

## DCB Newsletter Special Issue EPC 2000



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## Introduction

A new milestone in European patent law has been reached. On 13 December 2007, the most important change in European patent law since 1973 will enter into force.

Even though the renumbering of Rules will be a pain for all practitioners for many years to come, all in all, even though fundamental changes have been put in place, amendments are not in all respects dramatic.

Nevertheless, the new European Patent Convention (EPC) 2000 will have important effects on pending and new patent applications to be filed and even on granted patents in force at the time of entering into force of the EPC 2000.

In what follows, an overview will be given of some of the most relevant changes in the European patent system. Most of what follows is taken from and based upon materials published by the EPO.

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## Effects in Belgium

It deserves to be said that by Act of 21 April 2007, published on 4 September 2007, Belgium has ratified the EPC 2000, and hence the EPC 2000 will also for Belgium enter into force on the aforementioned date.

Equally important to mention in this respect is that the legislator has taken the opportunity to clarify a language issue which has unnecessarily occupied many patent law practitioners for many years. In order for a European patent to have effect in Belgium, it must be written or translated in one of the official languages of the country (Dutch, French and German). For many years, it was unclear whether German could be accepted as a language, even though it is an official language in Belgium. The Act of 21 April 2007 regarding various provisions relating to the procedures with respect to filing of European patent applications and the consequences of such European patent applications and European patents in Belgium has resolved doubts around this issue, as in the preparatory works to the Act, more in particular in the Explanatory Memorandum to the Act, it has been clarified that the wording "official language", referred to in Article 3 of the said Act of 21 April 2007 includes German.

This provision not only clarifies a matter which should have been resolved a long time ago, but implies also a welcome cost saving for users of the system, as European patents in German do no longer need to be translated.

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## **New provisions relating to filing (Article 14 EPC, Article 79 EPC)**

According to revised Art. 14 EPC, a European patent application may be filed in any language, for the purpose of obtaining a filing date. If the application is filed in a language other than an EPO official language (English, French or German), the applicant must file a translation into an EPO official language within 2 months of filing the European patent application, so that the application can be processed (see Rule 6(1) EPC 2000). If the translation is not filed in due time, the EPO invites the applicant to submit it within a 2 month period (Rule 58 EPC 2000). The legal effect of the non-timely filing of the translation, namely the application being deemed to be withdrawn, previously laid down in Article 90(3) EPC 1973, is now included in Article 14(2) EPC.

Furthermore, the EPC now provides in Article 79(1) EPC that the applicant shall be deemed to have designated all the contracting states which are party to the EPC at the time the application is filed. Applicants continue to have the option of withdrawing designations pursuant to Article 79(3) EPC and may do so at the outset, upon filing the European patent application, if they so wish.

According to Article 80 EPC 2000, the substance of which is implemented in Rule 40 EPC 2000, upon filing no claims are needed, and a reference to an earlier application, even when not claiming priority from this application, is possible to obtain a filing date.

Furthermore, according to Rule 56 EPC 2000, filing of missing parts of the description of the drawings (not the claims however) of an application is now possible without re-dating the filing date.

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## **Medical treatment and diagnostic methods (Article 53(c) EPC)**

The exclusion of methods of treatment and diagnostic methods referred to in Article 52(4) EPC 1973 has been added to the two exceptions to patentability in Article 53(a) and (b) EPC and will now form Article 53(c) EPC. The revised Article 53 EPC is applicable to European patents already granted at the time of EPC 2000 entry into force.

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## First, second and further medical indications (Article 54(4) and 54(5) EPC)

First medical indication patents, reading like “substance X for the use as a medicament” remain possible under the renumbered now Article 54(4) EPC 2000. Second and further medical indication claims, which up to now required the so-called Swiss claim wording, i.e., “use of substance X for the manufacture of a medicament for use in the treatment of disease Y”, will no longer be required to be formulated in this manner. Under the new Article 54(5) EPC 2000, it will be possible to claim second and further medical indications as so-called purpose-bound product claims, i.e., product claims limited to the specific purpose referred to in the claims. The wording will then read “Substance X for use in the treatment of disease Y”. In our opinion, it is recommended, however, to continue using also the old wording for inclusion, for as long as the exact scope of the new type of claims for second and further medical indications has not been determined by the EPO Boards of Appeal and national courts, as it can be expected that varying interpretations will be given to the new provisions of Article 54(5) EPC 2000.

The revised Article 54(4) EPC is applicable to European patents already granted at the time of EPC 2000 entry into force, to European patent applications pending at the time of EPC 2000 entry into force, and to European patent applications filed on or after the time of EPC 2000 entry into force.

