

BR/GT I/44 e/70

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Comment:

The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness.

The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.

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

Brussels, 20 May 1970
BR/GT I/44/70

- Secretariat -

Working Document
for Draft Implementing Regulations
to the Convention establishing a European System for the Grant of Patents
put forward by the Chairman of the
"Implementing Regulations" sub-Committee of Working Party I
compared synoptically with
the Preliminary Draft Implementing Regulations to the Convention relating to
a European Patent Law, as drafted by the EEC "Patents" Working Party
(unpublished working document 4419/IV/63 of 20 January 1964).

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Introductory Note

1. The proposals set forth in this document are closely based upon the provisions of the Preliminary Draft Implementing Regulations to the Convention relating to a European Patent Law, drawn up by the EEC Working Party on "Patents" (working document 4419/IV/63 of 20 January 1964 unpublished).
2. As in the above-mentioned Preliminary Draft Regulations, the draft articles submitted hereinafter are designated by reference to the articles of the First Preliminary Draft Convention, for which they lay down the terms and conditions of implementation. Consequently the order of these proposals follows that of the Articles of the Convention and should only be regarded as provisional.
3. The proposals are submitted on the right-hand pages of this document, opposite the corresponding provisions of the Preliminary Draft Regulations drawn up in 1964, which are set out on the left-hand pages, except of course in the case of completely new proposals.
4. Finally, as agreed by Working Party I when drawing up the First Preliminary Draft Convention, the question of whether a number of the proposals set out in this document should be incorporated in the Convention will be examined at a later stage.

KEY

1962 Draft	indicates the Draft Convention relating to a European Patent Law drawn up by the EEC "Patents" Working Party and published in 1962.
1965 Draft	indicates the 1962 Draft, updated to take into account the amendments contained in the EEC "Patents" Working Party's working document 2335/W/65 of 22 January 1965.
First Preliminary Draft	indicates the First Preliminary Draft of a Convention establishing a European system for the Grant of Patents, published in 1970 by decision of the Inter-governmental Conference for the setting up of a European system for the Grant of Patents.
Reports	indicates the reports by the Working Party I delegations on the provisions of the First Preliminary Draft, submitted at the 2nd meeting of the Inter-governmental Conference on 13 to 16 January 1970 and published in 1970.
Minutes of the 2nd Meeting	indicates the minutes of the 2nd meeting of the Inter-governmental Conference (working document BR/26/70 of 30 January 1970, unpublished).
1964 Draft	indicates the Preliminary Draft Implementing Regulations to the Convention relating to a European Patent Law, as drafted by the EEC "Patents" Working Party (working document 4419/IV/63 of 20 January 1964, unpublished).

- + on the right-hand page indicates that the text on the left-hand page is adopted without amendment.
- under the text on the left-hand page indicates that the text thus underlined has been deleted on the right-hand page.
- under the text on the right-hand page indicates that the text thus underlined is new, in relation to the 1964 Draft. Completely new paragraphs are not, however, underlined.

Patent classification in use by the European Patent Office

Proposal

The patent classification in use by the European Patent Office shall be the "international classification" referred to in Article 1 of the European Convention on the International Classification of Patents for Invention of 19 December 1954.

Notes:

1. This provision was previously contained in Article 62 of the 1962/1965 Draft. The Conference decided to incorporate it in the Implementing Regulations: see Note 1, Chapter IV, preceding Article 59 (former Article 60) of the First Preliminary Draft; Reports, point 67.
2. This provision is only attached to Article of the First Preliminary Draft for the reco

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Disclosure of the invention at an international exhibition

Proposal

(1) The exhibitor's right defined in Article 12(b) of the Convention shall, on pain of forfeiture, be claimed and justified at the time of filing of the application for a European patent.

(2) The justification of the exhibitor's right shall be submitted in the form of a certificate issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, stating that the invention was in fact exhibited there. This certificate must be accompanied by a description of the invention, duly authenticated by the above-mentioned authority.

Re. Article 16

Number 1

Suspension of proceedings for confirmation
of the provisional European patent

1964 Draft

(1) In the event of proof being provided to the European Patent Office that an action has been brought under Article 16, paragraph 1, of the Convention, the Office shall stay the proceedings for confirmation of the provisional European patent, unless the person having brought the action consents to their continuation. Such consent must be notified in writing to the European Patent Office; it shall be irrevocable.

(2) Proceedings for confirmation of the provisional European patent shall be resumed with the proprietor of the patent recorded in the Register of European Patents, when proof is provided to the European Patent Office that a final decision has been given. However, if the decision is in favour of the person who has brought the action, the proceedings shall not be resumed before the expiry of a suitable period which may not be less than the period laid down in Article 16, paragraph 3, of the Convention.

Suspension of proceedings for grantProposal

(1) In the event of a request for examination being made pursuant to Article 88 of the Convention, and of proof being provided to the European Patent Office that proceedings have been opened, for the purpose of establishing that a person referred to in Article 15, paragraph 1, of the Convention, other than the applicant, is entitled to the European patent the Office shall stay the proceedings for grant, unless the person who opened the proceedings concerning entitlement to the European patent consents to their continuation. Such consent must be notified in writing to the European Patent Office; it shall be irrevocable

(2) When proof is provided to the European Patent Office that a final decision has been given in the proceedings concerning entitlement to the European patent, proceedings for grant shall be resumed with the person in favour of whom the decision was given. If the decision is in favour of the person who claimed to be entitled to the European patent, proceedings for grant shall not be resumed before the expiry of a suitable period which may not be less than the period laid down in Article 16, first sentence, of the Convention.

