D YOUNG & CO

PATENT NEWSLETTER

October 2007

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EPC 2000 SPECIAL EDITION

It only seems like yesterday that the diplomatic conference was held (actually in November 2000) to discuss revisions to the European Patent Convention. Yet time moves slowly in political circles, and here we are some seven years later with EPC 2000 (or EPC2 as it is sometimes known) only now about to come into force.

This important change in European patent law seemed like the ideal time for D Young & Co to launch a patent newsletter. The trade mark newsletter published bi-monthly by D Young & Co has been a great success, and our aim is to publish patent and trade mark newsletters in alternate months going forward.

As time is always in short supply, we will try to produce a newsletter that will provide you with useful information in a concise way. By its very nature, a newsletter will not be able to give legal advice, and therefore if you have any questions, or need further information, please do consult your usual contacts at D Young & Co. EPC 2000 is not the lightest of subjects, but we hope to be able to provide you with a patent newsletter that is not only informative, but also enjoyable. I look forward to receiving your comments.

EUROPEAN PATENT CONVENTION (EPC) REVISIONS

A diplomatic conference in November 2000 (EPC 2000) suggested a substantial revision to the European Patent Convention (EPC) 1977 (see footnote 1). As the requisite number of EPC Contracting States has now ratified EPC 2000, EPC 2000 will enter into force no later than 13 December 2007. Some of the major changes introduced in the EPC 2000 are outlined below:

PRIORITY

Under EPC 2000, it will no longer be necessary to have a priority document translated into an official language of the EPC or to file a declaration that the patent application is a complete translation of the priority document. Translations or declarations may still be required where the validity of the priority claimed is relevant for determination of patentability (see footnote 2).

EUROPEAN PATENT APPLICATION MAY BE FILED IN ANY LANGUAGE

Under EPC 2000, a European application may be filed in any language. A translation into one of the official languages will need to be filed within 2 months of filing the European patent application.

ESTABLISHMENT OF A FILING DATE BY REFERENCE TO A PREVIOUSLY FILED APPLICATION

To establish a filing date under EPC 2000 it will be possible to either file a description (and drawings) or to reference a previously filed application. A reference to a previously filed application will need to give the filing date and number of that application and the Office with which it was filed. A copy of the previously filed application will need to be filed within two months of filing the application. Where the previously filed application is not in an official language of the EPO, a translation will need to be filed into one of these languages within the same period.

NOVELTY

Documents citable pursuant to Article 54(3) EPC (i.e. intervening European patent applications) under EPC 2000 will be citable for novelty in respect of all EPC designated states irrespective of the states actually designated in the intervening patent application.

For patent applications pending when EPC 2000 enters into force, the current law will apply. Hence, documents citable pursuant to Article 54(3) EPC will only be citable in respect of states designated in both patent applications (i.e. overlapping designated states).

Under EPC 2000, at the time of filing all states will be deemed to have been designated.

REQUEST FOR PRIOR ART DETAILS

The EPO will be entitled to invite the Applicant to provide details of prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates. Failure to provide such information may lead to withdrawal of the patent application.

SECOND MEDICAL USE CLAIMS

Second medical use and subsequent use claims in a non-Swiss-type font will be allowable under EPC 2000 (see footnote 3). Thus there will be no longer a requirement to use the "Swiss-type language", i.e. use of X in the manufacture of a medicament for the treatment of Y, to protect second and subsequent medical uses.

PUBLICATION TO IDENTIFY WHEN CLAIMS FILED AFTER INITIAL FILING DATE

Where amended claims have been filed after the filing date of the patent application, the published application will explicitly state that the claims as published were submitted after the original filing date.

FURTHER PROCESSING

If an EPO time limit is missed such that the patent application is deemed withdrawn, in some circumstances it is possible to utilise the Further Processing provisions of the EPC to request revocation of the withdrawal.

EPC 2000 has extended the circumstances in which the Further Processing provisions can be used to any time limit of the EPO which is not explicitly exempted.

