



Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets

# BIO-EUROPE 2007

## Anticipated changes to European Patent Law

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**12 November 2007, Hamburg**



# EPC 2000

- **Revision Conference: 20 – 29 November 2000**
- **EPC 2000**
  - enters into force on **13 December 2007**
  - ratified by **28/30** contracting states to date  
AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, GB, GR, HU,  
IE, IS, LI, LU, LT, LV, MC, MT, NL, PL, RO, SE, SI, SK  
(+ NO, HR: 01.01.2008)
  - still missing: FR, IT, PT, TR
- **Latecomers leave the EPC!**

# EPC 2000 - Main features at a glance

- **Grant procedure**

- New rules for accordance of filing date (PLT 2000)
- Streamlining of grant and opposition procedures
- Improved legal remedies (further processing, re-establishment of rights)

- **New procedures**

- Central limitation and revocation procedure
- Review of BoA decisions by EBA

- **Patentability**

- Alignment with TRIPS
- EP application has prior right effect for all contracting states
- Better protection for medical methods

# London Agreement on the application of Art. 65

- **Translation requirements today**
  - A European patent can be **validated** in one, several or all 32 contracting states
  - 23 languages may be relevant for **translation**
    - French, German, English, Italian, Dutch, Spanish, Swedish, Danish, Finnish, Greek, Portuguese, Turkish, Polish, Hungarian, Estonian, Latvian, Lithuanian, Romanian, Bulgarian, Czech, Slovakian, Slovenian, Icelandic
  - New Member States: Norway, Croatia
    - Further languages
- **National law** determines translation requirements

# London Agreement - Cost Reduction

- **Optional** agreement open to EPC contracting states
  - Applies only in EPC contracting states having ratified or acceded to the London Agreement
- **Adopted** at Intergovernmental Conference of EPC contracting states, London 17 October 2000
- To date, 14 national parliaments have **approved** the London Agreement
  - DE, FR, UK as well as CH, DK, HR, IS, LI, LU, LV, MC, NL, SE, SI
- **Reduction of translation costs (by ~ 40%)**
- **Entry into force** on the first day of the fourth month after France deposits its instrument of ratification (**probably** in November 2007): i.e. **1 March 2009**

# London Agreement - Cost Reduction

- States having an EPO official language as a national language shall **dispense** with translation requirements
  - applies to DE, FR, UK, CH, LI, LU, MC
- States having a national language other than English, French or German may require that
  - the **claims** be translated into their national language
    - applies to DK, HR, IS, LV, NL, SE, SI
  - the **description** be supplied in an EPO official language prescribed by the State
    - applies to DK, IS, NL, SE (description must be in English)
- Full translation upon enforcement / litigation

# Level of inventive step: Internal means

- Raising the bar by (possible) internal means
  - Strengthening the internal "votum"
  - Strengthening the roles of all three members of the examining division
  - Strengthening the problem-and-solution approach
  - Giving more precise guidance on what is "obvious" for the "person skilled in the art"

# Level of inventive step: Legal means

- Raising the bar by (possible) legislative means:
  - Definition of the "person skilled in the art" (IR)
  - Definition of the term "obvious" (IR)
  - Amendment of the definition of "inventive step" (EPC)
  - Creation of a legal basis for allowing the examiner to request amendments to the claims before starting the search (EPC)



# Level of inventive step: External practice

- **Raising the bar by external practice:**
  - **One independent claim per category only**
  - **Making it more attractive to third parties to file observations concerning the patentability** of the invention by
    - accelerating the examination procedure
  - **Improving applicant cooperation** during the examination procedure by
    - a **Code of practice**
    - an **amended fee structure**

# Divisional applications: Enlarged Board of Appeal G 01/06

- **Decision of the EBoA G 01/06 of 28 June 2007:**
- Refiling the same subject-matter again and again by sequences of divisional applications, by means of at least an unamended description, pending for up to twenty years, is **unsatisfactory and not adequate**,
- **Administrative measures:**
  - **giving priority** to the examination of divisional applications,
  - bundling and **speedily deciding on copending divisional applications**,
  - minimize the possibility for applicants to keep alive subject-matter on which a negative opinion had already been given,
- **Legislative initiatives to consider where there are abuses and what the remedy could be.**

<http://legal.european-patent-office.org/dg3/biblio/g060001ex1.htm> (point 13.5 of the Reasons)

