

BR/GT I/24 e/69

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Comment:

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INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 20 November 1969
BR/GT I/24/69

- Secretariat -

NOTE

The members of Working Party I will find annexed the proposals put forward by the Netherlands delegation for Articles 15 and 16, Chapter V, and Article 78 of the Preliminary Draft Convention for a European System for the Grant of Patents, as agreed at the meetings of Working Party I on 8 to 11 July and 14 to 17 October 1969.

BR/GT I/24 e/69 kel/PA/mk

PROPOSALS SUBMITTED TO THE WORKING PARTY
BY THE NETHERLANDS DELEGATION

Article 15

1. The right to a European patent shall belong to the inventor or his assignee. If the inventor is a person employed by a business enterprise, an institution or a public authority and if the national law applicable to the contract of employment grants the right to the patent to his employer in such a case, the right to the European patent shall belong to the latter. If several persons have made an invention independently of each other, the right to the European patent shall belong to the first person to file a patent application with the European Patent Office.
2. For the purposes of proceedings before the European Patent Office, the person making the patent application shall be deemed to be entitled to exercise the right referred to in paragraph 1.

Observations :

At its meeting of 8 to 11 July 1969, the Working Party decided that the question of entitlement to the grant of a European patent should be determined on the basis of a specific legislation, i.e. by the national law governing the invention. In this way, the national law would be decisive,

not only as regards the relations between employer and employee, but also as regards the other aspects contained in the previous Article 15.

The solution chosen calls for two remarks :

Firstly, it is extremely difficult to determine which is the law governing the invention. An invention is not situated in any particular place. It becomes apparent on the filing of an application for a patent. If this application is for a European patent, no national law applies. Secondly, even if it were possible to find a more satisfactory formula for determining which national law is applicable, each country would nevertheless be submitting to a foreign legislation, either that of another Contracting State or that of a non-Contracting State. In that case, why not choose the first solution, whereby the right to the patent is determined, as far as possible, by the Convention itself ?

For this reason the Netherlands delegation, instructed by the Working Party to study the question and to formulate suggestions, has taken the framework of the Chairman's proposal and of the 1965 Draft, with Article 15 containing two uniform rules (the right to the patent belongs to the inventor or his assignee ; should there be more than one inventor, the right to the patent belongs to the first applicant) and a reference to national law (relations between employer and employee). The last point is more explicit than in the Chairman's proposal and the

1965 Draft, the other two points remaining unchanged. In the new proposal, the reference to national law is more specific : it is the law governing contracts of employment. In most cases, where the parties to the contract have the same nationality and where the work is done in their own country this will not cause any difficulty to the courts. In other cases, judgement will have to be given in accordance with the rules of the relevant international private law. Difficulties may arise, but they will not be insurmountable.

Article 16

1. - deleted -

2. - deleted -

3. If a final decision has been given which recognises that a person referred to in Article 15, paragraph 1, other than the applicant, is entitled to the European patent, that person may, provided that the European patent has not yet been granted, file a new application in respect of the same invention within a period of three months following the final decision. In so far as the subject matter of the new application does not go beyond the description given in the original application, the new patent application shall be deemed to have been filed on the date of the earlier application and shall enjoy the right of priority where applicable. The original application for a European patent shall be deemed to be withdrawn once the new application has been filed.

4. - deleted -

Observations :

In the new proposal, Article 16, paragraph 3, provides that the only decisions giving a right to file a new application shall be decisions recognising that a person referred to in Article 15, paragraph 1, other than the applicant, is entitled to the European patent. The Netherlands delegation has tried in this way to introduce a maximum of unification, through which maximum legal guarantees can be obtained. For the same reasons, the proposal deletes paragraph 4 of Article 16. Paragraph 4 was added by the Drafting Committee and served to maintain the applicability of national law after grant of the patent. The retention of such a ruling could make the European patent, which is subject after grant to the same treatment as national patents in each country, subject to litigation as regards the right to the patent under national law. The Netherlands delegation expresses strong reserves in respect of such a situation. It wishes to point out, for the sake of completeness, that Article 16, paragraph 3, does not limit the countries where a decision may be obtained. Thus a decision given in a highly under-developed country may influence the effects referred to in that paragraph. The situation seems highly hypothetical, and, moreover, it seems almost impossible to find a satisfactory solution to this end.

(Chapter V)

Article 24a

1. A European patent application may be assigned and may be the subject of special rights for all the designated

States or for one or more of these States.

2. Assignment for one or some only of the designated States shall not lead to the division of the application in proceedings before the European Patent Office. For the purpose of such proceedings, the applicant and the assignee for one or some only of the designated States shall be deemed to be entitled jointly to exercise the right referred to in Article 15, paragraph 1.

Article 26

Repeat the Chairman's proposal, but in the first sentence of paragraph 3, after "other mortgages", insert the words "covering the same designated State". Make the same insertion in the second sentence, after "a particular mortgage".

Article 27

(Repeat the Chairman's proposal)

Article 28

Repeat the Chairman's proposal, but insert the words "covering the same designated State" after "pertaining to that European patent application" in paragraph 6.

Observations :

The Working Party recognised the usefulness of being able to assign a European patent application for part only

of the designated States. In its deliberations, the Working Party took account of the fact that, by virtue of Article 11, paragraph 3, the inventor may, before filing his application, assign his rights for certain States to a third person, who may then file a corresponding application valid for these States.

The Netherlands delegation was instructed to prepare a text allowing for the partial assignment of a European patent application, while at the same time preserving the unity of the application before the European Patent Office, for obvious reasons. The text proposed for Article 24a is given above.

The preservation of the unity of the European patent application raises the question of the rights of the applicant before the European Patent Office. Two solutions can be envisaged here. One would retain the rights of the original applicant, which has the advantage of simplicity but the disadvantage that the rights of the assignee are neglected. The second solution consists in regarding the original applicant and the assignee as co-proprietors for the purposes of proceedings before the European Patent Office. Their relation as regards these proceedings will then, at their own risk, be determined in accordance with the rules governing the case of more than one applicant. The Netherlands delegation has adopted this solution, which seems more equitable without being over-complicated.

In principle, Articles 24 to 30 will not be affected by the proposed amendment of Article 24a, save for a few obvious amendments, which are given above.

Following the amendment of Article 24a, it should further be stipulated in the Article on the grant of the European patent that, in the case of a partial assignment, the patent will be granted to separate persons for the various designated States concerned. The Netherlands delegation has not submitted a text for the Article in question, which has not yet been studied by the Working Party. Should the Working Party adopt the text of Article 24a this could be left to the Drafting Committee.

Article 78

(2b) If, when filing the European patent application, the applicant states that the International Patent Institute has drawn up a report on the state of the art on the basis of a national patent application for the same invention, part of the fee prescribed by the Rules relating to fees, paid pursuant to paragraph 1, shall be repaid to him, in so far as the report referred to in paragraph 2 is drawn up on the basis of the information contained in the report relating to the national application.

Observations :

The Netherlands delegation was instructed to propose a text to cover the case of a report on the state of the art having been obtained from the International Patent Institute prior to the filing of the European patent application. The text is given above.