Exemptions include the time limit for claiming a priority right, the time limit for filing an appeal and the time limit for filing a petition seeking review of a decision of the Board of Appeal, for example.

APPEAL TO THE ENLARGED BOARDS OF APPEAL

In exceptional circumstances where there has been a "fundamental procedural defect", it will be possible to file a petition to request a review of a Board of Appeal decision by the Enlarged Board of Appeal.

CLAIM INTERPRETATION

Article 69 EPC relates to the extent of protection conferred by a European Patent. Article 2 of the Protocol on the Interpretation of Article 69 EPC has been amended by EPC 2000 such that:

"Due account shall be taken of any element which is equivalent to an element specified in the claims".

Such an amendment would appear to follow for a form of doctrine of equivalents. The original proposal for amendment to Article 2 (which was more in line with the US style of doctrine of equivalents), however, was rejected. Thus, this new doctrine of equivalents may be narrower than the US doctrine of equivalents. At the time of writing it remains to be seen how this will be applied in practice.

INTRODUCTION OF CENTRALISED LIMITATION/REVOCATION

Centralised limitation and revocation procedures have been added to provide the Patentee with a simplified and more economical way of amending or revoking their European Patent provided that the European Patent is not in opposition proceedings. The Patentee will need to simply request revocation or limitation and pay the requisite fee (see footnote 4).

Where limitation is sought the Patentee needs to provide a new set of amended claims. However, a statement of reasons for the limitation and an amended description and/or drawings will not generally be essential.

Provided that the amendments made are limiting, clear and do not add subject matter, the request for limitation will be allowed. The European Patent Office (EPO) will notify the Patentee by issuing a Communication inviting the translation of the claims into the Official Languages of the EPO. It is not clear at this stage how quickly limitation requests will be processed by the EPO.
Individual contracting states may decide that "revalidation" is required. At the time of writing it has yet to be clarified which (if any) states require "revalidation".

PRIVILEGE

Privilege from disclosure in proceedings before the EPO for all communications between a professional representative in his capacity as such and his client or any other person (unless the privilege is expressly waived by the client) is explicitly mentioned in the EPC 2000 (see footnote 5).

EURO-PCT CHANGES

- The EPO Board of Appeal no longer has an appellate position in relation to the EPO's handling of PCT (Patent Cooperation Treaty) matters. Therefore, by way of example only, a refusal to search all or some of the claims and/or a finding of non-unity by the EPO as International Search Authority (ISA) would appear to be no longer challengeable by appeal.

- If there is any conflict between the EPC and the PCT the provisions of the PCT or its Regulations will now prevail.

- Unsearched subject matter in a PCT case will apparently be lost forever from the Euro-PCT case and an Applicant will need to file divisional application(s) to recover the subject matter. Arguably this may mean that if the EOS as ISA refuses to search the whole application during the International Phase of the PCT application then it may be necessary to file a divisional application after entering the European Regional Phase as no claims will be examined on the parent application.

SUMMARY

The revisions made to the EPC by EPC 2000 have moved a substantial amount of text from the Articles of the EPC into the Implementing Regulations and will provide greater flexibility for future changes to the EPC as the Implementing Regulations can now be amended by the administrative council. Notably the Articles of the EPC have not been renumbered whereas the Rules have been.

FOOTNOTES

1. A lot of the changes come from implementing the Patent Law Treaty (PLT); however, the EPO is not bound by the PLT.
2. At the time of writing our understanding is that the EPO will invite the Applicant to file a translation where appropriate.
3. This will apply in respect of patent applications filed after EPC 2000 comes into effect and for patent applications on which a decision to grant has not been issued when EPC 2000 enters into force.
4. At time of writing this has been set at EUR450 for revocation and EUR1000 for limitation.
5. Particularly mentioned are: assessments of patentability, preparation or prosecution of a European patent application and an opinion relating to validity, scope of protection or infringement of a European patent/patent application.

