

BR/GT I/63 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, 6 October 1970

BR/GT I/63/70

- 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
(Re. Articles 101 to 162)

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Regulations to the Convention relating to a European Patent Law, as drafted by the EEC "Patents" Working Party (unpublished working document 4419/IV/63 of 20 January 1964) and,
- the Regulations under the Patent Co-operation Treaty (PCT)

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/IV/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.

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a European Patent Law, as drafted by the EEC "Patents" Working Party (working document 4419/IV/63 of 20 January 1964, unpublished).

RPCJEC : indicates the Rules of Procedure of the Court of Justice of the European Communities.

PCT Regulations : indicates the Regulations under the Patents Co-operation Treaty.

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|---|--|
| + 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. |

Re. Articles 101 - 107
(former Articles 96d-103)

Opposition procedure

Note:

The 1964 Draft contained no provisions concerning opposition procedure, as such a procedure was not provided for in the 1962 Draft and was first introduced in the 1965 Draft. There are therefore no provisions corresponding to the proposals submitted on pages 7 to 13.

Form of the notice of opposition

P r o p o s a l

The notice of opposition shall contain:

- (a) the name, address, nationality, of the person giving notice of opposition and the State in which his residence or registered office is located, in accordance with the conditions set out in Article ... (Re. Article 66, No. 1), paragraph 2(c);
- (b) the file number of the European patent against which opposition is lodged, the designation of its proprietor and the title of the invention;
- (c) the declaration that opposition is lodged against the European patent, and at least one of the grounds for opposition provided for in Article 101(a) (new) of the Convention;

Notes:

- 1. Article 101(1), second sentence, of the First Preliminary Draft lays down that notice of opposition must be given in writing. It will be appropriate to examine whether this provision should be transferred to the Implementing Regulations, by analogy with Re. Article 88, No. 1, on the Form of the Request for Examination.
- 2. See Re. Article 88, No. 1, (2b) (BR/GT I/52/70 page 73 - Proposal).
- 3. Article 101(a) (new), referred to opposite, appears in BR/GT I/49/70; page 45, as a proposal.
- 4. See Re. Article 111, No. 1, (1b) and (2b) (BR/GT I/52/70, page 91 - Proposal).

No. 1

(Cont.)

Form of the notice of opposition

P r o p o s a l

(d) if the person giving notice of opposition has appointed an agent, his name and the address of his place of business, under the conditions provided for in Article ... (Re. Article 66, No. 1), paragraph 2(c), sub-sections 2 and 4.

5. See Re. Article 66, No. 1, (2d) and Re. Article 88, No. 1 (2c) (BR/GT I/52/70, page 73 - Proposal).

Rejection of the opposition as invalid

P r o p o s a l

(1) If the Opposition Division finds, on expiry of the opposition period, that the notice of opposition does not comply with the provisions of Article 101 of the Convention and of Article ... (Re. Article 101, No. 1) sub-paragraph (c), or does not indicate the file number of the patent against which opposition has been lodged, it shall reject the said opposition as invalid.

(2) If the Opposition Division finds that the notice of opposition does not comply with the provisions of Article ... (Re. Article 101, No. 1) other than those mentioned in paragraph 1, it shall so notify the person who lodged the opposition and shall invite him to rectify the irregularities found within such period as it may specify. If the notice of opposition does

Note: The invalidity of the opposition for non-payment of the fee ensues from Article 101 (1). It might, however, be examined whether this point should be included in the regulations Re. Article 101, Nos. 1 and 2. It should be noted, however, that no provision to date has been made in this respect Re. Article 88, Nos. 1 and 2.

Rejection of the opposition as invalid

P r o p o s a l

not include the designation of the proprietor of the patent against which the opposition has been lodged, or the title of the invention, the Opposition Division may decide to overlook this irregularity, if, nevertheless, the identity of the person lodging the opposition and of the patent against which opposition has been lodged, can be determined. If the document is not rectified in good time, the Opposition Division shall reject the opposition as invalid.

Re. Article 101

(former Article 96d)

No. 3 (new)

Continuation ex officio of the opposition proceedings

Proposal

(1) In the event of the death or incapacity of a person lodging opposition, the opposition proceedings shall may be continued ex officio, even without the participation of the heirs or legal representatives.

(2) If the Opposition Division finds, once the opposition proceedings have begun, that the opposition was lodged by a third party who was incapacitated or was not represented in accordance with the conditions laid down in Article ... of the Convention, the proceedings shall be continued ex officio. Such procedural steps as may already have been taken shall be deemed to be fully valid.

