

**Update of the 19th edition of
the Annotated European Patent Convention
from 15-11-2011 till 31-12-2011**

I Amendments in view of OJ 11 and 12 of 2011 and the EPO website

Convention

Page 72, Art. 53(c) 3.3.1, insert the following paragraph after '(T74/93 r.2.2.4).':

'Recently, T1635/09 held that use of a composition as a contraceptive in which concentrations of substances were selected to avoid side effects is a medical method because such prevention is therapeutic; the use is therefore excluded from patentability (r.3.1). Note, that this reasoning makes a cosmetic use of any composition a therapeutic method because all cosmetic products try to prevent side effects. 'Avoidance' should not be regarded as 'prophylaxis', as prophylaxis is the preventive treatment of disease (Oxford English Dictionary) and 'avoidance of a side effect' is not a 'treatment of a side effect'.'

Page 110, Art. 56:4.2, add the following paragraph at the end of the section:

'Starting from an amorphous form of a pharmaceutically active compound as prior art, it is obvious to try a crystalline form of the same compound if there are no prejudices or unexpected properties, because the skilled person in the field of pharmaceutical drug development will screen for polymorphs (T777/08 hn).'

Page 172, Art. 83:3, add the following paragraph after the first paragraph: 'Time-consuming and ethically questionable tests, e.g. to establish whether a particular product has a claimed pharmaceutical effect, are unreasonable if the claim could have been defined by features making the tests superfluous; such a claim does not comply with Art.83 (T1635/09 r.7.3).'

Page 336, Art. 134a(1):2

First paragraph: change 'Suppl. OJ 3/2011 p.2' to 'Suppl. OJ 12/2011 p.2'

End of first paragraph: change 'Suppl. to OJ 3/2011 p.41' to 'Suppl. OJ 12/2011 p.41'.

End of second paragraph: change 'OJ 2009, 490' to 'OJ 2011, 584'.

End of last paragraph: change 'OJ 2010, 423' to 'OJ 2011, 591'.

Implementing Regulations

No amendments

Rules relating to fees

The increase in the amount of fees, published in OJ 2011, 616, is not included in this overview, as it enters into force on 01.04.2012 and the eqe is based on the law as valid on 31.12.2011.

Page 743, Rfees 11:2, insert the following paragraph after the second paragraph:

"The EPO will probably change its procedure under Rfees11, because a recent decision requires an examining division to provide the facts which demonstrate when the examination has begun, if it wants to refuse a request for a 75% refund (J25/10 hn). Up to now the primary examiner gave only an unsubstantiated assertion that he had started already."

II Corrections

Notes to the Patent Cooperation Treaty

Page 529, second paragraph, replace “Well before publication of the search report” by “A few days after publication of the search report”.

Page 805, section 5.5.1, replace last sentence second paragraph 'Given that ... his goal' by:

"Given that the EPO typically takes a few months for such publications and the EPO has not guaranteed it will publish a withdrawn application, if the applicant decides to withdraw the European application after having paid the filing fee to avoid payment of further fees, there may be no publication after the withdrawal and the applicant would not achieve his goal."