

BR/GT I/162 e/72

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

- Secretariat -

Brüssel, den 29. Mai 1972
BR/GT I/162/72 Korr. 1

KORRIGENDUM

zum Bericht über die Sitzung der Untergruppe "Protokoll" (zu Artikel 16) der Arbeitsgruppe I vom 6. bis 9. März 1972 in Brüssel

Brussels, 29 May 1972
BR/GT I/162/72 Corr. 1

CORRIGENDUM

to the Minutes of the meeting of the Sub-Committee of Working Party I on the Protocol under Article 16, held in Brussels from 6 to 9 March 1972

Bruxelles, le 29 mai 1972
BR/GT I/162/72 Corr. 1

CORRIGENDUM

au Rapport de la réunion du Sous-groupe "Protocole" relatif à l'article 16 du Groupe de travail I tenue à Bruxelles du 6 au 9 mars 1972

BR/GT I/162 Korr. 1/Corr. 1 d/e/f/72

Korrigendum zu Dokument BR/BT I/162/72

Corrigendum to document BR/GT I/162/72

Corrigendum au document BR/GT I/162/72

- S. 3, Punkt 6, dritte Zeile :

Es muss heissen : "nach dem Recht einiger Vertragsstaaten"
statt : "zumindest im deutschen Recht"

- P. 3, No 6, third line :

read : "according to the law of certain States"
instead of : "in German law at least"

- P. 3, point 6, troisième ligne :

lire : "selon certains droits nationaux"
au lieu de : "au moins en droit allemand"

- S. 11, letzte Zeile :

Es muss heissen : "der Beklagten" statt "der Verteidigung"

Only concerns the German text

Ne concerne que le texte allemand

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

Brussels, 11 April 1972
BR/GT I/162/72

- Secretariat -

M I N U T E S

of the

meeting of the Sub-Committee of

Working Party I

on the Protocol under Article 16,

held in Brussels from 6 to 9 March 1972

BR/GT I/162 e/72 son/KM/prk

1. The first meeting of Working Party I's Sub-Committee on the Protocol under Article 16, in the context of the Inter-Governmental Conference for the setting up of a European System for the Grant of Patents, was held in Brussels from 6 to 9 March 1972 (1).

2. On the French delegation's proposal, the Sub-Committee elected Dr. MAST, Ministerialrat at the Bundesministerium der Justiz, as its Chairman.

Mr BALMURY, Advocate-General at the Court of Appeal in Paris, Ministry of Justice, agreed to act as the Sub-Committee's rapporteur to Working Party I.

The Sub-Committee's drafting committee met a number of times, chaired by Mr PIETERS, Deputy Head of the Legal Affairs Division, Netherlands Ministry of Economic Affairs.

3. The Sub-Committee's discussions were based principally on proposals submitted to it by the German delegation (BR/GT I/142/72), in accordance with the invitation made to this delegation by Working Party I (cf. BR/144/71, point 45).

I. Basic principles of the Protocol

4. Prior to examining in detail the provisions as proposed by the German delegation, the Sub-Committee discussed the

(1) The list of participants will be found annexed.

principles on which the Protocol should be based.

5. The Sub-Committee first of all examined whether only decisions on entitlement to obtain the European patent should be recognised under the Protocol, or whether the Protocol should also apply to the granted patent.

Two delegations were in favour of the Protocol's having a broader scope, adducing that it would be undesirable if a person losing an action involving the right to obtain a European patent were to be able to resume proceedings before the various national courts once the patent had been granted, the more so since, as these delegations saw it, all the factors involved in the dispute would already have been taken into consideration in the first decision.

In contrast, other delegations remarked that if a decision were to be made to give the Protocol such scope, it would have to be made into a much more elaborate instrument, including many more legal safeguards. Indeed, a relatively simple and brief convention of this nature would be legally and politically acceptable only in a limited field. Furthermore, such limited scope, far from introducing an artificial dichotomy in a dispute between parties concerning a European patent, would accord with the logic of the First Convention which in the main covers the period of granting the patent. What is more, a distinction should be drawn in this respect between formal and material claims: whereas the latter are concerned with the actual entitlement to the patent, formal claims are intended merely to remedy disputes which might arise between the fiction in Article 15,

paragraph 2, of the First Convention and the rule that "the right to a European patent shall belong to the inventor or his successor in title" (paragraph 1 of that Article). If the Protocol were to be given limited rather than broad scope, it would cover only decisions on such formal claims.

