

BR/GT I/119 e/71

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

Brussels, 30 September 1971
BR/GT I/119/71

- Secretariat -

MEMORANDUM

on the discussions held by Working Party I
(Luxembourg - 14 to 17 September 1971)
on the provisions to be re-examined
at the Working Party's 9th meeting

1. At its 8th meeting, which was held in Luxembourg from 14 to 17 September 1971, with Dr HAERTEL, President of the German Patent Office, in the Chair, and which was attended by government legal experts, Working Party I decided to resume its examination of certain of the provisions of the Preliminary Draft Convention and the Preliminary Draft of the Implementing Regulations, at its next meeting, which is scheduled to take place in Luxembourg from 12 to 22 October 1971.

The following provisions are involved :

- (i) Articles 15 and 16 of the Convention and Re. Article 16, Nos. 1 to 4, of the Implementing Regulations (Part I) ;
- (ii) Re. Article 63, No. 1, of the Implementing Regulations (Part II) ;

BR/GT I/119 e/71 ley/KM/ph

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(iii) Article 136 of the Convention and Re. Article 136, Nos. 1 and 3 to 7, of the Implementing Regulations (Part III) ;

(iv) Re. Article 145, No. 7, of the Implementing Regulation (Part IV).

2. As an aid to preparing the work, this memorandum, which is intended for the delegations to Working Party I, gives a summary of the discussions held during the examination of these provisions (1).

I

Article 15 (Right to the grant of a European patent)

Article 16 (Patent applications by persons not entitled to apply)

Re. Article 16, Nos. 1 to 4

3. The Working Party received proposals for these provisions from the following delegations :

German delegation (BR/GT I/114/71, pp. 1 to 4)

French delegation (BR/GT I/115/71, Annex I, pp. 1 to 7 and Annex II, p. 1)

Netherlands delegation
(Working document No. 3, dated 15.9.71)

Swedish delegation
(BR/GT I/110/71)

United Kingdom delegation
(BR/GT I/112/71, pp. 1 and 2).

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- (1) The minutes of the 8th meeting of Working Party I, for the attention of the delegations to the Conference, will form BR/132/71. The minutes will not detail the discussions of the Articles dealt with in this memorandum.

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The Working Party did not make a detailed study of the various proposals submitted, but restricted the scope of its discussions to certain matters of principle. The following matters were discussed:

- (A) Rules to be laid down in the Convention on the right to the grant of a European patent (Article 15)
- (B) Extent of the rights to be accorded to a person acknowledged as entitled to the grant of a European patent:
 - (a) during proceedings for grant (Article 16)
 - (b) during opposition proceedings (Article 101a)
 - (c) where appropriate, in respect of revocation actions against a granted patent (Article 133)

(A) RULES TO BE LAID DOWN IN THE CONVENTION ON THE RIGHT TO THE GRANT OF A EUROPEAN PATENT (Article 15)

The Working Party first studied the question of whether rules should be laid down in the Convention to establish who is entitled to the grant of a European patent, and on the effects of these rules on proceedings for grant before the European Patent Office.

Four theoretically possible solutions were analysed:

(a) First solution

The first solution would be the deletion of Article 15, paragraph 1, the definition of the right to the grant of a European patent being left entirely to national laws. Only the applicant would be considered entitled to the grant of a patent in proceedings for grant before the European Patent Office. Anyone wishing to claim ownership of the invention could take the appropriate steps before the national courts, but the establishment of his right could not have effect until after the grant of the patent.

7. The Working Party considered that it could hardly advocate this solution, particularly in view of the following two objections:

- (i) anyone whose right to the patent was established by a national judge would have to wait until the end of the proceedings for grant in order to exercise this right,
- (ii) he would have to institute as many actions before the national courts as there were States designated in the granted patent.

(b) Second solution

8. A second solution might be to invest the European Patent Office with the central authority to decide who is entitled to the patent.
9. Since it is impossible to standardise the laws on ownership of inventions for all the European States which may become Contracting Parties to the Convention, rules would have to be laid down in Article 15 of the Convention to determine which national laws would be applicable in each case. The European Patent Office would then have the task of applying twenty or so different national laws according to each individual case; this would be practically impossible if it is desired to retain the nature and structure hitherto envisaged for the European Patent Office.

Apart from this practical objection some delegations made the objection of principle to the idea that disputes traditionally falling within the sphere of property law should be dealt with by authorities other than national civil courts.

For these reasons the Working Party considered that the second solution should not be adopted.

(c) Third solution

10. The third solution was to the effect that if a person can invoke, before the European Patent Office, a national final decision, acknowledging his entitlement to a European patent, such person would be called upon to replace the initial applicant in the grant proceedings before the European Patent Office, with effect for all the countries designated in the application.

This solution would leave open the possibility, for all interested parties, of claiming the right to a European patent, after it has been granted, before the competent national courts in the States designated, other than the State where the final judgement has been rendered or other States where this judgement is recognised.

A number of delegations expressed their interest in this solution.

11. It was observed, in the first instance, that this solution would not entail untoward interference in national rights. At the stage of patent grant proceedings before the Office, such a judgement given by a court in a Contracting State would have only a limited effect vis-à-vis all the States designated in the application. Thus there would be no question of providing for a contractual system for the automatic recognition of such judgements between the Contracting States to the Convention.

Nevertheless, it appeared that, for this solution to be adopted, it would be necessary to go as far as possible towards laying down rules in the Convention to determine who actually is entitled to the invention; and at all events towards laying down very specific rules in the Convention to determine the law applicable and the competent court.

