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Will the New Year bring the rule of law to the EPO?

Miquel Montaña (Clifford Chance) · Wednesday, December 29th, 2021

According to article 1 of the European Patent Convention (EPC), “a system of law, common to Contracting States for the grant of patents for inventions is established by this Convention.”

So, at first glance, it would appear that the European Patent Organisation was meant to be an International Institution governed by the rule of law. In particular, by the text of the EPC and by the provisions of the Implementing Regulations which, according to article 164, form part of the EPC.

However, as is well known, over the years, the need to address practical matters has led the organs of the European Patent Organisation to use some instruments that have placed it at some distance from the rule of law.

One such instrument is the “Communications from the President of the European Patent Office (EPO). For example, on 13 May 1992, the President of the EPO, for the purpose of reducing the workload of the Spanish Patent Office, published a “Communication” “strongly encouraging” applicants, in the case of patents affected by Spain’s Reservation excluding the patentability of pharmaceutical products until 7 October 1992, to file a separate set of claims for Spain. Here we have an organ of the European Patent Organisation (the president of the EPO) prompting a result explicitly prohibited by article 118 of the EPC: the grant of a European patent with a text not identical for all Contracting States. Article 167 (Reservations) did not allow the EPC to deviate from that principle. What article 167 stated was that, if a European patent whose text had to be identical in all Contracting States (article 118) protected the chemical or pharmaceutical product as such, then that patent could be revoked or would have no effect in Spain. Readers will not find any article of the EPC stating that a European patent may have a non-identical text in the Contracting States that made a Reservation under article 167.

Another controversial instrument is the EPO Guidelines for Examination, which seek to serve as a guidance and a sort of ‘toolkit’ for Examiners. Fair enough. The problem is that, in practice, the Guidelines have introduced requirements for which sometimes it is difficult to find a legal basis in the text of the EPC. A recent example may be found in Decision T 1989/18 of 22 December 2021, where the Board of Appeal struggled to find a legal basis for the requirement for the description to be amended in line with the allowed claims (Guidelines for Examination, F-IV-4.4). In the end, it found none.

Taking into account that the EPO will be responsible for granting the forthcoming European patents with unitary effect, it is only natural to wonder whether, in view of this responsibility and

the fact that these patents will be scrutinized by the Unified Patent Court, the organs of the European Patent Organisation will go the extra mile to ensure the utmost respect for the rule of law.

Perhaps the New Year, which the author wishes will be full of health, good luck and prosperity for our readers, will bring us the answer.

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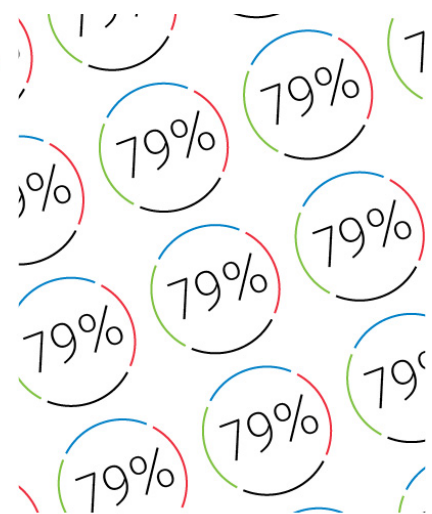
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