# Divisional applications: Possible amendments to Rule 36 EPC 2000

- **Reasons for a legislative initiative:**
  - Legal uncertainty for third parties/competitors for up to 20 years
  - The EPO has to start the examination procedure several times
  - Patents are intended as an incentive for the inventor/applicant to disclose details of the invention in order to allow society to use this information for further development; so-called "Patent Bargain"
  - The possibility of sequences of divisional applications containing the same broad disclosure contradicts the socio-economic intention of the patent system

# Divisional applications: Possible amendments to Rule 36 EPC 2000

- **"Legitimate" divisional applications** are to be **allowed** - as a consequence of non-unity of invention
- **Abusive** filing of sequences of divisional applications have to be **prevented**
- To that end, the European Patent Office intends to present in 2008 a proposal which **should enter into force on 1 January 2009**

# New fee structure

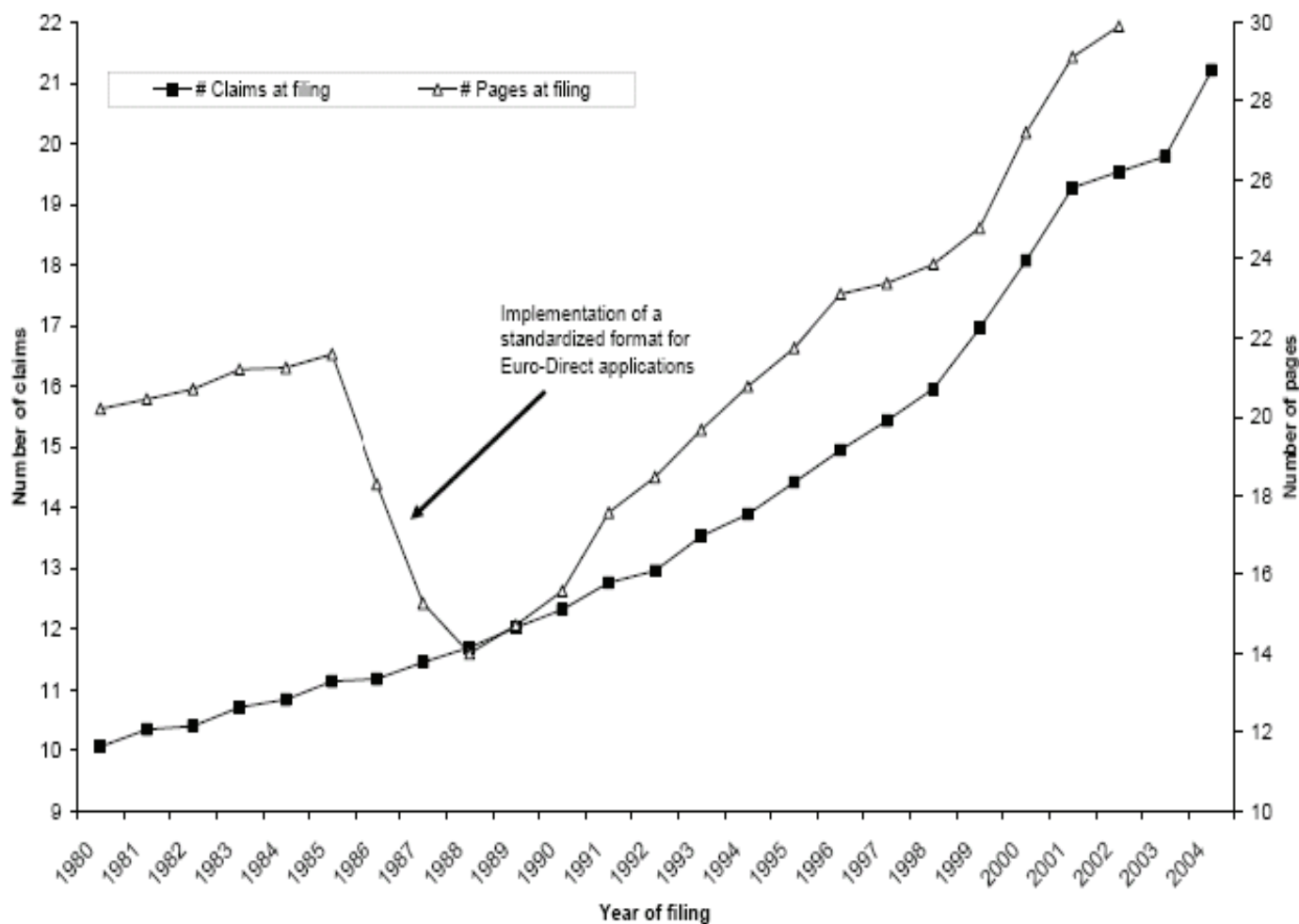
- **Main objectives** of the new fee structure
  - continuing to **streamline the grant procedure**
  - **steering applicant behaviour** through fee incentives/disincentives
  - **aligning the structure of Euro-direct and (Euro-)PCT fees**