12. As to the criteria which might be envisaged to determine the country whose courts would be competent in each case, one delegation suggested the following:

- (i) if the parties in dispute reside in the same State, the courts of that State ;
- (ii) if the dispute concerns an employment contract, the courts of the State whose legislation is applicable to the contract under the terms of Article 15 ;
- (iii) if the dispute concerns misappropriation the courts of the State where the misappropriation is alleged to have taken place ;
- (iv) if the dispute concerns a transfer, contractual or otherwise, of the right to obtain a patent, the courts of the State whose legislation is applicable to the transfer ;
- (v) in all other cases, the courts of the State where the European Patents Office is located.

13. The Working Party's attention was most particularly drawn to the case - most frequent in practice - of a dispute over the right to a patent, as between an employer and employee. A detailed suggestion to meet this eventuality was expressly made in the French delegation's proposal. The German and Netherlands delegations advocated the introduction of a provision whereby the legislation of the State in which the employee carries on his main activity would apply.

The same criterion of the employee's main place of activity was proposed by the United Kingdom delegation, which nevertheless suggested the application of the national law which the competent judge would apply. One delegation spoke out against this proposal on the grounds that the determination of which legislation was applicable would be fraught with uncertainty, as the legislation which the judge would apply was interpreted as comprising provisions under international private law.

Finally it was observed that this solution could equally well be applied to non-contracting countries if the envisaged rules provided for the application of the legislation of a non-contracting country or recognised the competence of a court in such a country.

(c) Fourth solution

A fourth solution, which was supported by the German delegation, provides that if a person can invoke a final decision which recognises his right to a European patent, he can submit a new application in respect of the same invention, and be entitled to the same date of filing or the same priority as in the case of the previous application, for the State designated in the previous application in which the judgement has effect, as well as for the other States designated in which the judgement is recognised.

The application filed previously would be deemed to be withdrawn as from the date of filing the new application, in respect of all the States designated in which the judgement has effect or is recognised. For the other States, the previous application could be maintained by the initial applicant and the grant proceedings continued.

16. In theory, this solution would appear to be straightforward and to preclude any interference in the Contracting States' legislation.

However, certain practical difficulties were pointed out :

- (i) it might prove difficult to follow a unitary grant procedure with two applicants who have just been opposed in a dispute
- (ii) similar difficulties might arise if the second applicant were recognised as having a right limited to a part of the subject matter of the previous application.

The German delegation nevertheless felt that these difficulties could be surmounted by providing, as an exception, for the grant proceedings to be kept separate in such cases.

17. As for the possibility of applying this solution to judgements rendered by courts in countries which are not parties to the Convention, it was observed that the interested party should obtain recognition in a designated Contracting State, before being able to invoke this recognition in that State and the other designated States which recognise its judgements. Such a procedure is in fact less complicated than it might seem, for, at least as far as all the EEC Member States are concerned, bound as they are by a Convention providing for mutual recognition of civil judgements, it would suffice to secure recognition of the judgement in any one of them.

18. One delegation raised another possible solution: whenever a dispute concerning the applicant's right to obtain a patent was brought before it, the European Patent Office would refer the case to the competent national court determined by the relevant rules of reference procedure, to be laid down in the Convention, and would suspend the grant proceedings.

19. Besides seeking solutions as summarised above, some delegations put forward general observations on the question.

One remark was to the effect that the number of cases of the right to the grant of a patent being challenged, which were likely to lead to a final decision during the stage of the patent grant proceedings, should not be overestimated, because of the time factor.

The Working Party was of the opinion nevertheless that a stipulation to this effect was necessary in the Convention.

It was further observed that in the context of the second Convention a homogeneous solution would have to be found with regard to the rights which should be accorded to the person entitled vis-à-vis an unentitled proprietor of a Community patent. Even if this solution to the question of European patent applications could be transposed to the States which will be parties to the second Convention (EEC States, and probably the States which have applied for membership of the European Communities), the problem would remain unchanged in cases where other Contracting States to the first Convention were also designated in the application.

20. The Chairman concluded from this exchange of views that the Working Party appeared to favour a solution on the lines of the third one set forth above.

(B) EXTENT OF THE RIGHTS TO BE ACCORDED TO A PERSON
ACKNOWLEDGED AS ENTITLED TO THE GRANT OF A EUROPEAN
PATENT

21. If it is assumed that the problem of the rules governing the right to the grant of a European patent can be settled in Article 15, paragraph 1, of the Convention, the question arises as to the rights to be accorded to a person acknowledged as entitled to this right. This problem arises :

- (a) at the stage of grant proceedings,
- (b) at the stage of opposition proceedings,
- (c) in the event of revocation proceedings against a patent that has been granted.

- (a) Extent of the rights to be accorded to a person
acknowledged as entitled to the grant of a European
patent, during grant proceedings, where the application
has been made by a person not entitled to apply
(Article 16)

22. At present the only right held by the person entitled to apply by virtue of Article 16 is that of filing a new application, the original application being deemed thenceforth to have been withdrawn. (The question of whether the new application will cover all the States designated in the former one or only those in which the judgment will have force of law or be recognised, depends upon the solution to be found to the problem raised under point (A) above.

The Working Party proposed to examine at a later date the possibility, requested by several delegations, of granting further rights to the person acknowledged as entitled to apply, in particular, the right of resuming a former application on his own behalf and that of requiring that an application already filed by a person not entitled to do so, be rejected.

