eliminates the need for the patentee to request amendment at each of the relevant national patent registries and invokes new tactical possibilities.

Effect of Post-grant Amendment. The new provisions also make it clear that, "to the extent that the patent has been revoked or limited in opposition, limitation or revocation proceedings," the "European patent application and the resulting European patent" shall "from the outset...be deemed not to have" been entitled to the "rights conferred by a European patent" or "by a European patent application after publication" under the EPC. The revision uniformly establishes the retroactive effect of revocation and now limitation, at both the EPO and national level. Since these "rights" include the right of national courts to consider the issue of infringement, this revision raises the important issue of whether revocation or limitation negates the effect of any prior judgment of infringement by a national court.

Prior Art Information. The EPO may also "invite" applicants "to provide information on prior art taken into consideration in national or regional patent proceedings...concerning an invention to which the European patent application relates." If the applicant then "fails to reply in due time... [the] application shall be deemed to be withdrawn."

The EPO states that approximately 90% of European patent applications claim priority from a national patent application. It is hoped that by providing relevant prior art information, applicants can help to speed up the European grant procedure and enhance the quality of searches and substantive examination.

Consideration of Equivalents. The provisions also expressly now state that "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." However, at present, there is no definition of "equivalent" in the EPC 2000; the definition put forward in the Basic Proposal for revision ("a means shall generally be considered as being equivalent if it is obvious to a person skilled in the art that by using such means achieves substantially the same result as that achieved from the means specified in the claim") did not survive the diplomatic conference. The practical effect of this revision therefore remains unclear.

Petition for Review. "Any party to appeal proceedings" who has been "adversely affected by the decision of the Board of Appeal" may now "file a petition" for the review of this decision "by the Enlarged Board of Appeal." The grounds for review are, however, limited to fundamental procedural defects: the participation in the Board of Appeal of personally or professionally conflicted, or non-appointed member; "a fundamental violation" of the provisions relating to the "right to be heard and [the] basis of decisions;" "any other fundamental procedural defect defined in the Implementing

Regulations;" and the occurrence of "a criminal act established under the conditions laid down" in those Regulations. It is therefore unlikely that this procedure shall be available to a party in the majority of cases.

United Kingdom

The United Kingdom ratified the EPC 2000 in May 2005. The UK patents system is governed by the Patents Act 1977 (1977 Act), which reformed domestic law and brought the EPC 1973 into effect in the United Kingdom. The 1977 Act has since been amended by the Patents Act 2004, which brings the EPC 2000 into effect in the United Kingdom, introduces into the 1977 Act measures designed to assist the enforcement of patent rights and the resolution of disputes, and generally updates the 1977 Act.

Various domestic provisions of the 2004 Act entered into force in January and October 2005. Its provisions relating to the EPC 2000 shall enter into force, via commencement orders, at the same time as the EPC 2000.

Conclusion

The aim of the 2000 EPC diplomatic conference "was to modernise the legal basis of the European patent system, and thereby ensure that it can continue to function efficiently in an increasingly integrated European economy within the framework of world trade." At its close, the EP Organization announced that this "ambitious aim" had been "achieved:" the European patent system had been reformed "in order to safeguard its long-term adaptability in the face of rapidly changing political and economic conditions."

Of the above revisions, perhaps the most important are the introduction of the central limitation procedure and the clarification of the effect of post-grant amendment. These revisions, which survived the diplomatic conference unscathed, are likely to have the most significant impact on future practice.

For full text of the press release of the EPC 2000 Diplomatic Conference, please [click here](#).

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