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

Luxembourg, 26 November 1971

BR/GT I/141/71

- Secretariat -

WORKING PARTY I

WORKING DOCUMENT

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

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- FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Articles	16, No. 3
	16, No. 4
	56, No. 1 (new)
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	63, No. 1
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(Texts drawn up by the Drafting Committee)

Article 16

Patent applications by persons not entitled to apply

(1) If it is ordered in pursuance of a final decision that a person referred to in Article 15, paragraph 1, other than the applicant, is entitled to the European patent, that person may, within a period of ... months following the final decision, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the application in which the decision has been taken or recognised, or has to be recognised on the basis of a special protocol:

- (a) declare that he will prosecute the application as his own application in place of the applicant
- (b) file a new application in respect of the same invention, or
- (c) merely request that the application be refused.

(2) In the case provided for in paragraph 1(a), provided that the original application is maintained in respect of Contracting States in which the decision does not apply the original applicant and the person entitled to the European patent by virtue of the decision shall not be considered as joint applicants before the European Patent Office unless both so request.

Article 16 (continued)

(3) In the case provided for in paragraph 1(b), in so far as the subject-matter of the new application does not go beyond the description given in the original application, the new patent application shall be deemed to have been filed on the date of the earlier application and shall enjoy the right of priority where applicable. The original application for a European patent shall be deemed to be withdrawn at the time of the new application for the Contracting States designated therein in which the decision has been taken or been recognised.

(4) If it is ordered in pursuance of a final decision that a person referred to in Article 15, paragraph 1, other than the applicant, is entitled to a European patent in respect of part of the matter disclosed in the application, paragraphs 1 to 3 shall apply mutatis mutandis to such part. Where appropriate the original application shall be restricted to the rest of the matter disclosed in it and contain different claims for the two groups of States; in the latter case a different description or drawings may, or where the European Patent Office considers it necessary, shall be submitted for the two groups of States.

CHAPTER 1a

POWERS AND FUNCTIONS OF THE ADMINISTRATIVE COUNCIL

Article 35a

Adoption and amendment of general rules

- (1)

- Unchanged from BR/134/71

- (2)

- Unchanged from Second Preliminary Draft
Convention published 1971

- (3)

- (Unchanged from BR/134/71

(4) The Administrative Council shall take the decisions referred to in the Implementing Regulations to this Convention.

CHAPTER III

Opposition procedure

Article 101

Opposition

- (1) Unchanged from BR/134/71
- (1a) { Unchanged from Second Preliminary
Draft Convention published 1971
- (1b) Unchanged from BR/134/71
- (2) { Unchanged from Second Preliminary
Draft Convention published 1971

(2a) Where a person provides evidence that in one or more Contracting States, following a final decision, he has been entered in the patent register or registers of such State or States instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State or States. By derogation from paragraph 1a, the previous proprietor and the person making the request shall not be considered as joint proprietors unless both so request.

- (3) Unchanged from BR/134/71

Article 101a

Grounds for opposition

Opposition may be only be lodged on the grounds that:

- (a) {
- (b) { Unchanged from Second Preliminary
 Draft Convention published 1971
- (c) the subject-matter of the European patent extends beyond the
 content of the application as filed, or, if the patent was
 granted on a divisional application or on a new application filed
 in accordance with Article 16, beyond the content of the earlier
 application as filed.

Article 106a (new)

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

(1) Subject to payment of the fee provided for in Article 101, paragraph 1, a third party who, after the opposition period has expired, 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 an Opposition Division or a Board of Appeal. 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. The Opposition Division or the Board of Appeal shall decide on the intervention.

(2) The provisions of Article 101, paragraphs 2 and 3, Article 101a, Article 101b, Article 102, Article 103, Article 105 and Article 115 shall be extended to cover intervention proceedings.

PART VII
REVOCATION OF THE EUROPEAN PATENT

Article 133

Grounds for revocation

- (1) { Unchanged from BR/134/71
- (a) { Unchanged from Second Preliminary
- (b) { Draft Convention published 1971
- (c) if the subject-matter of the European patent extends beyond the content of the application as filed, or if the patent was granted on a divisional application or on a new application filed in accordance with Article 16, beyond the content of the earlier application as filed;
- (d) if the protection conferred by the European patent has, contrary to Article 137b, paragraph 5, been extended during opposition proceedings;
- (e) if the proprietor of the European patent is not entitled under Article 15.
- (2) { Unchanged from Second Preliminary
- { Draft Convention published 1971

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 either through the intermediary of the court or directly.

