

EFTA Draft 4/67

Travaux Préparatoires EPC 1973

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C o n t e n t s

DOCUMENT IN ENGLISH:

DRAFT OF AN OPEN EUROPEAN PATENT CONVENTION FORMING THE FIRST CONVENTION IN THE TWO-PART SCHEME

- elaborated by the European Free Trade Association
(working document EFTA 4/67 of 19 January 1967)

- "EFTA-draft" -

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EUROPEAN FREE TRADE
ASSOCIATION

EFTA 4/67
3 Annexes
19th January, 1967.

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PATENTS

Report of the working party

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I MEETINGS

1. Following the receipt of the two reports (EFTA 12/65 and EFTA 43/65) of an ad hoc group of experts, the Council decided at the May 1965 Vienna Ministerial meeting to establish this working party (EFTA/C.SR 18/65, paragraph 82). The working party has met in Geneva five times, and its work is described so far in two progress reports (EFTA 82/65 and EFTA 113/65), two informal Summary Records (MISC 6762/66 and MISC 7400/67) and this report. Its drafting and statistical sub-committee met in Geneva in March and October 1966. A list of participants in the January 1967 meeting, at which this report was drafted, forms Annex I.

II MANDATE

2. The working party was given a mandate by the Council in two parts as follows:

- (a) to study the draft EEC Patent Convention in order to reach agreement about the requirements of a two-part convention which would be open for full membership by countries outside the EEC, so far as the granting of patents is concerned; and
- (b) to examine, in the light of current developments, other forms of international co-operation - in the first instance, in the granting and recognition of patents within EFTA, and further, including both the EFTA and EEC countries.

III POINT (a) OF THE MANDATE

3. In its reports to the Council in July and October 1965 (EFTA 82/65 and EFTA 113/65) the working party stated that a two-part version of the EEC scheme, providing on the one hand for an international patent granting procedure, and on the other hand for a common EEC patent, appeared to be a practical proposal and to meet the interests of countries inside and outside the EEC, and in particular those of EFTA countries. The July 1965 report (EFTA 82/65) included in its Annex II a breakdown of the articles of the EEC draft into two parts, and the October 1965 report (EFTA 113/65) included an explanatory note of the scheme as seen by the working party at that time.

4. Thereafter, the working party considered the detailed implications of the two-part scheme and has produced a rough convention draft based on the actual articles of the EEC text to form the first convention of the two-part scheme. This

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drafting has thrown up no insuperable technical problems. The draft forms Annex III to this report and an explanatory note which gives the general outline of the two-part scheme and a brief explanation of the technical contents of the draft, forms Annex II.

Conclusion

5. The working party confirms, on the basis of its draft, the views expressed in its reports of July and October 1965, that the scheme is a workable one which should meet the present interests of both EEC and EFTA countries, and possibly other countries. It thus forms a sound technical basis for negotiations with the EEC.

IV POINT (b) OF THE MANDATE

6. As to possible other forms of co-operation, the working party is of the opinion that elaborate forms of co-operation discussed in earlier reports or Summary Records (i.e. EFTA 113/65 and MISC 6762/66), such as centralized EFTA patent granting or mutual recognition of patents granted on similar laws and practices, should be considered only if it is clear that no possibility exists in the foreseeable future for a wider arrangement involving, e.g. the EEC. (In this connection the working party has in mind the possibility of an EEC-EFTA arrangement in line with point (a) of its mandate, or of some development from a current initiative in BIRPI.) The main problems involved in schemes of centralized EFTA patent granting and mutual recognition of patents have been considered by the working party and reported on in its January 1966 Summary Record (MISC 6762/66). It is not considered worth while doing any more detailed work on such schemes at this stage. The question for consideration is whether, pending wider developments, any more modest co-operation is possible.

7. The working party has received a statistical investigation of the duplication of applications within EFTA Member countries. This investigation is based on rather limited material and is not considered to be wholly reliable. However, the figures that it does provide do indicate a possible degree of duplication within EFTA countries which is sufficiently large to justify some further investigations into possibilities of mutual assistance within EFTA countries. If the investigations give positive results, mutual assistance should be of actual interest in the event of failure to achieve some general international patents scheme in line with point (a) of the mandate.

8. The working party would like to use the interim to give further thought to this matter and particularly to give consideration to some proposals put before it by the Scandinavian delegations in MISC 7396/67. Further it would like to consider the possibility of producing some more reliable and possibly more extensive statistical information, e.g. along the lines mentioned in paragraph 2 of MISC 7396/67.

Proposals

9. (a) The working party proposes, therefore, that delegations be invited to give their observations on the Scandinavian proposals, and to make suggestions for further statistical investigation. These suggestions and observations, it is proposed, should be submitted within the next three months to be considered later by the sub-committee already constituted for the drafting work on the two-part scheme, and for statistical work.
- (b) The working party proposes, therefore, that the sub-committee should meet at some time before October 1967.

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Annex I to
EFTA 4/67
19th January, 1967.

WORKING PARTY ON PATENTS

Geneva, 10th - 12th January, 1967

List of Participants

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<u>SWITZERLAND</u>	Mr. Joseph Voyame Prof. Pierre Jean Pointet Mr. Max Jaeger
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* Part of the meeting only

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EUROPEAN FREE TRADE
ASSOCIATION

Annex II to
EFTA 4/67
19th January, 1967.

EXPLANATORY NOTE ON THE PROPOSAL FOR A
TWO-PART SCHEME FOR A EUROPEAN PATENT

1. The draft which follows in Annex III is based on the draft Convention for a European Patent Law produced by the EEC countries. It does not purport to present a polished text.
2. It should be emphasized that the amendments of the EEC draft have been restricted to those necessary to provide an open, international scheme and no attempt has been made otherwise to change the original text.
3. The aim has been to provide a truly international convention which provides as the first part of a two-part scheme, a common patent examination and granting procedure. This first convention, it is believed, would be suitable for membership for non-EEC - in particular for EFTA - as well as EEC, countries; it would be open for accession by any country which is a member of the Paris Union; and it could be supplemented by a second convention (or possibly a protocol) regulating matters for the EEC countries alone (e.g. the economic rules and property rights attaching to a Community patent).
4. The following is a brief description of the main features of the first convention of the proposed two-part scheme. It explains how the first convention would work and how it differs from the EEC draft, and how it relates to the second part of the two-part scheme. It also draws attention to certain alternative possibilities which are available within the scheme, and which should be left open at this stage.

Patent granting procedure

5. The "deferred examination" system of the EEC draft scheme is retained. A unitary European patent will, however, exist only as an unconfirmed patent, and the title "European patent" is therefore used only in that connection. When the European patent is confirmed it is immediately superseded by a "bundle" of "final" national patents (see 6 below). By virtue of Article 2A(3), and of the separate second convention, a single final EEC patent would be granted covering the whole Community. An application will be examined by the European Patent Office in just the same way as is set out in the EEC draft. A search will be made and a "European" patent granted which will be effective in the countries covered by the application. An applicant should be able to select certain countries only for

his application, with appropriate variation of the application fee. It will be seen that by Articles 34(5) and 84(1) an applicant may be deterred from including countries in which he has no real interest by having to provide translations into languages other than English, French and German and to pay granting and printing fees commensurate with the number of countries covered. The European patent carries in each country the same rights as a national patent, subject to the restriction that if, in an infringement action the validity of the patent is challenged, the infringement proceedings must await confirmation of the patent. The patent rights are prescribed by national law, so it will be open to each country to prescribe what rights (if any) are carried there by the European patent. There will be no question of action at national level to establish the validity of the European patent; also there can be no assignment or other change of ownership on a national basis, since the European Patent Office cannot deal with two or more independent patentees in confirmation proceedings. Annual renewal fees will be paid for the maintenance of the European patent, dependent on the countries to be covered.

6. Full examination by the European Office will take place, as in the draft EEC scheme, on an application for "confirmation", either by the patentee or by a third party, made within five years of grant. Confirmation procedure is acceptable either as set out in the draft (i.e. subject to "intervention" by interested third parties) or - as is understood to be under consideration in the EEC - subject to a classical "opposition" procedure, cf. note following Article 87. Confirmation, if successful for the patentee, will result in the European Office granting final patents in all the countries covered by the application. It is envisaged that the final granting fee will be commensurate with the number of countries covered, and that there will be no extra national registration fees. It will be seen from the note to Article 2A(1) that the draft results in the granting of final patents for all countries covered by the European patent, leaving them to be judged according to the law of each country. In practice this will probably permit of variation from one country to another in respect of two matters only, viz. (i) the effect of prior national applications (see 9 below) and (ii) the exclusion from patentability of certain kinds of subject matter (e.g. food or drugs). As regards the latter it would be possible for a patent to be invalid or have no force in a particular country, in so far as it covers subject matter (e.g. food or drugs) excluded from patentability in that country. The final (national) patents would be quite independent of each other as regards their maintenance, validity and rights.

Effect of patents: influence on national law

7. The national patents so granted will be justiciable according to the laws of the individual countries concerned. Since the examination would have been carried out against the substantive law set out in the Convention,) it would be only sensible for national law to be in conformity with the international law. This would largely be the case if Member countries have ratified the Council of Europe Convention on the unification of certain points of patent law.

Licensing

8. (a) National provisions for compulsory licensing will apply to the final national patents and it will be for each country to decide how it wishes to apply them to the European patent.
- (b) As regards contractual licensing, a European patent may be licensed for the whole or part of the territories in which it is effective, but will have to be recorded in the Register of European patents at the European Patent Office in order to take effect in relation to third parties (cf. Articles 29 and 25). For the final national patent, contractual licensing is governed by national law.

