

# BR/GT I/125 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.

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- Secretariat -

N O T E

The delegations to Working Party I will find attached a note submitted on 12 October 1971 by the French delegation concerning the exclusion of the application for revocation while opposition proceedings may be instituted before the European Patent Office and while such proceedings are pending.

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NOTE FROM THE FRENCH DELEGATION

Exclusion for the application for revocation while opposition proceedings may be instituted before the European Patent Office and while such proceedings are pending:

References:

- Working Document No. R/1516/71 (ECO 131)(BC 20)
  - page 31 - concerning the meeting of the "Community Patent" Working Party held in Brussels from 10 to 18 June 1971;
- Working Document No. R/351/71 (ECO 41)(BC 4) of 8 March 1971, submitted by the Chairman of the "Community Patent" Working Party amending and supplementing the First Preliminary Draft of a Convention for the European Patent for the Common Market.

On 10 June 1971, at the suggestion of the Chairman of the "Community Patent" Working Party, the French delegation was asked to submit to Working Party I of the Inter-Governmental Conference a study of the problem referred to in the title of this note.

The "Community Patent" Working Party adopted the following new Article 59a, proposed by the Chairman of the Working Party, for the Convention for the European Patent for the Common Market:

Article 59a

"The application for revocation of a Community patent may not be lodged while opposition proceedings are pending before the European Patent Office against the grant of the patent or while an opposition may still be lodged."

The Chairman made the two following observations in connection with this text:

- (i) if Article 59a (new) is not adopted and if the text of the First Preliminary Draft of the Second Convention remains unchanged, two proceedings with the same purpose may take place simultaneously before the European Patent Office;
- (ii) if, during opposition proceedings or during the period laid down for instituting such proceedings, it is purely and simply declared that an application for revocation is inadmissible, the following consequences may ensue for the third party against whom the proprietor of the patent is taking action for infringement:

(a) the presumed infringer will be excluded from opposition proceedings if the proprietor of the patent does not take action against him until after the end of the period laid down for lodging opposition;

(b) during opposition proceedings pending before the European Patent Office, the presumed infringer will not be allowed to introduce an application for revocation before the European Patent Office.

The "Community Patent" Working Party, which shared the concern expressed by the Chairman in these observations and which came to the same conclusion, was in favour of giving the presumed infringer the opportunity of intervening in opposition proceedings pending before the European Patent Office and was also in favour of amending the First Convention along these lines.

Should such intervention not be allowed, the Working Party decided that the Second Convention should give the presumed infringer the option of introducing an application for revocation, even if opposition proceedings were already pending. In the latter case, the new Article 59a would have to be amended.

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The rejection of the provision contained in the new Article 59a of the Second Convention or an amendment to its wording, for the purpose of authorising the presumed infringer to institute revocation proceedings during opposition proceedings by way of

derogation to the principle laid down, would amount to leaving intact, in either case, the provisions of the Conventions which allow revocation proceedings and opposition proceedings to take place simultaneously before the departments of the European Patent Office.

These two proceedings are based on identical grounds (see Article 101a of the First Convention for the grounds for opposition; see Article 57, paragraph 1(a), (b) and (c) of the Second Convention for the grounds for revocation of the Community patent), with the exception of the ground for revocation laid down in Article 57, paragraph 1(d) of the Second Convention, which does not need to be taken into consideration in this study.

In addition, opposition proceedings and revocation proceedings against the same Community patent have the same purpose, namely the revocation (in whole or in part) of this patent (cf. Article 105a of the First Convention and Article 58 of the Second Convention).

Moreover, the opposition and revocation departments of the European Patent Office are the only departments competent for dealing with opposition proceedings and the application for revocation of the Community patent.

It is commonly acknowledged that in the interests of the proper administration of justice all risk of diametrically opposite legal decisions should be avoided, and that for this purpose connected requests, which are a fortiori identical, should not be brought before different authorities, nor should these different proceedings be brought before one and the same court.

Two parallel sets of proceedings before the European Patent Office, with the points in common set out above, would, if diametrically opposite decisions were given, have very serious disadvantages for the parties concerned, for third parties and for the European Patent Office.

If the Revocation Division were to revoke the patent and if the Opposition Division were to reject the opposition, this would result in inadmissible legal uncertainty and insecurity for the parties and third parties, as contradictory assessments and decisions would have been made with regard to the validity of the patent.

It would be irrelevant whether the parties had made identical or different contentions to support their separate actions. There would still be a risk of diametrically opposite decisions, with the serious consequences which this would entail, as long as the two sets of proceedings were not based on the same grounds and did not use the same contentions. The Opposition Division and Revocation Division would no doubt make use of the power conferred upon them by the Convention to extend their examination in the proceedings beyond the contentions made by the parties and the relief sought (cf. Article 101b, paragraph 1, of the First Convention and Article 62, paragraph 1, of the Second Convention). In doing so, they would be certain to include in their examination and to make reference in their decisions to all the grounds and all the possible arguments for revocation of the patent in question. This would remove the difference which might exist initially between the two sets of proceedings with regard to the grounds and arguments invoked by the parties.

