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

Brussels, 25 April 1972
BR/GT I/163/72

- Secretariat -

W o r k i n g D o c u m e n t

submitted by the Chairman of Working Party I

concerning the Draft Convention establishing a European System
for the Grant of Patents

Proposals for Articles 120 and 121

of the version drawn up by the Inter-Governmental Conference Drafting Committee

BR/GT I/163 e/72 ley/KM/prk

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Drafting Committee version

means Draft Convention establishing a European System for the Grant of Patents in the version drawn up by the Inter-Governmental Conference Drafting Committee (BR/184/72).

under the text in the column headed "Drafting Committee version"

means that the text thus underlined is deleted in the column headed "Chairman's proposal".

under the text in the column headed "Chairman's proposal"

means that the text thus underlined is an addition to the Drafting Committee version

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Introductory Note

I. Further processing of the European patent application upon payment of a fee

1. At the 5th Meeting of the Inter-Governmental Conference, the non-governmental international organisations expressed the wish that there should be some means of redress in some cases of the European patent application being deemed to have been withdrawn. They referred inter alia to the patent laws of the Scandinavian countries, which in certain cases allow delayed transactions to be carried out late upon payment of a fee and without proof of extenuating circumstances (cf. Minutes of the 5th Meeting of the Inter-Governmental Conference, Part 2, Point 73 - BR/169/72).

After hearing the international organisations, the Inter-Governmental Conference instructed Working Party I to look into the matter with reference to the provisions of Article 121 (142) of the Convention and Article 70 (Re. Article 145, No. 11) of the Implementing Regulations (1). It also asked the Swedish delegation to provide Working Party I with information about the relevant provision of Swedish patent law (cf. Minutes of the 5th Meeting of the Inter-Governmental Conference, Parts 1 and 3, Point 151 - BR/168/72). The Swedish delegation complied with this request in its note of 24 February 1972 (BR/GT I/148/72).

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- (1) The drafts of the Convention and Implementing Regulations are quoted in the version drawn up by the Conference Drafting Committee (cf. BR/184/72 and BR/185/72).

Wherever it is required for the purpose of understanding this working document, the new Article numbers are followed by the corresponding numbers of the Articles of the Second Preliminary Draft Convention or the First Preliminary Draft Implementing Regulations as contained in BR/139/71 and BR/176/72.

At its 11th meeting, Working Party I did not have sufficient time to make a conclusive examination of the consequences that would result should a provision corresponding to the patent laws of the Scandinavian countries be included in the Convention. It therefore decided to leave the decision on the international organisations' proposal to the Co-ordinating Committee. The Chairman undertook to draw up a working document dealing with this proposal before the 2nd meeting of the Committee, which is to be held from 15 to 19 May 1972 (cf. Minutes of the 11th meeting of Working Party I, point 88 - BR/177/72).

2. In this working document, the Chairman submits alternative proposals for Article 120, which was left open by the Conference Drafting Committee, and a proposed new drafting for Article 121 of the Convention.
3. Before going into these proposals in detail, it should be stated what possibilities are open to the applicant under the drafts of the Convention and Implementing Regulations, as drawn up by the Conference Drafting Committee, in the event of the European patent application being deemed to be withdrawn following failure to observe a time limit.

If the application is deemed to be withdrawn because of failure to observe the time limit for payment of the filing fee and search fee or all the designation fees, or for filing the request for examination, the fiction cannot be contested (cf. Article 121, paragraph 5, of the Convention). If the application is deemed to be withdrawn on other grounds, the fiction can only be retracted by restitutio in integrum, that is, only if the applicant has been prevented by force majeure from observing the time limit.

Article 70, paragraph 2, of the Implementing Regulations entitles the applicant in both cases to apply for a decision by the European Patent Office as to the justification of the withdrawal fiction. However, unless the applicant has in fact taken the prescribed action within the time limit in question, this decision cannot do otherwise than confirm the withdrawal fiction.

4. The note by the Swedish delegation states that the Scandinavian system of *restitutio in integrum* is only applied in cases of time limits set by the Patent Office. The Swedish delegation has found from experience that it is particularly useful in connection with official actions (communications) concerning the examination for novelty and patentability.