- (b) Extent of the rights to be accorded to a person acknowledged as entitled to obtain a European patent, during opposition proceedings, in the case of a patent being granted to a person not entitled thereto.
(Article 101a)

23. The Working Party mooted the possibility of inserting in Article 101a, among the grounds for opposition, a new ground concerning misappropriation of the invention. It was pointed out that no provision could be made for such a case, since the European Patent Office could only give rulings on opposition proceedings on grounds relating to the patentability of inventions. To introduce grounds based on misappropriation would have the effect of requiring the European Patent Office to give rulings concerning the ownership of inventions, with all the disadvantages and objections that this would entail, as was mentioned in respect of grant proceedings. Furthermore, any decisions taken on such a point would bear the risk of not being valid in all the designated States, and this would be contrary to the principle of the unitary nature of opposition proceedings.

24. Certain delegations wondered whether it would not be possible to extend the solution to be adopted for Article 16 to cover the stage of opposition proceedings. Two possible formulae were mentioned in this connection:

- (i) Where a person invokes a final decision before the European Patent Office during opposition proceedings, that person takes the place of the proprietor of the patent until the conclusion of proceedings, with effect in all the States designated, or, as the case may be, with effect solely in those States in which the judgment is recognised.
- (ii) The European Patent Office could, if the question were raised before it, be empowered to suspend opposition proceedings pending a decision by the competent national court or tribunal.
- (c) Advisability of making provision for misappropriation of the right to the grant of a European patent to be deemed as providing grounds for the revocation of a patent already granted. (Article 133)

25. The Working Party examined the advisability, or otherwise, of making provision in Article 133 of the Convention for misappropriation of the right to the grant of a European patent to be deemed to provide an additional ground for revocation.

In the absence of a mention of any such grounds in the Convention, the victim of misappropriation of this right, may obtain from a national court or tribunal acknowledgement of his right and consequently, following the grant of the patent, may have the patent assigned to him; he cannot, on the other hand, open judicial proceedings to obtain the revocation of a European patent on the grounds that the proprietor was not entitled to be granted it. Consequently, the interested party could not obtain a declaration revoking the patent with effect ex-tunc.

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Certain delegations, without underestimating the importance of this point, argued that on a practical level, the consequences of the absence of such a ground for revocation from the Convention would be relatively limited, in view of the national channels for obtaining recognition of the right to the patent, open to the person entitled, who could then renounce this right in such a way that the invention would from that moment become public property.

The Working Party did not at this stage reach any conclusions on the problem.

II

Re. Article 63, No. 1 (Procedure for letters rogatory)

26. The Working Party agreed in principle to a proposal from the French and United Kingdom delegations to replace the reference in paragraph 3 of this Article by the full text of those of the Articles of the Hague Convention on Civil Proceedings which refer to letters rogatory.

However, since the Hague Convention of 1 March 1954 on Civil Proceedings to which the Article under examination refers was revised by the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, concluded on 18 March 1970, the Working Party considered that it would be appropriate to include the text of the provisions relating to letters rogatory in their most recent version.

The Working Party instructed the Secretariat to circulate the relevant Articles of the 1970 Hague Convention: these Articles are reproduced in Annex I to this Note. It agreed to continue examining the question at its October meeting.

III

Article 136 (Investigations)

27. The Working Party received two proposals, one from the French delegation (BR/GT I/115/71, Annex I, pages 20 to 22), and the other from the German delegation (BR/GT I/114/71, pages 5 and 6).

The Working Party concentrated upon discussing the second proposal, which would involve a considerable change to the whole Article.

28. As regards paragraph 1, the Working Party took the following decisions:

- (a) It should be possible for evidence to be furnished not only at the instance of the parties but also at that of the European Patent Office.
- (b) The list of means of obtaining evidence should be indicative, not exhaustive.

(c) Personal examination of the parties, as against their mere appearance, should constitute a means of obtaining evidence.

(d) Statements on oath or affirmation have been added to the list.

29. As regards arrangements for examination of the parties, witnesses and experts, the Working Party came to the following conclusions:

(a) The European Patent Office may summon the parties, witnesses or experts to appear before it to testify, but should also be empowered, where it does not consider it necessary for those in question to travel to the Office itself, to request, by letters rogatory, of the competent judicial authorities in the country of residence, that they hear the evidence, where appropriate, on oath.

(b) The parties, witnesses or experts summoned before the European Patent Office should, if they so wish, be entitled not to appear before the Office but to be heard by the judicial authorities in their own country of residence.

The purpose of this formula was to avoid having to deal in the Convention with witnesses' right to refuse to give evidence; in this respect, national provisions would apply.

One delegation pointed out that this solution would in most cases mean that a party would have no opportunity to question witnesses or experts directly, which it would have been able to do in a hearing before the European Patent Office.

- (c) The Working Party decided, by majority vote, to delete paragraph 3 which made provision for the hearing of witnesses and experts on oath before the European Patent Office. It was understood that the Office would have the right, wherever it thought necessary, to require that a statement be repeated under oath before the competent national court or tribunal in the country of residence of the witness or expert.

The Working Party adopted this formula rather than that involving simple confirmation, given on oath before the said national court or tribunal, of the evidence given before the European Patent Office, since the text of the Hague Convention on the Taking of Evidence Abroad in Civil and Commercial Matters did not make it clear whether such an act, taken in isolation, might be considered as a judicial act, liable to be the subject of letters rogatory. (This text is given in Annex I).

The United Kingdom delegation expressed a reservation concerning the formula adopted. For one thing, repetition of a statement before a national court or tribunal might give rise to results different - if only in shades of meaning - from the results of a statement made before the European Patent Office. Furthermore, this formality seemed in no way useful for the information of the European Patent Office. The United Kingdom delegation would, in addition, object in principle to the possibility of having evidence confirmed by an oath given subsequently.