The revised Article 54(5) EPC is applicable to European patent applications pending at the time of EPC 2000 entry into force in so far as a decision on the grant of the patent has not yet been taken and to European patent applications filed on or after the time of EPC 2000 entry into force.

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### Novelty

Pursuant to Article 54(3) EPC 1973, in order to preclude double patenting, European patent applications having an earlier filing or priority date than the filing or priority date of a second European patent application, and which are published on or after the filing date of that second application, are considered to form part of the state of the art for the purpose of examining the novelty of this second patent application.

However, Article 54(4) EPC 1973 confines the prior art effect under Article 54(3) EPC 1973 to the minimum necessary to avoid a collision of rights, i.e. to those contracting states which are designated in both the earlier and the second application.

Article 54(4) EPC 1973 is now deleted, so that any European application falling under Article 54(3) EPC constitutes prior art with effect for all the EPC contracting states at the time of its publication, irrespective of the countries designated.

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## Claiming priority from WTO countries (Article 87 EPC)

Article 87(1) EPC is amended to align it with Article 2 of the TRIPS Agreement, which requires that priority rights also be extended to first filings made in any WTO member state, and be no longer limited to countries member of the Paris Convention.

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## Central limitation procedure (new Articles 105a, 105b, 105c EPC)

One of the fundamental changes under the EPC 2000 is the introduction of a central limitation procedure at the EPO at the request of the patent proprietor. Under the limitation procedure introduced in the new Articles 105a, 105b and 105c EPC, the European patent may be limited or revoked *ab initio* (see Article 68 EPC) at the request of the patent proprietor. Limitation or revocation may be requested at any time, although precedence must always be given to opposition proceedings. The limitation request may not be filed while opposition proceedings against the European patent in question are pending. The priority to opposition proceedings prevents limitation procedures in situations where opposition proceedings have already been filed.

Under Article 105a(1) EPC, a European patent – as granted or as amended in opposition or limitation proceedings before the EPO (see Rule 90 EPC 2000) – may be revoked or limited (by an amendment of the claims) at the request of the proprietor(s), subject to payment of a fee.

The European limitation procedure does not however take precedence over national proceedings (revocation proceedings in particular). Where parallel cases do occur, the national proceedings can be stayed or continued in accordance with national law or practice. Where national proceedings resulting in limitation have already been concluded, the limitation may be extended to further contracting states via European limitation proceedings (provided the requirements of the EPC are met). It is also emphasized that limitation of a European patent in proceedings before the EPO does not preclude further limitation in national proceedings.

With limitation, this means in particular establishing whether the requested amendment of the claims actually limits the patent or whether it is designed to protect something else, whether the requirements of clarity (Article 84 EPC), added matter (Article 123(2)) and extension of protection (Article 123(3)) are met. The EPO does not examine whether the aim of the limitation (e.g. delimitation with respect to a particular prior art) is achieved, or the subject-matter of the limited patent is still patentable under Articles 52 to 57 EPC. Under Article 105b(2) EPC, the EPO (an Examining Division, see Rule 91 EPC 2000) is required to limit or revoke the European patent, provided the prescribed conditions under Article 105b(1) EPC are met. Otherwise the request must be rejected.

Decisions of the Examining Divisions in limitation proceedings are subject to appeal (before a Technical Board of Appeal) in accordance with Articles 106 et seq. EPC (see Article 21 EPC).

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When the decision to revoke or limit the European patent in accordance with Article 105b(3) EPC takes effect, the effects of the European patent are cancelled *ab initio* (see Article 68 EPC) in full or in part in respect of all the contracting states in which it is or was valid. If, however, prior European or national rights are invoked during the limitation proceedings in respect of certain contracting states, the patent may be limited for these states by means of a separate set of claims (see Rule 138 EPC 2000).

Under Article 105c EPC, when the EPO publishes the mention of the decision to limit the European patent, it will publish an amended European patent specification containing the new version of the claims, a translation thereof into the official languages of the EPO and, where appropriate, the description and drawings as amended (see Rule 96 EPC 2000).

The revised Articles 105a, 105b and 105c EPC are applicable to European patents already granted at the time of EPC 2000 entry into force, and to European patents granted on EP applications pending at, or filed on or after, the time of EPC 2000 entry into force.

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## **Amending claims in national revocation proceedings always allowed (Article 138 EPC)**

Some important amendments have been made to the EPC regarding national revocation proceedings. The grounds for revocation by national courts of the national parts of European patents are exhaustively enumerated in Article 138 EPC.