The Sub-Committee finally decided to adopt the latter concept. Certain delegations remarked that the difference between the two alternatives would probably not prove too great in practice, in view of the authority - moral if not legal - of a decision on the right to obtain a patent as regards any dispute concerning the granted patent.

6. The Sub-Committee then examined the problem, raised by the German delegation in its working document, that, in German law at least, a "Feststellungsklage" (action for a declaratory judgment) would not be sufficient to overrule the fiction of Article 15, paragraph 2; this could only be attained by a "Leistungsklage" (action for a specific performance), in this case an action for the applicant for the patent to be instructed to assign the right to the patent to the person claiming it (cf. BR/GT I/142/72, point 2(c)). The Sub-Committee came to the conclusion that, in view of these legal concepts this was a real problem, particularly in respect of Article 16, paragraph 1(a). It decided to bear this in mind when examining the German delegation's proposals on Article 1 of the Protocol and Article 16 of the First Convention (cf. points 10 and 33 below).
7. A further point discussed was whether recognition under the Protocol should be extended to decisions by courts of States not parties to the Protocol (cf. BR/GT I/142/72, point 2(b)).

One delegation was in favour of so extending it on the grounds of the large number of European patent applications which were likely to be filed by nationals of non-party States and of the great inconvenience which would be entailed for the parties to a dispute concerning such an application if they had to take their dispute to a court of a State party to the Protocol, especially as in such cases both parties would very often be from non-party States.

On the other side, the following arguments were put forward by other delegations in favour of limiting the decisions to be recognised to those given by courts of the States parties to the Protocol;

- (a) The system proposed by the German delegation, whereby the courts of the Contracting State in which the European Patent Office was located would have jurisdiction for such disputes and the decisions of such courts would then be recognised under the Protocol, would clearly be more advantageous for a national of a non-party State than the present state of affairs, whereby they would have to take the dispute before each national court unless there was a bilateral agreement on the recognition of decisions between his State and the other State concerned.
- (b) It might well be difficult for a number of the States taking part in the drawing up of the First Convention to accept a general extension of the applicability of the Protocol to decisions by courts of non-party States. An extension of the "passive" applicability of the Protocol might, therefore, well restrict its "active" applicability.

- Owing to the fact that the recognition of judicial decisions necessarily implies a certain amount of mutual confidence between the States concerned, it would be unacceptable to extend the applicability of the Protocol to all non-party States. On the other hand, it would be politically difficult to make a distinction between non-party States in this respect.
- Such a distinction could clearly be made by virtue of a bilateral convention concluded with a non-party State on a reciprocal basis. But it is precisely such reciprocity which is lacking in the extension pure and simple of the applicability of the Protocol to non-party States.

In conclusion, the Sub-Committee decided to restrict the applicability of the Protocol to the decisions of courts of the States parties to this Protocol.

8. The Sub-Committee also agreed that the Protocol should not interfere more than is strictly necessary in the national legislation of the Contracting States.

II. Individual Articles of the Protocol (1)

Article 1

9. During its discussion of principles, the Sub-Committee had agreed to take into account the anxieties expressed by the German delegation with regard to the drafting of paragraph 1 of this Article, in the light of German national legal concepts in the field of the "Leistungsklage". However, the Sub-Committee amended

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(1) The text of the Protocol and of the amendments to the First Convention as finally adopted by the Sub-Committee appear in BR/GT I/161/72.

the drafting of this paragraph in the German proposal, since it was of the opinion that the phrase "transfer of the right to the grant of a European patent" ran the risk of being interpreted in too restrictive a manner, since certain national legislations could recognise only the declaratory judgment with respect to the right to the grant of a patent.

10. The Sub-Committee did not adopt paragraph 2 as proposed by the German delegation. Indeed, it was of the opinion that this provision was contrary to the principle recalled above (point 8) according to which the Protocol should not interfere more than is strictly necessary in national legislation and should limit itself to setting out rules of international jurisdiction.