Notes:

1. It will be necessary to study whether, under the law of the States taking part in the Inter-governmental Conference, the proceedings referred to in paragraph 1, first sentence and in paragraph 2, second sentence, might not be an administrative procedure (see Reports, point 30, paragraph 1 : "by a competent authority"). If it is not, the concept of "opening of proceedings" might be replaced by "bringing of an action".
2. Provisions similar to those of this Article should be adopted in the event of proceedings concerning entitlement to the European patent being opened or of a decision being given during the opposition period or at a time when the examination of an opposition has not yet given rise to a final decision by the European Patent Office (Reports, point 30, paragraph 1). The drafting of such a provision presupposes the prior amendment of Article 16 of the First Preliminary Draft.

Re. Article 16

Number 2

Limitation of the option to withdraw
the application for a European patent
or to surrender the provisional European patent

1964 Draft

(1) As from the receipt by the European Patent Office of evidence that an action has been brought under Article 16, paragraph 1, of the Convention, and until the expiry of the period laid down in paragraph 3 of the said Article, the application for a European patent may not be withdrawn nor may the provisional European patent be surrendered, save with the consent of the person who has brought the action.

Limitation of the option to withdraw the application for a European patent

Proposal

(1) As from the receipt by the European Patent Office of evidence that proceedings have been opened under Article ... (Re. Article 16, number 1) and until the expiry of the period laid down in Article 16, first sentence, of the Convention, the application for a European patent may not be withdrawn, save with the consent of the person who has opened the said proceedings.

Note:

See Note 2 on Article 16, number 1.

Mention of the inventor

1964 Draft

(1) The inventor may only be designated before the European Patent Office by the applicant for or the proprietor of a European patent. Such designation may be effected even after the patent has lapsed.

(2) The designation must be submitted in writing and under separate cover. It must state the name, forenames and full address of the inventor.

(3) The European Patent Office shall not verify the accuracy of the designation of the inventor.

Mention of the inventor

Proposal

(1) The inventor may only be designated before the European Patent Office by the applicant for the European patent. Such designation may be effected at any time prior to the payment of the fees provided for in Article 79, paragraph 1, of the Convention.

(2) +

(3) +

Notes:

1. Article 17 of the First Preliminary Draft makes provision for the exercise of the right to be designated as inventor only vis-à-vis the applicant for a European patent, as against the 1962/1965 Drafts which provided for the exercise of this right vis-à-vis the proprietor of the European patent.
2. It will be necessary to study whether the inventor may be designated before the European Patent Office during the opposition period or at a time when the examination of an opposition has not yet given rise to a final decision. The drafting of a provision to this effect presupposes a prior amendment to Article 17 of the First Preliminary Draft.

Publication of the mention of the inventor

1964 Draft

(1) Subject to the provisions of paragraphs 2 to 4 of this Article, the person designated as inventor shall be mentioned as such in the Register of European Patents, in the publication of the grant of a provisional European patent and in that of its confirmation as a final European patent as well as in the printed European patent specifications.

(2) In the event of it no longer being possible, when the inventor is designated, to apply the provisions of paragraph 1 in full, the inventor shall be mentioned in the European Patent Bulletin and, if the proprietor of the patent so requests, in the printed patent specifications not yet distributed. Such request shall not be deemed to have been lodged until the fee prescribed by the Rules relating to fees adopted pursuant to this Convention has been paid.

Publication of the mention of the inventor

Proposal

(1) Subject to the provisions of paragraphs 2 to 4 of this Article, the person designated as inventor shall be mentioned as such in the Register of European Patents, in the publication of the European patent application and in that of the grant of the European patent as well as in the printed specifications of the published European patent application or of the European patent.

(2) In the event of it no longer being possible, when the inventor is designated, to apply the provisions of paragraph 1 in full, the inventor shall be mentioned in the European Patent Bulletin and, if the applicant for the European patent so requests, in the printed specifications of the European patent application not yet distributed. Such request shall not be deemed to have been lodged until the fee prescribed by the Rules relating to fees adopted pursuant to this Convention has been paid.

Notes:

1. Article 98 (1) of the First Preliminary Draft lays down that the European Patent Office is to publish a specification of the European patent, while Article 85 of this Preliminary Draft does not specify the form in which the publication of the European patent application is to be made. Nevertheless, paragraph 1 of the present Article mentions "printed specifications of the European patent application". It will therefore be necessary to examine whether this expression corresponds to the form in which European patent applications will be published and, if it does, whether Article 85 of the First Preliminary Draft should be amended.

Re. Article 17, Number 2, (page 2)

1964 Draft

(3) In the event of a third party notifying the European Patent Office of a final decision whereby the applicant for or the proprietor of a European patent is required to designate him as the inventor, the provisions of paragraphs 1 and 2 shall apply. However, in the case referred to in paragraph 2, the third party may also ask to be mentioned on the printed patent specifications not yet distributed.

(4) The measures provided for in paragraphs 1 and 2 shall not be applicable where the inventor designated by the applicant for or the proprietor of a European patent addresses to the European Patent Office a written renunciation of his title as inventor.

Proposal

(3) In the event of a third party notifying the European Patent Office of a final decision whereby the applicant for a European patent is required to designate him as the inventor, the provisions of paragraphs 1 and 2 shall apply. However, in the case referred to in paragraph 2, the third party may also ask to be mentioned on the printed specifications of the European patent application not yet distributed.