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- (d) In view of the decision referred to under (b) the Working Party has decided not to maintain the option hitherto held by the European Patent Office to impose a fine on a witness or expert who fails to appear after service of a summons on him in proper form. The means of coercion to be employed in the case of a refusal to appear before the national courts will be determined by the national law of the competent court. Paragraph 4 has therefore been deleted.
- (e) In view of the decision referred to under (c), the Working Party decided by a majority to delete paragraph 5, which allowed the Contracting States to take penal proceedings against perjuries before the European Patent Office. Proceedings will be taken against a perjury offence on the part of a witness or expert before a national court in accordance with the law of the State in question, without it being necessary to make provision for this in the Convention.
- (f) In view of the peculiarly technical nature of the evidence involved in the patent field and of the risk that if too wide a use is made of the option of giving evidence before courts situated in the place of residence, the European Patent Office may find itself obliged to work almost exclusively from written documents drawn up by national judges who may not necessarily be very experienced in this field, it was observed that, if the European Patent Office considers it appropriate, provision should be made for the department of the European Patent Office which requested the hearing, to delegate one of its members to take part in the hearing by the national court, this member being given full powers to put questions to the parties, the witnesses or the experts.

Certain delegations argued, however, that a provision of this nature would go well beyond what is laid down in the Hague Convention on the Taking of Evidence Abroad in Civil and Commercial Matters. This states that participation by a member of a foreign court is subject to a declaration of acceptance by the State in question.

In view of this observation, the Working Party agreed to re-examine the problem.

- (g) As regards parties, witnesses and experts from non-contracting countries, the Working Party was conscious that it was not possible to lay down binding formulae like those adopted for parties, witnesses and experts from the Contracting States. However, it appeared that in practice, a situation of this nature would not cause real difficulties vis-à-vis investigation by the departments of the European Patent Office. Article 136 should be drafted in a manner sufficiently general to enable it to be applied, where necessary, by the consenting courts of non-contracting countries.

Re. Article 136, No. 1 (Investigation by the European Patent Office)

30. The French delegation proposed that it should be laid down that when the European Patent Office decides to hear the evidence of parties, witnesses or experts or to inspect premises, it should take a decision on the means it intends to employ to do this.

Certain delegations observed that this would introduce a new and purely formal element into the proceedings and would involve a move away from the wording of the corresponding articles of the Rules of Procedure of the Court of Justice of the European Communities, upon which the wording of the provisions had been based.

The Working Party nevertheless decided, by a majority, to accept the French delegation's proposal.

Re. Article 136, No. 3 (Summons to give evidence)

31. The Working Party decided to make certain textual amendments as a direct result of the amendment to Article (Re. Article 136, No. 1).

The Working Party also agreed to include in this Article the provisions of Article (Re. Article 145, No. 1) paragraph 1.

Finally, the Working Party agreed to lay down in this Article that the attention of the party, witnesses or expert summoned before the European Patent Office ought to be specifically drawn to his right to be heard by the competent judicial authority of his country.

Re. Article 136, No. 4 (Commissioning experts)

32. The Working Party considered that it should be made clear in the text that this Article applies only to experts designated by the European Patent Office.

33. The Working Party did not adopt a proposal made by the French delegation to the effect that the number of experts who may be called upon to give opinions (one or two) and the procedures for drawing up the report in the event of the expert opinions being given by three members, should be specified.
34. The Working Party noted its agreement in principle to a proposal made by the same delegation that provision should be made for the parties to object to an expert. It nevertheless considered that it was not necessary at that stage to make detailed provisions on this matter in the Implementing Regulations, and that it should be sufficient to state the principle in the Implementing Regulations and let the European Patent Office base its decision on objections to experts on the principles generally recognised in the Contracting States.
35. In view of the deletion of Article 136, paragraph 3, the Working Party finally deleted paragraph 2 (c).
- Re. Article 136, No. 5 (Hearing of witnesses and experts)
36. In view of the solution adopted in Article 136 as regards oaths, the Working Party noted its agreement on the deletion of the part of the first sentence printed in square brackets and the second sentence, which have become superfluous.
- Re. Article 136, No. 6 (Payment of expenses of witnesses and experts)
37. The Working Party amended the drafting of paragraph 3 of this Article.

One delegation raised the problem of the deduction of amounts paid as an allowance to witnesses and experts by the national courts hearing them. In reply it was said that the solution to the problem would be provided in the provisions to be drawn up for Article ... (Re. Article 63, No. 1), which would include the content of Article 14 of the Hague Convention on Taking Evidence Abroad in Civil and Commercial Matters. (cf. Part II above).

Re. Article 136, No. 7 (Conservation of evidence)

9. The United Kingdom delegation stated the reasons why it wished this provision to be deleted. Not only did the possibility of proceeding on request with an investigation before being certain that proceedings will in fact be instituted in the future seem superfluous where patents are concerned, but it could also be used malevolently against the applicant by interested third parties. (It would for example be possible to obtain information in this way that would otherwise have remained secret. Should it prove urgently necessary to make facts known before the opening of opposition proceedings, the interested parties may, after the publication of the application, avail themselves of the option of presenting observations to the European Patent Office, as provided for in Article 87 of the Convention.

10. The German delegation proposed that the Article in question should be retained, but with an amended paragraph 1, reading as follows :

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(1) On request, the European Patent Office may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision which it will probably have to take with regard to an existing application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The time of such measures to conserve evidence shall be notified to the applicant in sufficient time to enable him to be present when such measures are to be taken.