11. In order particularly to take into account the situation in the United Kingdom where the British Patent Office, acting as a court, hears and determines such disputes, the Sub-Committee inserted a provision stipulating that the term "courts" shall also include, for the purposes of this Protocol, non-judicial authorities which, according to the national law of a Contracting State, have jurisdiction to decide claims to the right to the grant of a patent. The Sub-Committee did not wish to rule out the possibility of other legal systems incorporating such formulae and therefore adopted a general provision.

In reply to the question whether such a specified authority could extend to applications for a European patent the jurisdiction which it applies by virtue of national provisions with regard to applications for national patents,

attention was drawn to Article 22a of the First Convention.

The Sub-Committee also agreed that, with a view to a correct application of the Protocol on this point, it would be necessary to provide that the Contracting States should notify the European Patent Office of the authorities on which jurisdiction of the type set out above is conferred, the European Patent Office informing the other Contracting States accordingly.

13. Finally, the Sub-Committee decided to add a third paragraph to this Article 1, stipulating that, for the purposes of this Protocol, only those States which are bound by this Protocol are included in the concept of Contracting States, in other words, insofar as the matter concerns the application of this Protocol, the States parties to the First Convention, but not parties to this Protocol, shall be considered as non-party States.

Article 2

14. In connection with this Article, the question arose of whether it would not be necessary to stipulate the national law according to which the State of residence would be determined, similarly to Article 52 of the 1968 Brussels Convention on Jurisdiction and the Enforcement of Civil and Commercial Judgments. However, the Sub-Committee considered that if such a provision was necessary in this instance, it would be preferable since the First Convention also refers to the concept of "residence" (cf. Article 154), to insert it in the First Convention.

Articles 3 and 4

15. These two provisions were examined together as, although neither the rule contained in Article 3, nor the principle laid down in Article 4, raised any problems, the way in which these two Articles were linked, retained the attention of the Study Group for a long time.
16. With regard to disputes between an employee and his employer, concerning an invention of the employee (Article 3), the text suggested by the German delegation was based on the principle that the court with jurisdiction and the law applicable should be that of one and the same State. This principle was, in fact adopted as a basic principle. However, the Sub-Committee agreed that this principle should not be applied where the private international law of the State mentioned in Article 15, paragraph 1, second sentence of the Convention, refers to the national law of another country. In fact, in this case the court with jurisdiction would remain the same and would thus be called upon to apply the national law of another State.
17. The Sub-Committee had no difficulty in adopting the principle which is at the basis of this provision, namely that of the right of the parties to designate the court with jurisdiction by joint agreement.
18. With regard to the link between these two provisions, the German proposal laid down that Article 3 prevailed over the principle of the autonomy of the parties according to the terms of Article 4. In this connection, it was pointed out that in fact several national laws in respect of contracts of employment limit, fairly strictly, the

possibility of clauses allocating jurisdiction.

However, another delegation was in favour of freedom of choice of the parties, to avoid cases - which, in the opinion of that delegation, were likely to be relatively frequent - where the two parties would be forced to bring their dispute before a jurisdiction other than that which they would have preferred.

In conclusion, the Sub-Committee decided to lay down that, even in respect of employee's inventions, the parties to the dispute may designate a court with jurisdiction by joint agreement, but only insofar as the national law governing the contract of employment authorises such an agreement.

Article 5

19. Finally, the Sub-Committee examined the case where the authorities of no Contracting State would have "ratione materiae" jurisdiction in accordance with the criteria of Articles 2, 3 and 4 (1). The Sub-Committee wondered whether it would not be appropriate to attribute exclusive jurisdiction in such cases to the courts of a specific Contracting State.

One delegation expressed doubts as to the advisability of such a provision. It considered that it was preferable to allow the parties to choose by joint agreement, the Contracting State before whose courts they desired to bring the matter. Having noted that Article 4 already provided for this choice in the majority of cases, the Sub-Committee considered that it was appropriate, on the other hand, to settle the case where the parties had not

reached agreement, to avoid one of the parties imposing a choice which would be to the disadvantage of the other party. In addition, it was stressed that such provisions, granting exclusive jurisdiction in certain cases, appeared in most international conventions in respect of recognition of decisions. The Sub-Committee thus agreed to provide for such exclusive jurisdiction and chose to grant it to the courts of the Contracting State in which the European Patent Office was located.

