

BR/GT I/115 e/71

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

Luxembourg, 14 September 1971
BR/GT I/115/71

- Secretariat -

N O T E

The delegations to Working Party I will find attached proposals put forward by the French delegation, relating to:

- in Annex I, certain provisions in the Second Preliminary Draft Convention,
- in Annex II, certain provisions in the First Preliminary Draft of the Implementing Regulations.

ANNEX I

Article 15

Right to the grant of a European patent

(1) The right to a European patent shall belong to the inventor or his successor in title who first files a patent application with the European Patent Office. If the inventor is an employed person and if the national law governing a relationship between the employee and the employer grants the right to the patent either to the employer or jointly to the employer and the employee, as the case may be, the right to the European patent shall correspondingly belong, either to the employer or jointly to the employer and the employee, as the case may be.

(2) Unchanged

(3) The application for a European patent may be filed either by joint owners, or by two or more persons having sole rights in respect of one or several of the States designated. In the second case, however, the unity of the application in proceedings before the European Patent Office shall not be affected. Those holding the rights in the different States shall be regarded as joint applicants for the purpose of these proceedings.

Article 16

Patent applications by persons not entitled to apply

Note

The two Articles proposed below (Art. 16 and 16 bis) include all the provisions of Article 16 of the Second Preliminary Draft Convention and of the corresponding Articles (Re. Art. 16, Nos. 1, 2, 3 and 4) of the Implementing Regulations.

They contain in addition some new provisions arising out of observations and proposals made by the "Implementing Regulations" Sub-Committee.

Article 16

Non-entitlement to apply of the applicant for
or proprietor of the patent

Cf. Re. Art. 16, No. 1,
para. 1
and Re. Art. 16, No. 3,
paras. 1 and 2

(1) If, during the proceedings for grant or during opposition proceedings, proof is provided to the European Patent Office that proceedings have been opened for the purpose of establishing that a person referred to in Article 15, paragraph 1, of the Convention, other than the applicant for or proprietor of the patent, is entitled to the European patent, the Office shall stay proceedings for grant or opposition proceedings, unless the person who claims to be entitled to the European patent consents to the continuation of those proceedings. Such consent must be notified in writing to the European Patent Office. It shall be irrevocable. However, proceedings may not be stayed before the publication of the European patent application pursuant to Article 65 of the Convention.

Re. Art. 16, No. 1,
para. 2, 1st sentence
and Re. Art. 16, No. 3,
para. 3, 1st sentence

(2) Where proof is provided to the European Patent Office that a final decision has been given in favour of the applicant for or proprietor of the European patent in the proceedings concerning entitlement to the European patent, and that the

proceedings have been stayed in accordance with paragraph 1, the European Patent Office shall notify the person concerned that the proceedings shall be resumed with him as from this notification.

Article 15

(3) If the decision referred to in paragraph 2 is made in favour of the person claiming to be entitled to the European patent, before the patent has been granted, that person may:

- either, provided that he has not consented to the continuation of the proceedings, in accordance with paragraph 1, file a new application for the same invention within a period of 3 months as from the decision. 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 once the new application has been filed.

(Now) cf. note to
Re. Art. 16, No. 1

Cf. Re. Art. 16, No. 1,
2nd sentence

Re. Art. 16, No. 3,
2nd sentence

- or, on his own account, resume the application for a European patent, in respect of which his entitlement has been recognised. Notification of the above-mentioned decision shall stay the proceedings, where this has not been done in accordance with paragraph 1. Proceedings shall not be resumed before the expiry of a suitable period, which may not be less than 3 months.

(4) If the decision referred to in paragraph 2 is given in favour of the person who claims to be entitled to the European patent, during opposition proceedings, such proceedings shall be resumed with the new proprietor at the expiry of the period laid down in paragraph 3, second sub-paragraph. However, the party concerned may, provided that he has not consented to the continuation of the proceedings in accordance with paragraph 1, request that any possible observations by the former proprietor with regard to opposition and subsequent proceedings be regarded as not having been made. In such a case, proceedings shall be resumed as from the first notification of examination of the opposition.