(4) The measures provided for in paragraphs 1 and 2 shall not be applicable where the inventor designated by the applicant for a European patent addresses to the European Patent Office a written renunciation of his title as inventor.

(2) It will be advisable to examine whether, in the French text of paragraph (3) of this Article, the expression "jugement passé en force de chose jugée" should not be replaced by "décision définitive" as in paragraph 2, Re. Article 16, number 1, for the same reasons.

Re. Article 17

Number 3

Rectification or cancellation of the designation of an inventor

1964 Draft

(1) An incorrect designation of an inventor may not be rectified or annulled save upon request accompanied by the consent of the wrongly designated person and, in the event of such request not being submitted by the applicant for or proprietor of the European patent, by the consent of the latter. In the absence of such consent, the claimant may produce a final decision. A request for rectification or annulment shall not be deemed to be made until such time as the fee prescribed by the Rules relating to fees adopted pursuant to the Convention has been paid.

(2) In the event of an incorrect mention of the inventor having been entered in the Register of European Patents or published in the European Patent Bulletin, such entry or such publication shall be rectified. The mention of an incorrect designation of the inventor shall be rectified on all printed patent specifications not yet distributed. This provision shall apply to ~~the~~ annulment of an incorrect designation of the inventor.

Rectification or cancellation of the designation of an inventor

Proposal

(1) An incorrect designation of an inventor may not be rectified or annulled save upon request accompanied by the consent of the wrongly designated person and, in the event of such request not being submitted by the applicant for a European patent, by the consent of the latter. In the absence of such consent, the claimant may produce a final decision. A request for rectification or annulment shall not be deemed to be made until such time as the fee prescribed by the Rules relating to fees adopted pursuant to the Convention has been paid.

(2) In the event of an incorrect mention of the inventor having been entered in the Register of European Patents or published in the European Patent Bulletin, such entry or such publication shall be rectified. The mention of an incorrect designation of the inventor shall be rectified on all specifications of the European patent application not yet distributed. This provision shall apply to the annulment of an incorrect designation of the inventor.

Notes:

1. The question arises as to whether the fee prescribed in the third sentence of paragraph 1 is justified, since a request for the designation of an inventor is not in itself subject to the payment of a fee.
2. With regard to the expression "jugement passé en force de chose jugée" in the French text of this Article, see Note 2 Re. Article 17, number 2.

Re. Article 17

Number 4

Responsibility as regards the designation
of the inventor

1964 Draft

Requests for the designation of the inventor and for the rectification or annulment of an incorrect designation of the inventor shall, pending publication of the provisional European patent, come under the responsibility of the Examining Sections. Such requests shall, during proceedings for the confirmation of the provisional European patent, come under the responsibility of the Examining Divisions and, in other cases, under that of the Patent Administration Divisions.

Responsibility as regards the designation of the inventor

Proposal

Requests for the designation of the inventor and for the rectification or annulment of an incorrect designation of the inventor shall come under the responsibility of the Examining Sections, until such time as a request for examination has been made in accordance with the provisions of Article 88 of the Convention, or the report on the state of the art has reached the European Patent Office. Such requests shall, subsequently, come under the responsibility of the Examining Divisions.

Note:

See Article 54 of the First Preliminary Draft.

Re. Article 24

Number 1

Application for a European patent of addition

1964 Draft

A European patent application which was not designated as an application for a patent of addition at the time of filing may not be converted into an application for a patent of addition.

Re. Article 21
(former Article 24)

Number 1

Conversion of an application for a parent patent into
an application for a European patent of addition

Proposal

+

Re. Article 24

Number 2

Attachment of a patent of addition to the parent patent

1964 Draft

A European patent of addition may only be attached to one single European parent patent; it may not be attached to a patent of addition.

Re. Article 21
(former Article 24)

Number 2

Attachment of a European patent of addition to the parent patent

Proposal

+

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Re. Article 21

Number 3 (new)

Grant of a patent of addition where the parent patent
has been assigned to different persons in different countries

Proposal

Note:

Provisions will have to be drafted at a later stage to meet the situation envisaged in the Note on Article 21 (3) of the First Preliminary Draft.

Procedure in the event of a European patent application being
assigned to different persons in different countries

Proposal

Note:

It might be advisable to examine whether, in the case mentioned above, it would be useful or necessary to adopt implementing procedures for this provision whereby the proprietors of rights in the various States would be considered as joint applicants for the purposes of proceedings for grant.

Re. Article 25

Number 3

Examination of a request for the recording of an assignment

1964 Draft

A request for the recording of an assignment in the Register of European Patents may be rejected only in the event of failure to comply with the conditions laid down in Article 25, paragraphs 2 and 3. The European Patent Office may, however, check upon the validity of an assignment and may, where appropriate, communicate for purposes of information to the party submitting a request for recording in the Register of European Patents, such grounds as it may have noted for the invalidity of the assignment.

Re. Article 23
(former Article 25)
Number 1

Examination of a request for the recording of an assignment

Proposal

+ in Article 23, paragraphs 1 and 2 of the Convention...

Number 1

Recording and cancellation of an entry concerning the
grant or assignment of a licence

1964 Draft

The provisions of Articles ... (re. Article 25, number 2 and
re. Article 26, number 2) shall apply to the recording and to
the cancellation of an entry in the Register of European Patents
concerning the grant or assignment of a licence in respect of
a European patent.

Recording and cancellation of an entry concerning the
grant or assignment of a licence

Proposal

The provisions of Articles ... (Re. Article 23, number 1, Re. Article 24, number ...,) shall apply to the recording and to the cancellation of an entry in the Register of European Patents concerning the grant or assignment of a licence in respect of a European patent application.

