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

Brussels, 13 September 1971

BR/GT I/114/71

- Secretariat -

NOTE FROM THE GERMAN DELEGATION

The delegations of Working Party I will find annexed comments and proposals by the German delegation on certain legal questions to be discussed at the 8th meeting of Working Party I.

BR/GT I/114 e/71 eld/BS/bp

NOTE FROM THE GERMAN DELEGATION
IN PREPARATION FOR THE 8TH MEETING OF
WORKING PARTY I

A. CONVENTION

I. The doubts expressed by the United Kingdom delegation (BR/GT I/112/71) on the present wording of Article 15, paragraph 1, second sentence, could be resolved by the following new version:

"In the case of inventions by an employed person, the right to the European patent shall be determined in accordance with the legal principles governing inventions by an employed person under the law of the country in which the employee is primarily employed."

This version makes it clear at the same time that the only consideration in determining the right of the European patent in the case of inventions by an employed person is the principle place of employment of the employee at the time of making the invention.

II. 1. In Article 16 it ought above all to be made clear that a final decision by a national court on the right to a European patent applies only to those Contracting States designated in the European application in which this decision has either been made or been recognised. It should be clearly stated that

the person entitled to apply as a result of the first decision may only file a new patent application in respect of those States and that the earlier patent application is in this case deemed to have been withdrawn only in the case of those States. In the case of those Contracting States which belong to the EEC, where the European patent has a unitary character, a reservation ought however to be made, which would make it possible to settle instances of conflicting decisions by courts of those States in the Convention on the European patent for the Common Market. (

2. According to the present wording of Article 16 sentence 1, this provision should be interpreted in the sense that the person entitled to apply, pursuant to Article 15 paragraph 1, and whose right to the European patent has been established by a final decision, must file a new patent application if he wishes to acquire the right to the European patent. Such interpretation would, under various national laws, unfairly restrict the opportunities available to the person entitled to apply as opposed to the person not entitled to apply. It therefore appears imperative that the Contracting States should expressly be empowered to provide that the person entitled to apply may demand that the person not entitled to apply renounce his claim to grant of the European patent. After the final renunciation of the claim to grant of the European patent, the person entitled to apply in the Contracting States where the decision has been made or been recognised, take the place of the previous applicant.

3. A person entitled to apply who is not interested in acquiring the European patent should also have the possibility of preventing the European patent from being granted to the person not entitled to apply.

4. The following new version of Article 16 is therefore proposed.

"Article 16

Patent applications by persons not entitled to apply

(1) If a final decision has been given which recognises that a person referred to in Article 15, paragraph 1, other than the applicant, is entitled to the European patent, that person may, provided that the European patent has not yet been granted, file a new application in respect of the same invention within a period of three months following the final decision, for Contracting States designated in the patent application in which the decision has been made or been recognised. In so far as the subject-matter of the new application does not go beyond the description given in the original application, the new patent application shall be deemed to have been filed on the date of the earlier application and shall enjoy the right of priority, where applicable. The original application for a European patent shall be deemed to be withdrawn at the time of the new application for the Contracting States designated therein in which the decision has been made or been recognised, provided that those States have been designated in the new application. It will be rejected for the Contracting States designated in the original application for a European patent, in which the decision has been made or been recognised, if the person entitled to apply by virtue of the decision makes a request to that effect within the period laid down in the first sentence.

(2) The Contracting States may provide that the person entitled to apply pursuant to Article 15 paragraph 1 may demand that the person not entitled to apply renounce his claim to grant of the European patent. If a final decision has been given which obliges the applicant to renounce his claim to the grant of the European patent in favour of the person entitled to apply pursuant to Article 15 paragraph 1, the person entitled to apply shall replace the previous applicant with effect for the State designated in the patent application in which the decision has been made or been recognised. Article 22, second and third sentences, and Article 23, paragraph 2 to 4, shall be applicable.