Notes : (1) It will be necessary to discuss:

- (a) whether the proceedings should be continued whatever the circumstances;
- (b) if so, whether participation by the heirs or legal representatives may nevertheless be required. - See Re. Article 96, No. 3 (1), 1964 Draft (BR/GT I 51/70, Re. Article 93, No. 3).

(2) See Re. Article 96, No. 3 (2), 1964 Draft (same document). In so far as the question of incapacity is raised in paragraph 1, it seems that it should also be provided for in the event of such incapacity being revealed only after the proceedings have begun. Furthermore, the question of representation may arise in this respect, in the event of the obligation laid down in the 1964-65 Draft being included in the first Preliminary Draft and being applicable to third parties who have lodged opposition.

Re. Article 100

(former Article 102)

No. 1 (new)

Conditions of the hearing

P r o p o s a l

If the Opposition Division desires to hear a participant in the opposition proceedings, the date of the hearing shall be notified to the other participants, who may attend the hearing.

Note:

Detailed provisions concerning the summons were drafted Re. Article 84, No. 1 (BR/GT I/52/70) as regards the Examining Section but were not adopted by the sub-Committee. It was therefore not felt necessary to draw up such provisions for opposition proceedings before the Opposition Division.

Articles 154 to 161 of the 1964 Draft

Note:

The Implementing Regulations Re. Articles 154 to 161 of the 1964 Draft are based in part on the Rules of Procedure of the Court of Justice of the European Communities (RPCJEC). The relevant Articles of the RPCJEC are indicated where they correspond to provisions of these Regulations.

Re. Article 15^a

No. 1

Obtaining of evidence by the European Patent Office

1964 Draft

Where it has to take measures for obtaining evidence involving the appearance of witnesses and experts or the inspection of premises, the European Patent Office shall communicate to the parties the date upon which such measures are to be taken and the facts to be proved. The parties may attend the obtaining of evidence. They may ask any appropriate questions of the witnesses and experts being heard.

Note: See the note on page 15 (in this case, Articles 45 (1) and 46 (2)).

Re. Article 154

No. 1

Obtaining of evidence by the European Patent Office

Proposal

BR/GT I/63 e/70 lor/PB/pc

Re. Article 154

No. 3

Part payment of costs of obtaining evidence

1964 Draft

The European Patent Office may make the obtaining of evidence, requested by any party, conditional upon deposit by that party with the European Patent Office of a sum the amount of which shall be fixed by reference to an estimate of the costs.

Note:

See note on page 15 (in this case Article 47 (3)).

Re. Article 154

No. 2

Part payment of costs of obtaining evidence

Proposal

BR/GT I/63 e/70 lor/PB/pc

Re. Article 154

No. 4

Summons for the purpose of obtaining evidence

1964 Draft

(1) The witnesses and experts who must be heard shall be summoned to give evidence. The summons shall give particulars of the facts regarding which they are to be heard.

(2) In addition to the particulars provided for in paragraph 1 and in Article ... (Re. Article 159, No. 1), paragraph 2, the summons of a witness shall contain the designation of the parties to the proceedings and particulars of the rights which he may invoke under the provisions of Article ... (Re. Article 154, No. 8).

Re. Article 154

No. 3

Summons for the purpose of obtaining evidence

Proposal

(1) +

(2) + ... (Re. Article 154, No. 6) ...

BR/GT I/63 e/70 lor/PB/pc

Re. Article 154

No. 5

Hearing of witnesses

1964 Draft

Before a witness may be heard, he shall be informed that, where appropriate, he may be required to certify his statement on oath. In the event of his being called upon to do so, he shall take the following oath after giving evidence:

"I swear that what I have said is the truth, the whole truth and nothing but the truth."

The oath may be taken in the manner laid down by the law of the country of the witness concerned.

Note: See note on page 15 (in this case, Article 47 (4) and (5)).

BR/GT I/63 e/70 lor/PB/prk

Re. Article 154

No. 4

Hearing of witnesses

P r o p o s a l

BR/GT I/63 e/70 lor/PB/prk

Re. Article 154

No. 6

Commissioning and hearing of experts

1964 Draft

- (1) Expert reports may be made in writing or orally.
- (2) The terms of reference of the expert shall include:

- (a) a precise description of his task;
 - (b) the time limit laid down for the submission of the expert report;
 - (c) the indication that he may, where appropriate, be called upon to take the oath;
 - (d) the designation of the parties to the proceedings;
 - (e) particulars of the rights which he may invoke under the provisions of Article ...
- (Re. Article 154, No. 8).

(3) A copy of the written report shall be submitted to the parties.