41. The Working Party did not have time to come to a decision as regards the two afore-mentioned proposals.

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42. In conclusion, the Working Party instructed the Drafting Committee to draw up the provisions that it had examined, with the exception of Article ... (Re. Article 136, No. 7), on the basis of the decisions taken and to submit to it the result of its work before the next meeting.

The texts thus drawn up by the Drafting Committee are contained in Annex II to this note.

IV

Re. Article 145, No. 7 (Interruption of proceedings)

43. Regarding the suggestion that proceedings should be interrupted in the event of the death of the professional representative some delegations expressed doubts as to the utility of such a provision, since, if necessary, the European Patent Office may extend periods pursuant to Article 141.

However, in view of the very important position occupied, de facto if not de jure, by representatives in proceedings before the European Patent Office, the Working Party adopted the German proposal, subject to reconsideration of its decision, if need be, in the light of such observations as interested circles might put forward.

The Working Party was of the opinion that the solution adopted should be applied to representatives without distinction, whether their appointment was compulsory or not, in order to preserve equal treatment between applicants of Contracting States and third countries.

While the Drafting Committee was engaged in its work, the question arose as to whether it would not be advisable also to make provision for interruption of the proceedings in the event of a representative becoming legally incapable. But such an eventuality might give rise to practical difficulties in determining the beginning and the end of the interruption. The Working Party decided to hold this question over for examination at its October 1971 meeting, on the basis of a proposal which the German delegation was invited to put forward.

44. As to the other problem raised by the German delegation, namely whether it was appropriate to refer to "other judicial proceedings" under paragraph 1(b), side by side with "in the event of ... being declared bankrupt", the French and United Kingdom delegations remarked that their respective national laws did in fact provide for judicial proceedings other than those for bankruptcy, "for the purpose of satisfying all the holders of debt claims on the debtor's estate". Such proceedings might also exist in the national laws of other States participating in the Conference.

After the United Kingdom delegation had moreover stated that certain non-judicial proceedings known under British law should also be covered by the provision in question, the Working Party agreed that this provision should be amended in such manner that it would adopt as the criterion only the truly decisive factor, namely the legal impossibility for the applicant for or proprietor of a European patent to continue with proceedings as a result of some action taken against his property.

45. The provisional text of this Article drawn up by the Drafting Committee is contained in Annex III.
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ANNEX I

III. CONVENTION ON THE TAKING OF EVIDENCE ABROAD IN CIVIL OR COMMERCIAL MATTERS ⁽¹⁾

(Concluded March 18, 1970,

The States signatory to the present Convention,
Desiring to facilitate the transmission and execution of Letters of
Request and to further the accommodation of the different methods
which they use for this purpose,
Desiring to improve mutual judicial co-operation in civil or
commercial matters,
Have resolved to conclude a Convention to this effect and have
agreed upon the following provisions:

CHAPTER I - LETTERS OF REQUEST

Article 1

In civil or commercial matters a judicial authority of a Contracting State may, in accordance with the provisions of the law of that State, request the competent authority of another Contracting State, by means of a Letter of Request, to obtain evidence, or to perform some other judicial act.

A Letter shall not be used to obtain evidence which is not intended for use in judicial proceedings, commenced or contemplated.

The expression 'other judicial act' does not cover the service of judicial documents or the issuance of any process by which judgments or orders are executed or enforced, or orders for provisional or protective measures.

Article 2

A Contracting State shall designate a Central Authority which will undertake to receive Letters of Request coming from a judicial authority of another Contracting State and to transmit them to the authority competent to execute them. Each State shall organize the Central Authority in accordance with its own law.

Letters shall be sent to the Central Authority of the State of execution without being transmitted through any other authority of that State.

Article 3

A Letter of Request shall specify—

- a) the authority requesting its execution and the authority requested to execute it, if known to the requesting authority;
- b) the names and addresses of the parties to the proceedings and their representatives, if any;
- c) the nature of the proceedings for which the evidence is required, giving all necessary information in regard thereto;
- d) the evidence to be obtained or other judicial act to be performed.
Where appropriate, the Letter shall specify, *inter alia*—
- e) the names and addresses of the persons to be examined;
- f) the questions to be put to the persons to be examined or a statement of the subject-matter about which they are to be examined;
- g) the documents or other property, real or personal, to be inspected;
- h) any requirement that the evidence is to be given on oath or affirmation, and any special form to be used;
- i) any special method or procedure to be followed under Article 9.

(1) Extract from the text edited by
the Permanent Bureau of the Hague
Conference on International
Private Law - Martinus Nijhoff -
The Hague - 1970.

A Letter may also mention any information necessary for the application of Article 11.

No legalization or other like formality may be required.

Article 4

A Letter of Request shall be in the language of the authority requested to execute it or be accompanied by a translation into that language.

Nevertheless, a Contracting State shall accept a Letter in either English or French, or a translation into one of these languages, unless it has made the reservation authorized by Article 33.

A Contracting State which has more than one official language and cannot, for reasons of internal law, accept Letters in one of these languages for the whole of its territory, shall, by declaration, specify the language in which the Letter or translation thereof shall be expressed for execution in the specified parts of its territory. In case of failure to comply with this declaration, without justifiable excuse, the costs of translation into the required language shall be borne by the State of origin.

A Contracting State may, by declaration, specify the language or languages other than those referred to in the preceding paragraphs, in which a Letter may be sent to its Central Authority.

