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Where is the EPC provision which would allegedly allow the EPO to "grant" a patent with a different text for Contracting States that entered reservations in accordance with Art. 167(2)(a)?

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Article 118 of the EPC (entitled "Unity of the European patent application or European patent") states that:

"*[…] the text of the application or patent shall be uniform for all designated Contracting States, unless this Convention provides otherwise.*"

Like other Articles such as Article 2.2, 14.3, 43.1, 130.1 or 148.1, Article 118 follows the logic consisting of setting out general principles which can only be abandoned ("carved out") if another provision of the Convention provides "otherwise." It is a technique widely used in all international treaties.

If the reader takes the time to carefully review the provisions of the EPC and its Implementing Regulations ("IR"), which according to Art. 164.1 form part of the EPC, the only provisions in which you will find carving out "otherwise" are Rules 18, 78.2 and 138, plus old Rule 87, which no longer apply to applications filed after the coming into force of EPC 2000 (13 December 2007). For the reader's benefit, it should be clarified that none of these Rules have anything to do with Reservations entered in accordance with Art. 167(2)(a).

According to the Guidelines for Examination in the EPO ("Guidelines"), Part H, Chapter III, paragraph 4, as an exception to the general rule imposed by Article 118, the European patent may contain different texts for different Contracting States. Interestingly, *all* the sections of paragraph 4 *except one* cite in the margin the provision of the EPC and/or Rule of the Implementing Regulations which allows the EPO to "grant" a European patent with different texts for different Contracting States. The *one* exception reads as follows:

"***4.4 Different text where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973***

Where a contracting State has entered reservations in accordance with Art. 167(2)(a) EPC 1973, patent application and patents seeking protection for chemical, pharmaceutical or food products as such may include different sets of claims for the State and for the other designated States respectively. Such reservations were made by Austria, Greece and Spain. Without prejudice to Art. 167(5) EPC 1973, the reservation for Austria ceased to have effect after 7 October 1987, those for Greece and Spain after 7

October 1992 (for Spain, see Notice from the EPO dated 18 June 2007, OJ EPO 2007, 439).

Normally, a common description should be sufficient for all sets of claims."

The Guidelines appear to assume that Art. 167(2)(a) would allow or entitle, that is, empower the EPO to "grant" a patent with a different text for those Contracting States that entered the Reservation. Let's revisit Art. 167(2)(a) to see if the Guidelines' assumption is correct:

"(2) Each Contracting State may reserve the right to provide that:

(a) European patents, in so far as they confer protection on chemical, pharmaceutical or food products, as such, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable; this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of a chemical product or a process of manufacture of a pharmaceutical or food product"

As readers will have noted: (i) the addressee of Art. 167 is not the EPO but any Contracting State; (ii) the power envisaged by this Article is not vested in the EPO but in the Contracting States.

Not only does Article 167 not empower the EPO to make an exception to Art. 118 but it is constructed on the premise that the European patent *must* have the same text in the Contracting State that entered the Reservation. Precisely because Art. 118 requires the European patent to have the same text except when Rules 18, 78.2 and 138, plus old Rule 87, apply, Article 167 empowers Contracting States that have entered the Reservation to establish that European patents, in so far as they confer protection on chemical, pharmaceutical or food products, as such, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable.

To give readers a feel of the confusion created by paragraph 4.4 of the Guidelines, it is worth noting that in its judgment of 10 January 2013 Barcelona Commercial Court number 4 wrote that:

"*41. It is true that the general rule is that the text of the claims shall be the same for all of the designated countries, but if Article 118 EPC itself provides for the possibility of the Treaty establishing otherwise, it is simply because the Convention itself admits the possibility of the text being different, which is in perfect keeping with the concept of European patent defended in this decision. No other rule is necessary, simply Article 118 itself admits that possibility. So much so that the EPO Guidelines for Examination (Guidelines for Examination in the European Patent Office, June 2012) provide for such option.*"

In our humble opinion, there is a high likelihood that if the Judge who wrote this judgment revisits the provisions of the EPC and the Implementing Regulations, he will feel the urgent need to review his views on this point. For if the last sentence of Art. 118 would really be a "catchall" clause empowering EPO Examiners to introduce any exceptions that they felt convenient (for example, to accommodate the interests of Contracting States that entered said Reservation), it would not have made sense for the drafters of the EPC and the Implementing Regulations to have had to tread carefully when drafting in said Rules the *only* exceptions that allow the EPO to deviate from the strict principle of Art. 118.

The Contracting States and the EPO are bound by the Rule of Law. Page 5 of the Guidelines warns the reader that "*the Guidelines do not constitute legal provisions*" and that for the ultimate authority on practice in the EPO it is necessary to refer to the text of the EPC and the Implementing Regulations.

If one follows the recipe on page 5, there can be no doubts whatsoever that neither the *text* of the EPC nor the *text* of the Implementing Regulations empowers the EPO to "grant" a patent with a different text as a consequence of said Reservation. Suggesting that the EPO would have done such a thing is suggesting that the EPO would have contravened the clear provisions of the EPC. A totally different question is that in order to reduce the workload of the national authorities of a Contracting State (Spain) that had entered such Reservation, in 1992 the Spanish Patent and Trademark Office reached a "de facto" agreement with the EPO according to which the latter would "strongly recommend" applicants to file a separate set of claims for Spain (Communication of 13 May 1992). But, for obvious reasons, in a system governed by the Rule of Law, the introduction of such a "de facto" measure could not – and did not – empower the EPO to "grant" a patent with a different text for the Contracting States that had entered said Reservation.

For the foregoing reasons, in this author's respectful opinion, the Barcelona Court of Appeal was absolutely right to conclude in its judgment of 2 October 2008 that stating that in such circumstances the EPO would have "granted" a patent with a different text for Spain does not find support in the text of the EPC.

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