(4) In the event of an expert being called upon to take the oath, he shall, after submitting his report, take the following oath:

"I swear that I have carried out my task conscientiously and with full impartiality."
The oath may be taken in the manner laid down by the law of the expert's country.

Note: See note on page 15 (in this case, for paragraphs 2 and 4, Article 49 (1) and (6)).

Re. Article 154

No. 5

Commissioning and hearing of experts

P r o p o s a l

(1) +

(2) +

(a) +

(b) +

(c) +

(d) +

(e) + ... (Re. Article 154, No. 6) ...

(3) +

(4) +

Re. Article 154

No. 8

Payment of expenses of witnesses and experts

1964 Draft

(1) Witnesses and experts shall be entitled to appropriate reimbursement of expenses for travel and subsistence. An advance for these expenses may be granted to them.

(2) Witnesses shall be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks.

(3) The Administrative Council may lay down the conditions governing the implementation of the provisions of paragraphs 1 and 2 of this Article. Payment of amounts due pursuant to these paragraphs shall be made by the European Patent Office.

Note. See note on page 15 (in this case, for paragraphs 1 and 2, Article 51 (1) and (2)).

Re. Article 154

No. 6

Payment of expenses of witnesses and experts

Proposal

(1) +

(2) +

(3) +

BR/GTI/63e/70 lor/PB/PRJ

1964 Draft

(1) The European Patent Office may, on request, take without delay measures for the obtaining of evidence, with a view to conserving evidence of facts liable to affect a decision which it might be called upon to take with regard to an application or a European patent, where there is reason to fear that the obtaining of evidence might subsequently become more difficult or even impossible.

(2) The request shall contain:

- (a) the name, given name(s) and place of residence, or the designation, status and registered place of business of the person making the request;
- (b) the title of the application or of the European patent in question;
- (c) the designation of the facts in respect of which measures for the obtaining of evidence are to be taken;
- (d) particulars of the measures for the obtaining of evidence;
- (e) a statement establishing the assumption that there is reason to fear that the obtaining of evidence might subsequently become more difficult or impossible.

(3) The request shall not be deemed to have been submitted until the fee prescribed by the Rules relating to fees adopted pursuant to the Convention has been paid.

(4) The decision on the request shall be incumbent upon the department of the European Patent Office required to take the decision liable to be affected by the facts to be established. The provisions of the Convention and of these Regulations with regard to the obtaining of evidence in proceedings before the European Patent Office shall be applicable to proceedings before the said department.

Re. Article 154

No. 7

Conservation of evidence

P r o p o s a l

(1) +

(2) +

(a) the name, address, nationality, of the person making the request and the State in which his residence or registered office is located, under the conditions laid down in Article ... (Re. Article 66, paragraph 2(c);

(b) +

(c) +

(d) +

(e) +

(3) +

(4) +

Re. Article 155

No. 1

Calculation of time limits

P.C.T./Regulations

1964 Draft

80.1 Periods Expressed in Years

When a period is expressed as one year or a certain number of years, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent year in the month having the same name 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.

80.2 Periods Expressed in Months

When a period is expressed as one month or a certain number of months, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent month on the day which has the

.../...

(1) Periods shall be laid down in terms of years, months, weeks or full days.

(2) If the beginning of a period is fixed by reference to an event, the day on which that event took place shall be discounted when calculating the period. If the beginning of the time limit is fixed by reference to a date, that date shall be included when calculating the period.

Calculation of time limits

PCT Regulations/Cont.

the same number as 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.

80.3 Periods Expressed in Days

When a period is expressed as a certain number of days, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire on the day on which the last day of the count has been reached.

Re. Article 155

No. 1

Calculation of time limits

Proposal

(1) +

(2) If the beginning of a period is fixed by reference to an event, the day on which that event took place shall be excluded from the calculation.

Notes:

(1) A Regulation in a different form, corresponding to paragraph 1, is contained in the PCT Regulations.

(2) The proposal contained in paragraph 2 is in agreement with the 1964 Draft (paragraph 2, first sentence) and with the PCT Regulations (Rules 80.1 to 80.3, the first half of the sentence in each case.)

According to the PCT Regulations it does not appear necessary to make an express ruling in the event of a period being fixed by reference to a date. As a matter of principle the beginning of a period should be fixed by reference to an event. The Convention and the Implementing Regulations should be re-examined in the light of this consideration. At the same time particular care should be taken to see that the wording in the different languages corresponds.