Taking account of prior national applications

9. The validity of a national patent can be affected by the existence of a prior application in respect of the same, or a similar, invention, which was unpublished at the date of application. This is dealt with in examination by the European Office under Article 11(3) so far as prior European applications are concerned, but not prior national applications. The latter will be left for action in the individual countries in relation to the final patents effective therein. Various possibilities are open. One is for the country concerned to conduct an examination for prior applications (and require any necessary amendment of the specification) immediately after grant of the final patent by the European Office (with power to enforce amendment or revoke the patent). Another is to leave the matter to be dealt with by a third party in a revocation action.

Secondary function of the European Office

10. The EEC draft provides for revocation (in respect of final patents) and compulsory licensing actions to be carried out by the European Office. EEC countries may wish these to

continue to be dealt with centrally as far as their Community patent is concerned, and it is envisaged that these provisions could be incorporated in the second, Community, convention. If so, the European Office could, as a secondary function, provide revocation boards as in the EEC draft, but these will be operative only in relation to the Community patent and answerable only to EEC countries. The European Office would be similarly responsible only to the EEC countries in respect of other post-confirmation activities, e.g. the maintenance of a register of Community patents.

Finance

11. The European Office will, to a substantial extent, be dependent for its revenue on renewal fees. In the EEC draft (Article 119) these are payable in respect of the third and subsequent years from filing. In the present scheme, renewal fees on national patents would be expected to be paid to the national authorities. It will be necessary however to divert some or all of these fees to the European Office and the Convention will need to provide for payments to be made either of the fees themselves direct, or of an equitable sum from the national authority. If the Office is to operate up to confirmation on behalf of all Member countries, but after confirmation (on revocation or compulsory licensing) for the EEC only, this will have to be reflected in the financial arrangements. For example, the post-confirmation operations could be costed and either made self-supporting in terms of the relevant fees or made the subject of compensatory payments one way or the other.

12. The most practical arrangement would probably be one in which the difference between the total budgeted cost of the European Patent Office and its direct revenue from fees on the European applications and patents is made good by lump sum contributions from the Contracting States apportioned according to a fixed scale to be negotiated and perhaps weighted according to national wealth in a way followed by the United Nations and other international organizations. It would be possible to base contributions on e.g. renewal fees paid in each country or the number of patents resulting from European applications; this may not however be satisfactory since these fees may be nationally regulated with other ends in view than the support of the European Patent Office and the number of patents may be dependent on the fees prescribed.

Administrative control

13. The EEC draft provides for an Administrative Council as a supervising authority for the European Office. This is retained in the present scheme but it is for consideration

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whether this body should operate at official or Ministerial level or both. In any case all Member countries would be represented thereon. The Community countries would, of course, be able to vote en bloc if they so wished. Decisions could be taken by straight majority or qualified majority. Non-Community countries would not have a vote on matters exclusively affecting post-confirmation functions.

Patent court

14. The EEC draft provides for a court to deal with certain appeals from decisions of the Office. Under the two-part scheme the court would be representative of all Members up to and including confirmation of the European patent, and representative of the EEC countries alone as regards post-confirmation matters. If the EEC countries wish to use the Luxemburg Court a suitable solution might be to use a panel of judges of the Luxemburg Court enlarged by the addition of judges from other Member countries. A judge or judges for any case would be selected from the enlarged or restricted panel as the case may be.

Entitlement to apply

15. There is no restriction on the nationality of an applicant.

Membership

16. (a) Any country which is a member of the Paris Union may join. Alternatively, there is the possibility, in view of the uniformity of national law implied, of restricting membership initially to countries which have ratified the Council of Europe Convention on unification of certain points of law. This has not been adopted as it would exclude from membership certain EFTA countries who are not prepared to widen the area of patentable subject matter to the extent required by the Council of Europe Convention.

(b) The present scheme includes provision for a denunciation article.

Special position of the EEC

17. The contents of the second convention for the EEC alone have not been considered in detail. However, this second convention could regulate in a unitary fashion the confirmed

EEC patent and provide for EEC countries' procedures for revocation, compulsory licensing, etc., essentially as in the EEC draft. Moreover, all the economic provisions of peculiarly Community interest will be solely under Community control.

Comparison with the EEC draft

18. For non-EEC countries, membership of the first (international) convention resulting in a "bundle of national patents" will ensure a full say in the governing body and the court. It will require each Member country to subscribe to the application of the substantive patent law of the convention during examination and grant and hence, in practice, commit it to applying much the same law domestically after grant. It will also involve acceptance by each country of patent specifications in the form acceptable to the European Patent Office on the basis of the first convention and any regulations made thereunder. Each country will, however, be free to regulate the effect of the patent in that country as it wishes and - subject to any restrictions imposed by membership of the convention on unification of certain points of law - refuse to grant national patents in respect of certain categories of subject matter. The possibility of regulating application fees and granting fees according to the number of countries covered, coupled with the cost of national renewal fees, should enable a sufficient inducement to be offered to applicants to restrict their patents to countries in which they are seriously interested and thus avoid undue proliferation of paper patents in Member countries.

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EUROPEAN FREE TRADE
ASSOCIATION

Annex III to
EFTA 4/67
19th January, 1967.

DRAFT OF AN OPEN EUROPEAN PATENT CONVENTION
FORMING THE FIRST CONVENTION IN THE TWO-PART SCHEME

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Explanatory remarks

1. In the following draft, the Article numbers of the EEC draft have been followed. Where new Articles are envisaged, they are indicated by the suffixes A, B, etc. At some points it has not been found feasible to produce a revised text, but the problems to be determined are indicated in a Note. The text on which the draft is based is that of the unofficial English translation, published in London by H.M. Stationery Office (first published in 1962; reprinted in 1963).

2. Articles and paragraphs reprinted unchanged from the EEC draft (apart from the deletion of the word "provisional" in certain cases) are preceded by *. Simple additions to Articles are underlined and the places of simple omissions are indicated by brackets. The original Notes to Articles have been retained for ease of reference unless clearly inapplicable. Notes added by the EFTA working party are underlined. References in the Notes to "the working party" relate to the EEC working party.

PART I GENERAL PROVISIONS

Article

1. European patent system

This Convention hereby establishes a system common to the Contracting States, for the granting of patents.

2. European patents

(1)* Patents conferring exclusive rights on their proprietors shall be granted under the name of "European patent" in accordance with the provisions of this Convention.

(2) European patents shall have a unitary character which arises from the fact that they have effect on the territory of all those Contracting States covered thereby and may only be assigned or otherwise change ownership in respect of all those States.

(3) European patents will have a provisional character, being subject to confirmation in accordance with Articles 63 - 104. After confirmation, they give rise to final patents, as defined in Article 2A, in each State covered by the European patent.

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(Note: It is for consideration whether "confirmation" is a suitable term in the context of the revised system now contemplated. Some such expression as "full examination" may be preferable.)

2A. Final patents

- (1) Final patents granted in accordance with Article 2(3) shall each constitute an independent national patent in the State concerned, having the same effect as if they were granted by the national authorities.

(Note: This means, of course, that a final patent granted for a particular country would be judged according to the law of that country and hence would be invalid, or have no force, e.g., in so far as it covers subject matter (such as food or drugs) excluded from patentability in that country, cf. Note on Article 176.)

- (2) If a European patent referred to in Article 2(3) is a patent of addition, each final patent shall, where the law of the State in question allows it, also be a patent of addition.
- (3) Any group of Contracting States may authorize the granting, in lieu of separate final patents, of a single common final patent effective in the whole of their territories.

3. European Patent Office

European and final patents shall be granted by a patent office common to the Contracting States, which shall be called the "European Patent Office".

4.* European Patent Court

A court common to the Contracting States, hereinafter called the "European Patent Court" shall be competent to deal, in the final instance, with actions relating to European patents, to the extent to which jurisdiction is conferred on it by the Convention.

(Notes: 1. A separate instrument will prescribe the organization and procedure of the European Patent Court; the question whether this Court will be attached to an already existing international court is left open.

2. This Article will require to be supplemented in the event of certain actions referred to in Articles 39, 40 and 208 of the Convention falling within the jurisdiction of a court other than the European Patent Court.)

5. Application for European patents

- (1) Any person desiring to obtain protection for his invention in some or all of the Contracting States, may apply for a European patent.
- (2) Subject to paragraph (3) below, an applicant may, within 12 months of the priority date of the application, add one or more States to those covered by the application; and he may, at any time up to grant of the patent, withdraw one or more States from those covered.
- (3) A group of States as referred to in Article 2A(3) may require that any application covering one State of the group shall cover all those States.

(Note: It is for consideration whether any application should cover a minimum number, or a particular group, of countries.)

- (6. This is probably unnecessary since Article 1 does not now refer to a system of law and Article 2A(1) implies the continued existence of national patent law.)

7.* Prohibition of simultaneous protection

The rights given to an invention by a European patent and by one or more patents granted in the Contracting States covered by the European patent may not be enjoyed simultaneously in so far as the invention originates from one and the same inventor.

(Note: This Article is written on the assumption that it is desired to prevent an inventor obtaining both national and European patents for the same invention. See also Note on Article 100. It is thought in some quarters that this Article should perhaps be omitted and the problem left to be resolved by national law.)

