

Concise

European Patent Law

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PREFACE

'Concise IP' is the short name given to a series of five volumes of commentary on European intellectual property legislation. The five volumes cover: Patents and related matters, Trademarks and designs, Copyrights and neighbouring rights, IT and a general volume including jurisdictional issues. The series is based on a successful formula used for a Dutch publication, a series called *Tekst & Commentaar* (Text & Commentary) and on the equivalent German publication, *Kurz Kommentar* (Short Commentary). Since their first publication, these have won a prominent place among Dutch and German legal publications with each volume becoming an authority in the field.

Concise IP aims to offer the reader a rapid understanding of all the provisions of intellectual property law in force in Europe enacted by European and other international institutions. The volumes take the form of an article-by-article commentary on the relevant regulations and other legal instruments. It is intended to provide the reader with a short and straightforward explanation of the principles of law to be drawn from each article, rule or other provision. Where appropriate, this is done by reference to the construction of that provision by senior courts. Usually only judgments of the European Court of Justice, higher national courts or other senior tribunals such as the Board of Appeal of the European Patent Office are cited, though there are exceptions where an important point has only so far be considered by a lower tribunal. The citations do not include an analysis of the facts of the case, only the relevant point of law.

In order to keep the commentaries clear, they are in a form that is as brief as the subject-matter allows. For in-depth analysis and discussion the reader will need to move on to specialist text books. Concise IP also differs from other publications in the form of commentaries, such as those in looseleaf format, by reason of its shorter, more direct style. The idea is that the reader will find it easy to gain a rapid appreciation of the meaning and effect of the provision of interest and thereafter be in a position to look in the right direction should further information be needed. The editors and authors are all prominent specialists (academics and/or practitioners) in their fields.

It is the intention of the editors and publisher to publish new editions every two to three years.

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Jochen Pagenberg is a special advisor to the German Justice Department for the preparation of the European Patent Litigation Agreement (EPLA) and serves as an expert to the intergovernmental European Working Party on Litigation. He is vice-president of the European Patent Layers Association, chairman of the special committee on European patent litigation of the AIPPI and of the OHIM Subcommittee of INTA. Memberships include AIPLA, ALAI, ECTA, IBA, Marques, PTMG, the American Chamber of Commerce and ATRIP.

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INTRODUCTION

1. European Law. (a) The European Patent Convention. The European Patent Convention constitutes the legal framework for the application, granting and opposition procedure for European patents. It has also become a model for the harmonization of national laws of member states of the European Patent Organisation, in particular the rules on patentability and interpretation of patent claims. The success of the system is demonstrated by nearly 200,000 patent applications per year. Membership of the European Patent Convention goes beyond the countries of the European Community and covers an economic area of considerable weight. The essential concept of the European Patent system is a central examination and grant of a European Patent. After grant the patent takes effect in the form of national patents in the states designated by the applicant. **(b) European Patent after grant.** The fact that the European Patent after grant becomes a bundle of national patents is a potential cause of disharmony when it comes to enforcement which may only be done in national courts. In spite of the uniform legal concepts, national courts have not always found a common interpretation of those concepts, in particular the requirements for the validity of a patent and the determination of the scope of protection, or even for the methods of examination. **(c) EPLA.** The European Patent Litigation Agreement (EPLA) which is currently being discussed and which, if concluded, will become the common litigation system for the 700,000 European patents granted so far has been blocked for a number of years for political reasons. It is now expected that after a European-wide consultation of users the EU Commission will approve it so that its adoption can be expected by the end of 2007 or beginning of 2008.