Re. Article 155, No. 1 (page 2)

1964 Draft

(3) Where a period is measured in terms of months or years, it shall be calculated from the day on which it begins until the day having the same number in the month during which the time limit expires. In this case, if the month when the time limit is due to expire has no day with the same number, the period shall expire at the end of the last day of that month.

Re. Article 155, No. 1 (page 2)

Proposal

(3) +

Note:

(3) Paragraph 3 of the 1964 Draft, on the expiry of time limits, is in agreement with the PCT Regulations (Rules 80.1 and 80.2, second half of the sentence in each case).

Rule 80.3 (2) of the PCT Regulations, is self-explanatory.

BR/GT I/63 e/70 son/PB/pc

Re. Article 155

No. 4

Extension of time limits

PCT Regulations

1964 Draft

80.5 Expiration on a Non-Working Day

If the expiration of any period during which any document or fee must reach a national office or intergovernmental organisation falls on a day on which such office or organisation is not open to the public for the purposes of the transaction of official business, or on which ordinary mail is not delivered in the locality in which such Office or organisation is situated, the period shall expire on the next subsequent day on which neither of the said two circumstances exists.

1964 Draft

Note: See the note on page 15 concerning Articles 30 (2), and 8C (2) of the RPCJEC.

BR/GT/ I/63 e/70 son/PE/pc

(1) In the event of a time limit being extended by the European Patent Office, the period of extension shall be calculated with effect from the expiry of the initial period.

(2) If the last day of the period is a day on which the European Patent Office is not open for receipt of documents, the period shall be extended until the first day thereafter on which the European Patent Office is open for receipt of documents.

(3) Paragraph 2 shall apply to the time limits provided for in the Convention or in these Implementing Regulations in the case of transactions to be carried out with the competent authority within the meaning of Article 66 (1)b of the Convention, if the last day of the period is a day on which the competent authority is not open for receipt of documents.

(4) The list of days for which it is established that the European Patent Office is not open for receipt of documents shall be published in the Official Gazette of the European Patent Office.

Re. Article 155

No. 2

Extension of time limits

Proposal

- (1) +
- (2) +
- (3) + (Article 64, Paragraph 1 (b))
- (4) +

Re. Article 156

No. 1 (new)

Observation of time limit prevented by force majeure

Proposal

(1) Applications for re-establishment of the applicant's rights shall be presented in writing.

(2) If an application for re-establishment of the applicant's rights is granted, an entry to this effect shall be made in the Register of European Patents and published in the European Patent Bulletin; provided that an entry has been published in accordance with Article 86 of the Convention.

Note:

(1) Paragraph 1 would be superfluous if the expression "in writing" were added to Article 156 (2), first sentence of the Convention. However, see Re. Article 88, No. 1, paragraph 1, and Note 1 on Re. Article 101, No. 1.

(2) Article 156 (6) of the Convention stipulates that anyone who exploits an invention in good faith in the course of the period between the refusal or the presumed withdrawal of a published European Patent application and the publication of the notification of the re-establishment of the applicant's rights or who has made actual and serious preparations to exploit the invention, may freely continue such exploitation in the course of his business or for the needs thereof. It therefore seems necessary to make provision in the Implementing Regulations for an entry concerning the re-establishment of the applicant's rights to be published in the Register of European Patents and the European Patent Bulletin.

Re. Article 157

No. 1

Death of Applicant or proprietor

1964 Draft

Public notice shall be effected by means of a notice affixed to a public notice board of the European Patent Office and simultaneous publication in the European Patent Bulletin. The European Patent Office may prescribe the utilization of other means of publication of the public notice.

Re. Article 157

No. 1

Death of applicant or proprietor

Proposal

BR/GT I/63 e/70 son/PB/pc

Re. Article 159

Miscellaneous provisions relating to proceedings and the issue of documents

The provisions numbered Re. Article 159 Nos. 1 to 9 were only grouped under this article for the sake of convenience. Owing to the present state of the First Preliminary Draft it has not been possible to link them with individual provisions made in that text.

Re. Article 159

No. 1

Term and form of the writ of summons

1964 Draft

(1) Writs of summons to a hearing, oral proceedings or a preliminary investigation shall give a minimum of one month's notice. In urgent cases the term may be reduced.

(2) The writ of summons shall state the consequences to which non-appearance may give rise, pursuant to the Convention or to these Regulations.

Re. Article 159

No. 1

Term and form of the writ of summons

P r o p o s a l

(1) +

(2) +

Re. Article 159

No. 2

Minutes of hearings, oral proceedings
and preliminary investigations

1964 Draft

(1) Minutes of hearings, oral proceedings and preliminary investigations shall be drawn up. These shall contain the essentials of the hearing, oral proceedings or preliminary investigations, the judicially important statements made by the parties and the testimony of the witnesses, experts or parties.

