

# What is the term of a European patent?

The title of this article poses what appears to be a simple question but which, upon detailed analysis, is anything but.  
By **Mike Snodin** (Fellow) and **Jim Boff** (Fellow).

**D**ivergence in laws and/or practice on patent term amongst the Contracting States to the EPC (and, in particular, those Contracting States that have ratified, or that will ratify, the UPC Agreement) poses serious problems that, in the view of the authors, require urgent attention. It is therefore hoped that the arguments and explanations below will provide a spur to action for those national patent offices affected by this issue. For reasons given below, this is particularly important for the UK IPO.

## The European problem

### Background

Article 63(1) EPC defines the term of a European patent as:

“20 years from the date of filing of the application”.

All signatories to the European Patent Convention therefore have an obligation to afford European patents the term of protection specified in Article 63(1) EPC.

It is a reasonable assumption that the framers of the European Patent Convention intended there to be only one correct interpretation of “20 years from the date of filing”

However, the signatories to the EPC have applied no fewer than **three** different interpretations of Article 63(1) EPC in their collective national laws. This has been done either through the use of diverging statutory definitions (as in the UK) or diverging interpretations of the laws (e.g. as applied by the national courts).

The majority of EPC Contracting States (including Germany) have *excluded* the date of filing of the patent application from the calculation of patent term, thereby effectively viewing “from the date of filing” as meaning “from **the end of** the date of filing”.

On the other hand, a significant minority (including the UK and France) have *included* the date of filing of the patent application from the calculation of patent term, thereby effectively viewing “from the date of filing” as meaning “from **the beginning of** the date of filing”.

Finally, in a minority of one, Greece appears to calculate patent term from **the end of the day after** the date of filing.

This situation is clearly undesirable, not least because it means that a significant number of EPC Contracting States are in breach of an obligation to provide (in their national laws) the patent term stipulated in the EPC.

Nevertheless, despite hardly being a secret, this situation has persisted for many years (e.g. in the UK since the Patents Act 1977 came into operation).

### Urgent need for harmonisation

The EU Regulation implementing enhanced cooperation in the area of the creation of unitary patent protection (Regulation no. 1257/2012) has imparted a new urgency to the need to seek a harmonious interpretation of Article 63(1) EPC.

## EU referendum

This article was submitted before the referendum result to leave the EU. While the urgency for the UK to change the date of expiry may be reduced as there are significant questions about whether the Unitary Patent can still go ahead based upon the present wording of the UPC Agreement, non-compliance with the EPC still needs to be addressed.

Regulation no. 1257/2012 creates a **unitary** right, and a unitary right can clearly only have **one** expiry date that applies to all of the territories in which it has effect.

This principle is enshrined in Article 3(2) of Regulation no. 1257/2012, which states that a European patent having unitary effect (EPUE):

**“may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States”** [emphasis added].

If and when it becomes operational, the Unified Patent Court (UPC) will therefore need to reach a **single** interpretation of Article 63(1) EPC, which will conflict with at least one of the interpretations currently used in EPC Contracting States in which the EPUE will have effect.

A different (i.e. conflicting) interpretation of Article 63(1) EPC may not pose a particular problem for those EPC Contracting States (such as France) where, once ratified, international treaties (such as the EPC and TRIPS) have direct effect. This is because the courts in those Contracting States can simply apply an interpretation based upon the provisions of an international treaty, even if that interpretation conflicts with a plain reading of the provisions of national law.

However, there is a serious problem for those EPC Contracting States (such as the UK) where the courts are unable to apply the provisions of international treaties unless and until those provisions are formally incorporated by amendment of the relevant national law(s). For those EPC Contracting States there is therefore now a very significant risk that the term of protection awarded to EPUEs (e.g. by the UPC) will be contrary to national law.

Additionally, Article 2(2) and 64(1) of the EPC oblige Contracting States of that Convention to ensure that a European patent has the same effect (including conferring the same rights) as a national patent. Thus, whatever term derives from the correct interpretation of Article 63(1) EPC is also the term that EPC Contracting States are obliged to award to **national** patents, and not just European patents.

## The problem for the UK

### The legislation

Under Section 25(1) of the 1977 Act, a patent having effect in the UK:

“shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent”.

It is unclear why the legislator chose to employ wording that differs so significantly from that of Article 63(1) EPC. That choice is particularly unfortunate in the light of the

fact that a key difference in wording (“**beginning with** the date of filing the application” vs. “**from** the date of filing of the application”) appears to have been interpreted as ruling out the interpretation of Article 63(1) EPC adopted by the majority of EPC Contracting States, wherein the date of filing is excluded from the calculation of patent term.

It is noteworthy and amusing that the effect of including the date of filing of the application in the calculation of term, is that it is possible for a patent to have a term that includes a period before the application was filed (or even before the invention was made)<sup>1</sup>.

