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

Brussels, 11th February 1972
BR/GT I/142/72

- Secretariat -

NOTE

Subject: Proposals for a Draft Protocol on the Recognition
of Decisions in respect of the Right to the Grant of
a European Patent (Protocol on Recognition)

Submitted by: German delegation

BR/GT I/142 e/72 lor/AV/prk

Proposals submitted by the German delegation for a Draft Protocol on
the Recognition of Decisions in respect of the Right to the
Grant of a European Patent
(Protocol on Recognition)

I.

1. At its meeting held from 22 to 26 November 1971, Working Party I set up a Sub-Committee to draw up a special Protocol on the recognition of decisions. The purpose of this Protocol would be to enable the decision of a court of a Contracting State to be recognised, quite apart from the bilateral and multilateral agreements which already exist, by all the States designated in a European patent application, while proceedings for grant are taking place before the European Patent Office.

The German delegation stated at that time that it would submit proposals for such a Protocol to the Sub-Committee (cf. BR/144/71, points 44 and 45).

2. The German delegation based the proposal submitted in Part II of this paper on the following considerations:
 - (a) It should be the aim of the Sub-Committee to draw up the Protocol in such a form that all the States parties to the Convention could become parties to this Protocol. The Protocol should therefore not impinge upon the national laws of the Contracting States any more than is necessary

to guarantee more easily than under the present text of Article 16 of the Convention the right of the person entitled under Article 15, paragraph 1, of the Convention during grant proceedings.

- (b) Recognition of the decisions of the courts of States not parties to the Convention would not seem expedient in view of the large number of States which this might involve and the complex jurisprudence of their courts. It is to be feared that such recognition might jeopardise the likelihood of a number of the States parties to the Convention acceding to the Protocol.
- (c) Under Article 15, paragraph 2, of the Convention the applicant is deemed in proceedings before the European Patent Office to be entitled to exercise the right to a European patent. In this way the applicant is accorded a formal right under civil law to the grant of a European patent. Article 16 of the Convention governs the eventuality of the material entitlement under Article 15, paragraph 1, of the Convention not coinciding in individual cases with the formal right to the grant of the European patent. The person entitled under Article 15, paragraph 1, of the Convention has to institute what is known as an action for a specific performance against the applicant who is not materially entitled in order to obtain the formal right to the grant of the European patent and to be entered in the Register of European Patents as the applicant. This cannot be attained by an action for a declaratory judgment, as under the law of at least a number of continental Contracting States rights of any kind can only be assigned by a decision in respect of an action for a

specific performance. It is therefore proposed that the Protocol be limited to the recognition of those decisions which accord the person entitled the right to the grant of the European patent.

The present wording of Article 16 of the Convention should be re-examined in this connection to align the field of application of this Article on that of the Protocol. A redraft of Article 16 of the Convention is proposed in Part IV of this paper. Such harmonisation would also appear desirable to align Article 16 with Article 23 of the Convention, as under the present wording of Article 16, declaratory judgments too would be sufficient to accord the person entitled the rights provided for in Article 16. However, the person entitled could not be entered in the Register of European Patents in place of the original applicant, for as set out above the declaratory judgment does not entail any "transfer", as is required by Article 23, paragraph 2, for the recording of a change of applicant. The legal situation would be changed only if Article 16 could be interpreted as meaning that the right to the grant of a European patent would be effectively transferred by the exercise of the options given in this provision, even though in certain circumstances a declaratory judgment only had been given. It is very doubtful that national courts would recognise such an interpretation, for instance in infringement proceedings. Since restricting Article 16 of the Convention to an action for a specific performance is more likely to provide a clear legal situation, it is proposed that Article 16 of the Convention be amended. If this proposal is adopted, the implementing regulations to Article 16 will have to be adapted accordingly.

- (d) It would be in the interests of legal security if only one particular court per Contracting State were responsible for deciding on the right to the grant of a European patent. This should be guaranteed by the provisions in Section 1 of the proposed Protocol on Recognition, which provide that one particular court of each Contracting State would have exclusive jurisdiction for all disputes.