(2) The minutes of the testimony of a witness, expert or party shall be read out to him or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the minutes have been approved. If approval to the minutes is not given, the objections raised shall be noted.

(3) The minutes shall be signed by the official of the European Patent Office who drew them up and by the official of the European Patent Office who conducted the hearing, oral proceedings or preliminary investigation.

(4) The parties shall be provided with a copy of the minutes.

Note: See note on p.15 (in this case: Articles 53 and 47, §(6), R.P.C.J.E.C.)

Re. Article 159

No. 2

Minutes of hearings, oral proceedings
and preliminary investigations

P r o p o s a l

- (1) +
- (2) +
- (3) +
- (4) +

Re. Article 159

No. 3

Form of decisions of the European Patent Office

1964 Draft

(1) Decisions by the departments of the European Patent Office whereby proceedings with regard to a party are concluded shall be made in writing.

(2) The decisions mentioned in paragraph 1 shall give grounds, unless they are the decisions of the examining sections granting a provisional European patent or the decisions of the examining divisions confirming a provisional European patent without the participation of third parties in the confirmation proceedings.

(3) The President of the European Patent Office may decide that other decisions are to be given in writing or are to state grounds.

Re. Article 159

No. 3

Form of decisions of the European Patent Office

P r o p o s a l

(1) +

(2) The decisions mentioned in paragraph 1 shall give grounds provided that they are not decisions to grant a European patent.

(3) +

Note:

In the event of the sub-Committee, on discussion of Re. Article 115 No. 1, deciding to specify that not only Board of Appeal decisions but also decisions of the examining section and examining division could be delivered at the hearing in the course of which the oral proceedings are concluded, the present article should cover all these decisions. Paragraph 1 would have to be amended accordingly.

Re. Article 159

No. 4

Ex officio Rectification

1964 Draft

Errors of fact and expression and obvious mistakes contained in decisions of the European Patent Office, in the Register of the European Patents and in publications of the European Patent Office, may be rectified ex officio.

Re. Article 159

No. 4

Ex officio rectification

P r o p o s a l

Re Article 159

No. 6

Notification of channels of appeal

1964 Draft

(1) Decisions of the European Patent Office against which an appeal, further appeal or action may be brought, shall as a rule be accompanied by a written notification informing the parties as to which of the channels of appeal is open, before what authority, within what term and in what form the appeal may be lodged, and what fee, if any, is to be paid.

(2) The parties may invoke neither the omission of the notification nor any errors contained therein.

Note: It will be necessary to reconsider whether this article should be retained.

Re. Article 159

No. 5

Notification of channels of appeal

P r o p o s a l

(1) Decisions of the European Patent Office in respect of which a channel of appeal is open shall, as a rule, be accompanied by a written notification informing the parties that an appeal against the decision may be brought, within what term and in what form the appeal may be lodged with the European Patent Office, and stating that the appeal fee must be paid.

(2) +

Re. Article 159

No. 7

Issue of certified copies

1964 Draft

The European Patent Office shall issue on request certified copies of the European Patent application upon payment of the fee prescribed by the Rules relating to fees adopted pursuant to the Convention. However, before publication of the provisional European patent, such copies shall be issued only to the applicant for the European patent.

Re. Article 159

No. 6

Issue of certified copies

P r o p o s a l

+ patent application

Re. Article 159

No. 7a

Advance payment of fees

1964 Draft

The European Patent Office may neither issue any document, copy, photo-copy or information nor render any other service except on advance payment of the corresponding fee.

Re. Article 150

No. 7

Advance payment of fees

Proposal

The European Patent Office may decide not to make the issue of documents, copies and photocopies, the supplying of information or the rendering of any other service dependent on the advance payment of the corresponding fee.

Note:

1) Under the 1964 draft, the European Patent Office could not comply with requests for documents when the fees were to be paid subsequently. This provision might impose unnecessary restrictions on credit-worthy applicants such as professional agents and large companies, particularly in the case of urgent requests for priority documents.

2) A necessary condition for the adoption of the present proposal would be the inclusion in the Rules relating to fees of a basic provision to the effect that the fees payable for the official services quoted shall be due for payment as soon as the application is filed. This raises the point of whether it would not be advisable to include the provision contained in No. 7 in the Rules relating to fees.

Interruption of proceedings

1964 Draft

(1) In the event of the death of the applicant for or proprietor of a European patent, proceedings before the European Patent Office shall be interrupted until the intervention of the heirs, subject to the application of the provisions of Article 157 of the Convention. The same shall apply to proceedings before the Revocation Board in the event of the death of an applicant.

