

BR/GT I/117 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, 16 September 1971
BR/GT I/117/71

- Secretariat -

WORKING PARTY I

WORKING DOCUMENT

SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

Articles	19
	23
	28a
	28b
	40
	57
	116
	135
	143
	151
	152
	153

FIRST PRELIMINARY DRAFT OF THE
IMPLEMENTING REGULATIONS

Re. Articles	23, No. 1
	28a, No. 1
	53, No. 2
	53, No. 2a (new)
	62, No. 1
	62, No. 2
	115, No. 1
	143, No. 1
	145, No. 7

(Texts drawn up by the Drafting Committee)

Article 19

Rights conferred by a European patent application
after publication

(1) Unchanged from Second
Preliminary Draft Convention
published 1971

(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 laws of the State concerned attach to the compulsory publication of unexamined national applications. In any event, every State shall ensure at least that, from the date of publication of a European patent application, the applicant can claim compensation reasonable in the circumstances from 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.

(3))
(4)) Unchanged from Second
(5)) Preliminary Draft Convention
published 1971

Article 23

Transfer of a European patent application

- (1) Unchanged from Second
Preliminary Draft Convention
published 1971

(2) Any transfer of a European patent application shall be recorded in the Register of European Patents at the request of the interested party or of one of the interested parties on production either of the original or of a certified copy of the instrument of transfer, or of official documents verifying the transfer, or of such extracts from such instrument or documents as suffice to establish the transfer. The request shall not be considered as made until such time as the fee prescribed for this purpose by the Rules relating to Fees adopted pursuant to this Convention has been paid.

- (3) Unchanged from Second
Preliminary Draft Convention
published 1971

(4) Any transfer shall not have effect vis-à-vis the European Patent Office until after receipt of the instrument, documents or extracts referred to in paragraph 2, it shall only become effective to the extent to which it is verified by these.

Article 28a

Entry of licences and rights in respect of a European
patent application in the Register of
European Patents

Paragraphs 2 and 3 of Article 23 shall apply to the
grant or transfer of a licence, to the establishment or
transfer of a right in rem in respect of a European patent
application and to the distraint of such an application.

Article 28b

Special regulation for Contracting States
party to a special agreement

In so far as any group of Contracting States has availed itself of the authorisation given in Article 8, this group may provide that a European patent application for which these Contracting States are designated may only be transferred, mortgaged or subjected to distrains in respect of all the Contracting States of the group and in accordance with the provisions of the special agreement.

Article 40

Liability

(1)

Unchanged from Second:
Preliminary Draft Convention
published 1971

(2) In the matter of non-contractual liability, the European Patent Office shall be bound to make good any damage caused by its employees in the performance of their duties in accordance with the provisions of the law of the State in which the European Patent Office is located, unless the damage is caused by employees attached to a branch referred to in Article 33, paragraph 2; in this event, the provisions of the law of the Contracting State in which such branch is located shall apply.

(3)

Unchanged from Second:
Preliminary Draft Convention
published 1971

(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, either the court with jurisdiction for the State in which the European Patent Office is located, or the court with jurisdiction for the State in which the branch is located, as the case may be.

Article 57

Enlarged Board of Appeal

(1) The Enlarged Board of Appeal shall be responsible for:

- (a) deciding points of law referred to it by Boards of Appeal and
- (b) giving opinions on points of law referred to it by the President of the European Patent Office, under the conditions laid down in Article 116.

(2) For giving decisions or opinions, the Enlarged Board of Appeal shall consist of seven members:

- five legally qualified members, one of whom shall be the Chairman;
- two technically qualified members.

Article 116

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

(1) In order to ensure uniform application of the law, or
if an important point of law arises:

- (a) the Board of Appeal shall, during proceedings on a case,
refer any question to the Enlarged Board of Appeal when a
decision is required for the above purposes;
- (b) the President of the European Patent Office may refer a
point of law to the Enlarged Board of Appeal where two
Boards of Appeal have given different decisions on that
question.