For the purposes of the 1st Convention, this means primarily that the case referred to in Article 95, paragraph 3 (Article 92, paragraph 2, and Article 95, paragraph 1b) of the Convention requires the possibility of retracting the withdrawal fiction without *restitutio in integrum* on the grounds of force majeure. This also corresponds to the ideas of the international organisations, who made special reference both to this case and to that of Article 123, paragraph 2 (Article 150, paragraph 2) of the Convention, and did not consider an extension to cover the time limit for paying renewal fees and other cases where delays must be avoided as justified (BR/169/72, point 73).

5. The Chairman's proposed first alternative for Article 120 of the Convention takes account of the views expressed by the organisations and by the Swedish delegation. The further processing of the European patent application should be carried out on request, requiring payment of a fee, if the application has been deemed to be withdrawn following failure to observe a time limit set by the European Patent Office, that is to say pursuant to Article 95, paragraph 3, and Article 123, paragraph 2, of the Convention.

in order to speed up the procedure, the period for filing the request for retraction of the legal consequence should be shorter than that provided for in Scandinavian patent law (4 months after expiry of the unobserved time limit). The Chairman is of the opinion that the time limit should be of the same length as that within which the applicant may request revision of the noting of loss of rights pursuant to Article 70, paragraph 2, of the Implementing Regulations.

The 2nd alternative submitted for Article 120 of the Convention provides for the processing of the European patent application to be continued even in the event of failure to observe the time limit referred to in Article 41, paragraph 1, of the Implementing Regulations, which results in the refusal of the application pursuant to Article 90, paragraph 3, of the Convention.

The inclusion of this legal consequence in Article 120 of the Convention is put up for discussion should the Co-ordinating Committee share the Chairman's view that even though an applicant who has failed to observe the time limit concerned can appeal against the refusal of the application, the decision by the Board of Appeal can only confirm the refusal unless the applicant has in fact taken the prescribed action within the time limit in question. In this case the applicant would, unless Article 120 of the Convention is extended as proposed, have no possibility to recoup his lost rights, as, according to the proposal made in point 10, which is to restrict Article 121 of the Convention to the time limits laid down in the Convention and Implementing Regulations, even restitutio in integrum would be impossible.

8. Inclusion of the refusal of the application in Article 120 of the Convention raises the question of the time limit within which the applicant may request further processing of the application in such a case, since refusal of the application does not constitute commencement of the time limit provided for in Article 70, paragraph 2, of the Implementing Regulations.

The Chairman feels that it would be logical if the time limit were to be the same as the period within which the applicant may appeal against the decision to refuse the application, i.e. three months after notification of the decision (cf. Article 107 of the Convention).

The Chairman would like to point out that, as may be seen from paragraph 2 of the 2nd alternative for Article 120 of the Convention, such a ruling would result in two different time limits for filing the request for further processing of the application, the longer of which could have a disruptive effect on the procedure, as it would frequently, and always in the case of priority applications, involve a delay in the publication of the application (Article 92 of the Convention).

Should the Co-ordinating Committee come out in favour of the principle behind the second alternative, the Chairman suggests that it should study whether Article 90, paragraph 3, of the Convention should be reworded to take account of the fiction of the withdrawal of the application. Such an adjustment would be advantageous in that firstly the time limit for the request for further processing of the application would be one and the same for all the cases referred to in Article 120 of the Convention, viz. 2 months after notification, and secondly

there would be fewer cases of delayed publication of applications. The Chairman would also point out that according to BR/GT I/148/72 such a ruling would also be in conformity with Scandanavian patent law.

9. In the event of either of the Chairman's two proposals for Article 120 of the Convention being adopted, Article 2 of the Draft Rules relating to Fees would also have to be amended to include the fee for further processing.
10. The introduction of the legal expedient of further processing of the European patent application in the cases referred to above, should deviate the need to allow for restitutio in integrum in cases of failure to observe time limits set by the European Patent Office. The proposed redraft of Article 121 of the Convention therefore provides for re-establishment only in the event of failure to observe time limits laid down in the Convention and the Implementing Regulations (cf. in this connection Article 160, paragraph 1, of the Convention).

