Revision of the European Patent Convention (EPC)

*BY HEINZ GODDAR**

On behalf of the European Committee of LESI, I had the pleasure of representing LES International at a Diplomatic Conference for the revision of the European Patent Convention of the EPC member states, which took place at Munich November 20–29, 2000.

The Conference was full of surprises. One of the biggest was that contrary to what had been suggested in a Basic Proposal for the Revision of the European Patent Convention by the President of the European Patent Office (dated July 28, 2000, and approved by the Administrative Council of the European Patent Office on September 5-8, 2000), computer software remains excluded from patentability under EPC. To this extent, my article in the December 2000 issue of *les Nouvelles*, (Volume XXXV, No. 4, pp. 61-65) reflecting the status of discussion of early November 2000, needs correction.

The Revision Act, as agreed on at Munich at the end of November, and thereby the revised text of the EPC, shall enter into force either (a) two years after the 15th member state has deposited its instrument of ratification or accession, or (b) on the first day of the third month following the deposit of the instrument of ratification or accession by the member state taking this step as the last of all of the contracting states, if this takes place earlier.

The Revision Act will have a heavy influence on licensing in and with Europe, bearing in mind the general importance of the patent system to create and protect licensable technology rights.

Compared with the earlier status discussed in the December 2000 *les Nouvelles*, the revised Articles 52 and 53 provide for future European patents to be granted for any inventions in all fields of technology, provided that they are new, involve an inventive step and are susceptible to industrial application (Article 52 (1).

Article 52 (1) (c), however, will still exclude patents for computer programs and for methods for doing business as such. That will mean that in the future, in view of the rather liberal practice of the EPO, inventions of the aforementioned kind will be patentable under EPC, provided that in a more or less formal manner technical elements, even in the form of data carrier features, are included into the patent claims.

Also in accordance with the approved Revision Act of the Munich Diplomatic Conference, Article 54 (4) in its present version has been deleted. That present provision means that prior applications, not yet published at the priority date, until now only are considered as prior art, for novelty only, insofar as a contracting state designated in respect of the later application was also designated in respect of the earlier application as published. The new version will mean that contents of European patent applications in any case — even if there is no overlap of the designated states — will be considered novelty destroying. This will not, of course, apply to inventiveness, in which case such prior applications in the future will not play any role at all.

As a further, remarkable result of the Diplomatic Conference it has to be stated that it provides, as the earlier Basic Proposal, for a central limitation procedure of EPC-based patents during the lifetime thereof. This will simplify the streamlining of patents before litigation, which presently only can be done nationally in the designated countries, to a large extent, thereby minimizing the risk of invalidation requests being successfully filed in case of disputes.

Another remarkable provision has been introduced by a new Article 112 (a), according to which any party to appeal proceedings adversely affected by the decision of a Board of Appeal of the EPO may file a petition for review of the decision by the Enlarged Board of Appeal. The petition may only be filed on one of the grounds exhaustively described in the Article 112 (a), but this list contains rather broad formulations, so that in the future the Enlarged Board of Appeal may play a court-like role to supervise the Boards of Appeal of the EPO in a much stronger manner than in the past.

The Diplomatic Conference has unanimously agreed on a Conference Resolution by which the Administrative Council and other relevant bodies of the EPC are urged to make preparations for another Diplomatic Conference. Proposals for further revision to be discussed at such a next Diplomatic Conference in particular shall relate to software and such changes as are required to implement the forthcoming Community Patent without delay. It is informally intended to have the next Diplomatic Conference take place toward the end of the year 2001.

As a conclusion, the preliminary results as agreed on at Munich, and as reflected in the Revision Act, appear to have the tendency to "centralize" the EPC procedure even further (e.g., from the central limitation procedure and the novelty destroying effect of prior EP applications without delay). It is remarkable that with the introduction of a central limitation procedure the EPS for the first time will be brought into a role to deal with EPC-based patents after "nationalization" even in cases where any opposition periods and procedures have been finalized.

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ERRATUM

An error appeared in the March 2001 issue of *les Nouvelles* (Volume XXVI No. 1) in the article entitled "Measuring the Effectiveness of a Company's Assets." On page 27, in the figure, the words "R&D Strategy" should read "Business Strategy." Apologies for any inconvenience this may have caused.