Notes :

(1) The number referred to as Re. Article 24, number ... corresponds to Re. Article 26, number 2 of the 1964 Draft which was worded as follows :

The entry in the Register of European Patents of a mortgage of a European patent may be cancelled only upon request supported either by documents establishing that the mortgage has lapsed, or by a declaration whereby the mortgagee consents to the cancellation of the entry. A request for the cancellation of an entry shall not be considered as made until the fee prescribed by the Rules relating to fees adopted pursuant to this Convention has been paid.

Since the question of whether provisions on the mortgaging of a European patent should be included in the Convention has not yet been tackled, it will, if the

Proposal

reply is in the negative, be expedient to incorporate the above-mentioned provisions into this Number, adapting them to the case of licensing.

- (2) When, at a later date, a study is made of which Convention provisions are to be incorporated into the Implementing Regulations and vice versa, account will have to be taken of the fact that the fee payable in respect of the request for the recording of an entry concerning the grant or assignment of a licence is provided for in the First Preliminary Draft, (Article 28 (2) which refers to Article 23 (2), second sentence), while provision is made in the Implementing Regulations for the fee payable in respect of the request for the cancellation of an entry of the same acts. (Re. Article 28, number 1, which refers to Re. Article 24, number ...).

Special indications for the recording of a licence

1964 Draft

(1) A licence in respect of a European Patent shall be recorded in the Register of European Patents as an exclusive licence if the proprietor of the European patent and the licensee so require.

(2) A licence in respect of a European patent shall be recorded in the Register of European Patents as a sub-licence where it is granted by a licensee whose licence is recorded in the said Register.

Special indications for the recording of a licence

Proposal

(1) A licence in respect of a European patent application shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require.

(2) A licence in respect of a European patent application shall be recorded in the Register of European Patents as a sub-licence where it is granted by a licensee whose licence is recorded in the said Register.

Legal authenticity of translations

1964 Draft

(1) For the purposes of the application of the provisions of the Convention and of these Implementing Regulations, the translation referred to in Article 34, paragraph 2 of the Convention shall take the place of the original text of the European patent application, save in respect of the determination of the extent of the protection applied for.

(2) Saving proof to the contrary, the European Patent Office may, for the purposes of determining the extent of the protection applied for, deem the translation referred to in Article 34, paragraph 2, of the Convention to be in conformity with the original text of the European patent application.

Legal authenticity and time limit for the filing of
a translation of the application

Proposal

(1) +

Note:

(2) +

(3) The translation referred to in Article 34, paragraph 2, of the Convention must be submitted within a period of ... months as from the filing of the application.

The time limit laid down in Article 34 (2) of the 1962 Draft was one month; that laid down in Article 34 (2) of the 1965 Draft was 3 months; Article 34 (2) of the First Preliminary Draft refers to the Implementing Regulations, but does not specify the length of the period in question.

The sanction provided for in the event of late filing of the translation is to be found in Article 69 (former Article 68(c)) of the First Preliminary Draft.

Re. Article 34

Number 1a

Reduction of fees

1964 Draft

The persons referred to in Article 34, paragraph 2, of the Convention shall enjoy a reduction in the fees payable by them under Articles of the Convention, to the extent that they avail themselves of the options allowed by the provisions of Article 34, paragraph 2, and paragraph 3, second sentence. This reduction shall be fixed at a percentage of the total of such fees by the Rules relating to fees adopted pursuant to the Convention.

Note:

The decision as to which Articles are to make provision for the reduction in fees referred to above will be studied at a later date. The percentage of this reduction will be laid down at the same time as the amount of the fees.

Re. Article 34

Number 2

Reduction of fees

Proposal

+ Note:

See Note in the 1964 Draft (opposite).

Re. Article 34

Number 2.

Use of the language of the proceedings

1964 Draft

Saving any provisions to the contrary in these Implementing Regulations, the language of the proceedings shall be used in particular in the notifications and decisions of the European Patent Office and in the documents produced by parties to the proceedings as well as in oral proceedings before the European Patent Office.

Re. Article 34

Number 3

Use of the language of the proceedings

Proposal

+

Note:

It will be advisable to examine whether this provision is necessary, in view of the fact that the provisions of Article 34 (3) of the First Preliminary Draft would appear to be sufficiently explicit, and that the exceptions to the use of the language of both written and oral proceedings are clearly specified in the subsequent provisions of the present Draft Implementing Regulations.

Re Article 34

Number 3

Exceptions to the language of the proceedings in written proceedings

1964 Draft

(1) Any party to proceedings before the European Patent Office, excepting the proprietor of or applicant for a European patent, may produce documents or, in the event of the application of Article 34, paragraph 3, second sentence of the Convention, a translation thereof into a language referred to in Article 34, paragraph 1 of the Convention, other than that of the proceedings.

(2) If the translation referred to in Article 34, paragraph 3, second sentence of the Convention, and in paragraph 1 of this Article, is not produced in good time, the document shall not be taken into consideration.

Exceptions to the language of the proceedings in written proceedings

Proposal

(1) +

(2) If the translation referred to in Article 34, paragraph 3, second sentence of the Convention, and in paragraph 1 of this Article, is not produced within a period of 1 month as from the date of filing of the document, the document shall not be taken into consideration.

Notes:

(1) The retention in paragraph 1 of the reference to the proprietor of a European patent is justified by the fact that the provision in question is applicable to opposition proceedings following the grant of a patent.