### The suggested correct interpretation of Article 63(1) EPC

There is **no explicit** indication in Article 63(1) EPC that the phrase “20 years **from** the date of filing of the application” means that the date of filing is **excluded** from the period of 20 years. However, there are numerous reasons why it can be concluded that this is precisely what was intended.

#### (i) Provisions of the EPC

Article 120 EPC states that:

“The Implementing Regulations shall specify:

- (a) the time limits which are to be observed in proceedings before the European Patent Office and are not fixed by this Convention;
- (b) the manner of computation of time limits and the conditions under which time limits may be extended...”

It is clear that paragraph (b) of Article 120 refers to both time limits specified in the Implementing Regulations **and** in the Convention. This is evident from fact that paragraph (b) refers to “time limits” in general, and not just the time limits mentioned in paragraph (a).

The “manner of computation” referred to in paragraph (b) of Article 120 is provided by way of Rules 131(2) and (3) EPC 2000, which correspond to Rules 83(2) and (3) EPC 1973 and which state that:

**“(2) Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the relevant event shall be the receipt of the document notified, unless otherwise provided.**

**(3) When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name**

1. Invention made at breakfast, application filed at teatime, patent term includes the whole day.

From the above arguments, it appears that the UK is, and always has been, in breach of the obligation to provide the patent term specified in Article 63(1) EPC.



**and on the day having the same number as the month and the day on which the said event occurred**, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month”. [emphasis added].

Whether or not it is accepted that the filing of a patent application counts as a “procedural step”, Rules 131(2) and (3) EPC 2000 together make it clear that periods specified in the Convention that run from the filing of a patent application (such as the period of 20 years specified in Article 63(1) of the Convention) must be calculated by **excluding** the date upon which the application was filed.

Use of this same “manner of computation” is also essential to ensure that Article 87 EPC is consistent with the Paris Convention. This is because Article 87(1) EPC does not stipulate the “manner of computation” of the period of priority but instead merely refers to:

“a right of priority during a period of twelve months from **the date of filing of the first application**” [emphasis added].

Given that the Paris Convention explicitly excludes the date of filing of a first application from the calculation of the period of priority (see below), Article 87(1) EPC is only consistent with the provisions of the Paris Convention if interpreted in the light of the principles of Rules 131(2) and (3) EPC 2000.

To interpret the same phrase “from the date of filing of the (first) application” differently in Article 87(1) EPC and Article 63(1) EPC requires some significant mental gymnastics and appears contrary to all logic.

This illustrates perfectly why the principles of Rules 131(2) and (3) EPC 2000 must also be taken into account when interpreting other periods specified in the EPC (including Article 63(1) EPC).

#### (ii) The Vienna and Paris Conventions

As the EPC is an international treaty, the terms of that Convention is normally interpreted in accordance with the rules of interpretation that are set out in the 1969 Vienna Convention on the Law of Treaties. Article 31(1) of the Vienna Convention states that:

“A treaty shall be interpreted in good faith **in accordance with the ordinary meaning to be given to the terms of the treaty in their context** and in the light of its object and purpose” [emphasis added].

With this in mind, it is important to determine whether there is an “ordinary meaning” that can be ascribed to the starting point for a calculation of a period that is set to run from a “trigger” date (such as a patent filing date).

As one of the longest-standing international conventions relating to intellectual property, the Paris Convention represents a particularly important source of such an “ordinary meaning”. This is because Article 4(C) of the Paris Convention stipulates that:

“(1) The periods of priority referred to above shall be twelve months for patents...

(2) These periods shall start **from the date of filing** of the first application; **the day of filing shall not be included in the period**” [emphasis added].

The second sub-clause of Article 4(C)(2) provides an unambiguous clarification of what is meant in the first sub-clause by “from the date of filing”. That is, it clarifies that the “ordinary meaning” of that phrase is “from **the end of** the date of filing”.

However, as will be evident from what follows, this is not the only reason for believing that this is the “ordinary meaning” of the crucial phrase in Article 63(1) EPC.

### (iii) Regulation no. 1182/71 (Euratom)

Regulation (EEC, Euratom) no. 1182/71 entered into force on 1 July 1971 and sets out how the rules applicable to periods, dates and time limits are determined under Community law.

Whilst the EPC is not Community law, all but one of the original Contracting States to that Convention were members of the European Economic Community at the time that the EPC was originally drafted. Thus, Regulation no. 1182/71 is highly pertinent to the interpretation of the EPC, as it contains a set rules under which the authors of the EPC will have been accustomed to operating.

Regulation no. 1182/71 contains different rules for calculating deadlines, dependent upon the manner in which the deadline in question is set (and for which purpose). The only provision of Regulation no. 1182/71 that is relevant to periods (such as that set in Article 63(1) EPC) that are applicable to multiple parties and that are set by reference to a particular “trigger” event (which event can occur on any date) is Article 3(1). Amongst other things, that Article states the following:

“Where a period, expressed in days, weeks, months or years is to be calculated from the moment at which an event occurs or an action takes place, **the day during which that event occurs or that action takes place shall not be considered as falling within the period in question**”.