(2)

Unchanged from Second.
Preliminary Draft Convention
published 1971

PART VIII

COMMON PROCEDURAL PROVISIONS
OF THE EUROPEAN PATENT OFFICE

CHAPTER I

General provisions governing procedure

Article 135

Membership of the Boards of Appeal

- | | | |
|-----|---|--|
| (1) | } | |
| (2) | | Unchanged from Second |
| (3) | | Preliminary Draft Convention
published 1971 |

(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 without the participation of the member concerned.

- 9 -

Article 143

Public notice

- deleted -

BR/GT I/117 e/71 gc

CHAPTER III

Costs and their enforcement

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 from Second
Preliminary Draft Convention
published 1971 |
| (3) | | |

Article 152

Enforcement of costs and fines

Any final decision of the European Patent Office fixing the amount of costs of proceedings or imposing a fine shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of such decision shall be limited to its authenticity.

CHAPTER IV
Representation

Article 153

Professional representation

Amendment concerning the French text only.

Re. Article 23

No. 1

Examination of a request for the recording of a
transfer

A request for the recording of a transfer in the Register of European Patents may be rejected only in the event of failure to comply with the conditions laid down in Article 23, paragraph 1, and paragraph 2, first sentence, of the Convention.

Re. Article 28a

No. 1

Examination of a request for the recording and
cancellation of a licence or a right in rem

(1) A request for the recording in the Register of European Patents of:

- (a) the grant or transfer of a licence in respect of a European patent application;
- (b) the establishment or transfer of a right in rem in respect of a European patent application; or
- (c) the distraint of a European patent application;

may be rejected only in the event of failure to comply with the conditions laid down in Article 23, paragraph 2, first sentence, of the Convention.

(2)

Unchanged from First Preliminary
Draft of the Implementing
Regulations, published 1971

Re. Article 53

No. 2

Allocation of duties to the Boards of Appeal
and designation of their members

(1) Duties shall be allocated to the Boards of Appeal and the regular and alternate 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 as a member of more than one Board of Appeal. These measures may, where necessary, be amended during the course of the working year in question.

- | | | |
|-----|---|----------------------------------|
| (2) |) | Unchanged from First Preliminary |
| |) | Draft of the Implementing |
| (3) |) | Regulations, published 1971 |

Re. Article 53

No. 2a (new)

Designation of the members
of the Enlarged Board of Appeal

The authority referred to in Article ... (Re. Article 53, No. 2), paragraph 2, shall designate, before the beginning of each working year, which members of the Enlarged Board of Appeal are to be regular members and which are to be alternate members.

Re. Article 62

No. 1

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

Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the provisions of the Convention and of these Implementing Regulations shall be effected directly between these bodies. Communications between the European Patent Office and the courts or tribunals or other authorities of the Contracting States may be effected through the intermediary of the above industrial property offices.

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 of the Contracting States may, in the course of their proceedings, communicate to third parties the files concerning European patent applications or European patents transmitted to them by the European Patent Office. Such communications shall be effected in accordance with the conditions laid down in Article 149 of the Convention, with the exception that the 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 transmission to the courts or tribunals or Public Prosecutors' Offices of Contracting States, indicate such restrictions as may, under Article 149, paragraphs 1 and 4, of the Convention, be applicable to the communication to third parties of files concerning a European patent application or a European patent.

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 from First Preliminary
Draft of the Implementing
Regulations, published 1971

BR/GT I/117 c/71 gc

Re. Article 143

No. 1

Public notice

- deleted -

BR/GT I/117 e/71 gc

Re. Article 145

No. 7

Interruption of proceedings

- (1)) Unchanged from First Preliminary
-) Draft of the Implementing
- (2)) Regulations, published 1971

(3) The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the patent at the date of interruption of proceedings shall begin again as from the day on which notification under paragraph 2 has been given. If such notification is given less than two months before the end of the period within which the request for examination must be made, the authorised person may request examination up to the end of two months after such notification has been given.

- (4)) Unchanged from First Preliminary
-) Draft of the Implementing
-) Regulations, published 1971