Article 137a

European divisional applications

(1) A European divisional application must be filed directly with the European Patent Office and may be filed in respect of subject-matter contained in an earlier European patent application:

(a) at any time after the earlier application has been received by the European Patent Office; nevertheless, after the start of the examination proceedings, only if the Examining Division considers it to be justified;

(b) (Unchanged from BR/134/71

(2) Where possible, the description and drawings of the earlier application and any divisional application shall relate only to the matter for which protection is sought by the respective application. However, when it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a cross-reference to that other application.

(3) {
(4) { Unchanged from BR/134/71

Article 137b (new)

Amendment of the European patent application and
of the European patent

(1) A European patent application and a European patent may not be amended in such a way that they contain subject-matter which extends beyond the content of the application as filed. A divisional application, a new application filed in accordance with Article 15, or a patent granted on the basis of either shall not contain subject-matter which extends beyond the content of the earlier application as filed.

(2) Before receiving the report on the state of the art, the applicant may not amend the description, claims or drawings of a European patent application, except where otherwise provided for in this Convention or in the Implementing Regulations.

(3) After receipt of the report on the state of the art, but before receipt of the first notification of the Examining Division, the applicant may abandon one or more of the original claims of the application or submit new or amended claims. If the applicant avails himself of this right, the new or amended claims instead of the original claims shall determine the protection sought in so far as their subject-matter does not extend beyond what was described in the application. The applicant shall provide a translation of the new or amended claims into each of the other two languages referred to in Article 34, paragraph 1.

Article 137b (continued)

(4) After receipt of the first notification from the Examining Division, the applicant may of his own volition, amend once the description, the claims and the drawings. No further amendment may be made without the consent of the Examining Division.

(5) The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.

Article 141

Time limits

The Implementing Regulations to this Convention shall specify:

- (a) the manner of computation of time limits fixed by this Convention or to be determined by the European Patent Office, and the conditions under which such time limits may be extended, either because the European Patent Office or the authorities referred to in Article 64, paragraph 1(b), are closed, or because mail is not delivered in the localities in which the European Patent Office or such authorities are situated;
- (b) the minima and maxima for time limits to be determined by the European Patent Office.

Article 171

Preservation of acquired rights

- (1)
 - (2)
 - (3)
 - (4)
- Unchanged from Second Preliminary
Draft Convention published 1971

Note to Article 171:

- deleted -

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 16

No. 3-

Suspension of opposition proceedings

(1) If, during the examination of an opposition lodged against a European patent, 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 proprietor of the patent, is entitled to the European patent, the European Patent Office shall stay the proceedings for examination of the opposition unless the person who claims to be entitled to the European patent consents to the continuation of such proceedings. Such consent must be notified in writing to the European Patent Office; it shall be irrevocable.

(2) If the proof referred to in paragraph 1 is provided during the opposition period, the European Patent Office shall stay proceedings for the examination of oppositions lodged against the European patent, subject to the consent referred to in paragraph 1.

(3) Where proof is provided to the European Patent Office that a final decision has been given in favour of the proprietor of the patent in the proceedings concerning entitlement to the European patent, the European Patent Office shall notify the parties that proceedings for examination of the opposition shall be resumed or opened following notification to the proprietor. If the decision is in favour of the person who claimed to be entitled to the European patent, the proceedings shall not be resumed or opened before the expiry of a suitable period.

(4) The provisions of Article ... (Re. Article 16, No. 1), paragraphs 3 and 4, shall apply mutatis mutandis.

Note to Re. Article 16, No. 3:

- deleted -

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 16

No. 4

Limitation of the option to surrender a
European patent

As from the receipt by the European Patent Office of notification that the proceedings referred to in Article ... (Re. Article 16, No. 3) have been opened, and up to the opening or resumption of the opposition proceedings, the European patent may not be surrendered in any of the Contracting States, save with the consent of the person who instituted the said proceedings. If, after a period of one month from receipt of the notification, proof that such proceedings have been instituted has not been furnished, the proprietor of the patent shall recover his right to surrender the said patent until such time as this proof is provided.

