

BR/GT I/112 e/71

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

Brussels, 22 July 1971
BR/GT I/112/71

- Secretariat -

NOTE FROM THE UNITED KINGDOM DELEGATION

The delegations to Working Party I will find attached observations and proposals made by the United Kingdom delegation on certain legal questions which are to be discussed at Working Party I's September meeting (1).

The attached note replaces the note from the United Kingdom delegation (BR/GT I/53/70) of 27 August 1970.

(1) The Articles are numbered as they are in the published volume containing the 1971 Preliminary Drafts.

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ANNEX

NOTE BY THE UNITED KINGDOM DELEGATION

EUROPEAN PATENT: LEGAL POINTS

A. CONVENTION

1. Articles 15 and 16 - Rights to the grant of a European Patent;
Patent applications by persons not entitled to apply
Re. Article 16, Nos. 1, 2, 3 and 4

It is apparent that a decision of (say) a United Kingdom Court about entitlement to apply for a patent can have no effect on a European application in so far as it designates other countries, at least until the European Patent Office deems the application to be withdrawn. It would appear, however, that serious difficulties would arise where two or more conflicting national decisions on entitlement are presented to the European Patent Office. We would therefore prefer to delete Article 16 and the corresponding Regulations, and leave questions of entitlement to be dealt with in the national phase after grant.

If it is agreed to delete Article 16 then it seems to us that it would not be worthwhile retaining Article 15, paragraph 1. In any event we point out that we are not happy with Article 15, paragraph 1. The second sentence speaks of "the national law governing a relationship between the employee and employer". Under this formula we think that cases may arise in which different courts would apply different laws to the same facts. We think that uncertainty should be removed by making one law applicable and we suggest that this should be the law which would be applied by the courts of the country where the employee is normally employed. Accordingly, if Article 15, paragraph 1 is retained we would suggest that the second sentence should read:

"If the inventor is an employed person, the right to the European patent shall be determined in accordance with the law governing the relationship between the employee and his employer which would be applied by the courts of the country where the employee is normally employed."

2. Article 23 - Assignment of a European patent application

We think that this Article should be revised to cover cases of assignment by way of gift and transfers by operation of law, e.g. on death and bankruptcy. We propose therefore that paragraphs (1) and (2) should read as follows:

- "(1) The assignment by way of contract of a European patent application shall ...
- (2) An assignment by way of contract, an assignment by way of gift or transfer by operation of law shall be recorded ... or of a certified copy of the assignment, or of official documents verifying the assignment or transfer, or of such extracts from such assignment or documents as suffice to establish the assignment or transfer. The request ..."

Since Article 59 provides that nothing shall be recorded on the Register until the date of publication under Article 85 we consider that Article 23, paragraph 4 needs revision to read:

"The assignment ... Office until receipt of the documents referred to in paragraph 2 and it shall ... verified by those documents."

3. Article 136 - Investigation

Article 136, paragraph 1. It is not consistent with other parts of the draft, e.g. Article 101b, paragraph 1 and Article 113, paragraph 1 that evidence may be furnished only by the parties. We think that the European Patent Office must be able to request evidence and we therefore suggest the deletion of the words "at the instance of the

parties to the proceedings". It is not clear that the list of kinds of evidence of Article 136, paragraph 1(a) - (e) is complete and we think also that it should specifically include the examination of samples or other real evidence and, where appropriate, affidavits or other written statements of the parties and non-expert witnesses.

Article 136, paragraph 3. We think that power to administer an oath should be extended to Examining and Opposition Divisions. We think also that it should be possible for a witness to make an "affirmation" and suggest the addition of "or affirmation" after "oath". Moreover, there seems no good reason for excluding a party who gives evidence himself from taking an oath or affirmation.

Article 136, paragraphs 4 and 6. We think that Article 136, paragraph 4 is objectionable since a witness could be found for failure to appear outside his country of residence. However, we would be prepared to accept this if it is made clear that a witness has an unconditioned option to give evidence on commission under Article 136, paragraph 6 in his country of residence instead of going to the European Patent Office. We suggest that Article 136, paragraph 6 be amended to read:

"Interested parties, witnesses and experts shall have the option of being heard, under oath or affirmation, by the judicial authorities of their countries of residence. This option may be exercised even when the hearing ..."