8.* Other international agreements

This Convention shall be without prejudice to any commitments entered into by the Contracting States by virtue of other international agreements.

PART II PATENT LAW

9.* Patentable inventions

European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

10.* Exceptions to patentability

European patents shall not be granted in respect of:

- (a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality (the mere prohibition of the exploitation of the invention not making it so contrary);
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals.

11. Novelty

- (1)* An invention shall be considered to be new if it does not form part of the state of the art.
- (2)* The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing the application for a European patent.
- (3) Additionally, the contents of European patent specifications published on or after the date referred to in paragraph 2, shall be considered as comprised in the state of the art, provided that such patents have an earlier priority date and cover one or more of the countries covered by the application referred to in paragraph (2). If several applications for European patents have been filed on the same day, the order in which they were filed shall determine how this paragraph is to be applied.

12.* Non-prejudicial disclosures

A disclosure of the invention within the meaning of Article 11 shall not be taken into consideration if it occurred within six months preceding the application for a European patent and if it was in consequence of:

- (a) an evident abuse in relation to the applicant or his predecessor in title;
- (b) the fact that the applicant or his predecessor in title has displayed the invention at official, or officially recognized, exhibitions falling within the terms of the Convention relating to international exhibitions signed at Paris on 22nd November 1928, and revised on 10th May 1948.

(Note: This Article reproduces exactly one of the provisions in the draft Convention for the unification of patent laws drawn up under the aegis of the Council of Europe.)

13.* Inventive step

An invention shall be considered as involving an inventive step if it is not obvious having regard to the state of the art.

14.* Industrial application

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

15.* Right to obtain a European patent

- (1) The right to a European patent shall belong to the inventor or his assignee.
- (2) For the purposes of procedure before the European Patent Office, the person making the patent application shall be deemed to be entitled to exercise the right referred to in paragraph (1).

16. Obtaining

- (1)* If the essential elements of a patent application or of a European patent have been unlawfully obtained from the invention of another, the person injured by such obtaining may request that the application or the patent be assigned to him.
- (2) The right referred to in paragraph (1) may not be exercised after confirmation of the European patent.
- (3)* As from the date of the notification to the European Patent Office that an action under paragraph (1) has been brought, the proprietor of the European patent may not surrender the patent save with the consent of the person who has brought the action.

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- (4)* If an action has been brought under paragraph (1) the European Patent Office shall stay the proceedings for confirmation of the European patent, unless the person having brought the action consents to their continuation; such consent shall be irrevocable.
- (5)* If a final decision is given in favour of a person who has brought an action under paragraph (1), that person may, within a period of three months following the final decision, file a new application in respect of the same invention, this application being deemed to have been filed on the date of the earlier application. The earlier application for a European patent shall be deemed to have been withdrawn and any European patent shall be deemed to have lapsed once the injured party has filed a new application.
- (6)* Following the final decision, any proceedings for confirmation of the European patent stayed under the terms of paragraph (4), shall be resumed. However, if the decision is in favour of the person who has brought the action, the procedure shall not be resumed before the expiry of a suitable period which may not be less than three months counting from the date on which the decision became final. If within this period the assignment has not been recorded in the Register of European Patents the procedure is resumed with the proprietor of the European patent.

17.* Right of the inventor to be mentioned as such

The inventor has the right, vis-à-vis the applicant for or the proprietor of a European patent, to be mentioned as such before the European Patent Office. An incorrect mention may not be rectified except with the consent of the wrongly designated person or, in the absence of such consent, by virtue of a Court Order.

18. Territorial scope of a European patent

A European patent shall, on grant, have effect in such of the Contracting States as were covered by the application for a patent. Subject to Article 24(3C) it may subsequently be surrendered in respect of one or more of these States in accordance with Article 124.

19. Prior national rights

- (1) In the event of a national patent having been granted in a Contracting State in respect of the whole or part of an invention which forms the subject of a European patent effective in that country, such national patent having been published on or after the date referred to in Article 11, paragraph (2), but having a priority date earlier than that of the European patent, the effect of the European patent shall not extend to the territory of the State in question, in so far as the European patent covers the same subject matter as the national patent.
- (2)* If an application for a European patent and an application for a national patent covering the same subject matter, have the same priority date without the priority of the one having been claimed in support of the other and without the priority of one and the same application having been claimed in support of both, the application for the European patent will be deemed to have been filed after that for the national patent.

20. 2nd variant. Infringement of the rights of the proprietor of a European patent

- (1) A European patent confers on its proprietor in each of the Contracting States the same rights as would be conferred by a national patent granted in that State. Subject to Article 176, any infringement of the rights of the proprietor of a European patent is to be dealt with under the laws of that State.

(2) Omitted

(Note: This is probably suitable only for the Common Market countries. In any case, there would be no point in allowing infringement proceedings to be started under the European patent which could not be followed out with the final national patent.)

(3) Omitted

21. Extent of the protection conferred by a European patent

- (1)* The extent of the protection conferred by a European patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

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- (2) A final patent granted following confirmation of a European patent shall determine retroactively the extent of the protection conferred in that State by the European patent.

(Note: There may be thought to be conflict with Article 176 but it is thought that if the validity of a provisional patent is not challenged, the Court's decision will be binding on those parties notwithstanding any subsequent restriction during confirmation.)

22.* Right of personal possession and right based on prior use

Any person who, if a national patent had been granted in respect of an invention in one of the Contracting States, would have had a right based on prior use of that invention or on personal possession of that invention, shall enjoy, in that State, the same rights in respect of a European patent for the same invention.

23. Omitted

24. European patents of addition

- (1)* European patents of addition shall be granted for the improvement of an invention protected by a European patent upon application being made subsequent to that for the parent patent and prior to the publication, pursuant to Article 85, of the parent patent.
- (2)* A European patent of addition may be granted only to the proprietor of the parent patent.
- (3)* The invention which forms the subject of the patent of addition shall not be subject to the requirement of an inventive step within the meaning of Article 13, in relation to the invention which forms the subject of the parent patent.
- (3A) The applicant for, or the proprietor of, a European patent of addition may, until such time as it is decided to confirm such patent, convert the application for a patent of addition or the patent of addition into an independent application or into an independent patent. If the conversion concerns a European patent of addition, the conversion shall be recorded in the Register of European Patents and published in the European Patents Journal. For purposes of determining the term of any final patent

granted thereon, the application date of the independent patent shall be deemed to be that of the patent of addition which it has replaced.

- (3B) (a) A patent of addition cannot be granted after confirmation of the parent patent.
- (b) When the parent patent is confirmed, a patent of addition must also be confirmed or converted into an independent patent.
- (c) A patent of addition cannot be confirmed prior to confirmation of the parent patent.

(3C) A European patent of addition, or an application therefor, shall at any time cover only those Contracting States which are covered at that time by the parent European patent. Nevertheless, if the parent European patent expires as the result of cancellation or surrender, the patent of addition shall become an independent patent. In the event of a number of patents of addition, only the first patent of addition to be granted shall become independent; the remainder shall be deemed to be patents of addition thereto.

(4) and (5) Omitted

(Note: Parts of these paragraphs are included in
(3A) - (3C).)

25.* Assignment of a European patent

- (1) A European patent may not be assigned except, in its entirety for the whole of the territories in which it is effective.
- (2) The assignment of a European patent shall be made in writing and require the signature of the parties to the contract.
- (3) The assignment shall be recorded in the Register of European Patents at the request of the interested party or of one of the interested parties on production either of the original or of a certified copy of the assignment deed, or of official documents verifying the assignment. The request shall not be considered as made until such time as the fee, prescribed for this purpose by the Regulations concerning fees made pursuant to this Convention, has been paid.

- (4) One copy of the deed or of the documents referred to in paragraph 3 shall be retained by the European Patent Office and made public. The European Patent Office shall only publish that part of the deed or document which relates to the assignment.
- (5) The assignment shall not have effect vis-à-vis the European Patent Office and third parties until after it has been recorded in the Register of European Patents. Nevertheless, an assignment, although not so recorded, shall have effect vis-à-vis third parties who have subsequently acquired rights in the European patent and who, at the time of such acquisition or at the time of taking steps to have these rights recorded, acted otherwise than in good faith.
- (6) The provisions of this Article shall apply to applications for European patents.

26. - 28. Omitted

(Note: Some provision will apparently be needed for dealing with mortgaging, rights in rem and distraint in a manner suited to the present scheme and in conformity with Article 2(2); but this is left for future consideration by legal experts.)

29. Contractual licensing of a European patent

- (1)* A European patent may be licensed for the whole or part of the territories in which it is effective.
- (2) Omitted
- (3)* The provisions of Article 25, paragraphs 3, 4 and 5 relating to the registration of assignments shall apply in like manner to the registration of the licences.

30.* Relevant law

- (1) The national law relevant to legal transactions concerning European patents shall be the law designated by the parties to the contract, provided:
 - (a) this Convention does not itself specify the relevant law;
 - (b) this Convention omits to refer the matter to a particular national law;

- (c) private international law does not rule out the possibility of the parties themselves being able to stipulate the relevant law.

If the parties omit to designate the relevant law, the latter shall be determined in accordance with the rules of private international law.

- (2) If private international law refers to the "lex rei sitae", the relevant law shall be the law of the Contracting State on whose territory the proprietor of the European patent is ordinarily resident or has his registered place of business. If the proprietor is neither resident nor has his registered place of business on the territory of one of the Contracting States, the relevant law shall be the law of the Contracting State in which an agent has been appointed or an address for service chosen in accordance with the terms of Article 172. If no agent has been appointed and no such address chosen the relevant law shall be the law of the country in which the European Patent Office is situated.