Re. Art. 16, No. 1,
para. 3 and No. 3,
para. 4

(5) The time limits in force as regards the applicant for or proprietor of a European patent shall be interrupted by suspension of the proceedings. If the proceedings are resumed, the time which has not yet elapsed shall begin to run as from the day on which the notification under paragraph 2 has been given.

Re. Art. 16, No. 1,
para. 4 and No. 3,
para. 4

(6) Notification of the suspension or resumption of proceedings shall be entered in the Register of European Patents and published in the European Patent Bulletin.

Article 16 bis

Limitation of the options of withdrawal
or surrender

Re. Art. 16,
Nos. 2 and 4

As from the receipt by the European Patent Office of notification that the action or claim to entitlement to the European patent referred to in Article 16, paragraph 1, has been introduced, and up to the expiry of the period laid down in paragraphs 2 and 3 of that Article, the application or the European patent may not be withdrawn or surrendered in any of the Contracting States, save with the consent of the person who instituted the said action. If, after a period of one month from receipt of the notification, proof that such an action has been instituted has not been furnished, the applicant for or proprietor of the patent shall recover his right to withdraw or surrender until such time as this proof is provided.

Article 19

Rights conferred by a European patent application
after publication

(1) Unchanged

(2) Any Contracting State may stipulate, in respect of its own territory, that a European patent application shall not confer such protection as is conferred by Article 18. However, the protection attached to the publication of the European application may in no event be less than that which the State concerned attaches to the compulsory publication of national applications and must in any event comprise the granting of appropriate compensation to the applicant, by any person using the subject-matter of the application in the said State in circumstances where that person would be liable under national law for infringement of a national patent.

Article 22

Unitary character of the European patent application
in proceedings before the European Patent Office

The European patent application may be assigned or give rise
to rights for one or several of the designated States. The pro-
visions of Article 15, paragraph 3, second and third sentences,
shall be applicable.

Article 22a

Law applicable

Unless otherwise specified in this Convention or in a special agreement under Article 8, the assignment of a European patent application and all the deeds affecting the ownership or use of the rights which it comprises shall, in each designated State and with effect for such State, be subject to the law applicable in that Contracting State to national patent applications.

Article 23

Assignment of a European patent application

(1) (2) (3) Unchanged

(4) The assignment shall not have effect vis-à-vis the European Patent Office until the documents referred to in paragraph 2 have been received and such effect shall be only to the extent to which the assignment is verified by the latter. It shall not have effect vis-à-vis third parties, to the same extent, until after notification of such assignment has been recorded in the Register of European Patents.

Article 28a bis

Entry of the withdrawal of the patent application
in the Register of European Patents

The proprietor of a patent application may, before the patent is granted, withdraw the application by means of a written request addressed to the European Patent Office and entered ex officio in the Register of European Patents, subject to the provisions of Article 59. If rights in rem, rights of mortgaging and licensing rights have been entered in the Register of European Patents, the declaration of withdrawal shall only be admissible if it is accompanied by the written consent of the proprietors of those rights.

Article 40

Liability.

(1) The contractual liability of the European Patent Office shall be governed by the law applicable to the relevant contract, provided that the said Office does not invoke its legal immunity.

(2) In the matter of non-contractual liability, the European Patent Office, provided that it does not invoke legal immunity or immunity from enforcement, shall be bound to make good any damage caused by its employees in the performance of their duties, in accordance with the national law applicable at the place of the damage or, if the victim gives his consent thereto, in accordance with the provisions of the law of the State in which the European Patent Office is located or in which one of the branches referred to in Article 33, paragraph 2 is located, if the employees who have caused the damage are attached to one of those branches.

(3) Unchanged

(4) The courts with jurisdiction to settle disputes under paragraphs 1 and 2 shall be:

(i) for disputes under paragraph 1, the courts of the State in which the European Patent Office is located, unless the contract concluded between the parties designates another court

(ii) for disputes under paragraph 2, according to the choice of the applicant, either the competent court of the State on whose territory the damage has occurred, or the competent court of the place in which the European Patent Office or a branch of the European Patent Office is located.