ADDITIONAL SEARCHES FOR NON-UNITARY EURO-PCT APPLICATIONS

Under the current law (EPC 1973 R112), the EPO gives the PCT Applicant a second opportunity to pay additional search fees for an application if they were not paid in the international phase. This second opportunity will no longer be available under EPC 2000 (provision deleted from the corresponding R164 EPC 2000). EPC 2000 establishes two possible scenarios for PCT applications entering the European Regional phase.

Firstly, in cases where the EPO does not draw up a supplementary search report (i.e. where the EPO was the International Search Authority), the Applicant will only be able to pursue subject-matter that was searched in the international search report.

Secondly, in cases where the EPO does draw up a supplementary search report (e.g. where USPTO or JPO was the International Search Authority), the supplementary search report will be drawn up on the basis of a single invention only, in respect of the invention or group of inventions first mentioned in the claims. The Applicant can then pursue only a single invention covered by either (i) the international search report or (ii) the supplementary search report. Notably, in this case, it seems that the Applicant could have a second invention searched by re-ordering the claims on entry to the European regional phase to place the second invention at the beginning of the claims.

In both cases, any further inventions can only be pursued via the filing of divisional applications.

Applicants could consider early entry to the European regional phase to take advantage of the existing second opportunity to pay additional search fees under R112 EPC 1973. However, even if R164 EPC 2000 is not in force at the time of entry to the European regional phase, the wording of new Rule 164 and the transitional provisions are such that R164 may still apply at a later time when the EPO performs an assessment of whether the unity requirements are met.

More generally, PCT Applicants would be advised to take account of this change when filing PCT applications and when responding to invitations to pay additional search fees in the PCT International phase.

CHANGES TO SECOND MEDICAL USE CLAIMS IN EUROPEAN PATENT APPLICATIONS

As part of the changes to the European Patent Convention which will come into force in December 2007, a new type of "second medical use" claim will become allowable. Second medical use claims are typically used to protect inventions which relate to a novel therapeutic application of a known substance, when the substance has previously been disclosed for use in a different medical or veterinary method. For example, a patent application may relate to the use of a particular compound to treat cancer, whereas the compound had been used previously for treating arthritis. Second medical use claims are commonly employed in European patent applications as an alternative to US-style claims to methods of treatment, since the latter continue to be excluded from patentability in Europe.

The European Patent Office (EPO) currently allows second medical use claims in the "Swiss" form, for example "Use of compound X for the manufacture of a medicament for treating disease Y". Under the new law, the EPO will also allow claims in the form "Compound X for use in treating disease Y", even though compound X had previously been disclosed for treating disease Z (assuming all of the other requirements for patentability are fulfilled). Claims in the form "Compound X for use in medicine", referred to as "first medical use" claims, will continue to be available where the invention relates to a medical use of a substance previously described only for use in non-medical methods.

It seems that the EPO will treat claims in the new second medical use form as though they have the same scope as claims in the old form. Apparently the aim of this change was not to extend protection for medical uses but to confirm the legal status quo which was based on the EPO's own case law. Since the new law enshrines protection for second medical uses in the legislation, doubts which were cast by the courts of some European states on the validity of second medical use claims should be overcome.

However, it is unclear how the national courts of European states will interpret the scope of the new second medical use claims, for instance when considering infringement actions. It is conceivable that the change from an essentially "process" type claim format to an essentially "product" type format may be advantageous to a patent holder seeking to prove infringement in some jurisdictions.

The new claim format for second medical uses will be permitted in European patent applications which are not yet granted when EPC2000 comes into effect in December 2007. In view of this, it is advisable to include both the new and old forms of second medical use claims in new and currently pending European patent applications which are likely to be granted on or after 13th December 2007. In some cases, it may be worth considering deferring grant until after this date in order to allow claims in the new format to be included.

POST-GRANT AMENDMENT AND REVOCATION AT THE EPO

EPC 2000 will provide a patent proprietor with the opportunity to limit the claims of a granted patent (or to revoke it completely) centrally at the EPO. The limitation or revocation will take effect ab initio in all designated states. Previously, other than during EPO opposition proceedings, it has been necessary to carry out any desired amendments to granted European patents independently at the national patent office of each designated state. The new procedure will therefore provide an attractive, less expensive, way of amending a European patent after grant.