(2) Article 34 (3), second sentence, of the First Preliminary Draft concerns the translation of documents drawn up in Danish, Dutch, Gaelic, Greek, Italian, Norwegian, Portugese, Spanish, Swedish or Turkish into the language of the proceedings (German, English or French) and is applicable to all parties to the proceedings, including the applicant for or proprietor of the patent, who have their registered place of business or their residence in the territory of one of the Contracting States in which an official language other than German, English or French is used, or who are nationals of one of these States.

Re. Article 34, Number 3, (page 2)

1964 Draft

(3) Documents used for purposes of evidence before the European Patent Office, and in particular publications, may be submitted in any language. The European Patent Office may, however, require that a translation be produced, within a given time limit, in one of the languages referred to in Article 34, paragraph 1, of the Convention, accompanied, where necessary, by an official document certifying that it is identical to the original text. In the event of the translation or official certificate not being submitted in good time, the document shall not be taken into consideration.

(4) The European Patent Office may take into consideration any observations, as provided for in Article 92 of the Convention, which are submitted in a language other than those referred to in Article 34, paragraph 1 of the Convention.

Proposal

(3) +

Paragraph 1 of this number, together with Article 34, (3), second sentence, of the First Preliminary Draft lays down the conditions for the translation of documents drawn up in any of the ten above-mentioned languages into one of the two languages used by the European Patent Office, other than the language of the proceedings. This paragraph applies to all parties to the proceedings who fulfil the conditions as to their registered place of business, residence and nationality, with the exception of the applicant for or proprietor of a patent.

(4) + ... Article 87 ...

(3) The one-month period proposed in paragraph 2 of this number was laid down in Article (3) of the 1962/1965 Draft, while the corresponding provision in the First Preliminary Draft transfers the fixing of this period to the Implementing Regulations.

Re. Article 34

Number 4

Derogations from the use of the language of the proceedings in oral proceedings

1964 Draft

(1) In the course of a hearing, of oral proceedings or of a preliminary investigation before the European Patent Office, any party to the proceedings may, in lieu of the language of the proceedings, use one of the other languages referred to in Article 34, paragraphs 1 and 2, of the Convention, on condition either that such party gives notice to the European Patent Office at least two weeks before the date laid down for the hearing, or makes provision for interpretation into the language of the proceedings. However, if the European Patent Office is not in a position to provide for the interpretation of one of the languages referred to in Article 34, paragraph 2, of the Convention, it shall so inform the party in question who, if he desires to use this language, must make provision for its interpretation.

X ((2) In the course of a hearing, of oral proceedings or of a preliminary investigation before the European Patent Office, the officials of the European Patent Office may, in lieu of the language of the proceedings, use one of the other languages referred to in Article 34, paragraph 1, of the Convention.

Derogations from the use of the language of the proceedings in oral proceedings

Proposal

(1) In the course of a hearing, of oral proceedings or of a preliminary investigation before the European Patent Office, any party to the proceedings may, in lieu of the language of the proceedings, use one of the other languages referred to in Article 34, paragraph 1, of the Convention, on condition either that such party gives notice to the European Patent Office at least two weeks before the date laid down for the hearing, or makes provision for interpreting into the language of the proceedings. In the course of the same proceedings, any party may use one of the languages referred to in Article 34, paragraph 2, of the Convention, on condition that he makes provision for interpretation into the language of the proceedings. The European Patent Office may grant derogations to the provisions of this paragraph.

(2) +

Notes:

1. With the exception of the last sentence, paragraph (1) amends the corresponding paragraph in the 1964 Draft in form only.

2. It will be necessary to examine whether the option opened by the provisions of paragraph (2) should not be limited to cases in which its exercise will be to the advantage of the parties to the proceedings.

Re. Article 34, Number 4, (page 2)

1964 Draft

(3) Witnesses and experts may make statements in one of the languages referred to in Article 34, paragraphs 1 and 2, of the Convention. However, should they declare that they are unable to express themselves adequately in one of these languages, the European Patent Office may authorise them to use another language. The European Patent Office shall make provision for interpretation into the language of the proceedings and, in the event of ex officio proceedings, shall bear the costs incurred thereby.

(4) On the joint request of the parties to the proceedings, the European Patent Office may allow the hearing, oral proceedings, or preliminary investigation, to take place in a language other than the language of the proceedings.

(5) Subject to the provisions of paragraph 1 of this Article, the European Patent Office shall, as required, provide for interpreting into the languages referred to in Article 34, paragraph 1 of the Convention.

Proposal

(3) In the event of witnesses and experts being unable to express themselves adequately in one of the languages referred to in Article 34, paragraphs 1 and 2, of the Convention, they may use another language. Should a preliminary investigation be decided upon following a request by a party to the proceedings, witnesses and experts who express themselves in languages other than those referred to in Article 34, paragraph 1, of the Convention, may be heard only if the party in question makes provision for interpretation into the language of the proceedings; the European Patent Office may, however, authorise interpretation into one of the other languages referred to in Article 34, paragraph 1, of the Convention.

Note:

(4) +

3. It will be necessary to examine whether provision should not be made for the replacement of the joint request of the parties referred to in paragraph 4 by their mutual consent.

(5) The European Patent Office shall make provision at its own expense for such interpretation as may be necessary pursuant to the preceding paragraphs, where the provision of this interpretation is not the responsibility of one of the parties to the proceedings.