(2) If, in the cases provided for in paragraph 1, one of the persons referred to in this paragraph becomes incapable, the proceedings shall be interrupted until a legal representative has been appointed. The same shall apply in the event of expiry of the representative's authorisation.

(3) If there is a professional agent, the proceedings shall not be interrupted. The European Patent Office may however suspend proceedings on the request of the agent.

(4) If the applicant for or proprietor of a European patent is declared bankrupt, proceedings before the European Patent Office shall be interrupted; they shall be resumed when the provisions applicable in the event of bankruptcy allow or when the bankruptcy proceedings are concluded. The same shall apply if other judicial proceedings are opened for the purpose of satisfying all the holders of debt claims on the estate of the debtor.

(5) The time limits in force at the date of interruption or suspension of proceedings shall come into full force again as from the day when the European Patent Office declares the end of the interruption or, in the case of suspension, gives notice of the resumption of proceedings.

Interruption of proceedings

P r o p o s a l

(1) In the event of the death of the applicant for or proprietor of a European patent, proceedings before the European Patent Office shall be interrupted until the intervention of the heirs, subject to the application of the provisions of article 157 of the Convention.

(2) If the applicant for or proprietor of a European patent becomes incapable, proceedings before the European Patent Office shall be interrupted until a legal representative has been appointed. The same shall apply in the event of expiry of the legal representative's authorisation.

(3) +

(4) +

(5) +

Note:

See Re. Article 101 No. 2, which stipulates that opposition proceedings are to be continued ex officio should the opposing party die or become incapable.

Re. Article 159

No. 9

Belated observations

1964 Draft

The European Patent Office may decide not to take into consideration observations not made within the term set.

Re. Article 159

No. 9

Related observations

P r o p o s a l

Note:

This is a general provision which should perhaps be included in the Convention where there is already a similar rule relating to the special case of appeals. (See article 113 (2) of the First Preliminary Draft.)

Re. Article 161

No. 1

General provisions on notifications

1964 Draft

(1) In proceedings before the European Patent Office the notifications referred to in Article 161 of the Convention shall relate to the original of the document to be notified or to a copy thereof certified by the European Patent Office. Certification shall not, however, be required in respect of copies of documents emanating from the parties themselves.

(2) Direct notification shall be made:

(a) by post;

(b) by delivery on the premises of the European Patent Office;

(c) by publication.

(3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the provisions applicable to the said office. This procedure shall be applied only where direct notification has produced no response or would appear to be inappropriate.

Note:

See note on p.15 (in this case paragraphs 1 and 2 correspond to Article 79 (1) RPCJEC)

Re. Article 161

No. 1

General provisions on notifications

P r o p o s a l

(1) +

(2) +

(a) +

(b) +

(c) +

(3) +

Re. Article 161

No. 2

Notification by post

1964 Draft

(1) Notification by post shall be by registered letter or by registered letter with recorded delivery.

(2) Decisions incurring a time limit for appeal and writs of summons shall be transmitted by registered letter with recorded delivery. The President of the European Patent Office may decide that this method of notification shall be used in other cases.

Re. Article 161

No. 2

Notification by post

P r o p o s a l

(1) +

(2) +

BR/GT I/63 e/70 son/PB/prk

Re. Article 161

No. 3

Notification by registered letter

1964 Draft

Where notification is effected by registered letter, this shall be deemed to be delivered to the addressee in the course of the 7th day following its posting, unless the document to be served has failed to reach its destination or has reached it at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the document has reached its destination and to establish the date of its delivery to the addressee.

Re. Article 161

No. 3

Notification by registered letter

P r o p o s a l

Where notification is effected by registered letter, this shall be deemed to be delivered to the addressee on the seventh day following its posting. Nevertheless, the addressee may claim that the document to be served has not reached him, or has reached him at a later date. In the event of any dispute it shall be incumbent on the European Patent Office to establish that the document has reached its destination and to establish the date of its delivery to the addressee.

Note:

The text of the 1964 Draft has been modified only in form.

Re. Article 161

No. 4

Refusal to take delivery

1964 Draft

Notification by registered letter or by registered letter with recorded delivery shall be deemed to have been effected even if acceptance thereof has been refused without good reason.

BR/GT I/63 e/70 son/PB/prk

Re. Article 161

No. 4

Refusal to take delivery

Proposal

+

BR/GT/ I/63 e/70 son/PB/pc

Re. Article 161

No. 5

Notification by delivery by hand

1964 Draft

(1) If the addressee is on the premises of the European Patent Office, notification may be effected by delivery by hand of the document to be served upon the addressee, who shall acknowledge receipt thereof.