PART III THE EUROPEAN PATENT OFFICE

31.* Legal status

- (1) The European Patent Office is an organization common to the Contracting States and endowed with administrative and financial autonomy.
- (2) The activities of the European Patent Office shall be controlled by the (Administrative Council).

(Note: This Article does not touch on the question whether the European Patent Office shall be dependent on a broader international institution of which the Administrative Council would be the controlling body. Such control would be carried out under the conditions laid down by the general Convention.)

32.* Legal character

- (1) The European Patent Office shall be a legal entity.
- (2) In each of the Contracting States, the European Patent Office shall have the maximum legal capacity given to legal entities by the national law; in particular, it may acquire or transfer immovables and movables and institute proceedings in its own name.
- (3) The President of the European Patent Office shall exercise the legal capacity of that office.

(Note: With regard to paragraph 3, the question will have to be examined, whether and to what extent the competency of the President in financial matters ought to be subject to the authority of the Administrative Council.)

33.* Location of head office and of branches for information and liaison

(1) 1st variant

The European Patent Office shall be located at
.....

2nd variant

The location of the European Patent Office shall be determined by unanimous decision of the (Administrative Council).

3rd variant

The location of the European Patent Office shall be determined by common agreement on the part of Contracting States.

- (2) By unanimous decision, the (Administrative Council) may, if need be, create branches of the European Patent Office for the purpose of information and liaison, in conjunction with the central industrial property services of the Contracting States or in conjunction with the (International Patents Institute at The Hague).
- (3) The creation of these branches may be decided upon in order to meet the needs of the European Patent Office or those of Contracting States or the (International Patents Institute at The Hague).

(Note: The third variant of paragraph 1 will be certain countries requiring the approval on the part of Parliament of an agreement independent of the Convention and exclusively relating to determining the location of the European Patent Office.)

34. Languages

- (1)* Subject to the following provisions the languages in use at the European Patent Office shall be English, French and German.
- (2)* Persons having their registered place of business or ordinary residence within the territory of one of the Contracting States, the language of which is not referred to in paragraph 1, and nationals of that State who are resident abroad, may file applications for European patents in the language of that State. Nevertheless, a translation in one of the languages referred to in paragraph 1, must be produced within a period of one month from the date of filing.
- (3)* Subject to the exceptions provided for in the Implementing Regulations, the language of an application for a European patent or, in the case referred to in paragraph 2, that of the translation, must be used in all dealings with the European Patent Office. If a document has to be produced before the expiration of a time-limit, the provisions of paragraph 2 shall correspondingly apply, provided that the translation is produced in the language of the proceedings.
- (4)* Entries in the Register of European Patents shall be made in the three languages referred to in paragraph 1. In cases of doubt, the entry in the language of the application shall be authentic.
- (5) The printed specification of European patents shall be published in the language of the application or, in the case referred to in paragraph 2, in that of

the translation; they shall include a translation of the claims into each of the other two languages referred to in paragraph 1. Any Contracting State may require that, for a patent to be effective in that State, the applicant shall furnish a translation of the whole specification into the language of that State and the specification shall be printed and published also in that language.

(Note: The printing and publishing could be done by the State in question.)

- (6)* The European Patent Bulletin shall be published in the three languages referred to in paragraph 1.
- (7)* The Official Journal of the European Patent Office shall be published partly in all of the languages of the Contracting States and partly in the three languages referred to in paragraph 1, in conformity with the Implementing Regulations.

35.* Privileges and immunities

The European Patent Office and its officials and other employees shall enjoy in the territory of Contracting States those privileges and immunities which are necessary to the carrying out of their tasks in accordance with the terms of the provisions laid down in a special protocol.

36.* Administration

- (1) The President of the European Patent Office shall ensure that the Office is administered in accordance with the provisions of this Convention and its Implementing Regulations; he shall be responsible for the activities of the European Patent Office to the (Administrative Council).
- (2) To this end, the President shall have the following powers:
 - (a) he shall take all necessary steps to ensure the functioning of the organization;
 - (b) he may place before the (Administrative Council) any proposal for amending this Convention and any proposal for general regulations or decisions concerning the European Patent Office which come within the competency of the (Administrative Council);

- (c) he shall prepare and implement the budget in conformity with the financial provisions;
 - (d) he shall submit each year the accounts, the balance sheet and a management report to the (Administrative Council);
 - (e) he shall exercise supervisory authority over the personnel;
 - (f) he shall appoint the officials and employees other than those referred to in Article 37, and shall decide on their promotions;
 - (g) he shall exercise disciplinary authority over the officials and employees other than those referred to in Article 37, and may propose disciplinary action to the (Administrative Council) with regard to officials referred to in Article 37, paragraph 3;
 - (h) he may delegate his functions to one or more officials or employees of the European Patent Office;
 - (i) he shall take part in the discussions of the (Administrative Council) relating to questions which concern the European Patent Office.
- (3) The President shall be assisted by a number of Vice-Presidents. In his absence, he shall be represented by one of the Vice-Presidents.

37.* Appointment of senior officials

- (1) The President of the European Patent Office shall be appointed by decision of the (Administrative Council).
- (2) The Vice-Presidents shall be appointed by decision of the (Administrative Council) after the President has been consulted.
- (3) The members of the Boards of Appeal and of the Revocation Boards shall be appointed by decision of the (Administrative Council), taken on the recommendation of the President.

38.* Duties of office

- (1) The officials and other employees of the European Patent Office are bound, even after the termination of their employment, not to disclose information which by its nature is a professional secret.

- (2) The officials or other employees of the European Patent Office may not, in the course of their employment, file applications for patents either directly or through an intermediary.
- (3) The (Administrative Council) shall fix the regulations for officials and the conditions of service for other employees of the European Patent Office.

39.* Jurisdiction in case of disputes between the
European Patent Office and its officers

(An international court) shall have jurisdiction in any litigation between the European Patent Office and its officers within the limits and subject to the conditions laid down in the regulations for officials or arising from the conditions of service of other employees.

40.* Liability

- (1) The contractual liability of the European Patent Office shall be governed by the law applicable to the relevant contract.
- (2) In the matter of non-contractual liability, the European Patent Office shall be bound, in conformity with the general principles common to the laws of Contracting States to make good any damage caused by its employees in the performance of their duties.
- (3) The personal liability of its employees towards the European Patent Office shall be laid down in their conditions of service or other rules applicable to them.
- (4) (An international court) shall have jurisdiction to hear disputes concerning the liability for damages referred to in paragraph 2.

41.* Control of the legality of decisions of the
(Administrative Council) and of the President of
the European Patent Office

- (1) For the purpose of controlling the legality of the decisions of the (Administrative Council) and of the President of the European Patent Office, the (European Patent Court) shall be empowered to hear appeals against decisions alleged to be ultra vires violation of a basic procedural rule, violations of the provisions of this Convention or of its Implementing Regulations, or abuse of authority, which may be lodged by a natural or legal person, provided that the decision which is challenged concerns such person directly.

- (2) Appeals referred to in the preceding paragraph must be lodged within a period of two months counting from the date, as the case may be, of the publication of the decision, of its notification to the interested party or, failing these, from the date on which that party learned of the decision.
- (3) If the appeal is well grounded, (the European Patent Court) shall quash the challenged decision.
- (4) (The Administrative Council) or the President of the European Patent Office shall be bound to take steps to implement the decision. Such obligation shall be without prejudice to any obligation which may arise from the application of Article 40, paragraph 2.

41A. (1) It shall be open to a group of Contracting States as referred to in Article 2A(3) to authorize the European Patent Office to undertake on their behalf such functions relating to the common patent, e.g. revocation and compulsory licensing actions, as may be prescribed in a second Convention concluded between those States.

- (2) For the purpose of decisions in the Administrative Council concerning matters relating only to the activities of the European Patent Office mentioned in paragraph (1), only the representatives of the member states of the group referred to shall have a vote.

42.* Cover for expenditure

- (1) The expenditure of the European Patent Office shall be covered:
 - (a) as a general rule, by the receipts of the European Patent Office, in particular by the fees prescribed under this Convention and its Implementing Regulations;
 - (b) exceptionally, by the financial contributions of Contracting States, to the extent that the receipts may not be adequate.
- (2) The fees referred to in the preceding paragraph shall be fixed in such manner that their yield, supplemented by other sources of revenue, shall generally cover all of the expenses of the European Patent Office and permit the establishment and maintenance of a reserve fund, the calling whereof shall be fixed by the Implementing Regulations. The fees shall be fixed by

Rules relating to fees made pursuant to this Convention. These Rules shall be enacted by the (Administrative Council).

- (3) The financial contributions of the Contracting States as provided in paragraph 1 of this Article shall be fixed in accordance with the following scale:

1st variant

Scale of the EEC Treaty (Article 200, paragraph 1)

(Belgium	7.9	Italy	28
France	28	Luxemburg	0.2
Germany	28	Netherlands	7.9)

2nd variant

Scale of the revised Convention of The Hague concerning the creation of an International Patents Institute (Article 13, paragraph 3).

(Notes: 1. The two variants are given by way of example. Other scales can be envisaged in consequence of the provisions finally adopted in the Convention and, for example, of those referred to under Article 5.