Re. Article 34, Number 4, (page 3)

1964 Draft

(6) Statements by officials of the European Patent Office and by parties to the proceedings, made in one of the languages referred to in Article 34, paragraph 1, of the Convention during a hearing, oral proceedings, or a preliminary investigation, shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of the proceedings. Amendments to the text of the description or claims of a European patent application or European patent shall be entered in the Minutes in the language of the proceedings.

Proposal

(6) Statements by officials of the European Patent Office, by parties to the proceedings and by witnesses and experts, made in one of the languages referred to in Article 34, paragraph 1, of the Convention, during a hearing, oral proceedings, or a preliminary investigation, shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the language of the proceedings. Amendments to the text of the description or claims of a European patent application or European patent shall be entered in the minutes in the language of the proceedings.

Notes:

4. It will be necessary to examine whether provision should be made in the regulations for measures to ensure that interpreters provided by a party to the proceedings possess the necessary linguistic qualifications and provide impartial interpretation.

Re. Article 34

Number 5

Change of language of the proceedings

1964 Draft

(1) On the request of the proprietor of or applicant for a European patent, and following consultation of the other parties to the proceedings, the European Patent Office may allow the language of the proceedings to be replaced by one of the other languages referred to in Article 34, paragraph 1, of the Convention, thereafter deemed to be the new language of the proceedings.

(2) Amendments to the text of the description or claims of a European patent application or European patent must be lodged in the initial language of the proceedings.

Change of language of the proceedings

Proposal

(1) +

(2) +

Re. Article 34

Number 6

Language of applications for patents of addition

1964 Draft

(1) An application for a patent of addition or, in the case referred to in Article 34, paragraph 2, of the Convention, the translation thereof must be lodged in the initial language of the proceedings for the parent patent.

(2) In the event of an application for a patent of addition failing to comply with the conditions of paragraph 1, the European Patent Office shall so inform the proprietor of the application. Failing the provision of the translation into the initial language of the proceedings for the parent patent within the space of one month as from the date of such notification, the application for a patent of addition shall be rejected. The provisions of Article ...(Re. Article 34, Number 1) shall be applicable in respect of the translation provided in the initial language of the proceedings for the parent patent.

Note:

When drafting paragraph 2 of this article, the Drafting Committee noted that this provision, drawn up to meet a somewhat theoretical case, will tend to give rise to difficulties in application. It is therefore proposed that it be deleted.

Re. Article 34

Number 7

Language of applications for patents of addition

Proposal

(1) +

(2) Deleted in accordance with the note
contained in the 1964 Draft.

Re. Article 34

Number 7

Language used in the event of the division of European patent applications

1964 Draft

The provisions of Article ... (Re. Article 34, Number 6), paragraph 1, as regards applications for patents of addition shall apply to the divisional applications referred to in Article 80, paragraph 4, of the Convention.

Language used in the event of the division of European patent applications

Proposal

The provisions of Article ... (Re. Article 34, number 7) shall apply to the divisional applications referred to in Article 81, paragraph 4, and Article 94, paragraph 2, of the Convention.

Re. Article 34

Number 8

Language used in the event of the division of provisional European patents

1964 Draft

Documents relating to the additional provisional European patents resulting from the division provided for in Article 98 of the Convention must be lodged in the initial language of the proceedings for the provisional European patent which has been divided.

Re. Article 34

Number 9

Language used in the event of the division of provisional European patents

Proposal

Note:

Any proposal regarding this number will have to be held back until an answer has been found to the question of whether the division of a European patent should be provided for in the context of opposition proceedings after grant of the patent.

Re. Article 54

Number 1

Establishing the duties of the Departments responsible for proceedings

1964 Draft

(1) The President of the European Patent Office shall determine the number of the Departments provided for in Article 54 of the Convention and shall, in respect of each of these, establish the limits of their responsibilities by reference to the patent classification referred to in Article 62 of the Convention.

(2) In addition to the responsibilities vested in them under the Convention and these Implementing Regulations, the President of the European Patent Office may allocate administrative duties to the Examining Sections, Examining Divisions and Patent Administration Divisions.

Number 1

Allocation of duties to the Examining Sections and Examining Divisions

Proposal

(1) The President of the European Patent Office shall determine the number of the Departments provided for in Article 53(a) and (b) of the Convention and shall allocate duties to the Examining Sections and Examining Divisions, by reference to the patent classification referred to in Article ... (Re. Article 1, number 1).

(2) In addition to the responsibilities vested in them under the Convention and these Implementing Regulations, the President of the European Patent Office may allocate administrative duties to the Examining Sections and Examining Divisions.

Note:

Unlike the 1964 Draft, paragraph (1) does not include the allocation of duties to Boards of Appeal among the responsibilities of the President of the European Patent Office. This allocation is covered by Number 2 over-leaf.

Re. Article 53
(Former Article 54)

Number 2 (new)

Allocation of duties to the Boards of Appeal

Proposal

(1) Duties shall be allocated to the Boards of Appeal and the members of the various Boards of Appeal before the beginning of each working year, for the duration of that year. Any member of the Boards of Appeal may be appointed as a member of several Boards of Appeal. These measures may be amended during the course of the working year in question only if circumstances render such amendment essential.

(2) The measures referred to in paragraph 1 shall be taken by an authority consisting of the President of the European Patent Office, who shall act as Chairman, a Vice-President of the said Office, the Chairman of the Boards of Appeal and three members of the Boards of Appeal elected for the working year in question by the full membership of these Boards. Decisions shall be taken by a majority vote; in the event of parity of voting, the President shall exercise the casting vote.

(3) The authority referred to in paragraph (2) shall decide on conflicts regarding the apportionment of duties between several Boards of Appeal.