(2) Notification shall be deemed to have taken place even if the addressee refuses to accept the document to be served or to acknowledge receipt thereof. Note shall be taken in the files of the date of such refusal to take delivery or to acknowledge receipt.

Note:

See note on page 15 (in this case Article 79 (1) RPCJEC)

Re. Article 161

No. 5

Notification by delivery by hand

Proposal

(1) +

(2) +

BR/GT I/63 e/70 son/PB/pc

Re. Article 161

No. 6

Notification by despatch by post

1964 Draft

- (1) Notifications in respect of addressees who have neither a registered place of business nor a place of residence on the territory of the Contracting States and who have not appointed a professional agent or chosen an address for service shall be effected by the posting of the document to be notified in the form of an ordinary letter bearing the last address of the addressee known to the European Patent Office.
- (2) The date of despatch and the address to which the document has been sent shall be recorded on the files.
- (3) Notification shall be deemed to have been made when despatch has taken place, even if the letter is returned to the sender owing to the impossibility of delivering it to the addressee.

Re. Article 161

No. 6

Notification by despatch by post

Proposal

(1) +

Note:

It will be necessary to examine whether this article serves any useful purpose, in view of Article 172 (2) and (3) of the First Preliminary Draft (compulsory representation).

(2) +

(3) +

Re. Article 161

No. 7

Public Notification

1964 Draft

(1) If the address or place of residence of the addressee cannot be established, notification shall be made by publication.

(2) Public notification shall be effected by displaying the document for notification on the public notice board of the European Patent Office. Instead of the document a notice may be displayed indicating where the document may be examined. The existence of the public notification shall be mentioned in the European Patent Bulletin at the same time as the notice is posted.

(3) The document shall be considered as notified one month after the date of posting.

Re. Article 161

No. 7

Public Notification

Proposal

(1) +

(2) Public notification shall be effected by displaying the document for notification on the premises of the European Patent Office. The existence of the public notification shall be mentioned in the European Patent Bulletin at the same time as the document is displayed.

(3) +

Re. Article 161

No. 8

Notification in the event of there being several legal representatives

1964 Draft

If the addressee of the notification has several legal representatives,
notification may validly be made to any one.

Re. Article 161

No. 8

Notification in the event of there being several legal representatives

Proposal

Re. Article 161

No. 9

Notification to professional agents

1964 Draft

- (1) If a professional agent has been appointed and the authorisation has been placed on the file, notifications shall be addressed to the agent.
- (2) If one professional agent has been appointed for several interested parties, notification of a single document to the agent shall be sufficient for all of the interested parties.
- (3) If several professional agents have been appointed for a single interested party, notification to any one of them shall be sufficient.

Re. Article 161

No. 9

Notification to patent agents

Proposal

(1) +

(2) +

(3) +

Re. Article 161

No. 10

Choice of common address for service

1964 Draft

(1) Where an application, request or appeal is filed by several persons having no representative, a common address for service must be chosen on the territory of one of the Contracting States. The same shall apply where an application, a patent or rights attaching to a request or appeal are assigned to several persons.

(2) If no address for service has been chosen in the cases referred to in paragraph 1, the European Patent Office shall invite the interested parties to choose such an address within a term which it shall specify. If no address for service is chosen within this term, notification to any one of the interested parties shall be sufficient.

Re. Article 161

No. 10

Ex officio appointment of a common representative

Proposal

(1) If there is more than one applicant, and the request for grant of a European patent does not comply with the requirements of Article ... [Re. Article 66 No. 1] paragraph 2 (i), the applicant first named in the request shall be considered the common representative.

(2) The preceding paragraph shall be applicable where a request, opposition or appeal is filed by several persons. The same shall apply where a patent application or the rights attaching to a request or an appeal are assigned to several persons.

- deleted -

Note:

1) The first paragraph proposed corresponds to Rule 4.8 (b) of the PCT Regulations.

The reference to the request or appeal in paragraph 1, sentence 1 and paragraph 1, sentence 2 of the text of the 1964 draft has been repeated in the proposal for paragraph 2. It will be necessary to examine whether paragraph 1 will not have to be extended to cover the case provided for in Article ... (Re. Article 66 No. 1), paragraph 2 (i).

2) Paragraph 2, sentence 2 will have to be extended to cover the patent, if it is decided that, in accordance with the note to Article 23 of the First Preliminary Draft, the provisions of Article 23 should apply to the assignment of the European patent during the opposition period and, if necessary, up to the conclusion of the opposition proceedings.

