

BR/GT I/164 e/72

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

Brussels, 18 April 1972
BR/GT I/164/72

- 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 132 and 133 of the redrafted version of the Draft Convention drawn up
by the Select Drafting Committee of the Inter-Governmental Conference and proposed new Articles
133a, 159a and 159b

compared synoptically with

the Second Preliminary Draft of a Convention establishing a European System for the Grant of
Patents

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KEY

Second Preliminary Draft

indicates the Second Preliminary Draft of a Convention establishing a European System for the Grant of Patents, taking into account the amendments contained in BR/139/71 of 6 December 1971.

----- under the text in the
"Second Preliminary Draft"
column

indicates that the text thus underlined has been omitted from the Chairman's proposals.

----- under the text in the
"Chairman's Proposal"
column

indicates that the text thus underlined is new in relation to the Second Preliminary Draft. Completely new paragraphs are not, however, underlined.

Introductory Note

- I. The problem of representation before the European Patent Office was discussed by the non-governmental international organisations when they were "heard" by the Inter-Governmental Conference at its 5th Meeting (cf. Minutes of the 5th Meeting of the Inter-Governmental Conference, Part II, BR/169/72, points 150 to 158).

The international organisations were not able to reach a united position. Those representing industry and those representing patent agents expressed the intention of establishing contacts with each other with a view to submitting a joint proposal to the Conference if possible. However, to the knowledge of the Chairman of Working Party I a joint proposal by those international organisations would now appear to be unlikely.

At the 11th meeting of Working Party I the Chairman undertook, in view of the short time left for the Conference to conclude its work, to submit proposals for rules governing representation before the European Patent Office in preparation for the 2nd meeting of the Co-ordinating Committee.

- II. This Working Document contains the Chairman's proposals. In the light of the points made by the international organisations at the 5th Meeting of the Inter-Governmental Conference, they are based on the following principles:

1. A distinction should be made between rules for a transitional period and definitive rules.

During the transitional period the national laws of the Contracting States should apply, subject to certain exceptions. As for the definitive rules, only the general principles should be laid down in the Convention and the Administrative Council should be given the power to determine the details, either by supplementing the Implementing Regulations, or by adopting special provisions.

2. A distinction should be made between natural and legal persons acting through their employees in proceedings before the European Patent Office, and natural and legal persons being represented in proceedings before the European Patent Office by persons entitled to act as representatives by virtue of satisfying particular compulsory requirements.
3. The persons entitled to act as representatives before the European Patent Office should be able to do so irrespective of whether they are employees or independent agents.
4. Natural and legal persons having their residence or registered place of business outside the Contracting States must, from the outset (i.e. from the opening of the European Patent Office), be represented by persons entitled to act as representatives before the European Patent Office.

III. In the following synopsis the provisions of the Second Preliminary Draft referred to are numbered and worded as in BR/139/71 of 6 December 1971. The Chairman's proposals have been made to fit in as far as possible with the redrafted version of the Draft Convention drawn up by the Select Drafting Committee of the Inter-Governmental Conference (document dated 29 March 1972).

With regard to the structure of the provisions concerning the definitive rules, the Chairman's proposals are in the following order, as suggested by the international organisations:

Acting without representation	(Article 132)
Compulsory representation	(Article 133)
Persons entitled to act as representatives	(Article 133a)

For the transitional period, rules derogating from the definitive rules are proposed only in respect of Article 132, paragraph 2, first sentence and Article 133a, paragraph 2. Consequently the provisions of Article 133 and those of Article 133a, paragraphs 1, 3, 4, 6 and 7 are applicable from the outset.

IV. The nub of the differences of opinion between the international organisations representing industry and those representing patent agents lay, in the view of the Chairman, in the question of so-called "multiple representation", namely whether employees of one legal person should be allowed, in proceedings before the European Patent Office, to represent other legal persons

which have economic links with the first legal person.

The Chairman's proposals provide that during the transitional period national laws should apply, with one exception. Where the national law of a Contracting State allows an employee of a legal person with its registered place of business in a Contracting State to represent before the central industrial property office of that State a subsidiary company, for example, which is located outside the Contracting States - to the knowledge of the Chairman present French law allows this - this facility should not be applicable in proceedings before the European Patent Office. The Chairman considers that this exception from national law is necessary, since otherwise certain legal persons in non-contracting States would be accorded exemption from compulsory representation for the transitional period, and it might then prove impossible or extremely difficult to remove this exemption at the end of the transitional period. Moreover, to the knowledge of the Chairman, no major non-European countries have or would be prepared to introduce comparable laws. Furthermore, the Chairman's proposals in practice provide the relief that during the transitional period also a legal person with its registered place of business in the Contracting States can appoint as an employee a person entitled to act as a representative pursuant to Article 159b.

