Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Subject: Earlier National Applications and the EU Patent, proposal for a Council Regulation on the EU Patent

By: *epi*

To: European Commission, EU ES Presidency, EU BE Presidency, EPO

Summary: We consider that the present proposal for the EU Patent Regulation has an unsatisfactory provision for the clash between earlier national applications and EU patents. In the enclosed position paper we discuss possible solutions in the light of some examples.

Documents: Council Note 16113/09 ADD 1, 27 November 2009

Date: 21.06.2010

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epi Position

Earlier National Patent Applications and the EU Patent, 16113/09 ADD 1, Art. 13a and Art. 28, 27.11.2009

Request

epi considers that the present draft for the EU Patent Regulation (EUPR) has an unsatisfactory provision for the clash between earlier national applications (ENA)[1] and EU patents (Article 28, paragraph 1(f) of the draft EUPR).

We urge the Commission to look at the problem as a matter of urgency, and to amend the draft EUPR before the Council adopts its position to be sent to the European Parliament for discussion in second reading.

The Present Situation

The European Patent Office (EPO) cannot cite ENAs against EP[2] patent applications. Also, opponents cannot cite such ENAs in opposition proceedings against granted EP patents. This is made clear by implication in Article 54 (3) EPC, which indicates that only unpublished EP applications can be cited against pending or granted EP applications.

If an ENA is found by the applicant or the EPO prior to grant of an EP application, the applicant can voluntarily[3] file a set of claims to be used in the designated state in which the ENA was filed.

A third party can attack the validity of the granted EP Patent in the relevant designated state on the basis of the ENA. This may result in the revocation of the EP patent or the amendment of the claims in the EP patent, but only for the designated state in question.

Thus, at present, the existence of an ENA has an effect on an EP application or patent, but only in respect of the designated state in question.

The Problem

According to the present draft of the EUPR, an ENA would affect the validity of the EU Patent throughout the EU. Thus, rather than the patent being limited or revoked only in respect of a single member state, it would be limited or revoked in respect of all member states. It appears to *epi* that this gives an unfair advantage to enterprises which have deliberately chosen to operate in only one state. If such an enterprise has decided that its commercial interests are limited to only a single member state, it seems inequitable that it could interfere with the commercial activities of another enterprise on a pan-EU scale. This is worsened in that the ENA would have its effect even if does not lead to a patent itself.

1 An "earlier national application" is a patent or utility model application which contains subject matter relevant to the novelty of a claim in a European patent application or European patent provided that the relevant subject matter is entitled to a date earlier than the date to which the claim is entitled and the application was published on or after the date to which the claim is entitled.

2 "EP" indicates that the application was filed under the European Patent Convention (EPC), either directly at the EPO, or as PCT application that has subsequently entered the EP regional phase.

The Solution

We consider that there are several solutions to this problem:

Firstly, it could be solved by providing in the EUPR that, where an ENA would be relevant to the validity of an EU patent, the patentee can either indicate that the EU patent is not valid in the relevant member state or that the EU patent is valid in that member state only in respect of a limited set of claims[3].

An alternative solution, more in line with the unitary character of the EU patent, would be to allow the patentee to convert the EU patent to an EP bundle patent[3] and, if appropriate, provide an amended set of claims for validation in the relevant member state[4].

A third solution would be to provide that an ENA has no invalidating effect on a later EU patent (Article 28(1)(f) deleted). Instead, some form of prior use right in the relevant member state may be allowed to the owner of the ENA, or both rights could exist contemporaneously, requiring cross-licensing between the patent proprietors and two licences for third parties[5].

Kindly see attached Annex 1 for possible scenarios under the EPC.

3 This may be allowed within a certain period from a decision invalidating the EU patent on the basis of an ENA.
4 *epi* prefers the second solution (conversion to EP bundle) over the first (EU patent with exception) and third (no effect, possible prior use right).
5 The latter is a situation that existed not infrequently under the British Patents Act 1949, without great problems in practice.

Annex 1

Scenarios under the EPC

Basic facts for all scenarios

1st June, 2010	National German patent application filed. The German application discloses in the description a machine comprising components A, B and C.
1st July, 2010	UK National patent application filed. The UK application discloses in the description a machine comprising components A, B and D, but has claims to a machine comprising components A and B.
30th June, 2011	EP application, claiming priority from UK application, filed. The EP application is identical to the UK application.
1st December, 2011	German patent application published.

1st Possible Scenario

30th June, 2014	EP application granted with claims to a machine comprising components A and B.
30th June 2015	German national revocation action, based on the German national application, commenced against the national German part of the EP patent. Patentee amends the claims to claim a machine comprising components A, B and D. (All other national patents derived from the EP application remain unamended.)

2nd Possible Scenario

1st December, 2012	The attention of the EPO is drawn to the German national application. Applicant files a first set of claims for all states except Germany and a second set of claims for Germany. The claims for Germany relate to a machine comprising components A, B and D. The claims for all other states relate to a machine comprising components A and B.
30th June, 2014	EP application granted with the two sets of claims.
[30th June 2015	German national revocation action, based on the German national application, commenced against the national German part of the EP patent. Action is unsuccessful.]

3rd Possible Scenario

30th June, 2014	EP application granted with claims to a machine comprising components A and B.
30th March 2015	EP opposition, based only on the German national application, commenced against the EP patent. Opposition dismissed as inadmissible as there is no valid ground of opposition.

Scenario under the current draft EU Patent Regulation

30th June, 2014	EP application granted as an EU patent with claims to a machine comprising components A and B.
30th June 2015	EU revocation action, based on the German national application, commenced against the EU patent. Patentee amends the claims to claim a machine comprising components A, B and D. EU patent is therefore amended for all member states on the basis of a right which only extends to Germany (granted or not).