2. The question of providing for an initial contribution, particularly by countries acceding (to the Convention) after it is signed, will be examined at a later stage.

3. With regard to Articles 42 - 53 generally, see Note following Article 53.)

43.*

Budget

- (1) Income and expenditure of the European Patent Office shall form the subject of estimates in respect of each financial year and shall be shown in the budget.
- (2) The budget shall be balanced as between income and expenditure.

44.*

Authorization for expenditure

- (1) The expenditure entered in the budget shall be authorized for the duration of one financial year, unless any provisions to the contrary are contained in the Regulations adopted pursuant to Article 53.
- (2) Subject to the conditions to be laid down pursuant to Article 53, any appropriations, other than those relating to staff costs, which are unexpended at the

end of the financial year may be carried forward, but not beyond the end of the following financial year.

- (3) Appropriations shall be set out under different headings according to type and purpose of the expenditure and subdivided, as far as necessary, in accordance with the Regulations adopted pursuant to Article 53.

45.* Financial year

The financial year shall commence on 1st January and end on 31st December.

46.* Draft budget

The President of the European Patent Office shall lay the draft budget before the (Administrative Council) not later than 30th September of the year preceding that of its implementation.

47.* Adoption of the budget

The budget shall be voted by the (Administrative Council).

48.* Provisional budget

- (1) If, at the beginning of the financial year, the budget has not yet been voted by the (Administrative Council), expenditures may be effected on a monthly basis per heading or other division of the budget, according to the provisions of the Regulations adopted pursuant to Article 53, up to one-twelfth of the budget appropriations for the preceding financial year, provided that the appropriations thus made available to the President of the European Patent Office shall not exceed one-twelfth of those provided for in (the draft budget).
- (2) The (Administrative Council) may, subject to the observance of the other provisions laid down in the first paragraph, authorize expenditure in excess of one-twelfth of the appropriations.
- (3) Contracting States shall pay each month, on a provisional basis and in accordance with the scale adopted for the previous financial year, the amounts necessary to ensure implementation of this Article.

49.* Budget implementation

- (1) The President of the European Patent Office shall implement the budget on his own responsibility and within the limits of the allocated appropriations.
- (2) Within the budget, the President of the European Patent Office may, subject to the limits and conditions laid down in the Regulations adopted pursuant to Article 53, transfer funds as between the various headings or sub-headings.

50.* Auditing of accounts

- (1) The income and expenditure account of the European Patent Office shall be examined by an Audit Board composed of independent auditors of whom one shall be the Chairman. The (Administrative Council) shall fix the number of auditors. The members and the Chairman of the Audit Board shall be appointed by the (Administrative Council) for a period of five years. Their remuneration shall be determined by the (Administrative Council).
- (2) The audit, which shall be based on vouchers and shall take place, if necessary, in situ, shall ascertain that all income has been received and all expenditure effected in a lawful and proper manner and that the financial management is sound. The Audit Board shall draw up a report at the end of each financial year, the adoption of this report requiring a majority vote of its members.
- (3) The President of the European Patent Office shall annually submit to the (Administrative Council) the accounts of the preceding financial year in respect of the budget, together with the report of the Audit Board. The President shall also communicate to the (Administrative Council) a balance sheet showing the assets and liabilities of the European Patent Office.
- (4) The (Administrative Council) shall give the President of the European Patent Office a discharge in respect of the implementation of the budget.

(Remark: The question of deciding whether in addition to the retrospective audit provided for in this Article, there should be prior approval of those decisions of the President which are of a financial nature, by an authority independent of him, must be examined on a later occasion.)

51.* Accounting and contributing currencies

- (1) The budget shall be drawn up in the unit of account fixed in accordance with the provisions of the Regulations adopted pursuant to Article 53.
- (2) The financial contributions provided for in Article 42, paragraph 1, shall be made available to the European Patent Office by the Contracting States in their respective domestic currencies.
- (3) The available balances of these contributions shall be deposited with the Treasuries of Contracting States or with bodies designated by them. The funds, while so deposited, shall retain their par value, in relation to the unit of account mentioned in paragraph 1, at the value in force at the date of deposit.
- (4) These balances may be invested under conditions to be fixed by the (Administrative Council).

52.* Transfer of currency holdings

- (1) The President of the European Patent Office may, provided he notifies the competent authorities of the Contracting States concerned, transfer the assets held by him in the currency of one Contracting State into the currency of another Contracting State, in so far as this may be necessary to enable them to be used. The President of the European Patent Office shall, as far as possible, refrain from making such transfers, if the European Patent Office possesses liquid or realizable assets in the currencies which it needs.
- (2) The President of the European Patent Office shall communicate with each Contracting State through the authority designated by the latter. For the carrying out of financial operations, the President of the European Patent Office shall have recourse to the services of the bank of issue of the Contracting State concerned or of any other financial institution approved by that country.

53.* Functions of the (Administrative Council) in financial matters

- (1) The (Administrative Council) shall:
 - (a) lay down the financial Regulations specifying, in particular, the procedure relating to the establishment and implementation of the budget and for the rendering and auditing of accounts;

- (b) determine the method and procedure whereby the contributions of Contracting States shall be made available to the European Patent Office;
- (c) establish rules concerning the responsibility of cashiers and accountants and make arrangements for their supervision.

(Note: Articles 42 - 53 are retained on the basis that they relate only to the functions of the European Patent Office defined in this Convention. Some further provisions will need to be added regulating the financial arrangement which will have to be negotiated between the EEC countries and the rest in respect of the functions undertaken, under Article 41A, for the EEC countries alone (cf. paragraphs 11 and 12 of Annex II to this report). Pending such negotiation, redrafting of these Articles is not considered worth while.)

54. Organization of the European Patent Office

The European Patent Office shall comprise:

- (a)* Examining Sections
- (b)* Examining Divisions
- (c)* Patent Administration Divisions
- (d)* Boards of Appeal
- (e) Omitted

55. Examining Sections

- (1) The Examining Sections shall be responsible for the examination of applications for European patents and for the grant of European patents.
- (2)* The Examining Sections shall be staffed by technical examiners.
- (3)* The decisions of an Examining Section shall be taken on behalf of that section by one examiner.
- (4) The examiners of the Examining Sections may not be members of the Boards of Appeal ().

56. Examining Divisions

- (1) The Examining Divisions shall be responsible for the examination and confirmation of European patents and for the grant of the final patents.
- (2)* In order to give a valid decision an Examining Division must consist of three technical examiners, including an examiner of the Examining Section which

decided to issue the European patent. If the nature of the decision necessitates, the Division shall be enlarged by the addition of a legally qualified examiner; in the event of a parity of votes, the vote of the Chairman of the Division shall be decisive.

- (3) The examiners of the Examining Division may not be members of the Boards of Appeal ().

57. Patent Administration Divisions

- (1)* The Patent Administration Divisions shall be responsible for all decisions of the European Patent Office relating to a published European patent, in so far as these decisions are not the responsibility of other departments or services of that Office.
- (2)* The Patent Administration Divisions shall be staffed by legally qualified members.
- (3)* The decisions of a Patent Administration Division shall be taken on behalf of the Division by one of its members.
- (4) The members of the Patent Administration Divisions may not be members of the Boards of Appeal ().

58.* Boards of Appeal

- (1) The Boards of Appeal shall be responsible for decisions on appeal from the decisions of the Examining Sections, Examining Divisions and Patent Administration Divisions.
- (2) In order to give a valid decision a Board of Appeal must consist of (three-four-five) members. They shall comprise legally and technically qualified members.
- (3) The members of the Boards of Appeal may not be members of the Examining Sections, Examining Divisions or Patent Administration Divisions.
- (4) In their decisions the members of the Boards of Appeal shall not be bound by any instructions. They shall comply only with the provisions of this Convention, and with those adopted in implementation thereof.

(Remark: The question of the ratio of legally qualified to technically qualified members has been left open. However, if the solution finally adopted is that of a Board composed of four members, it will be advisable to stipulate that the Chairman shall have a casting vote.)

59. Omitted

60.* Register of European Patents

- (1) The European Patent Office shall keep a register to be known as the "Register of European Patents" which shall contain those particulars the registration of which is provided for by this Convention or by its Implementing Regulations.
- (2) The Register of European Patents shall be open to public inspection. Extracts from its entries shall be delivered on request on payment of the fee prescribed by the Rules relating to fees adopted pursuant to this Convention.

61.* Publications of the European Patent Office

In addition to the publications referred to in Articles 83 and 103, the European Patent Office shall periodically publish:

- (a) a European Patent Bulletin containing entries made in the Register of European Patents, as well as any other particulars relating to European patents the publication whereof is prescribed by this Convention or by its Implementing Regulations;
- (b) an Official Journal of European Patents containing notices and information of a general character issued by the President of the European Patent Office, as well as any other particulars concerning the European Patent Law.

62.* Patent classification in use by the European Patent Office

The patent classification in use by the European Patent Office shall be the "international classification" referred to in Article 1 of the European Convention on the International Classification of Patents for Invention of 19th December 1954.

(Note: The adoption of the classification referred to in this Article is dependent on the progress of work on its preparation.)

63.* Exchange of publications

- (1) The European Patent Office shall despatch free of charge to the central industrial property offices of Contracting States, at their request and for their own use, one or more copies of the publications mentioned in Article 61.