With regard to the definitive rules, the Chairman's proposals leave the problem of multiple representation to be decided by the Administrative Council (cf. Article 132, paragraph 3).

In this way the time required for further study and discussion with a view to finding a European solution to this problem could be ensured.

V. For the sake of completeness, attention is drawn to the following points:

1. Article 132, paragraph 2, second sentence, will have to bear a reference to the Implementing Regulations, as the former Article 155 no longer appears in the Convention.
2. It might be expedient to transfer Article 133a, paragraph 3, second sentence, to Part IX (Article 141 et seq.).
3. A provision corresponding to Article 133a, paragraph 7, should be inserted in Article 31.
4. The Drafting Committee should be free to transfer parts of the proposals to the Implementing Regulations at its discretion.



Article 154, para. 1

Compulsory representation

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(1) Subject to the provisions of the following paragraphs, no persons shall be compelled to be represented before the European Patent Office.

Chapter III
Representation

Article 132 (154, para. 1)

Acting without representation

Chairman's Proposal

(1) Subject to the provisions of Article 133, no person shall be compelled to be represented before the European Patent Office by one of the persons referred to in Article 133a.

(2) Natural and legal persons having their residence or registered place of business within the territory of one of the Contracting States may act in any proceedings before the European Patent Office through one of their employees. The employee shall require an authorisation in accordance with Article 155.

(3) The Implementing Regulations may determine whether and under what conditions employees of a legal person in accordance with paragraph 2 may act for other legal persons which have their registered places of business within the territory of one of the Contracting States and which have economic links with the first legal person.

Article 154, paras. 2 and 3

Compulsory representation

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(2) Natural and legal persons not having either a residence or a registered place of business within the territory of one of the Contracting States must be represented in all proceedings before the European Patent Office.

(3) Subject to any exceptions permitted in the Implementing Regulations, and with the exception of the filing of the European patent application, persons referred to in paragraph 2 above may only act vis-à-vis the European Patent Office through their representative.

Article 133 (154, paras. 2 and 3)

Compulsory representation

Chairman's Proposal

(1) Natural and legal persons not having either a residence or a registered place of business within the territory of one of the Contracting States must be represented in all proceedings before the European Patent Office by one of the persons referred to in Article 133a.

(2) Subject to any exceptions permitted in the Implementing Regulations, and with the exception of the filing of the European patent application, natural and legal persons referred to in paragraph 1 above may only act vis-à-vis the European Patent Office through one of the persons referred to in Article 133a.

Article 153, paras. 1 and 5

Professional representation

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(1) Representation of natural and legal persons in proceedings before the European Patent Office may, subject to the provisions of paragraph 5 below, only be undertaken by natural persons whose names appear on a list maintained for this purpose by the said Office.

Notes to Article 153:

1. The State in which the European Patent Office is located will have to take the necessary steps, in good time, to enable representatives who are nationals of other Contracting States to establish a place of business in its own territory.

A provision to this effect, which should appear in the Convention, will be drafted later.

Persons entitled to act as representatives

Chairman's Proposal

(1) Representation of natural and legal persons in proceedings before the European Patent Office may, subject to the provisions of paragraph 6 below, only be undertaken by natural persons whose names appear on a list maintained for this purpose by the said Office.

(2) Any person who fulfils the following conditions may be entered on the list:

- (a) he must be a national of one of the Contracting States;
- (b) he must have his place of business within the territory of one of the Contracting States;
- (c) he must have passed the European qualifying examination.

Entry shall be effected upon request, accompanied by certificates which must indicate that the above conditions are fulfilled.

(3) Persons whose names appear on the list referred to in paragraph 1 above shall be entitled to act before all departments of the European Patent Office. In so far as special departments are set up in the European Patent Office by virtue of a special agreement under Article 141, the entitlement of the persons whose names appear on the list referred to in paragraph 1 to act as representatives may, in respect of these special departments, be limited by the special agreement to persons who are nationals of one of the Contracting States which are parties to the special agreement and who have their place of business in one of these Contracting States.

(4) Any person whose name appears on the list referred to in paragraph 1, and who has his place of business in a Contracting State other than that in which the European Patent Office is located shall be entitled also to set up a place of business in the latter State.

(5) The President of the European Patent Office may, in special circumstances, grant exemption from the requirement of paragraph 2(a).

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(5) Representation before the European Patent Office may also be undertaken by any legal practitioner qualified in one of the Contracting States and having his registered place of business within such State, to the extent that he is able, within the said State, to act as a representative in patent matters.