Article 136, paragraph 5. The present draft appears to give rise to criminal liability in several States for a single offence committed in only one of them. Moreover, it obliges a competent Court to take action whenever notified by the President of the European Patent Office. We suggest, therefore, that Article 136, paragraph 5 be replaced by a provision leaving the matter to be dealt with by the Courts of the country where the perjury took place, using extradition procedures if necessary. We suggest the following:

"Any perjury on the part of a witness or expert shall be a matter for the Courts of the Contracting State in which the perjury took place. The Contracting State may institute proceedings for perjury on notification by the President of the European Patent Office."

4. Article 143 - Death of applicant

Re. Article 145, No. 7 - Interruption of Proceedings

The procedures provided by Article 143 and Re. Article 145, No. 7 are not consistent, and we also think that

Article 143 is largely superfluous and should be deleted. However Re. Article 145, No. 7 needs amending since it could result in perpetual interruption in some cases, and this is not desirable. We suggest therefore that paragraph 2 of Re. Article 145, No. 7 should be amended so that the European Patent Office must be informed within six months from the death or legal incapacity of the applicant of the identity of the person authorised under the national law to act on his behalf, subject to the possibility of extension if this can be justified. If the European Patent Office has not been notified at the end of the six months, the application should be deemed withdrawn.

5. Articles 145 - Reference to general principles

The reference to "the principles of procedural law commonly recognised in the Contracting States" is vague and uncertain since the principles of the procedural law will, in many instances, vary from State to State. Moreover, since there is no sanction if the principles are not applied there seems no need for the limitation and we suggest its deletion. Clearly the European Patent Office will have to establish its own rules in those cases where no procedure is laid down. However, if a rule is to have any legal effect it must be contained in the Regulations and under Article 35(a) the Administrative Council is the only body with authority to amend the Regulations. We are thus not

clear as to the legal effect of a new rule made by the European Patent Office and think that the Article should be restricted to purely administrative practice directions. We suggest the following redraft:

"In the absence of provisions in this Convention and in the Regulations regulating the administrative practice of the European Patent Office, the European Patent Office shall establish its own rules."

6. Article 152 - Enforcement of costs and fines

Article 152, paragraph 1. We think it would be preferable to delete the words "this provision shall not apply to States". This matter should be left to the general rules of international law since States are not the only bodies with immunity from enforcement.

Article 152, paragraphs 2 and 3. These paragraphs lay down details of procedure which are not appropriate to the United Kingdom system of execution of judgements. We would prefer to replace these paragraphs by a more general provision reading as follows:

"(2) A decision of the European Patent Office taxing costs of proceedings or imposing a fine shall be enforced in a Contracting State, at the instance of the European Patent Office or other interested party, as if it were a judgement of a foreign Court whose judgements are entitled to enforcement in the Contracting State."

B. IMPLEMENTING REGULATIONS

7. Re. Article 63, No. 1 - Procedure for letters rogatory

We think it would be preferable for the relevant provisions of the Hague Convention on Civil Proceedings (the 1954 Convention has been replaced by the 1968 Convention) to be spelt out.

8. Re. Article 88, No. 3 - Continuation of grant proceedings
where a request made by a third party
is invalid

We would prefer that requests for examination from third parties should not be allowed. If, however, this is unacceptable we suggest that Re. Article 88, No. 3 should be deleted and Re. Article 101, No. 4 be extended to cover this case. There seems no need for the separate and more complicated provision.

9. Re. Article 136, No. 7 - Conservation of evidence

There seems no reason to provide for the collection of evidence for a hypothetical dispute which might never arise. We think that the Regulation is unnecessary, could have harmful effects and should be deleted. However, if it is retained it should be amended so that -

- (a) Paragraph (1) should refer to "is likely to be called upon" and not "might be called upon"; and
- (b) the applicant should be informed of the proceedings and given an opportunity to cross-examine (e.g. by treating the applicant as a party to the proceedings so that Re. Article 136, No. 1 applies).

10. Re. Article 145, No. 10 - Lapse

We do not favour extension of this Regulation to all sums owed to or by the European Patent Office. These will virtually all arise out of contracts and should be governed by the relevant law governing the contract.
