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

Brussels, 14th July 1971

BR/GT I/110/71

- Secretariat -

N O T E

Subject: Note from the Swedish delegation on Article 16 of the
Convention

The delegations to Working Party I will find attached
a note from the Swedish delegation regarding a problem
connected with Article 16 of the Preliminary Draft of a
Convention establishing a European System for the Grant of
Patents.

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NON-ENTITLEMENT TO A EUROPEAN PATENT AS A GROUNDS FOR REVOCATION.

VIEWS PRESENTED BY THE SWEDISH DELEGATION.

1. In the First Preliminary Draft Implementing Regulations, Re. Art. 16 No. 1, Note 1 on page 4, the Working Party states that an application for a European patent "may proceed to grant and a European patent be issued thereon in the name of an applicant who has been declared to be not entitled thereto". During the Conference meeting 20 to 28 April 1971 the Swedish delegation expressed some doubt if the First Preliminary Draft of a Convention etc. (in the following referred to as the D.C.) actually has to be interpreted in this way. On the invitation of the German delegation, the Swedish delegation was asked to submit a written statement specifically stating how the D.C. could be interpreted otherwise.
2. In the absence of any explicit decision by the Conference that imposes the consequences cited above, it is assumed that the Working Party conclusion is based on an interpretation of the existing text of the D.C. First, it is therefore investigated whether the wording of the text does actually impose upon the EPO the obligation to grant a patent to the wrongful party. If this is not the case, there should be no objection for the Working Party to present proposals based on the merits of the case. Secondly, then, certain arguments are presented in favour of a solution whereby the person entitled to the European patent should be allowed to protect his interests on a merely defensive basis, i.e. without the filing of a patent application.

3. In Art. 15 (1) it is explicitly stated that the right to a European patent shall belong to the inventor or his successor in title. Art. 96 of the D.C. states the grounds for refusal of a patent application in terms which generally apply when an application does not meet the requirements of the Convention. Clearly an application made by another party than the inventor or his successor in title falls under this heading. In principle, therefore, a patent cannot be granted to a party which does not qualify under Art. 15.
4. A different question is to what extent the EPO should be obliged to examine whether the applicant is entitled to the patent. The Swedish delegation has stated that it, in the interest of inventors, favours a solution whereby an applicant who is not himself the inventor should submit proof of assignment. However, it was recognized that it would be difficult for the EPO to examine national requirements in this respect.
5. For this reason, the provision in Art. 15 (2) was adopted, according to which the applicant shall be deemed to be entitled "to exercise the rights" etc. This provision can only be construed as a legal presumption to this effect. As such it must be capable of being overthrown by actual proof to the contrary. If it is established that the applicant is not entitled, it cannot, in our view, be envisaged that the EPO should knowingly grant the patent to somebody who had e.g. stolen the invention. This might even be said to follow from general principles of ordre public.

6. In Art. 16 the EPO is given the competence of recognizing a final decision (by a competent national authority) to the effect that somebody else than the applicant is entitled to the European Patent. The capability of the EPO in this respect is the same whether the one entitled to the patent does himself file a European patent application or not.
7. Art. 16 is necessary in order to grant to the legitimate party the rights there stated. The fact that in this context it is found practical to provide for an automatic disposal of the previous application, can in our view give no basis for a conclusion e contrario, whereby the EPO could not refuse an application on similar grounds. Of course, in such a case the EPO must await the end of the period stated in Art. 16, in order to safeguard the right of the party entitled to the patent to file a new application if he so wishes.
8. From a substantive point of view there are good reasons to prevent the grant of a European patent to an illegitimate applicant. It should again be emphasized that we are not now disputing the decision that the EPO should not itself examine this question. The issue is reduced to a situation where a final decision is presented to the EPO, i.e. a situation analagous with the one envisaged in Art. 16.

9. The rightful owner of the invention - be it the inventor himself or somebody who derives his right from him - may not want a monopoly but merely to secure the free use of the invention. There are for instance research organizations of the public welfare type who condition research grants on the obligation to place the results of the research at the disposal of the general public. It does not appear proper to force such organization to apply for a European patent in contradiction to its own statutes, or, alternatively to contest the patent, granted to somebody who is not entitled thereto, in the courts of each European country separately.
10. Respectable reasons for not wanting a European patent may also, e.g. in the case of small independent inventors, exist for reasons of costs. In our opinion the rightful owner should be allowed to save costs where he wants to limit his monopoly e.g. to a national patent in his own country, or where his interest is a merely defensive one. It seems hardly practical to force him to file a European application to fulfil this purpose.
11. It should also be noted that if a person is only partly entitled to a European patent (e.g. in the case of joint inventors), the possibility of filing a new application in his own name is not open to him. The possibility for him to call for the defeat of a patent granted with his exclusion seems to be the most practical way to protect his interests.

12. In general, the lack of the possibility to oppose the grant of a European patent on grounds of non-entitlement may weaken the position of inventors in negotiations with prospective exploiters.
 13. For these reasons it seems natural that among the grounds for opposition in Art. 101 a, should also be included the one where, by a final decision, the applicant is found not entitled to the European patent.
 14. From the D.C. it appears that also national courts are excluded from revoking a European patent granted to a party not entitled thereto. Thus, Article 133 does not include non-entitlement to the patent among the grounds for revocation that may be applied under the law of a Contracting State. In the national stage, however, the arguments for the presumption contained in Article 15 (2) are not valid. It seems hardly acceptable that even a national court of a Contracting State should be prevented from revoking for that State a European patent granted to the wrong party. Even if this view is not taken, it should be clarified, that if the law of a Contracting State so provides, a national court could transfer a European patent to the person entitled thereto.
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