- (2) The central industrial property offices of Contracting States shall despatch free of charge to the European Patent Office, at the latter's request and for its own use, one or more copies of the published applications for and printed specifications of national patents, as well as of publications analogous to those of the European Patent Office mentioned in Article 61(a) and (b).
- (3) The European Patent Office may conclude agreements relating to the exchange of publications with the central industrial property offices or other administrations of any State.

64. Requests for information

- (1)* Unless otherwise provided in this Convention or its Implementing Regulations or in national laws, the European Patent Office and the courts or administrations of Contracting States shall give mutual assistance to each other by communicating information or documents on request.
- (2) The European Patent Office shall communicate the files concerning applications for European patents and those concerning European Patents to the courts or departments of States covered by the applications or patents, notwithstanding the restrictions laid down in Article 162.
- (3)* The European Patent Office and the central industrial property offices of Contracting States shall, on request, mutually inform each other about the progress of examination proceedings concerning applications for patents filed, as a whole or in part, in respect of the same invention, with the European Patent Office and with the said offices. Such information shall relate, in particular, to the results of novelty searches, and to examiners' reports and decisions. These provisions shall also apply to action taken under Article 114.

65.* Letters rogatory

- (1) Upon receipt of letters rogatory from the European Patent Office, the courts of Contracting States shall undertake, on behalf of that Office, any necessary inquiries or other legal measures within the limits of their jurisdiction.
- (2) Each Contracting State shall designate the national authority to which the European Patent Office is to address its letters rogatory and shall lay down the procedure to be applied in the carrying out of such requests.

PART IV APPLICATIONS FOR EUROPEAN PATENTS

66.* Filing of the application

- (1) An application for a European patent may be filed:
 - (a) either at the European Patent Office;
 - (b) or, if the law of a Contracting State so permits, at the central industrial property office or other competent authority of that State. An application filed in this way shall have the same effect as if it had been simultaneously filed at the European Patent Office.
- (2) Any Contracting State may prescribe that a person having his registered place of business or his ordinary residence on its territory may not file an application for a European patent otherwise than as provided for in paragraph 1(b).
- (3) In case of failure to observe any provisions made pursuant to paragraph 2 above, the European Patent Office shall transmit the application for a European patent to the central industrial property office of the Contracting State concerned. The effect of the application for a European patent shall not be affected thereby. The provisions of Article 67 shall apply.

67.* Forwarding of applications for European patents

- (1) The national central industrial property office shall be obliged to forward to the European Patent Office, in the shortest time compatible with the application of national law concerning the secrecy of inventions in the interests of the State, any applications for European patents which have been filed with that office or with other competent authorities in that State.
- (2) The Contracting States shall take all reasonable steps to ensure that applications for European patents, the subject of which is obviously not liable to secrecy by virtue of the law referred to in paragraph 1, shall be forwarded to the European Patent Office within a period not exceeding six weeks from the date of filing. Other applications for European patents must, as a rule, be forwarded to the European Patent Office within four months of the date of filing.

- (3) An application for a European patent the subject of which has been made secret, shall not be forwarded to the European Patent Office and shall be deemed to have been withdrawn. It may be converted into an application for a national patent in conformity with Article 118 in the Contracting State in which it has been filed. The application fee paid under Article 68 shall be refunded.

68. Requirements of the application

- (1) The application for a European patent shall contain:
- (a) a request for the grant of a European patent stating the countries for which the grant is desired;
 - (b) a description of the invention together with any drawings referred to therein.

The application shall be written in one of the languages referred to in Article 34, paragraphs 1 and 2.

- (2)* The application for a European patent shall be subject to the payment of a filing fee prescribed in the Rules relating to fees made under this Convention.
- (3)* The application for a European patent shall be deemed to be filed on the date on which the conditions required under paragraph 1 of this Article have been met, provided that the filing fee be paid within one month following that date.
- (4)* If payment of the filing fee is made after the expiry of the period provided for in paragraph 3, the application shall be deemed to be filed on the date of payment, provided that the date in question is not later than two months after a demand for payment has been made by the European Patent Office.

69.* Unity of invention

An application for a European patent may relate to only one invention.

(Note: The requirement of this Article does not exclude the grant of a European patent in respect of a process, the resulting product and a method of application, as long as there is unity of invention.)

70.* Contents of the specification

- (1) The specification must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.
- (2) The specification shall conclude with one or more claims defining the protection applied for.

71.* Requirements of the Implementing Regulations

An application for a European patent must satisfy the conditions laid down in the Implementing Regulations to this Convention.

72.* Priority right

- (1) A person who has duly filed an application for a patent, or for the registration of a utility model, or his successors in title, shall enjoy, for the purpose of filing an application for a European patent in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.
- (2) The day of filing shall not be included in the period. If at the office of the competent authority within the meaning of Article 66, paragraph 1, at which the application for a European patent has been filed, the last day of the period is an official holiday, or a day when the offices of that authority are not open for the filing of applications, the period shall be extended until the first following working day.
- (3) Every filing that is equivalent to a regular national filing under the law of the State where it was made or under bilateral or multilateral treaties shall be recognized as giving rise to a right of priority.
- (4) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the outcome of the application.
- (5) A subsequent application for the same subject as a previous first application within the meaning of paragraph 4 above and filed in the same country of the Union for the Protection of Industrial Property shall be considered as the first application for the purposes of determining priority, provided that, at the time of filing

the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

- (6) If the first filing has been made in a State other than one of the Contracting States, the above-mentioned provisions shall apply only in so far as that State, grants a right of priority based on a first filing made at the European Patent Office. The (Administrative Council) shall publish a list of such States.

73.*

Effect of priority right

For the purpose of a right of priority, the date of the first filing shall be considered to be:

- (a) the date of filing the application for a European patent within the meaning of Article 11, paragraphs 2 and 3 of Article 19;
- (b) the date for the acquisition of a right based on prior use or personal possession within the meaning of Article 22, provided that there are no contrary provisions of national law applied in accordance with the said Article.

74.*

Claiming priority

- (1) Any person desiring to take advantage of the priority of a previous filing shall be required, within a period of four months from the date of applying for a European patent, to lodge a declaration with the European Patent Office indicating the date of the previous filing and the country in which it was made and mentioning the file number. These particulars may be amended within the above-mentioned period. Failure to produce them in due time shall lead to the loss of the right to claim priority of filing.
- (2) The European Patent Office may require any person making a declaration of priority to produce a copy of the first application, including the specification and drawings, within a period to be laid down by the Office, which shall expire not earlier than four months

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after the date of applying for a European patent. The copy must be certified as correct by the authority which received the first application. A certificate issued by that authority stating the date of filing shall be attached to the copy. Failure to produce the copy and the certificate in due time shall lead to the loss of the right to claim priority of filing.

- (3) Multiple priorities may be claimed in a single application for a European patent, notwithstanding the fact that they originate in different countries.
- (4) If one or more priorities are claimed in respect of one part only of the application for a European patent, the right of priority may cover only those elements of the application for a European patent which are included in the application or applications for a patent whose priority is claimed.
- (5) The particulars mentioned in paragraph 1 shall be entered in the Register of European Patents, appear in the printed specification of the European patent and be published in the European Patent Bulletin.
- (6) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the first application, priority may nonetheless be granted, provided that the application documents of the first filing as a whole specifically disclose such elements.

75. Equivalence of national filing with European filing

- (1) An application for a European patent shall be equivalent to a regular national filing in States covered by the application.
- (2)* The procedure for the grant of a national patent may not be initiated by virtue of paragraph 1, except under the conditions laid down in Articles 114 to 116.

PART V GRANT AND CONFIRMATION OF EUROPEAN PATENTS

76.* Examination of the European patent application

- (1) If the Examining Section finds that the application for the European patent has not been validly made within the meaning of Article 68, it shall notify the applicant accordingly.

- (2) When the application for a European patent has been validly made, the Section shall examine:
 - (a) whether, by its nature, the subject matter of the application is obviously not an invention;
 - (b) whether the invention is not patentable by virtue of Article 10;
 - (c) whether the invention is obviously not susceptible of industrial application within the meaning of Article 14;
 - (d) whether the application is obviously contrary to the provisions of Articles 69 and 70;
 - (e) whether the conditions referred to in Article 71 have been satisfied;
 - (f) whether, in the case of an application for a patent of addition, the subject of that application is obviously not an improvement within the meaning of Article 24, paragraph 1.

77.* Notification and refusal of the application

- (1) If the examination reveals that the invention or the application for a European patent does not meet the requirements specified in Article 76, paragraph 2, the Examining Section will notify the applicant accordingly and invite him to make observations or to remedy the disclosed deficiencies within a period to be fixed by the Section.
- (2) If the Examining Section finds that the invention is obviously not new, it may inform the applicant accordingly.
- (3) If, on expiry of the period referred to in paragraph 1, it appears that the invention or the application for a European patent fails to meet the requirements specified in Article 76, paragraph 2, the Examining Section shall refuse the application.
- (4) The application may not be refused on grounds which have not previously been notified to the applicant in accordance with paragraph 1.

78.* Request for novelty report

- (1) If the examination reveals that the invention and the application for a European patent satisfy the requirements specified in Article 76, paragraph 2, the Examining Section shall request the applicant to pay, within a period of one month, the fee for obtaining a novelty report as prescribed by the Rules relating to fees adopted pursuant to this Convention, unless the said fee has already been paid.
- (2) On the date of payment of the fee or, if the latter has already been paid on concluding the examination, the Examining Section shall request (the International Patents Institute of The Hague) to supply a report on the novelty of the invention concerned and shall transmit to it the documents of the application for the European patent.
- (3) If an additional novelty report becomes necessary, particularly in the case of complexity of the application, the Examining Section may request the applicant to pay, within a period of one month, the additional fee prescribed by the Rules relating to fees.
- (4) If the fees are not paid in due time, the Section shall refuse the application for a European patent.

