

BR/GT I/90 e/70

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Comment:

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

Brussels, 23 December 1970
BR/GT I/90/70

- Secretariat -

PROPOSALS BY THE GERMAN DELEGATION

to Working Party I Sub-Committee on "Implementing Regulations"

Re. Article 54, No. 2

Re. Article 101, No. 5

Re. Article 111, No. 2

Re. Article 120, No. 1

Re. Article 123, No.

Re. Article 159, No. 9

Re. Article 159, No. 10

Re. Article 54

(former Article 55)

No. 2

Delegation of duties

(1) The President of the European Patent Office shall be authorised to entrust to officials who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Sections, Examining Divisions or Opposition Divisions and posing no technical or legal problems, with the exception of the rejection of European patent applications on grounds opposed by the applicant, the grant and revocation of European patents and the rejection of oppositions.

(2) A delegation of duties by the President of the European Patent Office in accordance with paragraph 1 shall be published in the Official Journal of the European Patent Office.

Note :

The aim of the provision, which is proposed for reasons of economy, is that technically and legally qualified examiners, who will belong to Grade A, should be assisted by officials of lower Grades (B and C) so that they can devote themselves as far as possible to their principal work, that of actual examination. For example, this provision could allow officials of lower grades to assume responsibility for communications demanding costs or transmitting one party's statement to the other parties. The possibility might also be envisaged of making these officials responsible for examining whether the application satisfies the formal requirements laid down in the Implementing Regulations.

Re. Article 101

No. 5

Communications to the other opponents

(1) If several oppositions have been lodged, the Opposition Division shall communicate the other oppositions to the other opponents at the same time as the notification provided for under Article 101, paragraph 3, of the Convention.

(2) The written statements of the opponents shall be communicated to the other parties. If these statements contain facts and evidence not contained in the grounds for opposition, and if the Opposition Division intends to take these facts and evidence into account, the Opposition Division shall invite the proprietor of the patent to comment on these statements within a period to be fixed by the Division.

Note :

1. The provisions concerning communications to the parties in opposition proceedings in the First Preliminary Draft Convention are incomplete. There are provisions governing the following cases :
 - (a) the notification of oppositions to the proprietor of the patent (Article 101, paragraph 3, first sentence);
 - (b) the communication to the other parties of the observations of the proprietor of the patent on the oppositions (Article 101, paragraph 3, 2nd sentence);
 - (c) the communication to the other parties of the observations of the proprietor of the patent on a negative result of the examination (Articles 102, 103).

The proposed Re. Article 101, No. 5 should rectify the deficiency existing in the First Preliminary Draft Convention.

2. At the Sub-Committee's January meeting with Working Party I the question is to be examined whether the above-mentioned cases of communications for which provisions exist in the First Preliminary Draft Convention can be combined with the present Re. Article 101, No. 5 in the Implementing Regulations to form a general provision.

Re. Article 111

(former Article 108)

No. 2

Exemption from payment of the fee for appeal

The appeal shall be deemed to have been lodged even without payment of the fee for appeal provided for in Article 111, second sentence, of the Convention, where the contested decision is obviously based on a substantial procedural deficiency which, in the event of the fee being paid, would fully justify an annulment of the decision and an order to reimburse the appeal fee in accordance with Article ... (Re. Article 112, No. 1).

Note :

This provision should clarify the relationship between Article 159a and Article 111, second sentence, of the Convention. It may exceed the scope of Article 159a to the extent that it can also be applied in bilateral proceedings. In particular the case should be envisaged in which the proprietor of the patent eliminates deficiencies in response to a notification from the European Patent Office, but the statement to this effect does not reach the files because of a procedural error on the part of the European Patent Office and the Opposition Division revokes the patent because of an erroneous assumption that the applicant has failed to keep to the time limit. In such a case it seems unreasonable to require the proprietor of the patent to pay the appeal fee at first, only to refund it later.

Transmittal of the international application
to the European Patent Office

If an international application is filed with an authority of a Contracting State with effect for the European Patent Office, the Contracting State must ensure that the application reaches the European Patent Office no later than two weeks before the end of the thirteenth month after filing. If a priority is claimed, the priority date, or, if more than one priority is claimed, the date of the earliest priority, shall be taken as the beginning of the period.

Note :

If an international application, for which the EPO has been selected as receiving Office, is filed in a Contracting State which has made use of the authorisation provided for in Article 120, paragraph 1, second sentence, and Article 64, paragraph 2, of the First Preliminary Draft Convention, the Contracting State in question must, in accordance with Article 120, paragraph 2, of the First Preliminary Draft Convention, "take all necessary measures to ensure that the application is transmitted to the European Patent Office in time for the latter to be able to comply in due time with the conditions for transmittal under the Co-operation Treaty".