EPC 2000 also provides a patent proprietor with the right in proceedings relating to the validity of a European patent (e.g. before a national court) to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings.

At the EPO, the patent proprietor is not obliged to give any reason for the request for limitation or revocation. It is important to note that the request for a limitation will not fully re-open examination of the claims. The EPO will merely confirm that the limitations meet the EPO's requirements regarding added-matter and clarity. Patentability (novelty and inventive step) will not be re-examined. Third parties may in principle file observations at the EPO in relation to the proposed amendments in line with present practice concerning third party observations filed during the examination procedure, but since third party observations are limited to issues of patentability (novelty and inventive step), the EPO should not take these into account, although the proprietor may wish to do so. It will not be possible for third parties to oppose the limitation. The limitation or revocation can be requested at any time. However, a request for a limitation after an opposition has been filed will be rejected. If an opposition is filed after the patent proprietor files a request for a limitation, the latter proceedings will be terminated. In contrast, a request for a revocation will continue whether it is filed before or after an opposition has been filed against the patent.

If a limitation request is made during national proceedings (e.g. revocation proceedings), the national proceedings may be stayed or continued in accordance with national law or practice.

If the limitation request is allowed, the claims must be translated into the official language of the EPO and an amended patent specification is published. The national law of the contracting states where the European patent has been validated may require a translation of the amended patent specification to be filed.

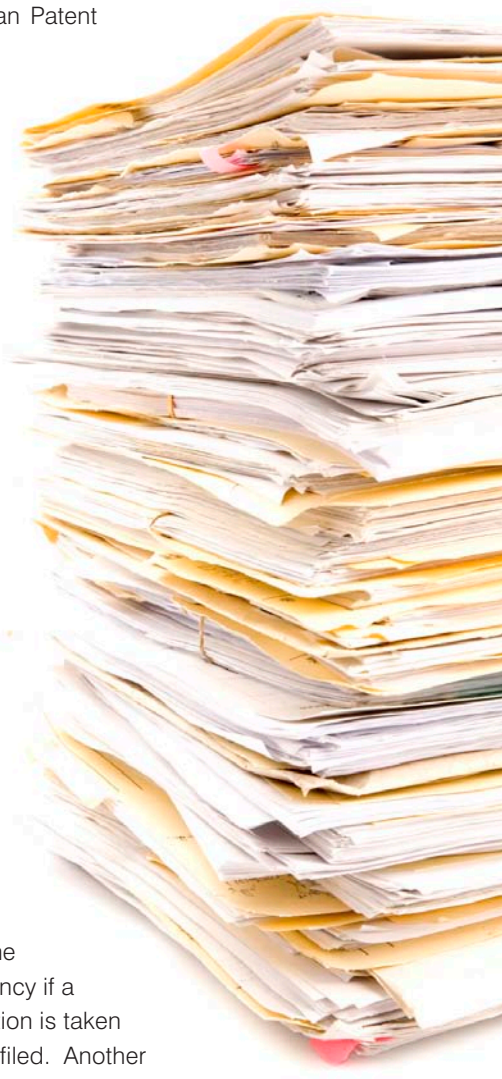
These new provisions provide a convenient means for a patent proprietor to amend his patent claims in the light of new prior art that was not considered during examination. This is of particular value because it allows the patent proprietor to amend claims to ensure that his claims are more robust prior to commencing litigation in the national courts. Presently in the UK, the allowability of a post-grant amendment is discretionary and requires that the patent proprietor provides a full disclosure, shows that there was no undue delay in seeking the amendment once he became aware of the prior art and that he had acted in good faith. If the UK Courts or Patent Office consider that these criteria are not met, then the amendment may be refused and the patent may be revoked. In contrast, the new EPO practice does not impose any penalty for a delay in requesting limitation or revocation. Requesting limitation or revocation at the EPO will therefore provide a way of bypassing the requirements imposed by the UK Courts and Patent Office under the present UK Patents Act.