# New fee structure

- **Main reasons** for the new fee structure
  - The EPO is receiving an increasing number of applications comprising **several hundred pages** with an ever-rising number of claims
  - Impact of this trend on the work of the Office in general
  - Shifting the burden of payment to those applicants who file large numbers of claims
  - Simultaneous introduction of a page fee on filing to prevent artificial inflation of individual claims in an attempt to circumvent the new claims fee

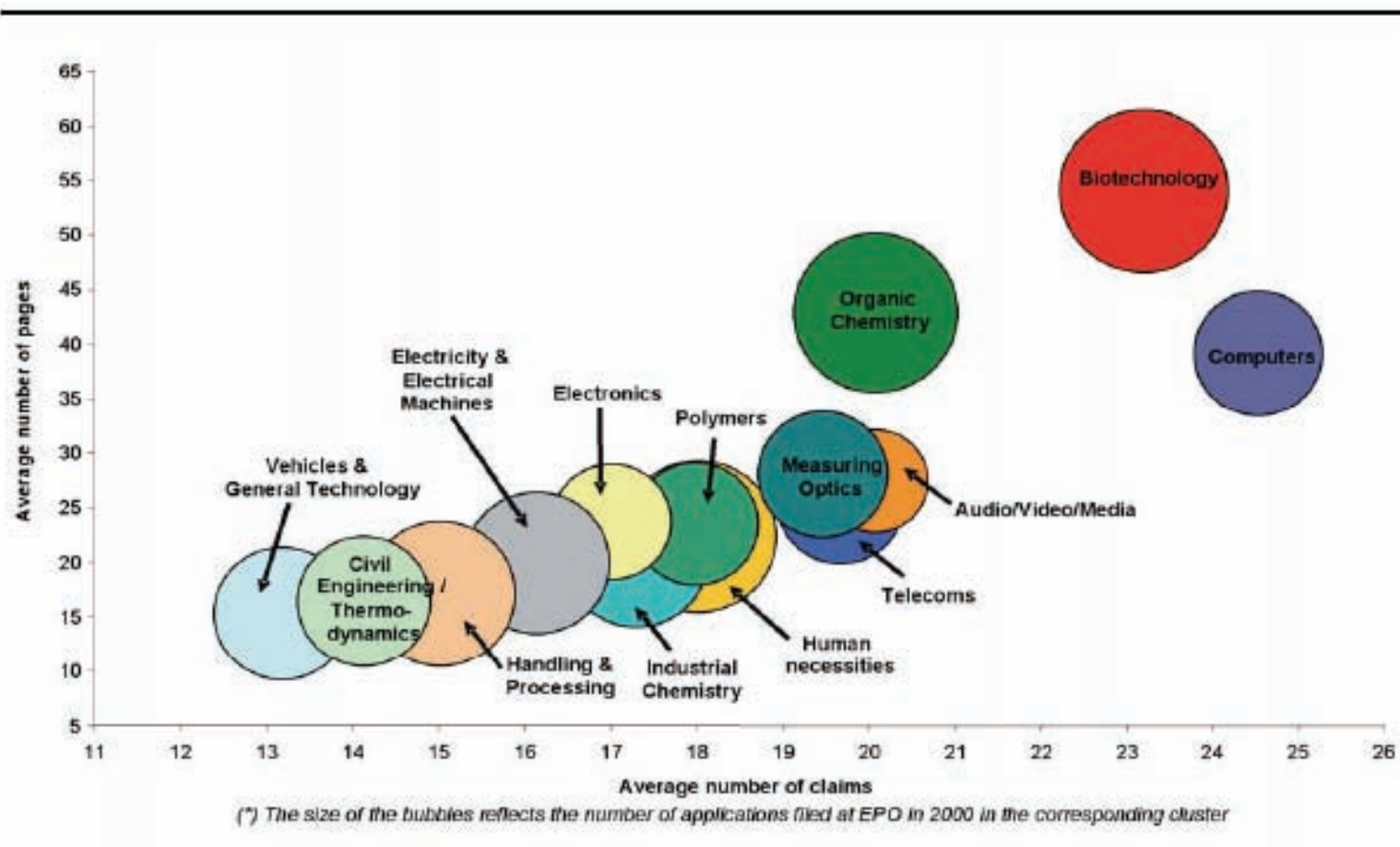
# New fee structure

Figure 1 – Average number of claims and pages in incoming applications at EPO (1980-2004)