It is true that if this proposal is adopted, neither restitutio in integrum nor further processing of the European patent application come into play in the event of failure to observe some of the time limits set by the European Patent Office, but it should be possible to accept this disadvantage, as such delays do not result in immediate loss of rights. These are primarily time limits which, when not observed, result in the Board of Appeal or Opposition Division not being obliged to take into account any information that the parties might file after the time limit expires. It must be assumed that the Board of Appeal and the Opposition Division will use their discretion in the matter wisely.

II. Extension of time limits in the event of interruption of
postal services

11. In BR/GT I/151/72 of 25 February 1972, the United Kingdom delegation proposed that when dealing with the matter of time limits account should also be taken of the possibility of the interruption of postal services in any Contracting State other than that in which the European Patent Office is located or between any such State and the State in which the European Patent Office is located, and it submitted redrafts for Article 119 (141) of the Convention and Article 85 (Re. Article 141, No. 2) of the Implementing Regulations.

At the 5th Meeting of the Inter-Governmental Conference the United Kingdom delegation asked that its proposal should be referred to Working Party I for study. The Conference agreed to this request (cf. BR/168/72, point 152).

At the 11th meeting of Working Party I several delegations felt that the case referred to by the United Kingdom delegation could be covered by Article 121 (142) or the proposals still to be examined in connection with re-establishment. The Working Party did not therefore take a decision on the United Kingdom proposal; instead, it decided to examine it in connection with the redrafting of Article 121 and the introduction of the new Article 120 of the Convention (cf. BR/177/72, point 89).

12. The aim of the United Kingdom proposal was to introduce a provision to the effect that in the afore-mentioned case the time limit not observed as a result of an interruption in postal services would be extended without necessitating restitutio in integrum or another request requiring payment of a fee for retraction of a legal consequence. The proposals for Articles 120 and 121 of the Convention submitted in this working document take this desideratum into account.

Should the United Kingdom delegation maintain its proposal, the Chairman would draw its attention to Rule 82.2 of the Regulations under the PCT.



Article 120, 1st Alternative, of the Convention

Further processing of the European patent application

Chairman's proposal

(1) If the European patent application is deemed to be withdrawn following failure to observe a time limit set by the European Patent Office, this legal consequence shall be retracted if the applicant requests further processing of the application.

(2) The request shall be filed in writing within two months of the date on which the communication that the European patent application is deemed to be withdrawn is notified. The delayed action must be taken within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.

(3) The department competent to decide on the action provided for in paragraph 2 shall decide on the request.

Note:

The legal consequence referred to in paragraph 1 occurs in the event of failure to observe the time limits laid down in the following provisions:

Article 95, paragraphs 1 and 2, of the Convention
Article 123, paragraph 1, of the Convention.

Article 120, 2nd Alternative, of the Convention

Further processing of the European patent application

Chairman's proposal

(1) If the European patent application is to be refused or is refused or is deemed to be withdrawn following failure to observe a time limit set by the European Patent Office, the legal consequence provided for shall not ensue or, if it has already ensued, shall be retracted if the applicant requests further processing of the application.

(2) The request shall be filed in writing, either, in the event of the refusal of the European patent application, within three months of the date on which the decision to refuse the application was notified, or in other cases, within two months of the date on which the communication that the application is deemed to be withdrawn is notified. The delayed action must be taken within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.

(3) The department competent to decide on the action referred to in paragraph 2 shall decide on the request.

Note:

The legal consequences referred to in paragraph 1 occur in the event of failure to observe the time limits provided for in the following provisions:
Article 90, paragraph 3, of the Convention in conjunction with Article 41, paragraph 1, of the Implementing Regulations;
Article 95, paragraphs 1 and 2, of the Convention;
Article 123, paragraph 1, of the Convention.

Article 121 (142; Re. 142, No. 1, IR), paragraph 1, of the Convention

Restitutio in integrum

Drafting Committee Version

(1) The applicant for or proprietor of a European patent who is prevented by force majeure from observing a time limit shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of this Convention, of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

Article 121 (142; Re. 142, No. 1), paragraph 1, of the Convention

Restitutio in integrum

Chairman's proposal

(1) The applicant for or proprietor of a European patent who is prevented by force majeure from observing a time limit laid down in this Convention shall, upon application, have his rights re-established, if the non-observance in question has the direct consequence of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