Any translation accompanying a Letter shall be certified as correct, either by a diplomatic officer or consular agent or by a sworn translator or by any other person so authorized in either State.

Article 5

If the Central Authority considers that the request does not comply with the provisions of the present Convention, it shall promptly inform the authority of the State of origin which transmitted the Letter of Request, specifying the objections to the Letter.

Article 6

If the authority to whom a Letter of Request has been transmitted is not competent to execute it, the Letter shall be sent forthwith to the authority in the same State which is competent to execute it in accordance with the provisions of its own law.

Article 7

The requesting authority shall, if it so desires, be informed of the time when, and the place where, the proceedings will take place, in order that the parties concerned, and their representatives, if any, may be present. This information shall be sent directly to the parties or their representatives when the authority of the State of origin so requests.

Article 8

A Contracting State may declare that members of the judicial personnel of the requesting authority of another Contracting State may be present at the execution of a Letter of Request. Prior authorization by the competent authority designated by the declaring State may be required.

Article 9

The judicial authority which executes a Letter of Request shall apply its own law as to the methods and procedures to be followed.

However, it will follow a request of the requesting authority that a special method or procedure be followed, unless this is incompatible with the internal law of the State of execution or is impossible of performance by reason of its internal practice and procedure or by reason of practical difficulties.

A Letter of Request shall be executed expeditiously.

Article 10

In executing a Letter of Request the requested authority shall apply the appropriate measures of compulsion in the instances and to the same extent as are provided by its internal law for the execution of orders issued by the authorities of its own country or of requests made by parties in internal proceedings.

Article 11

In the execution of a Letter of Request the person concerned may refuse to give evidence in so far as he has a privilege or duty to refuse to give the evidence—

- a) under the law of the State of execution; or
- b) under the law of the State of origin, and the privilege or duty has been specified in the Letter, or, at the instance of the requested authority, has been otherwise confirmed to that authority by the requesting authority.

A Contracting State may declare that, in addition, it will respect privileges and duties existing under the law of States other than the State of origin and the State of execution, to the extent specified in that declaration.

Article 12

The execution of a Letter of Request may be refused only to the extent that—

- a) in the State of execution the execution of the Letter does not fall within the functions of the judiciary; or
- b) the State addressed considers that its sovereignty or security would be prejudiced thereby.

Execution may not be refused solely on the ground that under its internal law the State of execution claims exclusive jurisdiction over the subject-matter of the action or that its internal law would not admit a right of action on it.

Article 13

The documents establishing the execution of the Letter of Request shall be sent by the requested authority to the requesting authority by the same channel which was used by the latter.

In every instance where the Letter is not executed in whole or in part, the requesting authority shall be informed immediately through the same channel and advised of the reasons.

Article 14

The execution of the Letter of Request shall not give rise to any reimbursement of taxes or costs of any nature.

XX TAKING OF EVIDENCE

159

Nevertheless, the State of execution has the right to require the State of origin to reimburse the fees paid to experts and interpreters and the costs occasioned by the use of a special procedure requested by the State of origin under Article 9, paragraph 2.

The requested authority whose law obliges the parties themselves to secure evidence, and which is not able itself to execute the Letter, may, after having obtained the consent of the requesting authority, appoint a suitable person to do so. When seeking this consent the requested authority shall indicate the approximate costs which would result from this procedure. If the requesting authority gives its consent it shall reimburse any costs incurred; without such consent the requesting authority shall not be liable for the costs.

ANNEXE I

CONVENTION SUR L'ORTITION DES R OGATOIRES A L'ETRANGER EN MATIERE CIVILE OU COMMERCIALE

(Conclue le 18 mars 1970)

Les Etats signataires de la présente Convention,
Désirant faciliter la transmission et l'exécution des commissions
rogatoires et promouvoir le rapprochement des diverses méthodes
qu'ils utilisent à ces fins,

Soucieux d'accroître l'efficacité de la coopération judiciaire mu-
tuelle en matière civile ou commerciale,

Ont résolu de conclure une Convention à ces effets et sont
convenus des dispositions suivantes:

CHAPITRE I - COMMISSIONS ROGATOIRES

Article premier

En matière civile ou commerciale, l'autorité judiciaire d'un Etat
contractant peut, conformément aux dispositions de sa législation,
demander par commission rogatoire à l'autorité compétente d'un
autre Etat contractant de faire tout acte d'instruction, ainsi que
d'autres actes judiciaires.

Un acte d'instruction ne peut pas être demandé pour permettre
aux parties d'obtenir des moyens de preuves qui ne soient pas destinés
à être utilisés dans une procédure engagée ou future.

L'expression «autres actes judiciaires» ne vise ni la signification
ou la notification d'actes judiciaires, ni les mesures conservatoires ou
d'exécution.

Article 2

Chaque Etat contractant désigne une Autorité centrale qui assume
la charge de recevoir les commissions rogatoires émanant d'une
autorité judiciaire d'un autre Etat contractant et de les transmettre à
l'autorité compétente aux fins d'exécution. L'Autorité centrale est
organisée selon les modalités prévues par l'Etat requis.

Les commissions rogatoires sont transmises à l'Autorité centrale
de l'Etat requis sans intervention d'une autre autorité de cet Etat.