The aim of the proposed provision is to specify the obligation to transmit the application in due time by stating the latest date on which the application can reach the EPO.

According to the last sentence of Rule 22.1(a) of the Regulations under the PCT, when the European Patent Office acts as a receiving Office, it must mail the international application to the International Bureau not later than 5 days prior to the expiration of the 13th month from the priority date.

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Re. Article 120, No. 1

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If one assumes that the EPO requires 9 days for the process through which the international application goes from the initial processing at the European Patent Office, via examination in accordance with Article 11, paragraph 1, of the PCT to posting to the International Bureau, there results a period of 13 months minus 2 weeks from the priority date.

Re. Article 123

(former Article 113g)

Effects of Article 123 of the Convention
on other provisions

Notes :

1. It has not yet been laid down in the Implementing Regulations in what form the translations pursuant to Article 123, paragraphs 2 and 3, are to be published. It is proposed that the following sentence be added to Re. Article 85, No. 1 :

"The same shall apply for the publication of the translations pursuant to Article 123, paragraphs 2 and 3, of the Convention."
2. In the minutes of the third meeting of Working Party I from 24 to 28.11.1969 (BR/12/69), the following is stated under No. 71 :

"With reference to paragraph 4 it was pointed out in the Working Party that the time of publication of the international application, which is to take the place of the publication of the European patent application, is not the same as the time of publication of the latter. This could have certain effects for various rules in the Convention, e.g. for Article 24(1) (Patents of addition), for Article 60 (Register of European Patents) and for Article 162 (Inspection of files). The Working Party agreed to examine the question of the effect of paragraph 4 on the other provisions of the Convention before its next meeting."

The question was transferred at the 6th meeting of Working Party I, when the "List of questions remaining open" was discussed, to the Sub-Committee on "Implementing Regulations" (cf. BR/GT I/67/70, page 35). The German delegation is of the opinion that no cause for amending existing provisions or creating new ones emerges from examination of the effects of Article 123, paragraph 4, on the other provisions of the Convention and Implementing Regulations, and particularly on Articles 21(24), paragraph 1, 59(60) and 162 of the Convention cited in BR/12/69.

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Re. Article 159

No. 9

Form of notices and other communications from the
European Patent Office

Notices and other communications from the European Patent Office are to be signed by and to state the name of the responsible official. Instead of the signature and statement of name a printed or stamped seal of the European Patent Office may be used.

Note :

The practical significance of the proposed provision lies in the second sentence, which allows mechanical processes to be used in the procedure before the EPO. A similar provision is contained in the Implementing Regulations to the Madrid Convention on the international registration of Trade Marks of 29.4.1970. Article 1, paragraph 4 of these Implementing Regulations reads :

"If the Implementing Regulations prescribe the signature of the national authority, a facsimile or an official seal may be used instead".

Lapse

(1) Rights of the European Patent Office to the payment of fees shall lapse /four/ years after the end of the calendar year in which the fee fell due.

(2) Rights against the European Patent Office for the refunding of fees or sums of money paid in excess of a fee, shall lapse /four/ years after the end of the calendar year in which the right arose.

(3) The period of lapse shall be suspended in the case covered by paragraph 1 by a request for payment of the fee and in the case covered by paragraph 2 by a reasoned claim in writing. After the suspension it shall begin again and shall end at the latest /six/ years after the end of the year in which it originally began.

Notes :

1. The aim of the proposed provision is to prevent the possibility of rights of the European Patent Office to the payment of fees and rights against the European Patent Office for the refunding of fees or sums of money paid in excess of a fee being invoked indefinitely. Both the European Patent Office and the entitled parties or third parties should be able to assume after a reasonable period that no more claims can be made, especially as the justification of a claim can no longer be investigated in circumstances where the relevant documents have been destroyed.

Such rights of the European Patent Office will arise where services incurring fees have been rendered without payment of the fee already due. The following cases may be envisaged :

- (a) in accordance with Article 4, paragraph 2 of the Rules relating to Fees, it is decided not to make the service incurring the fee dependent upon the advance payment of the fee;

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(b) the fact that the fee has not been paid is overlooked.

Rights against the European Patent Office may arise inter alia if fees are paid late or if a fee is paid in excess.

2. The periods placed in square brackets are intended as a basis for discussion. The periods proposed in paragraphs 1 and 2 correspond to the expiry periods in Germany and, to the best of the German delegation's knowledge, in other Contracting States.