Notes:

(1) The proposal that the President of the European Patent Office should not be responsible for the allocation of duties to the Boards of Appeal, but that this responsibility should be vested in a special authority, takes account of a suggestion made during the Conference with a view to strengthening the similarities between the Boards of Appeal and the Courts (see Minutes of second meeting, point 24).

(2) It will be necessary to examine whether this Article should not be supplemented in order to make clear:

- (a) the criteria for the allocation of duties referred to in paragraph (1) (for example: by reference to the patent classification referred to in Re. Article 1, number 1);
- (b) the authority (for example: Vice-President of the European patent office responsible for allocating business to the various Boards of Appeal.

Re. Article 54

Number 1a

Classifying of European patent applications and of European patents

1964 Draft

The President of the European Patent Office shall decide as to the classifying of European patent applications and of European patents by reference to the patent classification referred to in Article 62 of the Convention.

Re. Article 53
(Former Article 54)

Number 3

Classifying of European patent applications

Proposal

The President of the European Patent Office shall decide as to the classifying of European patent applications and of European patents by reference to the patent classification referred to in Article ... (Re. Article 1, number 1).

Administrative structure of the European Patent Office

1964 Draft

(1) The Examining Sections and Examining Divisions shall be grouped together administratively so as to form Major Divisions, the number of which shall be laid down by the President of the European Patent Office.

(2) The Major Divisions, Patent Administration Divisions, Boards of Appeal, Revocation Boards and administrative services of the European Patent Office shall be grouped together administratively so as to form Directorates General.

(3) Each Vice-President of the European Patent Office shall be placed at the head of a Directorate General. The appointment of each Vice-President to a Directorate General shall be decided upon by the /Administrative Council/, following consultation with the President of the European Patent Office.

Administrative structure of the European Patent Office

Proposal

(1) The Examining Sections and the Examining Divisions shall be grouped together administratively so as to form Examining /Units/ /Departments/, the number of which shall be laid down by the President of the European Patent Office.

Note:

(2) The Examining /Units/ /Departments/, Boards of Appeal, the Enlarged Board of Appeal and administrative services of the European Patent Office shall be grouped together administratively so as to form Directorates General.

(3) Each Directorate General shall be directed by a Vice-President. The appointment of a Vice-President to a Directorate General shall be decided upon by the Administrative Council, following consultation with the President of the European Patent Office.

The change in the first sentence of paragraph 3 would enable one of the Vice-Presidents to assist the President in all his duties, instead of being made responsible for a Directorate General.

Re. Article 55

Number 1

Special Examining Section for the fixing of costs of proceedings

1964 Draft

(1) The President of the European Patent may grant exclusive responsibilities to one Examining Section for the fixing of the procedural costs provided for in Article 164, paragraph 4, and in Article 165, paragraph 3, of the Convention.

(2) The provision contained in Article 55, paragraph 2, of the Convention shall not be applicable in respect of the Examining Section referred to in paragraph 1.

Re. Article 54
(Former Article 55)

Number 1

Special Examining Section for the fixing of costs of proceedings

Proposal

(1) The President of the European Patent Office may grant exclusive responsibilities to one Examining Section for the fixing of the procedural costs provided for in Article ... of the Convention.

(2) The provision contained in Article 54, paragraph 2, of the Convention shall not be applicable in respect of the Examining Section referred to in paragraph 1.

Note:

Since the Articles of the First Preliminary Draft to which it is intended to refer have not yet been drawn up by Working Party I, examination of the present provisions might be deferred.

Re. Article 60

Number 1

Particulars to be entered in the Register of European Patents

1964 Draft

(1) The presentation for public inspection of the Register of European Patents must be such as to give all the information on each European patent application and, if the case arises, on the provisional patent resulting therefrom as well as on the final patent.

(2) The compulsory entries to be made in the Register of European Patents shall be as follows :

- (a) registration number of the European patent application;
- (b) date of filing of the patent application;
- (c) title of the invention;
- (d) classification code given to the European patent application;

Re. Article 59
(Former Article 60)

Number 1

Particulars to be entered in the Register of European Patents

Proposal

(1) The presentation for public inspection of the Register of European Patents must be such as to give all the information on each published European patent application and on each patent resulting therefrom, during the opposition period and, where appropriate, until the conclusion of opposition proceedings.

(2) The compulsory entries to be made in the Register of European Patents shall be as follows :

- (a) +
- (b) +
- (c) +
- (d) +

Note:

(1) As regards paragraph (1), the extent to which particulars relating to a European patent may be entered in the Register of European Patents during the opposition period or during opposition proceedings (change of proprietor of a European patent or lapse of the patent in one of the Contracting States), will depend on whether provisions are to be laid down in the Convention, whereby the Contracting States would be required to communicate to the European Patent Office any change of ownership of the patent, or the lapse of the patent (see the notes to Articles 23 and 101-106 of the Convention).

1964 Draft

- (e) name, forenames and address, or business name and registered place of business, of the proprietor of the European patent application or the European patent;
- (f) name, forenames and address of the designated inventor;
- (g) name, forenames and business address of the representative of the proprietor of the European patent application or European patent /referred to in Article 172 of the Convention/;
- (h) rights of priority claimed;
- (h₁) in the event of a division of the application, the numbers of the divisional applications;
- (i) in the case of applications for European patents of addition, the information referred to under points (a) and (b) as in the application for the parent patent;
- (j) in the case of divisional applications for a European patent, the information referred to under points (a) and (b) for the initial patent application;
- (k) /Particulars regarding the division of a provisional patent/;
- (l) in the case provided for in Article 16, paragraph 3, of the Convention, the information referred to under point (b) with regard to the previous application;
- (m) in the cases provided for in Article 24, paragraphs 4 and 5 of the Convention, the conversion of an application for a European patent of addition or of a European patent of addition into an independent application or patent.