2. International law. (a) The Patent Cooperation Treaty. Like the EPC, the Patent Cooperation Treaty (PCT) is the result of an international effort to simplify the filing of patents by adopting common rules for the filing and further processing of applications. The mutual recognition of the conditions for search and examination go far beyond the framework of the Paris Convention from which the recognition of priority is derived. The PCT also allows for the possibility to postpone examination – and thereby defer payment of fees and the translation of applications – the system is administrated by the World Intellectual Property Organization (WIPO). **(b)** Another goal of international harmonization has partly been realized with respect to formalities. These have been harmonized in the Patent Law Treaty (PLT). The original aim of an international harmonization of substantive law failed due to divergences, primarily between the European and the American systems. Since the PLT was adopted, member countries of WIPO have continued to work on this project which is now known as SPLT (Substantive Patent Law Treaty). An adoption of this treaty is not in sight.

3. Community Law. (a) Council Regulation for Supplementing Protection Certificates. Council Regulation 1768/92 concerns the creation of supplementary protection for medicinal products. The problem of regulatory delays for pharmaceutical products was regarded as a severe hardship for the industry, since there was an imbalance between the cost of research in the pharmaceutical industry and the profit made within the period of patent protection, available in practice from sales of the products. In 1996 Regulation 1610/96 was enacted to provide a similar scheme of supplementary protection certificates in relation to plant protection products. **(b) Legal protection of Biotechnical Inventions Directive.** Directive 98/44 harmonizes important aspects of the law in Member States in relation to biotechnological inventions. The definition of patentable subject matter, the formulation of claims in this field and the scope of protection granted are the primary focus of the Directive. **(c) Draft Regulation.** A Draft Regulation for a Community Patent has been under discussion for more than six years. In 2006, the EU Commission involved users in its deliberation process and announced that it will support the EPLA project on which later the Community Patent could be built.

CONVENTION ON THE GRANT OF EUROPEAN PATENTS

(European Patent Convention)

of 5 October 1973

text as amended by the act revising Article 63

EPC of 17 December 1991 and by decisions of the

Administrative Council of the European Patent Organisation

of 21 December 1978, 13 December 1994, 20 October 1995,

5 December 1996, 10 December 1998 and 27 October 2005

and comprising the provisionally applicable provisions

of the act revising the EPC of 29 November 2000

The Contracting States,

Desiring to strengthen co-operation between the States of Europe in respect of the protection of inventions,

Desiring that such protection may be obtained in those States by a single procedure for the grant of patents and by the establishment of certain standard rules governing patents so granted,

Desiring, for this purpose, to conclude a Convention which establishes a European Patent Organisation and which constitutes a special agreement within the meaning of Article 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised on 14 July 1967, and a regional patent treaty within the meaning of Article 45, paragraph 1, of the Patent Cooperation Treaty of 19 June 1970,
Have agreed on the following provisions:

PART I. GENERAL AND INSTITUTIONAL PROVISIONS

Chapter I. General Provisions

[European law for the grant of patents]

Article 1

A system of law, common to the Contracting States, for the grant of patents for invention is hereby established.

1. General. The EPC governs all matters leading to the grant of European patents but, with the exception of the opposition procedure (for which see arts. 99 to 105), it is not concerned with post-grant procedures. Patents may only be enforced under the national laws of Contracting States. However, the EPC imposes obligations on, or defines alternatives available to the Contracting States regarding the rights to be conferred by a European patent under national laws (for which see arts. 63 to 70). Of these, probably the most important is the extent of protection conferred by claims (art. 69 and its protocol).

[European patent]

Article 2

(1) Patents granted by virtue of this Convention shall be called European patents.

(2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless otherwise provided in this Convention.

1. National equivalence (para. 2). This paragraph makes it clear that a European patent, once granted, is to be treated by the Contracting States as if it were a national patent granted by that State, save where the EPC provides otherwise.

[Territorial effect]

Article 3

The grant of a European patent may be requested for one or more of the Contracting States.

1. General. Art. 80 requires the designation of at least one Contracting State for a date of filing to be accorded and all or any may be designated. Designation of Contracting States is governed by art. 79. New Contracting States have regularly joined the EPC and the current list of Contracting States is provided in the notes to art. 166. Switzerland and Liechtenstein are special cases in that they may only be designated jointly, as provided for by arts. 142 to 149 that govern unitary patents. Several European states, while not becoming Contracting States to the EPC, have signed an Extension Agreement with the European Patent Organisation, thereby allowing European patents to be extended to these so-called Extension States. However, this article makes it clear that grant of a European patent must be requested for one or more Contracting States, and not just for Extension States.