(3) A group of Contracting States which has made use of the authority conferred by Article 8 may make provisions to cover the case of conflicting final decisions in those States.

III. Article 28a

It is proposed to delete the words "to the establishment or assignment of a right in rem". The entry of the establishment or assignment of a right in rem in the Register of European Patents would be an additional burden on the European Patent Office · as so far as the German delegation can judge, such an entry would, however, have no effect on the formation or existence of a right in rem.

IV. Article 40

The present wording of Article 40, paragraph 2 does not make it clear which law shall be applicable if it cannot be established whether damage caused by employees of the European Patent Office has occurred in the European Patent Office itself or in one of the branches referred to in Article 33 paragraph 2. The following wording is therefore proposed to clarify Article 40, paragraph 2 :

"...is located, provided that the damage is caused by employees attached to a branch referred to in Article 33 paragraph 2 ; in this case, the provisions of the law of the Contracting State in which such branch is located shall apply."

V. Article 136

1. The present provisions of the Convention and of the Implementing Regulations regarding investigation are incomplete. There is in particular a lack of provisions on the right of refusal of witnesses and experts and on previous information on the right of refusal. In addition, other penal questions are left open, such as the culpability of giving false evidence not under oath and various other problems connected with penal proceedings. Nor is the present concept of the obligatory appearance of witnesses and experts before the European Patent Office satisfactory since, because of the distances, which are sometimes considerable, between the countries of residence of the witnesses and experts and the European Patent Office,

considerable burdens are placed on third parties who are not directly concerned.

Because of the difficulties indicated, a regulation based on the following principles is proposed for study :

- (a) In principle, interested parties shall be heard before the European Patent Office.
- (b) Witnesses and experts may demand to be heard by the judicial authorities of their country of residence. A member of the Section of the European Patent Office which has requested the hearing, with powers to put questions to the witnesses or experts, may take part in the hearing.
- (c) Oaths shall be administered only by the judicial authorities of the country of residence of the interested parties, witnesses or experts (at the request of the European Patent Office).
- (d) The European Patent Office may summon witnesses and experts to appear before the European Patent Office. The following points must, however, be indicated in the summons :
 - (aa) the possibility covered by (b)
 - (bb) the evidence given before the European Patent Office may, at the request of the European Patent Office, required to be given on oath before the civil judicial authorities of the country of residence:
 - (cc) a refusal to give evidence before the European Patent Office nullifies any claim for compensation (Implementing Regulation re Article 136, No. 6) :

If these principles are adopted, the following provisions would have to be altered : Article 136, paragraphs 3, 4 and Article 136 No. 3, No. 4 (2) (c), No. 5 and No. 6 of the Implementing Regulations.

2. Article 136 paragraph 1:

Together with the United Kingdom delegation, we are of the opinion that the European Patent Office should be empowered also to take evidence ex officio. It should moreover be made clear that the list of means of evidence in paragraph 1 is not exhaustive. Furthermore it seems expedient to give a clearer wording to paragraph 1 (a) by stressing that evidence is furnished not by the appearance but by the examination of the parties. Finally, it would be useful to extend the list of means of evidence, by adding to it the acceptance of a sworn statement, since this is a commonly used means of evidence.

The following new wording of paragraph 1 is proposed :

"(1) In any proceedings before the European Patent Office the following means of evidence are in particular admissible :

- (a) the examination of the parties
- (b) to (e) as before,
- (f) the presentation of a sworn statement."

VI. Article 142

According to Article 145, No. 5 paragraph 2 of the Implementing Regulations, the parties may invoke neither the omission of notification nor any errors contained therein. This provision is unacceptable to the German delegation on constitutional grounds. Apart from constitutional considerations, the principle of

equality of opportunity will, in the German view, also be prejudiced, since the majority of decisions of the European Patent Office are provided with the notification of the possibility of appeal; thus, one section of the applicants can uphold their rights in good time on the grounds of the notification, while this possibility will be denied a few applicants for lack of sufficient notification. In order not to place the parties concerned at a greater disadvantage than all other recipients of decisions of the European Patent Office, it appears to the German delegation imperative either to provide for a sanction in Article 145 No. 5 paragraph 2 of the implementing regulations or to extend the field of application of Article 142.

