

E0302SN1.WP6

Explanatory remarks

1. **Article 7 of the Revision Act** contains transitional provisions for those provisions in the revised version of the EPC which concern European patent applications and European patents. Under Article 7(1), first sentence, the revised version applies to all European patent applications filed after its entry into force, and to all European patents granted in respect of such applications. It will not, however, apply to European patents already granted when it enters into force, or to European applications pending at that time, unless otherwise decided by the Administrative Council (Article 7(1), second sentence).

2. Article 7's transitional provisions do not apply to the revised text's purely organisational and institutional provisions (see point 16 below), whose applicability is governed by general principles of international treaty law, in particular that of "non-retroactivity" (see Article 28 Vienna Convention). This means they can apply only to measures taken after their entry into force. For provisions which apply provisionally under Article 6 of the Revision Act, the date of adopting the Revision Act, ie 29 November 2000, is decisive.

3. Transitional arrangements are basically unnecessary for the EPC provisions deleted by the Revision Act, as in accordance with general principles of law they no longer apply once the revised version enters into force.

4. The **Council decision of 28 June 2001** concerning Article 7(1), second sentence, Revision Act lays down special transitional arrangements extending the specified provisions to cover European patents and European patent applications already granted or still pending when the revised text enters into force.

5. **Article 1, point 1**, of the decision lists all the provisions concerning applications and patents which apply unreservedly also to patents granted, and applications pending, when they enter into force. These provisions are primarily substantive and procedural ones applied by the Office in the grant procedure.

6. As regards the substantive provisions, especially Articles 52, 53 and 54(3) and (4) EPC, the new wording does not change the current legal position. Article 52(1) EPC has been brought into line with Article 27(1), first sentence, of the TRIPs Agreement, clearly expressing in internationally binding terminology the long-standing principle of European patent law that patent protection is available only for creations in a technological field. Shifting the substance of existing Article 52(4) to Article 53(c) EPC is a purely editorial change.

7. The revised version of Article 53(a) EPC likewise simply brings it into line with Article 27(2) of the TRIPs Agreement and the relevant provisions of Directive 98/44/EC on the protection of biotechnological inventions; it leaves EPO practice unaffected.

8. Revised Article 54(3) and (4) EPC features purely editorial changes, and will therefore apply also to patents granted, and applications pending, when they enter into force. This does not, however, apply to the deletion of old Article 54(4) EPC, which means that every published European patent application, regardless of the designation situation, will in future be considered a prior application within the meaning of Article 54(3) EPC. That is why Article 1, point 1, of the Council decision expressly states that Article 54(4) of the old EPC continues to apply to patents granted, and applications pending, when revised Article 54 EPC enters into force.

9. The changes to Article 69 EPC are likewise purely clarificatory and editorial. The same is true of the addition made to the Protocol on the Interpretation of Article 69 EPC as part of the revision. In one form or another, patent practice in all the contracting states has long accepted that equivalents should be taken into account in determining the extent of protection of a European patent. The Protocol's new Article 2 neither gives a binding definition of equivalents nor specifies exactly how they are to be taken into account. The new provision is thus intended not to change the existing legal situation but to formalise the elements underlying it.

10. Point 1 also includes provisions - such as Articles 51, 88, 90, 92-94, 129 and 135 EPC - which are both institutional and application- or patent-related. Where, as in the case of Article 51(2) EPC concerning the fixing of time limits for paying fees, they allow for details to be laid down in the Implementing Regulations, the Administrative Council will have to adopt separate transitional provisions when exercising that power. To ensure that the future implementing provisions can apply to pending applications, provision has had to be made for this in the

revised EPC's enabling provisions too.

11. **Article 1, point 2**, of the decision lists the provisions applicable to patents already granted when they enter into force, and to patents granted in respect of applications pending at that time. They concern opposition, limitation and revocation proceedings.

12. **Article 1, point 3**, provides for new Article 54(5) EPC to apply to pending applications on which the grant decision (Article 97(2), Rule 51(11) EPC) is still outstanding when it enters into force. This will ensure that whilst the new provision cannot apply to finished cases, pending and subsequent applications will be able to benefit from purpose-related substance protection for further medical uses.

13. **Article 1, point 4**, provides that the new procedure for reviewing decisions of the boards of appeal applies to all decisions taken as from new Article 112a's entry into force, thus making it quite clear that it also covers decisions on patents granted or applications filed before that date.

14. **Article 1, point 5**, concerns the revised provisions on further processing and re-establishment of rights. These apply to patents granted and applications pending when they enter into force, provided the time limit for requesting the remedy in question is still running.

15. Under **Article 1, point 6**, revised Articles 150 to 153 EPC apply also to international applications pending when they enter into force. The new provisions replace old Articles 150 to 158 EPC, but involve no substantive changes. Deleted Articles 154(3) and 155(3) EPC will, however, continue to apply to international applications already pending, for which the EPO boards of appeal will thus remain responsible for deciding on any PCT protest.

Summary

16. The transitional arrangements under the revised Convention may thus be summarised as follows:

- Under Article 7(1), second sentence, Revision Act, and the Council decision, the provisions of the revised EPC listed in Article 1, points 1 to 6, of the decision will apply also to European

patents already granted, and to European and international applications pending, when they enter into force.

- Under Article 7(1), first sentence, Revision Act, Articles 14(1) and (2), 60, 75, 76, 77, 78, 79, 80 and 87 of the revised EPC will apply only to European patent applications filed after their entry into force.

- Special transitional arrangements are not necessary for the revised text's purely organisational and institutional provisions (see point 2 above), ie Articles 4a, 11, 16, 17, 18, 21, 22, 23, 33, 35, 37, 38, 42, 50, 130, 134, 134a, 140, 149a and 164 EPC, the new Protocol on the Staff Complement, and revised Section I of the Protocol on Centralisation. These will apply as from the revised text's entry into force, except that, under Article 6 Revision Act, Articles 16 to 18, 37, 38, 42 and 50 EPC, the Protocol on the Staff Complement and Section I of the Protocol on Centralisation apply provisionally as from 29 November 2000.

- The EPC provisions deleted by the Revision Act, notably Articles 91, 95, 96, 102, 126, 136, 154 to 163, and 167 EPC, will no longer apply once the revised text enters into force. This does not apply to Articles 54(4), 154(3) and 155(3) EPC (see points 8 and 15 above). Article 167(5) EPC remains unaffected.