### (iv) Customary practice

In addition to the period of priority, there are numerous instances where the customary practice of many patent offices (including the EPO and the national offices of the original Contracting States to the EPC) is, and was also at the time of

the inception of the EPC, to exclude the date of a “trigger” event from the calculation of a period running from that event. Particular examples of that practise may be found, for example, in:

- determination of response deadlines (where response periods set in months always expire on a day having the same number as the date of the “trigger” event – with the only exception being if there is no such day in the month); and
- determination of the national / regional phase filing deadlines for PCT applications.

The above-mentioned, customary practice is therefore yet another reason to conclude that the “ordinary meaning” of the term specified in Article 63(1) EPC is “20 years from **the end of** the date of filing of the application”.

### (iv) Plain language

The word “from” implies from the nearest point. Just as if asked to measure the distance “from” a wall one does not include the thickness of the wall, when one is asked to determine a distance “from” a date one does not include the date.

In addition, to say a patent has a 20-year term and to include the date of filing means that patents will automatically have less than a 20-year term (because no one seriously can argue that the patent term includes a period before the application was filed, or invention made).

### The consequences of inaction for the UK

From the above arguments, it appears that the UK is, and always has been, in breach of the obligation to provide the patent term specified in Article 63(1) EPC.

Up to date, the UK has suffered no adverse consequences from this breach of its obligations. However, especially if the UPC Agreement comes into force, this situation is very likely to change.

### (I) Judgments of the UPC

According to “Brussels II” (Regulation 1215/2012, as amended by Regulation 542/2014), the UK will be obliged to both recognise and enforce judgments of the UPC. In particular, the provisions of Article 39 of Regulation 1215/2012 will have the consequence that judgments of the UPC “shall be enforceable ... without any declaration of enforceability being required”.

In the light of the above arguments, it appears inevitable that the UPC will issue judgments that conflict with the UK’s interpretation of Article 63(1) EPC. Therefore, the courts in the UK will be obliged to enforce judgments of the UPC that may well be inconsistent with, or even have no basis under, UK patent law as it currently stands. Such a situation would be



clearly unacceptable and could undermine the legitimacy of the UPC.

On the other hand, with the UK courts having no basis other than section 25 of the 1977 Act for the determination of patent term, it is also likely that failure to amend that section before the UPC comes into operation could, for European “bundle” patents during the transitional period of Article 83(1) of the UPC Agreement, lead to the UK courts issuing judgments that are inconsistent with judgments of the UPC.

A system in which the term of protection depends upon the court one is going to is not a sound system. Politically, having the UPC say a patent is in force in the UK on a day when the UK courts would say it is not in force would be, to put it mildly, very embarrassing.

## (II) Obligations under TRIPS

Even in the absence of the UPC, there are strong grounds for harmonising patent term in the UK with the correct interpretation of Article 63(1) EPC. This is because the above arguments in connection with that correct interpretation apply equally to the “ordinary meaning” of the phrase “twenty years counted from the filing date” in Article 33 of the TRIPS Agreement.

The inevitable conclusion stemming from this is that the UK is currently in breach of its obligations under the TRIPS Agreement, and hence is at risk of having its patent law challenged in a dispute at the WTO.

## Summary

For the reasons outlined above, it is clear that the law on patent term in the UK appears in breach of obligations under at least two international treaties. It is also equally clear that there are likely to be unpleasant, and potentially very serious consequences if the UK does not resolve this issue as a matter of urgency.

Primary legislation is not required for the UK to come into compliance with its international obligations.

Section 25(1) of the 1977 Patents Act reads in full:

“A patent granted under this Act shall be treated for the purposes of the following provisions of this Act as having been granted, and shall take effect, on the date on which notice of its grant is published in the journal and, subject to subsection (3) below, shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent **or with such other date as may be prescribed.**”

The view of the authors is therefore that the power wisely granted by section 25(1) of the 1977 Act to prescribe a different term should be used so that the UK term is compliant with Article 63(1) EPC (and TRIPS Article 33).

It would be necessary to make this amendment effective retroactively (due, for example, to TRIPS obligations, as well as the retroactive effect of the provisions of the UPC Agreement). As this could have other implications that would need to be taken into account (e.g. possible recalculation of the duration of all existing SPCs), it is clear that it would be better if preparations to make the amendment were commenced sooner rather than later. **D**

**Mike Snodin** is a member of CIPA Life Sciences Committee and is the founder and director of Park Grove IP. **Jim Boff** is a member of CIPA Patents Committee and partner in Phillips & Leigh. The views expressed in this article are the personal views of the authors. Emails: [mike.snodin@parkgrove-ip.com](mailto:mike.snodin@parkgrove-ip.com); [jim.boff@PandL.com](mailto:jim.boff@PandL.com)