Nevertheless, it is important to note that the UK Courts and Patent Office will continue to consider the issues of full disclosure, lack of undue delay and good faith when considering the award of damages or other relief. In view of this, patent proprietors should continue to exercise diligence if any prior art considered relevant to the patentability of the claims comes to light after grant.

It will be interesting to see how EPO and UK practice will develop in light of these changes.

The above-discussed provisions of EPC 2000 will be applicable to all European patents and patent applications after entry into force of EPC 2000 (on 13 December 2007 at the latest).

FILING IN A NON-EPO LANGUAGE



Under the current version of the European Patent Convention, Article 14 requires a European patent application to be filed in an official language of the EPO (English, French or German), subject to one limited exception relying on the nationality or residence of the applicant.

Under the EPC 2000, Article 14 has been amended in view of Article 5 of the Patent Law Treaty to enable a European patent application to be filed in any language, irrespective of the nationality or residence of the applicant. While the option of filing in any language requires a subsequent translation into an official language of the EPO, this translation may be brought into conformity with the application as filed at any time during proceedings before the European Patent Office.

One benefit of this approach is that a translation into an official language of the European Patent Office is not required to obtain a filing date, which means that the translation can be prepared with less urgency if a decision to file a European patent application is taken shortly before the application is due to be filed. Another benefit is that when a translation is filed, any errors in the translation can be corrected simply by bringing the translation into conformity with the application as filed.

However, filing a European patent application in a non-EPO language is not without its disadvantages. For instance, a foreign language description cannot easily be amended before filing or checked for completeness by a European patent attorney. While the latter problem can be avoided by filing by reference to an earlier application under new Rule 40(1)(c) EPC, this requires a certified copy of the earlier application to be provided within two months from filing. Failure to provide the certified copy may result in loss of the application, although in some cases the EPO may automatically obtain a certified copy. Moreover, filing by reference to a previous application rules out the possibility of amending the description to conform with European practice. Consideration should also be given to the risk of failing to file the translation within the two months set out in Rule 6(1) EPC, or alternatively within the further two months from notification set out in Rule 58 EPC. Failure to provide the translation before the expiry of the latter period will result in deemed withdrawal of the application, which can only be remedied using re-establishment of rights under Article 122 EPC, whereupon “all due care” must be shown.

Overall, it is difficult to reconcile the benefits and disadvantages of filing a European patent application in a non-EPO language to determine whether this provision of the EPC 2000 should be used in all cases. As such, consideration should be given to the particular requirements of the applicant, and the circumstances of each case.

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EXAM SUCCESS

Congratulations to Simon O'Brien who has recently been appointed an Associate following his qualification as a European Patent Attorney. Simon specialises in biotechnology, biochemistry, molecular biology and general chemistry subject matter, including therapeutics, diagnostics, gene sequences, pharmaceuticals and petrochemicals (visit www.dyoung.com/people/staff/simonobrien.htm for Simon's full profile).

LONDON AGREEMENT

There have been some important recent developments with regard to the London Agreement. According to the London Agreement, concluded some while ago but not yet in force, the need for translation of European patent applications into numerous languages to bring them into effect in various countries will be greatly reduced. The London Agreement is an optional agreement between member states of the European Patent Organisation. Nine countries have already ratified the London Agreement. The last country required to ratify the London Agreement for it to come into force is France.

On 24 August 2007, a bill authorising ratification of the London Agreement was adopted by the French Government. It will be discussed in the Assemblée Nationale and French authorities expect it to be voted by late November 2007. If the bill is passed, the deposit of ratification instruments from France could therefore be expected early in 2008 and the Agreement could then enter into force three months later.

Countries that have already ratified the London Agreement are: Germany, United Kingdom, the Netherlands, Switzerland, Iceland, Latvia, Liechtenstein, Monaco and Slovenia. The parliaments of Sweden and Denmark have also approved the Agreement. Hopefully therefore, the London Agreement will enter into force in 12 of the 32 member states of the European Patent Organisation early in the first half of 2008 (see www.epo.org/focus/news/2007/20070911.htm).

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