20. The Sub-Committee then examined the procedure whereby the courts concerned would implement the rules of jurisdiction contained in the Protocol.

Article 6

It first of all decided that it was for the court before which claims were brought to verify ex officio whether it had jurisdiction (Article 6), which should give the necessary guarantees as to the decision to be recognized.

Article 7

21. The Sub-Committee also examined the procedure to be followed in the event of a conflict of jurisdictions and agreed on the principle that the court to which an earlier application had been made should have priority over a court before which the same dispute had been brought at a later date. However, the Sub-Committee also wanted to settle the case of a negative conflict of jurisdictions by laying down that the court to which a later application is made shall stay proceedings as long as doubts persist as regards the jurisdiction of the court to which an earlier application was made.

For these two Articles, the Sub-Committee intended to conform to a well established international practice as regards the recognition of decisions (cf. for example the 1968 Brussels Convention on Jurisdiction and the Enforcement of Civil and Commercial Judgements).

Article 8

22. After examining the questions concerning the jurisdiction of the authorities originating the decisions to be recognized, the Sub-Committee examined the procedure for recognition itself. Here also it agreed upon the solution which is most generally accepted, namely automatic recognition without the need for resorting to any procedure for this purpose, and without any inquiries being made in principle into the decision to be recognized. The Sub-Committee in fact considered that inquiries of this nature would lead to extraordinary complications, since they would be required not only of the European Patent Office but also of the national courts of the Contracting States called upon to recognize a decision of the courts of the other Contracting States.

Article 9

23. The Sub-Committee wondered however whether it might not be appropriate to envisage restrictions to this automatic recognition of decisions and to this absence of any supervision.

Firstly, it considered the case of decisions taken following a procedure where the rights of defence had not been respected. Most international conventions exclude

recognition if these rights have been seriously infringed. One delegation stressed however that this Protocol was not absolutely comparable to the other conventions. It was not a question of recognition of decisions in one State by another. The European Patent Office itself would be called upon to recognise decisions on the basis of the Protocol and that recognition would have most important effects on an application for a European patent on the basis of Article 16 of the First Convention. This delegation wondered whether it would be possible for the European Patent Office to evaluate infringement of the rights of the defence with the certainty that, for example, the courts of the States designated in the European patent application would evaluate it in the same manner.

24. The Sub-Committee considered that this problem should not be over-estimated in the first place on account of the gravity of infringements of the right of the defence which would have to be established if recognition was not to be given, which in itself would limit the cases of implementation of the projected provision and therefore its dangers. On the other hand, it considered that, the proof of infringements of its rights being the responsibility of the defence, it would suffice for the European Patent Office to judge, with the required degree of strictness, if there had been an infringement, without having to wonder whether the decision which it was rejecting could be recognised by the courts of another Contracting State. Several delegations pointed out, moreover, that they had difficulty in conceiving of a convention on the recognition of decisions which did not include a clause safeguarding the rights of the defence which in their opinion represented an "ordre public" clause. Consequently, the Sub-Committee finally decided to include such a provision in its draft Protocol.

25. The Sub-Committee then examined the case of the co-existence of two incompatible decisions in proceedings between the same parties and wondered which of the two decisions should have precedence. One solution was to give precedence to the first final decision to be taken; the Sub-Committee considered, however, that it was more logical to establish by this means a sanction in respect of the obligation on courts to which a later application is made to decline jurisdiction (Article 7 of the Protocol) by giving precedence to the decision taken by the court to which the earlier application is made, as against the court which should have declined jurisdiction, whatever the respective dates of these decisions.
26. The Sub-Committee finally discussed the Protocol's place among the international obligations of the Contracting States.
- It first of all considered the case of relations among Contracting States themselves, and considered that the Protocol should have precedence over conventions of recognition, already in existence or to come into existence, between the Contracting States, on the basis of the principle that special law derogates from general law.
27. Although some delegations considered that it followed automatically, the Sub-Committee thought it useful to state clearly that the Protocol would not affect the implementation of any agreement between a Contracting State and a State not bound by this Protocol.
28. The Sub-Committee then wondered whether it would be appropriate to state that a decision by a Contracting State recognizing a decision originating in a non-Contracting State, under the terms of a convention between these two

States would have no effect with regard to the other Contracting States. One delegation expressed its preference for a solution which would provide that each Contracting State should take account of decisions recognized in another Contracting State on the basis of an international convention, but the Sub-Committee was unable to subscribe to its point of view. It did however consider it preferable not to settle this problem explicitly, since it did not wish to rule out the possibility that the decision in question could be recognized, on other grounds, in certain Contracting States. In any event it agreed that the decision of recognition could not be interpreted in the same way as a decision within the meaning of Article 8 of the Protocol and would not require to be recognized for this reason.