Article 55a

Opposition Divisions

(1) Unchanged

(2) An Opposition Division shall consist of three technical examiners, one of whom shall assume the chairmanship. These technical examiners shall not previously have taken part in the proceedings for grant of the patent to which the opposition relates. However, the Opposition Division may - on a consultative basis - enlist a technical examiner who may have taken part in the proceedings for grant of the patent concerned. The Opposition Division may entrust the examination prior to a final decision to one of its members or to the technical examiner it has enlisted. The oral proceedings decisive. The provisions of Article 135 of this Convention shall be applicable.

Article 56

Boards of Appeal

(1) (2) Unchanged

(3)(Now) The Boards of Appeal shall be presided over by one of their legally qualified members.

Article 57

Enlarged Board of Appeal

(1) (a) Unchanged

(b) Patent Office, under the conditions laid down in Article 116 of this Convention.

(2) The Enlarged Board of Appeal shall consist of seven members:

- five legally qualified members, one of whom shall assume the chairmanship

- two technically qualified members

Article 115

Decision or opinion of the Enlarged Board of Appeal
on certain points of law

Delete the case covered by paragraph 1(b), first sub-paragraph
(in square brackets).

Article 135

membership of the Boards of Appeal
prevention from taking part

(1) Members of the Boards of Appeal or of the Enlarged Board of Appeal may not take part in an appeal proceeding if they have any personal interest therein, or if they have ever had any interest therein in any capacity. In such cases they may, however, submit observations if the Boards of Appeal or the Enlarged Board of Appeal consider it expedient.

(2) (3) Unchanged

(4) The Boards of Appeal and the Enlarged Board of Appeal shall decide as to the action to be taken in the cases specified in paragraphs 2 and 3 above without the participation of the member concerned, but after he has been heard if the Board in question considers it expedient.

(5) (New) In the event of one or more members of a Board of Appeal being prevented from taking part or objection being made to them, the Chairman of the Board must refer the matter to the Vice-President of the European Patent Office who is responsible for the departments of the European Patent Office, who shall then either:

(a) bring in one or more members of other Boards to complete the Board concerned for the purpose of deciding on the case, or
(b) after the Board concerned has relinquished the case, refer it to a different Board for decision.

(6) (New) In the event of one or more members of the Enlarged Board of Appeal being prevented from taking part or objection being made to them, they shall be replaced by:

(a) the Chairmen of the Boards of Appeal, in descending order of seniority in the office of Chairman of a Board of Appeal, when one or more legally qualified members are being replaced

(b) the technically qualified officials who are most competent in the art, as designated by the Vice-President of the European Patent Office who is responsible for the departments of the European Patent Office, when one or more technically qualified members are being replaced.

If objection to or prevention from participation results in the Enlarged Board of Appeal consisting of an even number of members, the Chairmen shall have the casting vote.

Article 136

Investigation

(1) An Examining Division, an Opposition Division or a Board of Appeal may, ex officio or at the request of the parties, order that evidence be furnished by any of the following means
(remainder unchanged).

(2) Unchanged

(3) Unchanged

(4) Parties, witnesses and experts may, by letter rogatory from the European Patent Office and in accordance with the provisions of Article 63, be heard by the judicial authorities of the country of their domicile or residence, especially if the distance from the place where the European Patent Office is located renders the journey too difficult or arduous or unless they have legitimate reason for not appearing before the appropriate department of the European Patent Office. Witnesses and experts may, by letter rogatory from the European Patent Office, be heard under oath by the judicial authorities mentioned above, at the request of the departments of the European Patent Office.

(5) If one of the parties receives notification of a decision by a department of the European Patent Office requiring his personal appearance, or the production of information or documents, or inspection as stipulated in the above-mentioned decision, and if this party either refuses to appear or appears but refuses to reply before the department of the European Patent Office or the national judicial authority required, by letter rogatory, to hear him, or refuses to furnish the requested information or documents or to allow inspection, the appropriate department of the European Patent Office may draw any legal consequences from such refusals and regard them as evidence in assessing the claims of the party concerned.