79.* Notification of the novelty report

- (1) On receipt of the novelty report, the Examining Section shall communicate it to the applicant and request him to pay, within a period of three months, the fees relating to the grant and printing prescribed by the Rules relating to fees made under this Convention.
- (2) If the fees relating to the grant and printing are not paid in due time, the Examining Section shall refuse the application for a European patent.

80.* Division of the application

- (1) An applicant may divide his application for a European patent by limiting the claims thereof and by filing divisional applications in respect of the inventions thus excluded from the claims.
- (2) The limitation of claims must be effected:
 - (a) before the examination referred to in Article 76 has been completed;

- (b) within the period prescribed in Article 79, paragraph 1.
- (3) The provisions of Article 82, paragraph 2, shall apply to claims restricted under the terms of paragraph 1.
- (4) Divisional applications shall be deemed to be filed on the date of the original application and shall have the benefit of any right to priority in so far as their subject matter does not extend beyond what was described in the original application, provided that the divisional applications have been filed within a period of two months after the limitation referred to in paragraph 1.
- (5) The filing fee referred to in Article 68, paragraph 2, must be paid in respect of each individual application within a period of one month after the filing thereof.

81.* Amendments of documents

Apart from the amendment of claims provided for under Articles 80 and 82, the specification of the invention and the drawings of an application for a European patent may not be amended except for the purpose of correcting linguistic or clerical errors or obvious mistakes.

82.* Amendment of claims

- (1) Within the period laid down in Article 79, the applicant may inform the Examining Section that he abandons one or more of the original claims of his application or he may submit to the Section a new version of all or some of these claims.
- (2) If the applicant avails himself of the right referred to in paragraph 1, the amended claims instead of the original claims shall determine the protection sought in so far as they do not exceed the scope of what is disclosed in the application.

83.* Hearings before the Examining Section

The Examining Section shall either on its own initiative or, if considered expedient, on request give a hearing to the applicant or any other party to the proceedings.

84. Grant of the European patent

- (1) On submission by the applicant of any translations required under Article 34(5), and on the payment of the granting fee and any necessary printing fees, the Examining Section shall grant the European patent.
- (2)* The grant of a European patent shall be recorded in the Register of European Patents and published in the European Patent Bulletin.

85. Publication of a European patent

- (1)* At the same time as it publishes the grant of the European patent, the European Patent Office shall publish a printed specification containing the description of the invention together with the drawings, if any, the amended or substituted claims, referred to in Article 82, paragraph 1, and, in an appendix, the novelty report relating to the invention.
- (2)* The printed patent specification shall state that the European patent has been granted only after an examination limited in conformity with Article 76, giving no guarantee as to the novelty of the invention, and that it confers no more than a provisional protection.
- (3) The printed patent specification shall also state the countries covered by the patent at the time of grant.

86.* Certificate for a European patent

- (1) As soon as the printed patent specification has been published, the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent to which shall be annexed the printed specification.
- (2) The certificate shall certify that the European patent has been granted to the person mentioned in the certificate in respect of the invention described in the printed patent specification.

87.* Commencement of protection

The protection afforded by the European patent shall commence on the day of publication of the grant.

(Note: The Articles 88 - 97 have not been dealt with in detail since it is understood that they may be replaced by provisions allowing for opposition instead of intervention proceedings. The title for this chapter might become more appropriately "Full examination of the European patent and grant of final patents". If the term "confirmation" is discarded, some consequential drafting changes will be necessary in other Articles in which confirmation is referred to.)

88.* Request for examination

- (1) On request, the European Patent Office shall examine whether the patent, the invention which forms the subject thereof, and the published specification, satisfy all of the requirements of this Convention.
- (2)* Such a request may be made by the proprietor of the European patent or by any other person during the five years which follow the day of publication of the grant. The request will not be considered as made until after the examination fee prescribed by the Rules relating to fees adopted pursuant to this Convention, has been paid.
- (3) The request may not be withdrawn.
- (4) When a request for examination has been made in conformity with paragraph 1, any subsequent requests for examination shall be regarded as void and the fees repaid, subject to the provisions of Article 91, paragraph 2.

89.* Transfer of proceedings to the Examining Division

As soon as a request for examination of a European patent has been made, it shall be referred to an Examining Division.

90.* Publication of a request for examination

- (1) A request for examination of a European patent shall be published in the European Patent Bulletin.
- (2) The proprietor of the patent shall be notified of the request if it has not been made by him.

91.* Notice of intervention

- (1) Within a period of three months following the publication of the request for examination, any other person may, on filing a notice of intervention,

be associated in the examination proceedings. The notice of intervention shall not be deemed to have been made until after payment of the fee for such a notice prescribed in the Rules relating to fees adopted pursuant to this Convention.

- (2) A third party who has made a request for examination after the initial request will be notified by the European Patent Office of the existence of that initial request. He may, within a period of three months following such notification, convert his request for examination into a notice of intervention. The excess amount of the fee paid shall be refunded.
- (3) The proprietor of the patent shall be informed of the notice of intervention.

92.* Observations concerning the validity of a European patent

- (1) Following the publication of the grant of a European patent, anyone may present his observations concerning the validity of that patent. Such observations must be made in writing and must include a statement of the grounds on which they are based.
- (2) The observations referred to in paragraph 1 shall be communicated to the proprietor.

93.* Reply on behalf of the proprietor of a patent

Following the expiry of the period mentioned in Article 91, paragraph 1, the Examining Division shall invite the proprietor of the European patent to comment, within a period of three months, on the novelty report and any observations communicated to him and, if necessary, to amend his specification.

94.* Examination of a European patent

- (1) The Examining Division shall commence the examination of the European patent on receipt of the proprietor's reply or, in the absence of such a reply, not later than on the expiry of the period prescribed in Article 93.
- (2) The Examining Division shall ascertain whether the European patent and the invention which forms the subject thereof and the published specification meet all the requirements of this Convention.

95.* Notification of the result of the examination

- (1) If the examination of a European patent reveals that the patent, the invention which forms the subject thereof or the published specification fail to meet the requirements of this Convention entirely or partly, the Examining Division shall notify the proprietor of the patent accordingly and invite him to present his observations or rectify the irregularities discovered within a period to be fixed by the Division, by submitting, if necessary, an amended specification.
- (2)* The notification of the results of the examinations must be reasoned statement indicating all the reasons against the confirmation of the European patent as a final European patent.

96.* Third party intervention

- (1) If the Examining Division is of the opinion that the European patent together with the invention which forms the subject thereof and the published specification, taking into consideration any amendments made by the proprietor of the patent, meet the requirements of this Convention, it will inform the proprietor of the patent and any third parties interested in the proceedings, that it intends to confirm the European patent as a whole or in part. Interested third parties may present their reasoned observations in writing within a period to be fixed by the Examining Division.
- (2) Interested third parties for the purposes of paragraph 1 shall be those who have made a request for examination as provided for in Article 88 or who have lodged a notice of intervention as provided for in Article 91.
- (3) On the expiry of the period provided for in paragraph 1, the Examining Division shall communicate the observations referred to in that paragraph to the proprietor of the patent and invite him to comment thereon within a period to be fixed by the Division.

97.* Renewed notification concerning the examination

- (1) If, after having examined the observations and comments provided for in Article 96, the Examining Division considers that the European patent cannot be confirmed as a final European patent to the extent envisaged in the notification referred to in Article 96, paragraph 1, subsequent procedure will take its course in accordance with Article 95.

- (2) In the case referred to in paragraph 1, the third party intervention procedure provided for in Article 96 shall apply if the Examining Division considers it expedient.

98. Division of a European patent

- (1)* The Examining Division shall decide to divide a European patent:
- (a) at the request of the proprietor, if the Examining Division considers the request to be justified;
 - (b) if the European patent comprises more than one invention.
- (2)* In the cases provided for under paragraph 1, the Examining Division shall notify the proprietor of the extent to which it proposes to divide the European patent. This notification shall be made in accordance with the provisions of Article 95.
- (3)* It shall be the duty of the proprietor to submit to the Examining Division the specifications and any drawings, pertaining to divisional European patents.
- (4)* Each of the additional European patents granted by the Division shall be liable to the payment of the divisional fee prescribed by the Rules relating to fees adopted pursuant to this Convention. This fee shall be additional to those provided for in Article 101.

99. Termination of proceedings on lapse of a European patent

If a European patent, during examination proceedings, lapses in respect of all countries covered thereby, the Examining Division shall terminate the proceedings and inform the proprietor and third parties interested under the terms of Article 96, paragraph 2. If it similarly lapses prior to the date specified for the beginning of the examination under Article 94, paragraph 1, one-half of the examination fee and of fees paid on notice of intervention shall be repaid to the applicants.

100. Cancellation of a European patent

- (1) The Examining Division shall cancel a European patent:

- (a)* if, following the application, if necessary, of the provisions of Articles 95 to 97, it is of the opinion that the European patent together with the invention which forms the subject thereof and the published specification, do not meet the requirements of this Convention as a whole or in part;
- (b)* if the fees relating to confirmation and printing prescribed in Article 101 have not been paid in due time;
- (c) if the European patent has for its subject an invention in respect of which a valid national patent has been granted in one of the Contracting States covered by the patent, to the same inventor or to his successor in title.