Article 3

La commission rogatoire contient les indications suivantes:

- a) l'autorité requérante et, si possible, l'autorité requise;
- b) l'identité et l'adresse des parties et, le cas échéant, de leurs repré-
sentants;
- c) la nature et l'objet de l'instance et un exposé sommaire des faits;
- d) les actes d'instruction ou autres actes judiciaires à accomplir.
Le cas échéant, la commission rogatoire contient en outre:
 - e) les nom et adresse des personnes à entendre;
 - f) les questions à poser aux personnes à entendre ou les faits sur les-
quels elles doivent être entendues;
 - g) les documents ou autres objets à examiner;
 - h) la demande de recevoir la déposition sous serment ou avec
affirmation et, le cas échéant, l'indication de la formule à utiliser;
 - i) les formes spéciales dont l'application est demandée conformé-
ment à l'article 9.

(1) Extrait du texte édité par le Bureau
permanent de la Conférence de La Haye
de Droit International Privé -
Martinus Nijhoff - La Haye - 1970.

151

XX OBTENTION DES PREUVES

La commission rogatoire mentionne aussi, s'il y a lieu, les renseignements nécessaires à l'application de l'article 11.

Aucune légalisation ni formalité analogue ne peut être exigée.

Article 4

La commission rogatoire doit être rédigée dans la langue de l'autorité requise ou accompagnée d'une traduction faite dans cette langue.

Toutefois, chaque Etat contractant doit accepter la commission rogatoire rédigée en langue française ou anglaise, ou accompagnée d'une traduction dans l'une de ces langues, à moins qu'il ne s'y soit opposé en faisant la réserve prévue à l'article 33.

Tout Etat contractant qui a plusieurs langues officielles et ne peut, pour des raisons de droit interne, accepter les commissions rogatoires dans l'une de ces langues pour l'ensemble de son territoire, doit faire connaître, au moyen d'une déclaration, la langue dans laquelle la commission rogatoire doit être rédigée ou traduite en vue de son exécution dans les parties de son territoire qu'il a déterminées. En cas d'inobservation sans justes motifs de l'obligation découlant de cette déclaration, les frais de la traduction dans la langue exigée sont à la charge de l'Etat requérant.

Tout Etat contractant peut, au moyen d'une déclaration, faire connaître la ou les langues autres que celles prévues aux alinéas précédents dans lesquelles la commission rogatoire peut être adressée à son Autorité centrale.

Toute traduction annexée à une commission rogatoire doit être certifiée conforme, soit par un agent diplomatique ou consulaire, soit par un traducteur assermenté ou juré, soit par toute autre personne autorisée à cet effet dans l'un des deux Etats.

Article 5

Si l'Autorité centrale estime que les dispositions de la Convention n'ont pas été respectées, elle en informe immédiatement l'autorité de l'Etat requérant qui lui a transmis la commission rogatoire, en précisant les griefs articulés à l'encontre de la demande.

Article 6

En cas d'incompétence de l'autorité requise, la commission rogatoire est transmise d'office et sans retard à l'autorité judiciaire compétente du même Etat suivant les règles établies par la législation de celui-ci.

Article 7

L'autorité requérante est, si elle le demande, informée de la date et du lieu où il sera procédé à la mesure sollicitée, afin que les parties intéressées et, le cas échéant, leurs représentants puissent y assister. Cette communication est adressée directement auxdites parties ou à leurs représentants, lorsque l'autorité requérante en a fait la demande.

Article 8

Tout Etat contractant peut déclarer que des magistrats de l'autorité requérante d'un autre Etat contractant peuvent assister à l'exécution d'une commission rogatoire. Cette mesure peut être soumise à l'autorisation préalable de l'autorité compétente désignée par l'Etat déclarant.

Article 9

L'autorité judiciaire qui procède à l'exécution d'une commission rogatoire, applique les lois de son pays en ce qui concerne les formes à suivre.

Toutefois, il est déferé à la demande de l'autorité requérante tendant à ce qu'il soit procédé suivant une forme spéciale, à moins que celle-ci ne soit incompatible avec la loi de l'Etat requis, ou que son application ne soit pas possible, soit en raison des usages judiciaires de l'Etat requis, soit de difficultés pratiques.

La commission rogatoire doit être exécutée d'urgence.

Article 10

En exécutant la commission rogatoire, l'autorité requise applique les moyens de contrainte appropriés et prévus par sa loi interne dans les cas et dans la même mesure où elle y serait obligée pour l'exécution d'une commission des autorités de l'Etat requis ou d'une demande formulée à cet effet par une partie intéressée.

Article 11

La commission rogatoire n'est pas exécutée pour autant que la personne qu'elle vise invoque une dispense ou une interdiction de déposer, établies:

- a) soit par la loi de l'Etat requis; ou
- b) soit par la loi de l'Etat requérant et spécifiées dans la commission rogatoire ou, le cas échéant, attestées par l'autorité requérante à la demande de l'autorité requise.

En outre, tout Etat contractant peut déclarer qu'il reconnaît de telles dispenses et interdictions établies par la loi d'autres Etats que l'Etat requérant et l'Etat requis, dans la mesure spécifiée dans cette déclaration.

Article 12

L'exécution de la commission rogatoire ne peut être refusée que dans la mesure où:

- a) l'exécution, dans l'Etat requis, ne rentre pas dans les attributions du pouvoir judiciaire; ou
- b) l'Etat requis la juge de nature à porter atteinte à sa souveraineté ou à sa sécurité.

L'exécution ne peut être refusée pour le seul motif que la loi de l'Etat requis revendique une compétence judiciaire exclusive dans l'affaire en cause ou ne connaît pas de voies de droit répondant à l'objet de la demande portée devant l'autorité requérante.

Article 13

Les pièces constatant l'exécution de la commission rogatoire sont transmises par l'autorité requise à l'autorité requérante par la même voie que celle utilisée par cette dernière.