It is proposed to insert the following paragraph 1 (a) in Article 142 after paragraph 1 :

"(1)(a) A case of force majeure also exists if a decision of the European Patent Office, against which an appeal is admissible, contains no notification of the possibility of appeal or an erroneous notification thereof."

VII. Article 167

Paragraph 2 of this provision affirms the competence of the International Court of Justice in differences falling under paragraph 1. The decisions of the International Court of Justice would not however be binding for the Federal Republic of Germany, since as a non-member State of the United Nations, Article 94 (1) of the United Nations Charter does not apply to it.

It is therefore proposed to draft paragraph 2 as follows:

"... be brought before the International Court of Justice by application in conformity with the Statute of the Court, for a binding decision."

B. IMPLEMENTING REGULATIONS:

I. Re. Article 136 No. 6:

Paragraph 3 could be interpreted as being a limitation on paragraphs 1 and 2. It is therefore proposed to replace the word "conditions" by "details" in paragraph 3.

II. Re. Article 145 No. 2:

It appears advisable to provide in paragraph 1 that the results of an inspection should also be taken into consideration. This could be done by adding in paragraph 1 after the words "or parties" the words "together with the results of inspection".

III. Re. Article 145 No. 7:

1. It is suggested that provision be made for a short-term interruption of proceedings also in the event of the death of the professional representative, at least in the case of compulsory representation, in order to avoid time limits expiring before the applicant for or proprietor of a patent is able to make legal representation of his interests.
2. It is furthermore suggested to examine the necessity of the words "or of other judicial proceedings being opened for the purpose of satisfying all the holders of debt claims on his estate"

in paragraph 1 (b). According to German law no other such judicial proceedings exist apart from bankruptcy proceedings. At the same time, in paragraph (2) the words "or other judicial" should be deleted.

IV. Re. Article 145 No. 9:

With a view to enabling the European Patent Office to rationalise proceedings extensively, it appears necessary to waive the requirement of signature of the responsible official. Within the Patent Office each notice will be signed by the responsible official. It should suffice that the recipient be able to recognise an official letter or communication from the European Patent Office on the basis of the letter-head or form and the indication of the responsible official's name. It is therefore proposed to delete the words "to be signed by and" in the first sentence, and the words "signature and" in the second sentence.

V. Re. Article 145 No. 10:

1. The provisions relating to lapse are incomplete. For example, rules are lacking with regard to its effect (the right to refuse to pay fees on the grounds of opposition or of the expiry of the claim?) and to the delaying of the lapse (for example through a hindrance of the judicial proceedings by force majeure). Settlement of the questions still remaining open is necessary since a supplementary reference to the general principles existing in the Contracting States with regard to lapse has not been possible until

Article 145 only applies to the reference to general principles, while the provisions relating to lapse, in the German view, relate to substantive law. It would be expedient however if the questions of lapse still remaining open are not settled in detail in the Convention or in the Implementing Regulations. It should suffice to state that Article 145 is correspondingly applicable.

2. The 6-year period of lapse is too short in respect of claims introduced, particularly when the proof of debt has been obtained shortly before the expiry of the 6-year time-limit.
3. It is therefore proposed to redraft paragraph 3 and a new paragraph 4 as follows:

"(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 or by an action. 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, unless the right has been recognised as valid judicially; in this case the lapse shall end one year after the entry into legal force of the judgement;

(4) Article 145 is correspondingly applicable."

4. It will, moreover, still have to be examined whether the provisions relating to lapse should remain in the Implementing Regulations or whether they should be transferred to the Convention.