However, the possibility cannot be discounted that a court to which a dispute is referred might wrongly accept jurisdiction for that case even after careful checking. Although such cases would be quite rare, provision must be made for them for practical reasons.

It is therefore provided in the proposed Protocol on Recognition that neither the European Patent Office nor the courts or authorities of the Contracting States may check the jurisdiction of the court whose decision is to be recognised (Article 8, paragraph 2, of the proposal). Recognition is therefore solely on the basis of the presentation of the final decision which has been given in a Contracting State (Article 8, paragraph 1, of the proposal). In view of the principles which are generally accepted in respect of the recognition of decisions by courts of other States, the legality of the decision may not be checked either (Article 8, paragraph 2, of the proposal); this principle must, however, be restricted from the point of view of "ordre public". The decision should therefore not be recognised where an applicant who did not contest an action can prove that he was unable to defend himself against the charge because certain provisions of form were not observed (Article 9, point 1, of the proposal).

Exceptionally, the situation of the European Patent Office being presented with two contradictory decisions from different courts may arise. In the interests of legal clarity during grant proceedings, it is proposed that in such cases the priority principle should be applied. There should be no recognition where an applicant can prove that the decision submitted by the other party for recognition is incompatible with another decision which was given in a Contracting State in respect of the same parties and which obtained force of law earlier than the decision submitted by the other party (Article 9, point 2, of the proposal).

It should also be made clear that by acceding to this Protocol, Contracting States will not impinge upon existing bilateral or multilateral agreements on the recognition of decisions. However, hesitations on this point will be dispelled where the other States involved in such agreements also become parties to the Protocol on Recognition. Article 10 of the proposal attempts to solve this problem.

It should also be pointed out that the proposed provisions have been drafted on the basis of provisions of the EEC Convention on Jurisdiction and the Enforcement of Civil and Commercial Judgments, signed on 27 September 1968. (1)

- (e) As already stated under (a), it would be desirable for all the States which are parties to the Convention to become parties to the Protocol on Recognition. It is therefore proposed in Part III that the Protocol on Recognition be

(1) Translators note: As no authentic English text of this Convention exists to date, the English wording of the relevant Articles of the proposed Protocol must be regarded as provisional pending an English translation of the Convention being authenticated.

declared an integral part of the Convention. In any case, any Contracting State can make a reservation under the proposed new Article 159a of the Convention.

3. It is suggested that the Sub-Committee should also examine whether it would be expedient for the Convention to contain a provision making it clear that the national courts of the Contracting States have jurisdiction for deciding on disputes in respect of European patent applications.

There could be doubts as to whether such a provision is necessary in the light of Article 76, paragraph 1, of the Convention, under which an application for a European patent is equivalent to a regular national filing in the Contracting States designated. Nevertheless, the German delegation has drawn up in Part IV the text of an Article 16a or 19a which could be discussed in the event of the Sub-Committee considering such a clarification expedient or necessary.

Proposal for
the Protocol on the Recognition of Decisions
in respect of the Right to the Grant of
a European Patent
(Protocol on Recognition)

Section I

Jurisdiction

Article 1

(1) The courts of the Contracting States shall, in accordance with Articles 2 to 5, have jurisdiction to decide on actions for the transfer of the right to the grant of a European patent in respect of some or all of the States designated in the European patent application.

(2) Territorial and material jurisdiction shall be governed within each Contracting State by those of its national laws which would govern decisions on actions under civil law concerning national patent applications. Each Contracting State shall have the right to refer such actions to a particular national court in respect of the whole of its territory or several circuits. The right of the parties to agree that jurisdiction is to be given to a particular court (Article 4) shall not be affected.

Article 2

Any applicant for a European patent having his residence or registered place of business in a Contracting State shall, subject to Articles 3 and 4, be sued before the courts of that Contracting State.

Article 3

If the subject-matter of a European patent application is the invention of an employee, exclusive jurisdiction shall belong to the courts of the Contracting State whose law governs the right to the European patent pursuant to Article 15, paragraph 1, second sentence, of the Convention establishing a European System for the Grant of Patents. However, if, pursuant to Article 15, paragraph 1, second sentence, of the Convention establishing a European System for the Grant of Patents, the right to the European patent is governed by the law of a State not party to the Convention, the courts of the Contracting State in which the European Patent Office is located shall have exclusive jurisdiction.