(6) Where a witness duly summoned before the European Patent Office refuses to appear without giving proof of excessive distance or offering a legitimate excuse, the European Patent Office may, by letter rogatory, require that he be heard by the judicial authorities of his country of domicile or residence.

Such witness may not claim compensation and shall bear the costs incurred in connection with his hearing.

Article 152 of this Convention shall be applicable to the decision of the European Patent Office, which shall determine the amount of such costs.

(7) Any witness duly summoned, who appears neither before the appropriate department of the European Patent Office nor before the national judicial authority instructed by letter rogatory to hear him, or who appears but, without proper reason, refuses to testify or take an oath, shall be responsible for all expenses incurred in his hearing without prejudice to the penalties that may be imposed upon him by the above-mentioned national judicial authority and the damages that may be exacted before the above-mentioned national court by the party injured by his failure to bear witness or take an oath.

Such witness may not claim compensation. Article 152 of this Convention shall apply to the decision of the European Patent Office, which shall determine the amount of the costs for which he is accountable.

(8) Each Contracting State shall treat any perjury on the part of witnesses or experts before the European Patent Office as if the offence had been committed before one of its national courts dealing with civil proceedings. On notification by the President of the European Patent Office, proceedings shall be taken against such person by the competent national judicial authorities.

Article 143

Public notice

(1) If the applicant dies, and if his heirs cannot be located, the European Patent Office shall, after a period of six months from his death, by public notice invite the heirs to establish, within a reasonable time, their rights in respect of the European patent application.

(2) Unchanged.

Article 145

Reference to general principles

- to be deleted.

Article 151

Costs in opposition proceedings

(1) Each party to opposition proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or Board of Appeal, for reasons of equity, orders a different apportionment of costs incurred during a preliminary investigation or in oral proceedings.

| | | |
|-----|---|------------|
| (2) | } | Unchanged. |
| (3) | | |

Article 152

Enforcement of costs

(1) Decisions of the European Patent Office taxing costs of proceedings shall be enforceable. this provision shall not apply to States.

(2) Decisions referred to in paragraph 1, accompanied by a request from /the European Patent Office or / the interested party, shall be addressed to the national authority designated by the Contracting State in the territory of which enforcement is to be carried out. The order for enforcement shall be appended to the decision, without other formality than verification of the authenticity of the document and notification thereof in good time to the defendant or of any measure taken to that end.

(3) When these formalities have been completed, enforcement shall be governed by the rules of civil procedure in force in the Contracting State in the territory of which it is carried out.

(4) Any dispute relating to the enforcement of the decisions of the European Patent Office mentioned in paragraph 1 shall be referred to the competent national court of the place of domicile or residence of the defendant to the enforcement. Such national court shall keep the European Patent Office informed.

Article 153

Professional representation

(1) +

(2) +

(3) +

(4) +

(5) Representation before the European Patent Office may also be undertaken by any legal practitioner or solicitor qualified in one of the Contracting States and having his registered place of business within such State, to the extent that he is able, within the said State, to act as a representative in patent matters.

ANNEX II

Implementing Regulations

Re. Article 16

No. 1
No. 2
No. 3
No. 4

- deleted (their contents are now included in Article 16 of the Convention as modified by the French delegation's proposal).

Implementing Regulations

Re. Article 53

No. 2

Allocation of duties to the Boards of Appeal

(1) Duties shall be allocated to the Boards of Appeal and the members of the various Boards of Appeal shall be designated before the beginning of each working year. Any member of a Board of Appeal may be designated in this way as a member of more than one Board of Appeal. These measures may, where necessary, be amended during the course of the year in question. In addition, at any time any member of a Board of Appeal may, exceptionally, be designated to complete one of the other Boards for the purpose of deciding on a case.

(2) Unchanged

(3) The authority referred to in paragraph 2 shall decide on conflicts regarding the apportionment of duties between two or more Boards of Appeal and, where one of these Boards relinquishes a case as a result of one or more of its members being prevented from taking part or objection being made to them, on the allocation of the case concerned to a different Board of Appeal, in accordance with Article 135.

Implementing Regulations

Re. Article 62

No. 1

Communications between the European Patent Office
and the authorities of Contracting States

First sentence unchanged.