Chairman's Proposal

(6) Representation before the European Patent Office may also be undertaken by any legal practitioner qualified in one of the Contracting States and having his registered place of business within such State, to the extent that he is able, within the said State, to act as a representative before the central industrial property office. Paragraph 3, second sentence, of this Article shall apply mutatis mutandis.

(7) The Administrative Council shall be authorised to adopt provisions governing the qualifications and training required of a person for admission to the European qualifying examination, the conduct of the European qualifying examination, and the establishment or recognition of an institute constituted by the persons entitled to act as representatives pursuant to this Article.

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Article 159a (new)
Acting without representation

Chairman's Proposal

(1) During a transitional period, the expiry of which shall be determined by the Administrative Council, notwithstanding the provisions of Article 132, paragraph 2, first sentence, natural and legal persons having their residence or registered place of business within the territory of one of the Contracting States may act in any proceedings before the European Patent Office through one of their employees in so far as this is permitted under the national law of the State in which the natural or legal person has his residence or registered place of business for proceedings before the national central industrial property office. Article 133 shall remain unaffected.

(2) The European Patent Office may require for each specific case that a certificate from the national central industrial property office be furnished as proof of the extent of the representative's right to act.

Professional representation

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(2) Any person having his registered place of business within the territory of one of the Contracting States who, according to a certificate furnished by the central industrial property office of that State, is entitled to act professionally as a representative in patent matters before that office, may be entered on the list. Entry shall be effected upon request, accompanied by the certificate referred to above, which must specify the extent of such entitlement.

(3) When, in any Contracting State, entitlement to act as a representative is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act as representatives in patent matters before the central industrial property office of the said State must have habitually acted as such for at least five years. Provided that persons whose professional qualification to represent natural and legal persons in patent matters before the central industrial property office of one of the Contracting States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession. The certificate referred to in the preceding paragraph must indicate that the applicant satisfies one of the conditions referred to in the present paragraph.

Article 159b (153, paras. 2, 3 and 4)

Persons entitled to act as representatives

Chairman's Proposal

(1) During a transitional period, the expiry of which shall be determined by the Administrative Council, notwithstanding the provisions of Article 133a, paragraph 2, any person who fulfils the following conditions may be entered on the list maintained for this purpose by the European Patent Office pursuant to Article 133a, paragraph 1:

- (a) he must be a national of one of the Contracting States;
- (b) he must have his place of business within the territory of one of the Contracting States;
- (c) he must be authorised to represent natural or legal persons in patent matters before the central industrial property office of the Contracting State in which he has his place of business.

Entry shall be effected upon request, accompanied by certificates which must indicate that the above conditions are fulfilled. The certificate furnished by the national central industrial property office in accordance with sub-paragraph (c) must also specify the extent of the entitlement to act as a representative before this authority.

(2) When, in any Contracting State, entitlement to act as a representative is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act as representatives in patent matters before the central industrial property office of the said State must have habitually acted as such for at least five years. Provided that persons whose professional qualification to represent natural and legal persons in patent matters before the central industrial property office of one of the Contracting States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession. The certificate referred to in paragraph 1(c) must indicate that the applicant satisfies one of the conditions referred to in the present paragraph.

Article 153, paras. 2, 3 and 4 continued

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(4) Persons whose names are entered on the list referred to in paragraph 1 may only act before the European Patent Office to the extent that they are entitled, within the terms of the certificate referred to in paragraph 2, to act as representatives in patent matters in the Contracting States in which they exercise their profession.

Chairman's Proposal

(3) The President of the European Patent Office may, in special circumstances, grant exemptions from the requirement of paragraph 1(a). The President of the European Patent Office may also grant exemption from the requirement of having habitually acted as a representative for five years in patent matters before the central industrial property office of a Contracting State in accordance with paragraph 2, first sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way.

(4) Persons having their place of business in a State which acceded to this Convention less than one year before the expiry of the transitional period referred to in paragraph 1 or after the expiry of the transitional period, may, under the conditions laid down in paragraphs 1 to 3, during a period of one year calculated from the date of entry into force of the accession of the State in which they have their place of business, be entered on the list maintained for this purpose by the European Patent Office in accordance with Article 133a, paragraph 1.

(5) Persons whose names are entered on the list maintained by the European Patent Office by virtue of paragraph 1, may only act before the European Patent Office to the extent that they are entitled, within the terms of the certificate furnished by the national central industrial property office pursuant to paragraph 1 to act as representatives in patent matters in the Contracting States in which they exercise their profession.

(6) Persons whose names are entered on the list maintained for this purpose by the European Patent Office in accordance with paragraphs 1 to 4, shall continue to be entitled to act as representatives before the European Patent Office after the expiry of the transitional period without having to take the European qualifying examination under Article 133a, paragraph 2(c).