[European Patent Organisation]

Article 4

(1) A European Patent Organisation, hereinafter referred to as the Organisation, is established by this Convention. It shall have administrative and financial autonomy.

(2) The organs of the Organisation shall be:

- (a) a European Patent Office;**
- (b) an Administrative Council.**

(3) The task of the Organisation shall be to grant European patents. This shall be carried out by the European Patent Office supervised by the Administrative Council.

1. General. This article sets out the function of the European Patent Organisation and the relationship between the EPO and the Administrative Council, see para. 3 in particular.

Chapter II. The European Patent Organisation

[Legal status]

Article 5

(1) The Organisation shall have legal personality.

(2) In each of the Contracting States, the Organisation shall enjoy the most extensive legal capacity accorded to legal persons under the national law of that State; it may in particular acquire or dispose of movable and immovable property and may be a party to legal proceedings.

(3) The President of the European Patent Office shall represent the Organisation.

[Seat]

Article 6

(1) The Organisation shall have its seat at Munich.

(2) The European Patent Office shall be set up at Munich. It shall have a branch at The Hague.

1. Offices of the EPO (para. 2). In addition to the offices in Munich and the Hague, the EPO has sub-offices in Berlin and Vienna. The offices in Munich, the Hague and Berlin all act as filing offices within the meaning of art. 75(1)(a) for the receipt of European patent applications; the office in Vienna does not. A sub-office has also been established in Brussels for the purpose of liaison, as provided for under art. 7, but not for the purpose of acting as a filing office.

[Sub-offices of the European Patent Office]

Article 7

By decision of the Administrative Council, sub-offices of the European Patent Office may be created if need be, for the purpose of information and liaison, in the Contracting States and with inter-governmental organisations in the field of industrial property, subject to the approval of the Contracting State or organisation concerned.

1. Liaison sub-office. The EPO has a sub-office in Brussels for liaison with the European Community.

[Privileges and immunities]

Article 8

The Protocol on Privileges and Immunities annexed to this Convention shall define the conditions under which the Organisation, the members of the Administrative Council, the employees of the European Patent Office and such other persons specified in that Protocol as take part in the work of the Organisation, shall enjoy, in the territory of each Contracting State, the privileges and immunities necessary for the performance of their duties.

[Liability]

Article 9

(1) The contractual liability of the Organisation shall be governed by the law applicable to the relevant contract.

(2) The non-contractual liability of the Organisation in respect of any damage caused by it or by the employees of the European Patent Office in the performance of their duties shall be governed by the provisions of the law of the Federal Republic of Germany. Where the damage is caused by the branch at The Hague or a sub-office or employees attached thereto, the provisions of the law of the Contracting State in which such branch or sub-office is located shall apply.

(3) The personal liability of the employees of the European Patent Office towards the Organisation shall be laid down in their Service Regulations or conditions of employment.

(4) The courts with jurisdiction to settle disputes under paragraphs 1 and 2 shall be:

- (a) for disputes under paragraph 1, the courts of competent jurisdiction in the Federal Republic of Germany, unless the contract concluded between the parties designates the courts of another State;
- (b) for disputes under paragraph 2, either the courts of competent jurisdiction in the Federal Republic of Germany, or the courts of competent jurisdiction in the State in which the branch or sub-office is located.

Chapter III. The European Patent Office

[Direction]

Article 10

(1) The European Patent Office shall be directed by the President who shall be responsible for its activities to the Administrative Council.