Communications between the European Patent Office and the
courts or tribunals or other authorities ... industrial property
offices.

Implementing Regulations

Re. Article 62

No. 2

Communication of files to third parties by the
courts or tribunals or Public Prosecutors' Offices
of Contracting States

(1) The courts or tribunals or Public Prosecutors' Offices ...
payment of the fees provided for in paragraph 5 of that Article
shall not be required.

(2) The European Patent Office shall, at the time of trans-
mission to the courts or tribunals or Public Prosecutors' Offices ...
(remainder of paragraph unchanged).

Implementing Regulations

Re. Article 62

No. 3

Expenditure in respect of communications between the
European Patent Office and the authorities
of Contracting States

Text to be supplemented as follows:

Expenditure in respect of each communication effected pursuant to Article 62 of the Convention shall be chargeable, in principle, to the body making the communication. Should such communications result from a request by an interested person or by a party to proceedings pending before the European Patent Office or before the courts or tribunals or other authorities of Contracting States, costs may be chargeable to such persons by decision of the European Patent Office or by the appropriate courts or tribunals or other authorities of Contracting States, as applicable.

Implementing Regulations

Re. Article 63

No. 1

Procedure for letters rogatory

(1) Each Contracting State shall designate the national authority or authorities to which the European Patent Office shall address its letters rogatory, which shall themselves be enforceable and shall be executed according to national law or, at the request of the European Patent Office, in accordance with a special formality if such formality is compatible with the laws of the requested State (Hague Convention, Articles 9 and 14).

(2) Letters rogatory shall be drawn up in the language of the requested authority or be accompanied by a translation in the language of that authority (Hague Convention, Article 10).

(3) Without other formality than verification of the authenticity of the document, the judicial authority to which a letter rogatory is addressed must comply therewith, employing the same means of coercion as it would carrying out a commission for the authorities of the requested State. Such coercion shall not necessarily be employed if the appearance of the parties in the case is involved.

(4) The execution of a letter rogatory may be refused only if:

- (a) the authenticity of the document is not established
- (b) in the requested State, execution of the letter rogatory does not fall within the powers of the Bench.

(c) the requested State deems it likely to be prejudicial to its sovereignty or security (Hague Convention, Article 11).

(5) Should the requested national authority have no jurisdiction in the matter, the letter rogatory shall automatically be transmitted to the competent judicial authority of the same State, in accordance with the rules laid down in its legislation (Hague Convention, Article 12).

(6) In all cases where a letter rogatory is not executed by the requested authority, the latter shall immediately so inform the requesting authority, stating in the case of paragraph 4 above, the reasons why execution of the letter rogatory has been refused, and, in the case of paragraph 5 above, the authority to which the letter rogatory has been transmitted (Hague Convention, Article 13).

(7) The execution of letters rogatory shall not give rise to reimbursement of fees or costs of any kind. However the requested State shall have the right to require of the European Patent Office reimbursement of compensation paid to witnesses or experts, as well as of costs incurred by the enforced intervention of a law officer, because the witnesses would not appear of their own free will, or expenses arising from the possible application of a special formality for execution of the letter rogatory requested by the European Patent Office as provided for in paragraph 1 above.

Implementing Regulations

Re. Article 28

No. 3

Continuation of grant proceedings where a request
made by a third party is invalid

Note:

The provision should be retained in its present wording, if
a third party is to be allowed to submit a request for examination.

Implementing Regulations

Re. Article 115

No. 1

Form of the decision of the Board of Appeal

(1) The written decision shall be signed by the Chairman of the Board of Appeal and by the official of the European Patent Office who is responsible for the Secretariat of the said Board of Appeal.

(2) Unchanged.

Implementing Regulations

Re. Article 136

No. 1

Investigation by the European Patent Office

(1) Where the European Patent Office decides to undertake an investigation comprising the personal appearance of the parties, the hearing of oral evidence of witnesses and experts or the inspection of premises, it shall make a decision to this end, setting out the investigation ordered, the relevant and admissible facts to be proved, and the date, time and place of the said investigation. If oral evidence of witnesses and experts is requested by a party, the decision of the European Patent Office shall determine the period of time within which the party making the request must make known to the Office the names and addresses of the witnesses and experts whom it wishes to be heard.