Lorsque la commission rogatoire n'est pas exécutée en tout ou en partie, l'autorité requérante en est informée immédiatement par la même voie et les raisons lui en sont communiquées.

Article 14

L'exécution de la commission rogatoire ne peut donner lieu au remboursement de taxes ou de frais, de quelque nature que ce soit.

Toutefois, l'Etat requis a le droit d'exiger de l'Etat requérant le remboursement des indemnités payées aux experts et interprètes et des frais résultant de l'application d'une forme spéciale demandée par l'Etat requérant, conformément à l'article 9, alinéa 2.

L'autorité requise, dont la loi laisse aux parties le soin de réunir les preuves et qui n'est pas en mesure d'exécuter elle-même la commission rogatoire, peut en charger une personne habilitée à cet effet, après avoir obtenu le consentement de l'autorité requérante. En demandant celui-ci, l'autorité requise indique le montant approximatif des frais qui résulteraient de cette intervention. Le consentement implique pour l'autorité requérante l'obligation de rembourser ces frais. A défaut de celui-ci, l'autorité requérante n'est pas redevable de ces frais.

Article 136
Investigation

(1) In any proceedings before an Examining Division, an Opposition Division or a Board of Appeal, the means of giving or obtaining evidence shall include the following:

- (a) hearing the parties;
- (b) requests for information and the production of documents;
- (c) hearing the witnesses;
- (d) opinions by experts;
- (e) inspection;
- (f) sworn statements in writing.

(2) Unchanged from Second Preliminary
Draft Convention
published 1971

(3) {
(4) { - deleted -
(5) }

(6) If the European Patent Office considers it necessary for a party, witness or expert to give evidence orally it shall either

- (a) issue a summons to the person concerned to appear before it, or
- (b) request, in accordance with the provisions of Article 63, the competent court in the country of residence of the person concerned to take such evidence.

Article 136 (continued)

(7) A party, witness or expert who is summoned in accordance with paragraph 6(a) may request the European Patent Office to allow his evidence to be heard by a competent court in his country of residence. On receipt of such a request, or if there has been no reply to the summons by the expiry of a period fixed by the European Patent Office in the summons, the European Patent Office may, in accordance with the provisions of Article 63, request the competent court to hear the person concerned.

(8) If a party, witness or expert gives evidence before the European Patent Office, the latter may, if it considers it advisable for the evidence to be given on oath, request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or affirmation.

(9) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence on oath or affirmation and to permit a member of the department concerned to attend the hearing and question the party, witness or expert.

Re. Article 136

No. 1

Investigation by the European Patent Office

Where the European Patent Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the 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.

.../...

Re. Article 136

No. 3

Summons to give evidence (1)

(1) A summons, issued to a party, witness or expert to give evidence, shall contain an extract from the decision mentioned in 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. A minimum of one month's notice shall be given unless they agree to a shorter period.

(2) In addition to the information provided for in paragraph 1, a summons shall contain the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke under the provisions of Article ... (Re. Article 136, No. 6).

(3) The summons shall also contain an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and shall require him to inform the European Patent Office within a time limit to be fixed by the Office whether he is prepared to appear before it.

.../...

(1) The Secretariat considered, on re-reading the texts, that there should be no reference in paragraph 2 to Article ... (Re. Article 145, No. 1), paragraph 2, the content of which, in accordance with the Working Party's decision, is now contained in this Article. It therefore seems that Article ... (Re. Article 145, No. 1) should be deleted completely.

Re. Article 136

No. 4

Commissioning experts

(1) The European Patent Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

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

- | | | |
|-----|---|--|
| (a) | { | Unchanged from First Preliminary Draft of the Implementing Regulations, published 1971 |
| (b) | | |
| (c) | | - deleted- |
| (d) | | |
| (e) | | Unchanged from First Preliminary Draft of the Implementing Regulations, published 1971 |
| (3) | | |

(4) The parties may object to an expert. The department of the European Patent Office concerned shall decide on the objection. In taking this decision, it shall draw upon the principles of procedural law generally recognised in the Contracting States.

Re. Article 136

No. 5

Hearing of parties, witnesses and experts

(1) The parties may attend a preliminary investigation and may question the witnesses and experts.

(2) Before a party, witness or expert may be heard, he shall be informed that he may be required to take an oath and that perjury may incur sanctions.

Re. Article 136

No. 6

Payment of expenses of witnesses and experts

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

(3) The Administrative Council shall lay down the details governing the implementation of the provisions of paragraphs 1 and 2 of this Article. Payment of amounts due pursuant to these paragraphs shall be made by the European Patent Office.

Re. Article 145

No. 1

Summons

- deleted -

BR/GT I/119 e/71 (Annex II) prk

Re. Article 145

No. 7

Interruption of proceedings

(1) Proceedings before the European Patent Office shall be interrupted:

- (a)
 - ({ Unchanged from First Preliminary Draft of the Implementing Regulations, published 1971
- (b) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property being prevented by legal reasons from continuing the proceedings before the European Patent Office;
- (c) in the event of the death or legal incapacity of the representative of the applicant for or proprietor of a European patent.

(2) When, in the cases referred to in paragraph 1(a) and (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings before the European Patent Office, the European Patent Office shall notify such person and any interested third party that the proceedings shall be resumed as from a date to be fixed by the European Patent Office.

(2a) (new) Paragraph postponed.

Re. Article 145, No. 7 (continued)

(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 person authorised under paragraph 2 may request examination up to the end of two months after such notification has been given.

(4)

({ Unchanged from Second
{ Preliminary Draft Convention
(published 1971