29. The Sub-Committee lastly considered the expediency of recognizing decisions taken before the entry into force of the Protocol. It was of the opinion that it was very possible that the recognition of a decision delivered before the entry into force of the Protocol might be requested with regard to the State whose court delivered the decision in question. The Sub-Committee observed that this possibility would have little practical application by reason of the time limit laid down in Article 16 of the Convention within which reference for evcking a decision, and considered that, if the above-mentioned time limit was respected, the recognition of such decisions could be allowed.

30. It was not however able to subscribe to the views of the United Kingdom delegation which, emphasizing that in the majority of instances, the same invention would first be the subject of a national patent application, and only subsequently - on the basis of priority - of a European application, wanted decisions concerning the right to the grant of a national patent to be recognized.

The Sub-Committee considered that it was not certain that the European application would correspond exactly to the national application with which the decision dealt, and it would therefore not be appropriate to broaden the scope of the Protocol, which was restricted to decisions concerning the right to the grant of a European patent.

I. Amendments to the Convention

Place of the Protocol in the Convention

31. In its desire that the greatest number of States parties to the Convention should also be bound by the Protocol, the Sub-Committee decided to make the Protocol an annex to the Convention and an integral part thereof, on the same terms as the Implementing Regulations.

The Sub-Committee wished however to provide, at least during a transitional period, an option for the States parties to the Convention not to be bound by the Protocol. It considered that the simplest solution would be to give the said States a possibility of reservation identical to that already existing in the Convention (Article 159). It proposes, consequently, to Working Party I that this new possibility of reservation should be inserted in Article 159 of the First Convention.

Attribution of jurisdiction to national courts

32. The Sub-Committee wondered whether it was necessary to lay down in the Convention a provision expressly attributing to national courts jurisdiction in matters relating to the European patent. It finally considered that this jurisdiction was already implicit in those Articles of the Convention which treated the European patent similarly to a national patent (cf. in particular

Article 22a of the First Convention) and that no explicit provision was therefore necessary.

Article 16

33. The Sub-Committee agreed to propose to Working Party I an amendment to Article 16 of the First Convention in order to take account of the anxieties expressed by the German delegation relating to the impossibility under German national law to achieve the result sought in Article 16 by a "Feststellungsklage" (action for a declaratory judgment) (cf. point 6 above).

IV. Miscellaneous

34. After one delegation raised the problem of relations between the Protocol and the Second Convention, the Sub-Committee agreed that it would be difficult to imagine all the States parties to the Second Convention not being bound by this Protocol. Moreover, the Sub-Committee wondered whether the Protocol in its present form would really be adapted to the specific requirements of the Second Convention. It agreed that these problems should be examined, but that they did not, however, fall within the competence of the Sub-Committee.
35. With regard to the procedure to be followed, the Sub-Committee decided, in its desire to speed up the work, to submit the text of the Articles adopted directly to the Drafting Committee of the Intergovernmental Conference without prejudice, however, to the examination of these Articles by Working Party I.
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Anlage

zu Dok. BR/GT I/162/72

Annex

to Doc. BR/GT I/162/72

Annexe

au doc. BR/GT I/162/72

VERZEICHNIS DER TEILNEHMER

an der Erste Tagung
der Untergruppe "Protokoll" der Arbeitsgruppe I
(Brüssel, 6. bis 9. März 1972)

LIST OF PARTICIPANTS

at the first meeting
of the sub-committee "Protocol" of Working Party I
(Brussels, 6 to 9 March 1972)

LISTE DES PARTICIPANTS

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du Sous-groupe "Protocole" du Groupe de travail I
(Bruxelles, du 6 au 9 mars 1972)

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