Re. Article 161

No. 11

Power to receive notifications after conclusion of proceedings

1964 Draft

(1) At the close of proceedings the notifications relating to a European patent shall be made validly to the last known address for service chosen by several persons owning a European patent, unless a professional agent has been appointed.

(2) The same shall apply where a common professional agent has been appointed by several persons owning a European patent and having their registered office or place of residence on the territory of one of the Contracting States.

Re. Article 161

No. 11

Power to receive notifications after conclusion of proceedings

Proposal

deleted

Note:

A provision corresponding to Re. Article 161, No. 11 of the 1964 draft is no longer necessary because Article 172 (2) and (4) of the First Preliminary Draft lays down that representation shall continue even after the patent has been granted.

Re. Article 161

No. 13

Correction of irregularities in the notification

1964 Draft

If it cannot be established that a document has been duly notified or if, when the document has arrived at its destination, the compulsory provisions relating to the notification have not been observed, the document shall be deemed notified as from the date on which it is proven that the addressee has received it.

Re. Article 161

No. 12

Irregularities in the Notification

Proposal

BR/GT I/63 e/70 ley/PB/pc

Re. Article 162

No. 1

Inspection of the files without explicit consent

1964 Draft

Any person who can prove that the applicant for a European patent or the proprietor of a provisional European patent which has not yet been published, has exercised a right over that application or patent in respect of him, may obtain inspection of the files without the consent provided for in Article 162, paragraph 1 of the Convention.

Re. Article 162

No. 1

Inspection of the files without explicit consent

Proposal

Any person who can prove that the person who has filed a European patent application has exercised a right over that patent application in respect of him, may obtain inspection of the files without the consent provided for in Article 162 paragraph 1 of the Convention.

Note: There was a discrepancy between the French and German texts of the 1964 Draft.
The present proposal contains the substance of the French text.

Re. Article 162

No. 2

Parts of the file not for inspection

1964 Draft

(1) The parts of the file which shall not be open to the inspection provided for in Article 162 paragraph 2 of the Convention, shall include:

- a) the documents relating to a request for exemption from payment of fees or other procedural costs under Article 169 paragraph 1 of the Convention;
- b) the documents relating to a request for the grant of a further period of time for the payment of renewal fees under Article 122 of the Convention;
- c) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Revocation Boards under Article 153 of the Convention;
- d) draft decisions and opinions, and all other documents used for the preparation of decisions and opinions and which are not communicated to the parties.

(2) The President of the European Patent Office may decide that other documents shall not be open to inspection.

Re. Article 162

No. 2

Parts of the file not for inspection

Proposal

(1) +

a) - deleted -

b) - deleted -

c) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal, in accordance with Article 153 of the Convention;

d) +

(2) +

Re. Article 162

No. 3

Inspection of the original application

1964 Draft

Where a divisional application for a European patent results in the grant of a provisional European patent before the original application, the documents relating to the latter application which were filed with the division, shall be made available for inspection, without the consent provided for in Article 162 paragraph 1 of the Convention, to any person who so requests after the publication of the patent arising from the divisional application.

Re. Article 162

No. 3

Inspection of the original application

P r o p o s a l

- deleted -

Note:

This provision can be deleted as the original application and the divisional applications are to be published simultaneously pursuant to Article 85 of the First Preliminary Draft.

Re. Article 162

No. 4

Procedures for the inspection of files

1964 Draft

(1) The inspection of the files of European patent applications and of European patents shall take place on the premises of the European Patent Office.

(2) On request, the inspection of the above-mentioned files may take place on the premises of the central industrial property office of the Contracting State on whose territory the person making the request has his residence or place of business.

(3) The issue of copies of file documents may be requested instead of inspection of the said files.

Re. Article 162

No. 4

Procedures for the inspection of files

P r o p o s a l

(1) +

(2) +

(3) +

Re. Article 162

No. 5

Communication of an item of information contained in the files

1964 Draft

(1) The European Patent Office may communicate information concerning any file of a European patent application or European patent subject to the payment of the fee prescribed by the Rules relating to fees adopted pursuant to the Convention. The provisions of Article 162 paragraphs 1 and 2 of the Convention and of Articles (Re. Article 162, Nos. 1 to 3) shall be applicable to such communications.

(2) The European Patent Office may, upon receipt of a request for the communication provided for in paragraph 1, require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

Re. Article 162

No. 5

Communication of an item of information contained in the files

P r o p o s a l

(1) + ... (Re. Article 162, Nos. 1 and 2) ...

(2) +

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