Article 4

If the parties conclude an agreement, either in writing or verbally with written confirmation, that has no connection with a working or similar relationship, to the effect that a court or the courts of a Contracting State is or are to decide on the right to the European patent or the right to the grant of the European patent, such court or courts of that Contracting State shall have exclusive jurisdictions.

Article 5

In cases not governed by Articles 2 to 4, the courts of the Contracting State in which the European Patent Office is located shall have exclusive jurisdiction.

Article 6

The courts of the Contracting States shall ex officio verify whether or not they have jurisdiction pursuant to Articles 2 to 5.

Article 7

(1) In the event of actions based on the same claim and between the same parties being brought before the courts of different Contracting States, the court to which the later application was made shall ex officio deny jurisdiction in favour of the court to which the first application was made.

(2) In the event of the jurisdiction of the court to which the first application was made being challenged, the court obliged under paragraph 1 to deny jurisdiction shall take no decision until such time as the other court takes a final decision.

Section II

Recognition

Article 8

(1) Final decisions given in any Contracting State on the right to the grant of a European patent in respect of some or all of the Contracting States designated in the

European patent application shall be recognised without requiring a special procedure in the other Contracting States in respect of which this Protocol has entered into force.

(2) The jurisdiction of the court whose decision is to be recognised and the legality of such decision may not be reviewed.

Article 9

Article 8 shall not be applicable where:

1. an applicant who has not contested the action proves that the document initiating the action was notified to him neither regularly nor sufficiently early for him to defend himself, or
2. an applicant proves that the decision is incompatible with a decision given on an action between the same two parties in one of the Contracting States and which acquired legal force before the decision to be recognised.

Cases in which the Protocol shall not apply

Article 10

This Protocol shall not apply to decisions given by the courts of any State which, in a Contracting State in respect of which this Protocol has entered into force, are to be recognised on the basis of an obligation contracted in another international convention, unless this Protocol has also entered into force in respect of such other State.

III.

Amendments to the Convention necessitated
by the Protocol on Recognition

Article 159

Reservations during a transitional period

+ rest of text unchanged

Article 159a (new)

Reservations on the Protocol on Recognition

(1) Each Contracting State may, at the time of signature or when depositing its instrument of ratification or accession to the Convention, reserve the right to provide that the Protocol on the Recognition of Decisions in respect of the Right to the Grant of a European Patent shall not be applicable to it.

(2) Any Contracting State that makes a reservation pursuant to paragraph 1 may, by a notification addressed to ..., withdraw this reservation. Such withdrawal shall take effect one month from the date of receipt of such notification.

Article 161

Implementing Regulations and Protocol on Recognition

(1) The Implementing Regulations and the Protocol on the Recognition of Decisions in respect of the Right to the Grant of a European Patent shall be integral parts of the Convention.

(2) unchanged.

Article 168

Limitation of reservations

Signature or ratification of or accession to the Convention may not be subject to any reservations other than those provided for in Articles 159 and 159a of this Convention.

Article 173

(1) unchanged.

(2) (a) and (b) unchanged.

(c) any reservation or withdrawal of reservation pursuant to Articles 159 and 159a;

(d) to (f) unchanged.

(3) unchanged.

IV

Amendments to the Convention that should also be
discussed by the Sub-Committee

Article 16

Patent applications by persons not entitled to apply

In the event of a final decision which accords the right
to the grant of the European patent to a person other than
the applicant, that person may ...

/Article 16a or 19a (new)

Jurisdiction in respect of actions concerning European patent applications shall, subject to the Protocol on the Recognition of Decisions in respect of the Right to the Grant of a European Patent, be vested in the national courts of the Contracting States which would, have territorial and material jurisdiction in respect of actions under civil law concerning national patent applications. Each Contracting State shall have the right to refer such actions to a particular national court in respect of all its territory or several circuits.7