As for the European Patent Office, whose departments are concerned in opposition and revocation proceedings, its authority would certainly suffer quite seriously from diametrically opposite decisions, revealing a regrettable divergence between the positions adopted by the two departments, acting simultaneously, with regard to the assessment of the facts and indeed the application of the rules of the Convention.

Therefore, in any case, the simultaneity of opposition proceedings and revocation proceedings has very serious disadvantages and consequently should be abandoned.

2. It should not, however, be forgotten that it is in the interests of the proprietor of the European patent that a decision should be given as quickly as possible as to the validity of the patent which he holds, so that he may, as soon as possible, invoke it against any infringer and use the invention in respect of which he may have incurred considerable expense, both for obtaining protection for it and for using it.

It is also in the interest of the presumed infringer, for his part, that he should be able to prosecute without delay the invalidation of the patent invoked against him by using the arguments in his possession which he considers decisive. In this way he may bring to nothing the infringement action before it has a chance to succeed or come to an end by seriously prejudicing it both morally and materially.

Finally, third parties and the European Patent Office have an obvious advantage in knowing rapidly and finally whether or not the patent is valid.

The adoption of the principle of the pure and simple inadmissibility of the application for revocation, introduced by the presumed infringer during the period for lodging opposition or during opposition proceedings, would put the infringer in a difficult position, as was observed by the Chairman of the "Community Patent" Working Party: either he would be excluded from opposition proceedings if the proprietor of the patent did not take action against him until after the end of the period for lodging opposition, or he would be deprived of the option of introducing an application for revocation while opposition proceedings were pending.

In either situation, the presumed infringer has no alternative but to introduce an application for revocation either at the end of the opposition period (if no opposition has been lodged) or after a final decision has been given on the opposition: in either case the periods necessary for establishing finally whether the patent in question is valid or not are prolonged to his disadvantage.

In these circumstances, it does not appear advisable, in view of the length of the periods which this would entail, to adopt a provision which, in one form or another, laid down that opposition and revocation proceedings may only be instituted successively. Moreover, it should be added that the succession of the two sets of proceedings does not remove the danger of flagrant and regrettable contradiction between the successive decisions of the departments concerned.

It may also be borne in mind, for the record, that the presumed infringer would find no assistance in Article 75 of the Second Convention. This Article allows the national court before which the infringement proceedings in respect of a Community patent are brought to suspend these proceedings under certain conditions, particularly when the defendant (presumed infringer) has lodged opposition against the same Community patent. But Article 75 may not be applied in the present case as, for example, the presumed infringer against whom action is being taken for infringement after the end of the period for lodging opposition may, as the texts stand at present, neither participate in opposition proceedings pending nor put forward in such proceedings the arguments for revocation in his possession.

3. It would appear, therefore, that to satisfy all the interests involved and to avoid all sources of difficulty, the only acceptable solution would be the principle of inadmissibility as set out in the new Article 59a of the Second Convention, while at the same time authorising the presumed infringer to intervene in the opposition proceedings pending by putting forward any arguments for revocation in his possession.

This solution would allow the presumed infringer to prosecute, as quickly as possible, the revocation of the patent invoked against him. All possibility of diametrically opposite decisions is obviously excluded as only one department is called upon to take a single decision on the main opposition proceedings and on the intervention made in connection with them. No ambiguity may be feared as to the validity or the existence of the patent concerned.

From the legal angle, such an intervention cannot be criticised: the presumed infringer is acting in defence of interests and rights which would have enabled him to take action independently; he is prosecuting a result which bears a certain degree of identity with the result of the dispute in which he is taking part, namely the revocation of the patent.

It should be noted that no amendment is required to the texts of the Conventions as they stand with regard to the period for instituting opposition proceedings as the presumed infringer may, at that time, lodge opposition himself.

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If the procedure of intervening in opposition proceedings is retained, the new provisions to be laid down should obviously be inserted in the First Convention and, if necessary, in the Implementing Regulations thereto. For this purpose, the following drafts are proposed:

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## I. CONVENTION

### Article 106 (new)

Intervention of the presumed infringer  
in opposition proceedings pending  
before the European Patent Office

(1) Subject to the payment of the fee provided for in Article 101, paragraph 1, any third party who provides the European Patent Office with proof that the proprietor of a patent granted by that office has instituted infringement proceedings against him may intervene in opposition proceedings which have been instituted against the same patent and which are pending before the European Patent Office. The application for intervention, which is to be addressed to the department before which the opposition is lodged, shall be made by means of a reasoned request containing the contentions and conclusions of the person making the intervention and accompanied by copies of the supporting documents.

(2) The Opposition Division shall decide on the intervention by means of a decision under Article 105 and under the conditions laid down in that Article.

(3) The provisions of Article 101, paragraphs 2 and 3, of Article 101a, of Article 101b, of Article 102 and of Article 103 shall be extended to cover intervention proceedings.

## II. IMPLEMENTING REGULATIONS

### Re. Article 101

#### No. 5 (new)

Intervention of the presumed infringer  
in opposition proceedings pending  
before the European Patent Office

The provisions of Articles ... (Re. Article 101, Nos. 1, 2, 3, 4 and 5) shall be applicable where necessary to the intervention of a third party, who is the defendant in infringement proceedings, in opposition proceedings lodged before the European Patent Office against the European patent in respect of which he is accused of infringement.

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