

EPC 2000 – Changes to the European Patent System

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The European Patent Convention (EPC) was created in 1978 and established a central European patent process. At that time only six countries joined the EPC: Germany, Switzerland, Belgium, France, Great Britain and Sweden. Presently 31 countries belong to the EPC and an additional five nations allow for the extension of an issued European patent into their country.

EPC 2000 is the first revision to the European Patent Convention since the EPC was established 30 years ago. The EPC was revised to bring it into agreement with the requirements of the TRIPS Agreement (The Agreement on Trade Related Aspects of Intellectual Property Rights) and the Patent Law Treaty of 2000. Other changes were made purely to simplify the European patent process.

Key changes made to the European Patent Convention include:

Patentable Inventions

- Even though methods of medical treatment or diagnosis remain unpatentable, a patent can be obtained for a second medical use of a known compound.

Filing Requirements

- An application no longer requires claims. The claims can be submitted within two months of being notified by the European Patent Office (EPO) to provide the missing claims. This can be especially useful where the European patent application is the initial application filed.
- The application can be filed in any language. Translation into one of the three official languages, English, French, or German, will be required.
- It is now possible to file a European patent application solely by providing a reference to a previously-filed application, including the filing date, serial number and country.
- The fee structure for country designations has changed. Instead of paying a fee for each country the European patent application will include (up to a maximum of seven fees), a single designation fee is required and includes all 31 countries.
- In the event that part of an application is inadvertently omitted when being filed, it is possible to correct this missing part by referencing where in a prior application the missing part can be found.

For most applications, these changes will not have any effect. In cases where the decision is made to file an application just before a filing deadline, however, these changes make it possible to file such a last-minute application.

Examination Procedure

- When an International Patent Application (PCT application) enters the European phase, the supplementary search report from the EPO will be prepared on the first claimed invention only. This change applies to all European patent applications pending as of December 13, 2007.

For these previously filed applications, applicants may wish to review their applications to make sure that, in the event the European examiner determines the application contains multiple inventions, that their most important invention is included in the first claim.

- The European Patent Office does not have a “duty of disclosure” like the U.S. Patent Office. The U.S. “duty of disclosure” requires a patent applicant to inform the Patent Office of any prior art the applicant is aware of that may be relevant to patentability. However, the European Examiner now has the option to request the applicant provide such a disclosure. It is not known how much EPO examiners will use this procedure.

Patent Enforcement

- The new protocol on the interpretation of claims states, “For the purpose of determining the extent conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.” During patent litigation, whether or not equivalents of claim elements were considered in determining infringement was decided by the national courts. Some countries considered equivalents and others did not. This change will make the consideration of equivalents uniform among the different national courts.
- The patent owner can now request limitation of an issued European patent at any time during the life of the patent. If a patent owner learned of prior art that affected the validity of the claims in the European patent, this process, Central Limitation, allows the owner to amend the patent claims so that the patent claims remain valid.

Previously, in the event that a competitor challenged the validity of an issued European patent, the challenge was based only on the claims in the patent. If there were alternate claims not in the patent that would survive the challenge of validity, the patent owner could not introduce any alternate claims. The new Central Limitation process allows the owner to introduce these alternate claims rather than have the entire patent revoked.

- European attorneys are now required to keep any information received from the patent applicant in confidence unless the client agrees to the release of the information. This new requirement should meet the requirements of U.S. law for privileged communication. Previously, a European patent attorney could be forced to disclose information received from their client that a U.S. attorney would be required to keep confidential.

Fee Increases

In addition to the changes made by EPC 2000, some significant fee changes have been made recently for European patent applications.

- Beginning April 1, 2008, an excess claim fee of 200 Euros (\$314) is due for each claim in excess of 15.
- Beginning April 1, 2009, the excess claim fee will be 500 Euros (\$786) for each claim in excess of 50.

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