(2) The parties shall be notified of the date, time and place of the hearing of witnesses and experts and of the inspection of premises, as well as of the facts to be proved. The parties may attend such preliminary investigation and may question the witnesses and experts.

Implementing Regulations

Re. Article 136

No. 3

Summons to give evidence

(1) Witnesses and experts shall be summoned to give evidence. The summons shall contain an extract from the decision mentioned in paragraph 1 of Article ... (Re. Article 136, No. 1) indicating, in particular, the date, time and place of the investigation ordered and stating the facts regarding which witnesses and experts are to be heard.

(2) In addition to the information provided for in paragraph 1 and in Article ... (remainder of paragraph unchanged).

Implementing Regulations

Re. Article 136

No. 4

Commissioning experts

(1) Expert reports may be made in writing or orally. Only one expert shall be commissioned unless the European Patent Office deems it necessary to designate three.

In the event of there being more than one expert and if the expert report is made in writing, only one report shall be prepared and only one majority opinion given. However, in the event of divergent opinions, the experts shall state the reasons for the varying opinions without giving indication of the personal opinion of each.

(2) Any party having grounds for objection to the expert or experts shall submit such objections personally or through a special representative within 15 days of the decision of the European Patent Office referred to in paragraph 1 of Article ... (Re. Article 136, No. 1) by means of a simple statement to the Office containing the reasons for objection and the evidence which he possesses or offers to verify by means of witnesses after this period an objection cannot be submitted.

The European Patent Office shall decide on the objection and this decision shall be enforceable, any appeal notwithstanding. If the objection is admitted, the same decision shall, ex officio, designate a new expert or new experts to replace the expert or experts to whom objection was made.

If the objection is rejected the party who has raised it shall meet the costs of the objection proceedings.

(3) The terms of reference of the expert shall include:

- (a) the reference to the decision of the European Patent Office provided for in paragraph 1 of Article ...
(Re: Article 136, No. 1) (remainder of
Article unchanged).

Implementing Regulations

Re. Article 136

No. 5

Hearing of witnesses and experts

Note:

- provision to be retained
- square brackets to be deleted.

Implementing Regulations

Re. Article 136

No. 6

Payment of expenses of witnesses and experts

(1) Subject to the provisions of Article 136, paragraph 7,
witnesses and experts who appear and, where applicable, testify
under oath before the European Patent Office or the national
authorities requested to hear them, by letter rogatory from the
European Patent Office, shall be entitled ... (remainder of
paragraph unchanged).

(2) Such witnesses and experts shall also be entitled
respectively to appropriate compensation for loss of earnings and
to fees for their work ... (remainder of paragraph unchanged).

(3) Unchanged.

Implementing Regulations

Re. Article 143

No. 1

Public notice

(1) The President of the European Patent Office shall determine how the public notice is to be given, a copy of which shall be communicated to the relevant judicial and administrative authorities of the State in which the last place of domicile or residence known to the European Patent Office of the deceased applicant or of his representative was situated, in order that possible heirs may be sought within the appropriate period laid down by the notice.

Implementing Regulations

No. Article 145

No. 1

Summons

(1) The parties, witnesses and experts shall be called to oral proceedings or a preliminary investigation by a summons giving a minimum of one month's notice unless they agree to a shorter period.

(2) Unchanged.

Implementing Regulations

Re. Article 145

No. 5

Notification of possibility of appeal

- (1))
 - (2))
- to be deleted

Implementing Regulations

Re. Article 145

No. 7

Interruption of proceedings

(1) ...

(b) in the event of the applicant for or proprietor of a European patent being declared bankrupt, or of other proceedings being opened for the purpose of satisfying all the holders of debt claims on his estate.

(2))
(3)) Unchanged.

Note: the adjective "judicial" has been deleted before the word "proceedings".

Implementing Regulations

Re. Article 145

No. 10

Lapse

- unchanged
 - delete the Note to this Article.
-