Note to Re. Article 16, No. 4:

- deleted -

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 56 (new)

No. 1

Rules of Procedure of the
Boards of Appeal

The authority referred to in Article ... (Re. Article 53, No. 2) shall adopt the Rules of Procedure of the Boards of Appeal. They shall require the approval of the Administrative Council.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 57 (new)

No. 1

Rules of Procedure of the Enlarged Board of Appeal

The Enlarged Board of Appeal shall adopt its own Rules of Procedure which shall require the approval of the Administrative Council.

Re. Article 63, No. 1: Procedure for letters rogatory

- (1) Each Contracting State shall designate a central authority which will undertake to receive letters rogatory issued by the European Patent Office and to transmit them to the authority competent to execute them.
- (2) The European Patent Office shall draw up letters rogatory in the language of the competent authority or shall attach to such letters rogatory a translation into the language of that authority.
- (3)(new) Subject to the provisions of paragraphs 5 and 6, the competent authority shall apply its own law as to the procedures to be followed in executing such requests. In particular, it shall apply appropriate measures of compulsion in accordance with its own law.
- (4)(new) If the authority to which the letters rogatory is transmitted is not competent to execute it, the letters rogatory shall be sent forthwith to the authority in the same State which is competent.
- (5)(new) The European Patent Office shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place and shall inform the parties, witnesses and experts concerned.

(6)(new) If so requested by the European Patent Office, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority.

(7)(new) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the European Patent Office to reimburse any fees paid to experts and interpreters and the costs incurred by the procedure of paragraph 6.

(8)(new) If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the European Patent Office, appoint a suitable person to do so. When seeking the consent of the European Patent Office, the competent authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, it shall reimburse any costs incurred; without such consent, the European Patent Office shall not be liable for such costs.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 65 (new)

No. 1

Notification to the applicant

The European Patent Office shall notify the applicant that the application has been forwarded to the European Patent Office by the national central industrial property office.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 101

No. 6 (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 to intervention proceedings under Article 106a of the Convention.

Re. Article 130, No. 2: Renewal fees in respect of applications
for divisional European patents

Renewal fees in respect of an application for a divisional European patent must be paid within four months of the filing of such application. Article 130, paragraphs 2, 2a and 3, of the Convention shall apply.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

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 the European Patent Office may request the competent court in the country of residence of the person concerned to take or re-examine this evidence on oath or affirmation.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 136

No. 7

Conservation of evidence

(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 may be called upon 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 date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in sufficient time to allow him to attend. He may ask questions.

(2)

- (a)
- (b)
- (c)
- (d)
- (e)

Unchanged from First Preliminary Draft
of the Implementing Regulations published 1971

(3)

(4)

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 140

No. 1

Summons to oral proceedings

(1) The parties shall be summoned to oral proceedings and their attention shall be drawn to paragraph 2. Article ... (Re. Article 136, No. 3), paragraph 1, second sentence shall be applied mutatis mutandis.

(2) If a party who has been duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without him.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 140

No. 2

Conduct of oral proceedings

- deleted -

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 141

No. 2

Extension of time limits

(1) If the last day of a period is a day on which the European Patent Office is not open for receipt of documents or on which ordinary mail is not delivered in the locality in which the European Patent Office is situated, the period shall be extended until the first day thereafter on which the European Patent Office is open for receipt of documents and on which ordinary mail is delivered.

(2) Unchanged from First Preliminary Draft of the Implementing Regulations published 1971.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

Re. Article 141

No. 3

Duration of time-limits

Where the Convention specifies a period to be determined by the European Patent Office, such period shall not be less than two months, nor more than four months. In certain special cases, the period may be extended upon request, presented before the expiry of such period.

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS

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.

e. Article 145, No. 7 (continued)

(2a) In the case referred to in paragraph 1(c) the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the European Patent Office has informed the other parties of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall notify the applicant for or proprietor of the patent:

) where Article 154, paragraph 2, of the Convention is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within a period of two months as from this notification being made, or

) where Article 154, paragraph 2, is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this notification is made.

(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 from the day on which notification under paragraph 2 or paragraph 2a, second sentence, has been given or the proceedings have been resumed under paragraph 2a, first sentence. If such date is

Re. Article 145, No. 7 (continued)

less than two months before the end of the period within which the request for examination must be made, such a request may be made up to the end of two months after such date.

(4)

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