The amendments made in Article 138 EPC now allow the patent proprietor in national proceedings to limit European patents, while hitherto this was not possible in all member states, even though it was already possible to limit patent rights during national revocation proceedings in many member states. The practice of self-limitation of patent rights in national court proceedings is now enshrined in the EPC and thus available in all member states.

The new wording of Article 138(2) EPC makes it clear that limitation and partial revocation of a European patent are always to take the form of a corresponding amendment to the patent claims.

New Article 138(3) EPC makes the principle of self-limitation explicit and binding in proceedings relating to the validity of European patents. Now the patent proprietor has the right in such proceedings to submit an amended, i.e. limited, version of the claims which in his view meets the objections to the validity of his patent. This limited version of the patent must then form the basis for subsequent proceedings. In other words, the patent proprietor will now be entitled to submit an amended set of claims, which set will be the basis for subsequent court proceedings. If the court or authority dealing with the case considers that the proprietor's own limitation is insufficient, it may further limit the patent or revoke it in full.

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As in European opposition proceedings and in accordance with the new limitation procedure (see Articles 105a, 105b and 105c EPC), the effect of limiting or revoking a European patent in national revocation proceedings is retroactive. A reference to national revocation proceedings has therefore been added to Article 68 EPC 2000.

The revised Article 138 EPC is applicable to European patents already granted at the time of EPC 2000 entry into force and to European patents granted on EP applications pending at the time of EPC 2000 entry into force.

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## **Further processing and re-establishment of rights (*restitutio in integrum*) (Article 121 and 122 EPC)**

Under the EPC there are two tiers at the disposal of the patent applicant to remedy loss of rights in patent applications: further processing and *restitutio in integrum* (which under EPC 2000 will be renamed as re-establishment of rights). While further processing – which in essence allows the applicant at least an extra two months period for meeting a deadline which he missed – was only available in a limited number of situations, the EPC has considerably broadened the scope of further processing by making it the standard legal remedy in cases of failure to observe time limits in the European patent grant procedure.

Under Article 121(1) EPC 2000, applicants may, following failure to observe a time limit vis-à-vis the EPO, request the further processing of their application. The possibility of further processing is thus as a rule available, subject to the excluding provision of Article 121(4) EPC, in respect of all time limits which applicants fail to observe in the grant procedure or in related *ex parte* appeal proceedings. However, as before, Article 121 EPC does not apply to time limits to be observed by parties in *inter partes* opposition and appeal proceedings.

Under Article 121(4) EPC 2000, further processing is ruled out for the priority period under Article 87(1) EPC, the time limits for appeal (Article 108 EPC), petition for review (Article 112a(3) EPC) and requests for further processing and re-establishment of rights. Under Rule 135(2) EPC 2000, further processing is thus ruled out in respect of the periods for filing translations under Article 14(2) and (4) EPC (Rule 6(1) EPC 2000), for seeking remedies under Article 61 EPC (Rule 16(1)(a) EPC 2000), for filing the declaration of priority or a correction thereof (Rule 52(2) and (3) EPC 2000), for subsequent filing of parts of the description or drawings (Rule 56 EPC 2000), for subsequent communication of information on deposit of biological material (Rule 31(2) EPC 2000), for payment of further search fees (Rule 64 EPC 2000), for payment of renewal fees under Article 86(2) EPC (Rule 51(2) to (5) EPC 2000), and for the time limits in connection with reference to a previously filed application (Rule 40(3) EPC 2000), examination on filing (Rule 56 EPC 2000), correction of deficiencies after formalities examination (Rules 58 and 59 EPC 2000) and the request for an appealable decision (Rule 112(2) EPC 2000).

The revised Article 121 EPC is applicable to European patent applications pending at the time of EPC 2000 entry into force, if the time limit for requesting further processing has not expired yet, and to European patent applications filed on or after the time of EPC 2000 entry into force.

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In view of the broadened scope of further processing under new Article 121 EPC, the scope of Article 122 EPC (re-establishment of rights) has been limited accordingly.

For re-establishment of the priority period under Article 87(1) EPC, the time limit for such requests ends two months after expiry of the priority period (see Rule 136(1), second sentence, EPC 2000).

New Article 122(4) EPC provides for re-establishment to be ruled out in respect of the time limit for requesting re-establishment (repeated in Rule 136(3) EPC 2000).