# New fee structure

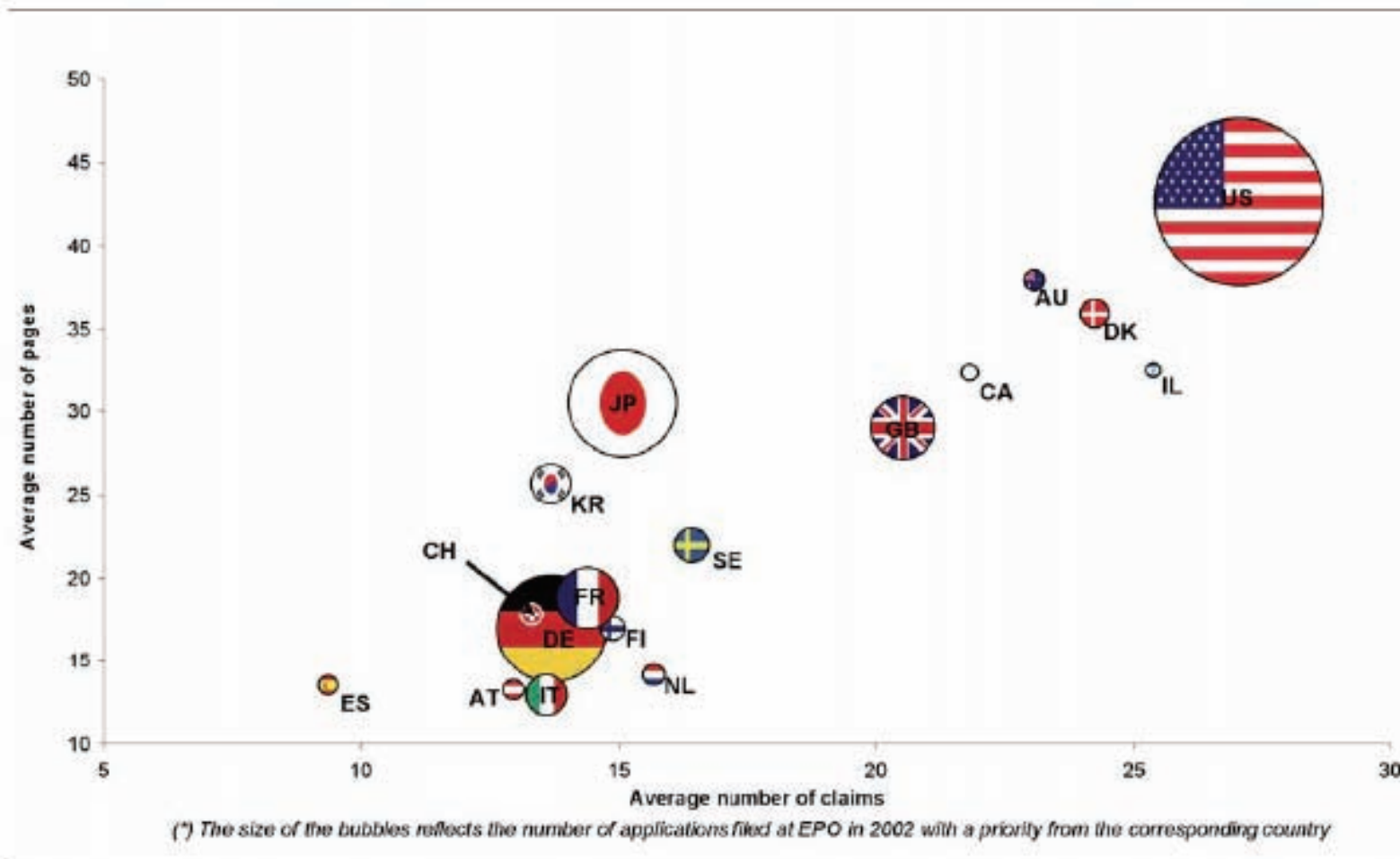
Fig. 2 – Average size of EPO applications, by Joint Cluster (\*)





# New fee structure

Fig. 3 – Average size and number of EPO applications, by priority country (\*)



# New fee structure

- Bigger increases of **renewal fees** for European patent applications\*
- Increase of **late payment fee**\*
- **Page fees on filing**\*\*
- **Claims fees on a sliding scale**\*\*

\* **Entry into force: 1 April 2008**

\*\* **Entry into force: 1 April 2009**



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# Thank you for your attention!

Ingwer Koch

12 November 2007