(2) To this end, the President shall have in particular the following functions and powers:

- (a) he shall take all necessary steps, including the adoption of internal administrative instructions and the publication of guidance

for the public, to ensure the functioning of the European Patent Office;

- (b) in so far as this Convention contains no provisions in this respect, he shall prescribe which transactions are to be carried out at the European Patent Office at Munich and its branch at The Hague respectively;
- (c) he may place before the Administrative Council any proposal for amending this Convention and any proposal for general regulations or decisions which come within the competence of the Administrative Council;
- (d) he shall prepare and implement the budget and any amending or supplementary budget;
- (e) he shall submit a management report to the Administrative Council each year;
- (f) he shall exercise supervisory authority over the personnel;
- (g) subject to the provisions of Article 11, he shall appoint and promote the employees;
- (h) he shall exercise disciplinary authority over the employees other than those referred to in Article 11, and may propose disciplinary action to the Administrative Council with regard to employees referred to in Article 11, paragraphs 2 and 3;
- (i) he may delegate his functions and powers.

(3) The President shall be assisted by a number of Vice-Presidents. If the President is absent or indisposed, one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Council.

1. Presidential directions (para. 2(a)). The President issues guidance to the EPO and the public alike through publishing Decisions of the President in the OJEPO. The EPO Guidelines is also a publication under the auspices of the President in accordance with para. 2(a).

2. Vice-Presidents (para. 3). Each of the five Directorates-General is headed by a Vice-President. The Directorates-General are usually referred to as DG1 to DG5. DG1 and DG2 are responsible for European patent applications up to grant and during opposition. Traditionally, DG1 was responsible for formalities upon filing and search, and DG2 was responsible for examination and opposition. This distinction has been removed following the EPO's bringing examination and search together (the 'BEST' programme: Bringing Examination and Search Together). DG3 comprises the Boards of Appeal, DG4 is responsible for general administration, staff matters, finance and patent information, and DG5 is responsible for legal matters and international affairs. The procedure allowing a Vice-President to deputize for the President was established by the Decision of the Administrative Council dated 6 July 1978, published OJEPO 1978, 326.

[Appointment of senior employees]

Article 11

(1) The President of the European Patent Office shall be appointed by decision of the Administrative Council.

(2) The Vice-Presidents shall be appointed by decision of the Administrative Council after the President has been consulted.

(3) The members, including the Chairmen, of the Boards of Appeal and of the Enlarged Board of Appeal shall be appointed by decision of the Administrative Council, taken on a proposal from the President of the European Patent Office. They may be re-appointed by decision of the Administrative Council after the President of the European Patent Office has been consulted.

(4) The Administrative Council shall exercise disciplinary authority over the employees referred to in paragraphs 1 to 3.

[Duties of office]

Article 12

The employees of the European Patent Office shall be bound, even after the termination of their employment, neither to disclose nor to make use of information which by its nature is a professional secret.

[Disputes between the Organisation and the employees of the European Patent Office]

Article 13

(1) Employees and former employees of the European Patent Office or their successors in title may apply to the Administrative Tribunal of the International Labour Organisation in the case of disputes with the European Patent Organisation in accordance with the Statute of the Tribunal and within the limits and subject to the conditions laid down in the Service Regulations for permanent employees or the Pension Scheme Regulations or arising from the conditions of employment of other employees.

(2) An appeal shall only be admissible if the person concerned has exhausted such other means of appeal as are available to him under the Service Regulations, the Pension Scheme Regulations or the conditions of employment, as the case may be.

[Languages of the European Patent Office]

Article 14

(1) The official languages of the European Patent Office shall be English, French and German. European patent applications must be filed in one of these languages.

(2) However, natural or legal persons having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad, may file European patent applications in an official language of that State. Nevertheless, a translation in one of the official languages of the European Patent Office must be filed within the time limit prescribed in the Implementing Regulations; throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the original text of the application.

(3) The official language of the European Patent Office in which the European patent application is filed or, in the case referred to in paragraph 2, that of the translation, shall be used as the language of the proceedings in all proceedings before the European Patent Office concerning the application or the resulting patent, unless otherwise provided in the Implementing Regulations.