The Implementing Regulations may rule out re-establishment for other time limits as well. In view of the broader scope of application of further processing (see Article 121 EPC), re-establishment for those time limits in respect of which further processing can be requested has been ruled out (see Rule 136(3) EPC 2000). Re-establishment is therefore ruled out for the following in particular: - time limits for payment of fees under Rules 38, 39(1), 45(2), 70(1) and (3) and 159(1)(c)-(f) EPC 2000; - any time limits set by the EPO.

Only patent proprietors will continue to be able to request re-establishment of rights as a legal remedy in opposition proceedings and appeal proceedings following opposition.

The revised Article 122 EPC is applicable to European patents already granted at the time of EPC 2000 entry into force, if the time limit for requesting re-establishment has not expired yet, to European patent applications pending at the time of EPC 2000 entry into force, if the time limit for requesting re-establishment has not expired yet, and to European patent applications filed on or after the time of EPC 2000 entry into force.

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## **Referrals to the Enlarged Board of Appeal (Article 112a EPC)**

Prior to the EPC 2000, reference to the Enlarged Board of Appeal was only possible by a Regular Board of Appeal or by the President of the EPO, if there are concerns that contradictory case law would co-exist, or when there was an important point of law to be further analysed. Parties have no direct right to apply to the Enlarged Board of Appeal for judicial review. Under the EPC 2000, judicial review by the Enlarged Board of Appeal at the request of parties has been extended, be it limited to very narrowly defined situations. Under new Article 112a(1) EPC, a party adversely affected by a decision of a Board of Appeal may file a petition for review, but only on the grounds defined by the EPC. These are: fundamental procedural defects which occurred in appeal proceedings; and the existence of a criminal act which may have had an impact on the decision.

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Fundamental procedural defects are, in the first instance, those defined in Article 112a(2)(a) to (c) EPC, that is: a breach of Article 24 EPC governing exclusion of and objection to members of a Board of Appeal; the participation of persons not appointed as a member of the Boards of Appeal; and fundamental violation of Article 113 EPC. New Rule 104(a) and (b) EPC 2000 provides that a petition may also be based on a fundamental procedural defect arising from: failure to arrange for the holding of oral proceedings requested by a party; or failure to decide on a request relevant for the Board's decision.

For the purpose of Article 112a(2)(e) EPC, a criminal act can only be established in criminal proceedings by a sentence which is *res judicata*. Rule 105 EPC 2000 lays down how the existence of a criminal act is to be established: a criminal act shall only be a ground for a petition for review if a competent court or authority has finally established that the criminal act occurred. A conviction is not necessary. The operative criterion is not whether the (criminal) court or authority has passed sentence, as this would leave out cases where, for example, the perpetrator dies before sentence can be pronounced, or where a finding of diminished capacity makes sentencing impossible. Instead, the crucial issue is whether an act constituting a criminal offence has actually occurred, and whether the fact of its having occurred has been definitely established by a competent court or authority.

The time limits under Article 112a(4) EPC are excluded from further processing under Article 121(4) EPC 2000.

A high fee – EUR 2 500 – is payable for a petition for review. However, Rule 110 EPC 2000 provides that the fee for the petition for review shall be reimbursed if the Enlarged Board re-opens the proceedings before the Board of Appeal.

The revised Article 112a EPC is applicable to decisions of the Boards of Appeal taken as from the date of the entry into force of the EPC 2000.

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## Interpretation of claims (Article 69 EPC and Protocol on Interpretation)

According to Article 69 EPC, the extent of protection of a European patent shall be determined by the claims, and the description and drawings shall be used to interpret the claims. A so-called “Protocol on Interpretation of Article 69” gives further guidance how claims of European patents should be interpreted. The text of this Protocol has now been further amended, so as to make clear that also so-called equivalents may fall within the scope of protection of the patent. It has been and still is a subject of debate whether patents can cover not only embodiments which fall literally within the scope of the claims, but also cover embodiments which, even though they do not fall literally within the scope of protection of the claims, can nevertheless be considered equivalent to them.

It is to be seen how courts will deal with this amendment, especially in those countries where courts are reluctant to extend scope of protection to equivalents.



The revised Protocol on the Interpretation of Article 69 EPC is applicable to European patents already granted at the time of EPC 2000 entry into force, and to European patents granted on EP applications pending at the time of EPC 2000 entry into force.

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## Conclusion

De Clercq, Brants and Partners will further follow up the implications of the changes which the entering into force of the EPC 2000 has caused and will cause to present and future filings. It goes without saying that also under the new EPC 2000, our firm will continue to provide you with the best services possible.

If you would have any questions, it speaks for itself that we will be happy to answer them and be of any further assistance you may require.

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