Proposal

(e) name, forenames and address or official designation and registered place of business of the proprietor of the European patent application;

Note:

2. The provision in paragraph 2 (e) has been amended to agree with Rule 4.4 (b) of the PCT Implementing Regulation.

(f) +

(g) name, forenames and business address of the representative of the proprietor of the European patent application or of the European patent referred to in Article ... of the Convention;

(h) +

h₁) +

(i) +

(j) in the case of divisional applications for a European patent, the information referred to under points (a), (b) and (h) as in the application for the parent European patent.

(k) deleted.

(l) in the case provided for in Article 16 of the Convention the information referred to under points (b) and (h) with regard to the previous patent application;

(m) in the cases provided for in Article 21, paragraph 7, of the Convention, the conversion of an application for a European patent of addition into an independent European patent application.

- (n) /date of grant of the provisional European patent/;
- (o) date of publication of the grant of the provisional European patent;
- (p) date of filing of the request for examination /and of notice of intervention/;
- (q) /date of confirmation of the provisional European patent as a final European patent/;
- (r) date of publication of the confirmation of the provisional European patent as a final European patent;
- (s) date of withdrawal of an application, of the annulment, surrender or lapse or of a decision as regards the revocation of a European patent;
- (t) rights and assignments of such rights over a European patent application or a European patent where these are recorded pursuant to the Convention.

(3) The President of the European Patent Office may decide that entries other than those referred to in paragraph 2 shall be made in the Register of European Patents.

Note:

The entries in square brackets are to be re-examined at a later date.

Proposal

- (m₁) (new) in the case referred to in Article 88, paragraph 4, of the Convention, the finding that the application for a European patent of addition is deemed to be an independent patent application;
- (n) deleted;
- (o) date of publication of the European patent application;
- (p) date of filing of the request for examination;
- (q) date of grant of the European patent;
- (r) date of publication of the grant of the European patent;
- (s) date on which the European patent application is rejected, withdrawn or deemed to be withdrawn;
- (s₁) (new) date of lapse of the European patent in one of the Contracting States during the opposition period and, where appropriate, pending a final decision on opposition;
- (s₂) (new) date of entering opposition;
- (s₃) (new) date and purport of the decision on opposition;
- (t) +
(3) +

Communications between the European Patent Office and the authorities of Contracting States

1964 Draft

Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the provisions of the Convention and of these Implementing Regulations shall be effected directly between these bodies. Communications between the European Patent Office and the Courts or other authorities of the Contracting States may be effected through the intermediary of the above industrial property offices.

Re. Article 62
(Former Article 64)

Number 1

Communications between the European Patent Office and the authorities of Contracting States

Proposal

+

BR/GT I/44 e/70 ett/PA/sjf

Communication of files to third parties by the Courts or Government Departments of Contracting States

1964 Draft

(1) The Courts and Government Departments of the Contracting States may, in the course of their proceedings, communicate to third parties the files concerning European patent applications or European patents transmitted to them by the European Patent Office. Such communication shall be effected in accordance with the conditions laid down in Article 162 of the Convention, with the exception of the condition provided for in paragraph 3 of that Article.

(2) The European Patent Office shall, at the time of transmission to the Courts of Government Departments of Contracting States, indicate such restrictions as may, under Article 162, paragraphs 1 and 2, of the Convention, be applicable to the communication to third parties of a European patent application or a European patent.

Communication of files to third parties by the Courts and
Government Departments of Contracting States

Proposal

(1) +

Note:

Working Party I has not yet drafted the Article(s)
of the Convention which relate to the communica-
tion of files.

... Article ... of ...
... Article ... of ...

(2) +

... Article ... of ...

Expenditure in respect of communications between the European Patent Office and the authorities of Contracting States.

1964 Draft

Expenditure in respect of each communication effected pursuant to Article 64 of the Convention between the European Patent Office and the central industrial property offices, the Courts, or other authorities of Contracting States, shall be chargeable to the body making the communication.

~~Article 62~~
(former Article 64)

Number 3

Expenditure in respect of communications between the European Patent Office
and the authorities of Contracting States

Proposal

+ ... Article 62 ...

Procedure for letters rogatory

1964 Draft

(1) Each Contracting State shall designate the national authority to which the European Patent Office is to address its letters rogatory and, subject to paragraphs 2 and 3, shall lay down the procedure to be applied in the carrying out of such requests.

(2) The European Patent Office shall draw up letters rogatory in the language of the Court in question or shall attach to such letters rogatory a translation into the language of the Court.

(3) The provisions of Articles 11 to 14 and of Article 16 of the Convention on Civil Proceedings signed at the Hague on 1 March 1954 shall be applicable.

Note:

The attention of the representatives of the Ministries of Justice should be drawn to this Article.

Procedure for letters rogatory

Proposal

(1) +

Notes:

(2) +

(3) The provisions of Articles 11 to 14 and of Article 16 of the Hague Convention of 1 March 1954 on Civil Proceedings shall be applicable.

1. The Convention referred to in paragraph (3) was not signed on 1 March 1954 by all the States taking part in the Inter-governmental Conference.
2. See the note under Re. Article 65, number 1, of the 1964 Draft.