(4) The persons referred to in paragraph 2 may also file documents which have to be filed within a time limit in an official language of the Contracting State concerned. They must however file a translation in the language of the proceedings within the time limit prescribed in the Implementing Regulations; in the cases provided for in the Implementing Regulations, they may file a translation in a different official language of the European Patent Office.

(5) If any document, other than those making up the European patent application, is not filed in the language prescribed by this Convention, or if any translation required by virtue of this Convention is not filed in due time, the document shall be deemed not to have been received.

(6) European patent applications shall be published in the language of the proceedings.

(7) The specifications of European patents shall be published in the language of the proceedings; they shall include a translation of the claims in the two other official languages of the European Patent Office.

(8) There shall be published in the three official languages of the European Patent Office:

- (a) the European Patent Bulletin;
- (b) the Official Journal of the European Patent Office.

(9) Entries in the Register of European Patents shall be made in the three official languages of the European Patent Office. In cases of doubt, the entry in the language of the proceedings shall be authentic.

1. General. Of all the articles in Part I of the EPC, this is by far the most significant for the patent practitioner. It sets out in general terms the language requirements of the EPO and so governs the languages that can be used when corresponding with the EPO. The available languages form two groups: the official languages of the EPO, English, French and German; and the 'admissible'

languages that may be used in certain circumstances. The admissible languages are any official language of a Contracting State.

2. Filing a patent application in an official language (para. 1). Para. 1 defines English, French and German to be the official languages of the EPO and allows patent applications to be filed in any one of these languages. The choice between official languages is at the option of the applicant, irrespective of his nationality or residence. Para. 1 requires a European patent application to be filed in 'one' of the official languages of the EPO and art. 80(d) requires the description and claims to be in one of the official languages in order for the application to be accorded a filing date. This is interpreted to mean that the language chosen for the description and claims must be the same (Case J18/96 *N.N.*).

3. Filing a patent application in an admissible language (para. 2). By way of alternative, para. 2 provides that persons, both natural and legal, may file a patent application in an admissible language, namely, an official language of a Contracting State, provided one of the following conditions is met: the person is resident or has their principal place of business in that Contracting State; or is a national of that Contracting State but resident abroad. **(a) 'Person'.** The 'person' who may file refers to the applicant and not to the professional representative (Case T149/85 *Bredero*). Although not expressly stated by the EPC, at least one authority believes that only one such applicant on any particular patent application need meet these requirements to make use of this article (*Müncher Gemeinschaftskommentar*). **(b) Principal place of business.** Para. 2 states that legal persons must have their 'principal' place of business in such a Contracting State. There is some controversy over the exact meaning of 'principal' place of business based on the exact equivalence or otherwise of the corresponding French and German texts, which refer to 'siège' and 'Sitz' respectively. This same anomaly is present in art. 133(2) where the requirements for representation are set out. **(c) List of admissible languages.** The EPO's publication 'National Law relating to the EPC' provides information on filing European patent applications at Table II. Column 4 of that table provides a list of admissible languages, being the official language(s) of each Contracting State. Some Contracting States have more than one official language, for example, Switzerland lists German, French and Italian. For these countries, any of the official languages of that State may be chosen. **(d) Sanction for non-compliance.** Although it was noted in Case J15/98 *Benas de Brigante, Norah Martha* that art. 80(d) contained no requirement of nationality or residence for a date of filing to be accorded, the EPO Guidelines at A-VIII, 3.1 suggest that the EPO is not following this decision, but is instead requiring that all conditions of para. 2 be met for a date of filing to be accorded under art. 80, in accordance with Case J9/01 *Safenat Panéach N.V.* This approach was confirmed in Case J6/05 *Uponor Innovation AB*.

4. Filing with national offices (para. 2). Generally, national offices acting as receiving offices for the EPO within the meaning of art. 75(1)(b) allow applications to be filed in any admissible language. Table II column 3 of the National Law