

BR/GT I/53 e/70

Travaux Préparatoires EPC 1973

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, 26 August 1970
BR/GT I/53/70

- Secretariat -

NOTE FROM THE BRITISH DELEGATION

Delegations to Working Party I will find annexed herto some observations of a juridical nature forwarded by the British delegation and pertaining to certain articles of the 1970 First Preliminary Draft and of Working Document BR/GT I/10/69.

BR/GT I/53 e/70 rin/PB/bm

EUROPEAN PATENT CONVENTION

NOTE BY THE UNITED KINGDOM ON SOME GENERAL LEGAL POINTS

The following points relate to the 1970 Preliminary Draft:-

1. Article 15 - Right to the European Patent

Article 15(1), second sentence speaks of "the national law governing a relationship between the employee and the employer". This may lead to uncertainty. We suggest that the second sentence should read "If the inventor is an employed person and the national courts with jurisdiction in the place where he was normally employed grant the right to the patent to the employer, or to the employer and employee jointly, the right to the European Patent shall belong accordingly, or to his, or their, successor in title."

2. Articles 24-27 and 29 - Mortgaging etc. of the European Patent Application (BR/GT I/45/70)

We agree with the Chairman that provisions of this kind are not needed. If they are inserted, we propose that the Convention should say that they apply in relation to the European Patent application only to the extent that they apply in relation to national patent applications in the individual States.

3. Article 40

We suggest that Article 40(2) should read as follows:-

"(2) as regards non-contractual liability,

the European Patent Office shall be bound to make good any damage caused by its employees in the performance of their duties in accordance with the provisions of the law relating to non-contractual liability in the country whether the European Patent Office (or the appropriate branch) is situated."

The existing formula makes for complete uncertainty, at any rate for a number of years until a jurisprudence has been evolved. It would be preferable to apply a specified system of law even if this means allowing some cases to be determined by a legal system which may be somewhat alien to the applicant for the patent. On this basis the best choice seems to be the law of the country where the Patent Office is situated.

The following comments relate to Articles not contained in the published draft of 1970.

4. Article 154 - Obtaining Evidence (BR/GT I/10/69)

Basically we feel that it is up to the parties to a proceeding before the EPO to furnish the evidence necessary to support their case, rather than for the EPO itself to conduct investigations. There will however be occasions when a party wishes to call a witness who is unwilling to attend before the European Office. He should be given the opportunity to give his evidence by means of a declaration

sworn before a person entitled to administer oaths in his country of residence. If cross-examination is required by the other parties to the proceedings and the witness remains unwilling to attend before the EPO, the evidence should be taken on commission, if necessary by means of Letters Rogatory. To allow the EPO to demand the presence of unwilling witnesses and fine them for non-attendance or refusal to testify seems unnecessarily high-handed.

Article 154(6) suggests that this may already be the intention; but it seems in conflict with paragraph (4) of that Article which we feel should be deleted.

Article 154(1) lists among the methods of obtaining evidence the inspection of premises. In so far as this concerns inspection by consent of the occupants no difficulty arises. But if it is intended to also include inspection by order of the European Patent Office or by order of national courts in response to letters of request issued by the European Office, there may be certain difficulties. Members of the European Patent Office would not under existing UK law have any right of entry, and the provisions of the Foreign Tribunals Evidence Act 1856 which authorises our courts to obtain evidence at the request of foreign courts

(and since 1963 international tribunals) do not extend to inspection of premises. There may be certain difficulties also in relation to discovery of documents. We would therefore welcome further information about the intentions behind Article 154 and in particular whether

(a) it is intended that the EPO itself should have power to issue interrogatories, orders for the discovery of documents and authority for the inspection of premises, all of which would cause some difficulty for us, and

(b) whether it is intended that our courts should afford these facilities in response to letters of request from the EPO, in which case we would have to widen the scope of our existing legislation.

Article 154(5)

We suggest that this paragraph should confer the power to punish on the national courts of the country where the evidence was taken. If the witness or expert is no longer in that country extradition could be sought.

5. Article 169 - Assistance to Applicants (BR/GT I/10/69)
We agree with the Chairman's proposal.

6. Article 170 - Enforcement of Costs and Fines
(BR/GT I/10/69)

The United Kingdom has no objection in principle to enforcement but has some reservations on the details of procedure. A provision in more general language would be preferred, requiring that the decision, upon being presented for enforcement in accordance with the formalities required by the law of the Contracting State where enforcement is sought, shall be enforceable as if it were a judgment of a Court in that State. It could, if it were thought necessary, be provided in addition that the decision may not be subjected to any further examination except as to the authenticity of the document.

7. Article 171(5) (BR/GT I/10/69)

The reference to "any lawyer called to the Bar" is probably a mis-translation of the original text. Because of the division in the British legal profession between barristers and solicitors, these words, if retained, would preclude a Solicitor from practising before the European Patent Office, although he is entitled to practise before the British Patent Office. It should be clear that any qualified lawyer entitled to appear before the national office of the Contracting State may appear before the EPO in patent matters..