(Note: Paragraph (c) is retained in conformity with Article 7. If Article 7 were omitted, this paragraph would be omitted also. It is thought that a patentee should be allowed to meet an objection under paragraph (c) by partial surrender under Article 124(1)(b)(i). There is also a view that if the applicant does not choose to use Article 124, the patent should not be defeated in its entirety but only with regard to the Contracting State(s) in which the double patenting occurs.)

- (2)* Cancellation of a European patent may not be made on grounds which have not previously been communicated to the proprietor of the patent.
- (3)* The decision (to cancel the European patent) must state the reasons on which it is based. It shall be communicated to the proprietor of the patent and to third parties interested under the terms of Article 96, paragraph 2.
- (4)* When the decision referred to in paragraph 1 is final, the cancellation of a European patent shall be published in the European Patent Bulletin and entered in the Register of European Patents.
- (5)* When the decision to cancel has become final, a European patent will be deemed to have been, from the beginning, without the rights provided for under Article 20.

101. Confirmation of a European patent

- (1) If, after having applied any relevant provisions of Articles 95 to 97, the Examining Division is of the opinion that a European patent together with the invention which forms the subject thereof and the printed specification, taking into consideration the proprietor's amendments thereto, meet the requirements of this Convention, the Division shall inform the proprietor of the patent that it intends to grant final patents in respect of the countries covered by the European patent as amended, and request him to pay, within a period of one month, the fees prescribed for granting and printing by the Rules relating to fees adopted pursuant to this Convention.

(Note: The Rules may prescribe a special granting fee for each country.)

- (2) When the fees for granting and printing have been paid, the Examining Division shall decide to grant final patents for the countries concerned. In the case of intervention by third parties, the decision shall state the grounds on which it is based. The decision shall be communicated to the proprietor of the patent and to third parties interested under the terms of Article 96, paragraph 2.
- (3) The grant of final patents shall be entered in the Register of European Patents and published in the European Patent Bulletin once the decision referred to in paragraph 2 has been made final.
- (4) The effect of the publication referred to in paragraph 3 is to convert the European patents into final patents for the countries concerned.

102.* Hearing before the Examining Division

Whenever the Examining Division deems it necessary, it shall, on its own initiative or on request, hear the proprietor or any other party to the proceedings.

103. Publication of final patents

At the same time as it publishes the grant of the final patents, the European Patent Office shall publish the printed specification of the final patents containing the description of the invention, together with the drawings. This specification shall indicate the countries covered by the patents.

104. Certificate of final patents

- (1) As soon as the printed patent specification has been published, the European Patent Office shall issue to the proprietor a certificate for the final patents to which shall be annexed the printed specification.
- (2) The certificate shall state that the patents have been granted in the name of the persons mentioned in the certificate in respect of the invention described in the printed patent specification.

105.* Decisions subject to appeal

- (1) An appeal shall lie from decision of the Examining Sections, the Examining Division and the Patent Administration Divisions.
- (2) A decision which does not terminate proceedings as regards one of the parties cannot, of itself, be the subject of an appeal.
- (3) A decision in respect of the allocation of costs of proceedings cannot, of itself, be the subject of an appeal. No appeal shall lie against a decision dealing solely with such allocation.
- (4) A decision fixing the amount of costs of proceedings cannot be the subject of an appeal unless the amount is in excess of

(Note: The appeal procedure should be laid down either in the Convention or in the Implementing Regulations.)

106.* Effect of appeals

An appeal shall have suspensive effect.

107.* Persons entitled to appeal and to take part in appeal proceedings

Any party to proceedings who was adversely affected by a decision may appeal. The other participants in the proceedings shall be parties to the appeal proceedings, as of right.

108.* Time-limit and form of appeal

An appeal must be lodged, in writing, at the European Patent Office within a period of two months from the date of the decision appealed from; it must set out the grounds on which it is based. An appeal shall not be deemed to be lodged until after the payment of the fee for appeal prescribed by the Regulations relating to fees adopted pursuant to this Convention.

109.* Interlocutory revision

- (1) If the authority whose decision is contested considers the appeal to be admissible and well-founded, it shall rectify its decision. It may order the fee for appeal to be refunded.
- (2) If the appeal is not allowed within the two weeks following its receipt, it shall be remitted to the Board of Appeal without delay, and without comment as to its merit.
- (3) The provisions of paragraph 1 shall not apply when third parties participate in the proceedings.

110.* Examination of appeals

- (1) If the appeal is admissible, the Board of Appeal shall examine the facts; this examination shall not be restricted to the arguments and evidence of the parties concerned nor to the contentions on which the appeal is based, provided that these contentions do not involve amendment of the application for a European patent, or of the European patent, by the applicant or the proprietor respectively.
- (2) The Board of Appeal may disregard fresh facts or evidence which were not included in the statement of grounds of appeal or in the reply to the appeal.
- (3) The Board of Appeal may require a supplementary report from the Examining Section on the novelty of the invention.

111.* Oral proceedings

The Board of Appeal, when it considers such procedure suitable, may, either at its own instance or at the request of a party, deliver a decision following oral proceedings.

112.* Decision in respect of appeals

- (1) If the appeal does not comply with the requirements of Articles 105, 107 and 108, or with those of the Implementing Regulations of the present Convention, the Board of Appeal will reject it as inadmissible.
- (2) If the Board of Appeal, following the examination specified in Article 110, paragraph 1, considers that the appeal cannot be allowed, it will dismiss it as unfounded.

- (3) If the appeal is allowable in whole or in part, the Board of Appeal will annul the decision attacked, in whole or in part. The Board may either decide upon the matter itself or if, having regard to the state of the proceedings, it should consider such action necessary, it may remit the matter to the authority responsible for the decision in question, for the necessary action to be taken.
- (4) If the Board of Appeal remits the matter for action by the authority which issued the decision in question, such authority must ensure that its final decision in the matter conforms with that of the Board of Appeal. If the decision in question emanated from the Examining Section, the Examining Division will also be bound by the decision of the Board of Appeal.
- (5) The decision of the Board of Appeal must state the reasons on which it is based and may only be based upon facts or evidence on which the parties involved have had an opportunity to present their comments.

113.* Further appeal to the European Patent Court

- (1) A decision of the Board of Appeal pronouncing upon an appeal as specified in Article 105, may be the subject of further appeal to the European Patent Court. The lodging of such appeal will have suspensive effect.
- (2) Appeal may be lodged:
 - (a) for substantial violation of rules of procedure or form;
 - (b) for violation of the provisions of the present Convention or of any rules made in implementation thereof (in so far as matters concerning procedure and form of national provisions are not involved), when a decision of the European Patent Court is necessary to assure uniform application of law, or when a question of important and fundamental rights is at issue.
- (3) Such appeal may be lodged by any party to the proceedings who was adversely affected by the decisions of the Board of Appeal.

- (4) Further provisions concerning the conditions and effect, as well as the procedure for such further appeals, shall be contained in the Convention establishing a European Patent Court.

114. Application of national procedure

- (1) Upon request of the applicant for or proprietor of a European patent, the central industrial property office of any Contracting State covered by the application or patent will apply the procedure for the grant of a national patent, based upon the European filing which, by virtue of Article 75, is equivalent to a national filing.
- (2) The application for conversion must be made within a period of three months, calculated either from the refusal or withdrawal of an application for a European patent, or from its cancellation or surrender, or from the date of withdrawal of such State from those covered by the application or patent. The right conferred by the said Article will lapse if the application is not submitted within the prescribed time.

(Note: Perhaps "conversion" is not the best word.)

115. Application for conversion

- (1) The application referred to in Article 114 shall be accompanied:
- (a)* by a copy of the application for a European patent duly certified by the European Patent Office and of any documents received by that Office under Article 77, paragraph 1, and Article 81, and of a priority claim in respect of any earlier application;
- (b)* by a copy of the novelty report, if any;
- (c) by a certificate from the European Patent Office:
- (i) indicating the date upon which the application for the European patent was refused or withdrawn, or upon which the European patent was cancelled or surrendered or upon which the State in question was withdrawn from those covered by the application.

- (ii)* indicating the latest claims which the applicant has established in the course of proceedings before the European Patent Office, apart from any which he may previously have abandoned;
 - (iii)* specifying the elements of the state of the art, other than those mentioned in the novelty report, which were cited by the European Patent Office;
 - (d)* by the fees payable on application for a national patent, or by proof of their payment.
- (2)* Each Contracting State may require a translation of the documents mentioned in paragraph 1, subparagraphs (a) and (c)(ii) in one of the official languages admitted by its central industrial property office, accompanied by an official certificate of conformity with the original text. The period allowed for the submission of these documents shall not be less than two months.

116.* Validity of national filing

The documents specified in Article 115, paragraph 1(a), submitted under Article 114, and supported, where necessary, by the translation referred to in Article 115, paragraph 2, shall constitute a valid national filing, provided that they are accompanied by the document referred to in Article 115, paragraph 1(b) or, failing this, provided that the national central industrial property office has certified that the formal requirements of a European patent application have been complied with. The claims of the national patent may not exceed in scope the claims referred to in Article 115, paragraph 1(c)(ii).

(Note: The terms of the second sentence of this Article imply that a statement of claims is required by the national laws of each Contracting State. This would definitely be the case if the draft European Convention on the unification of patent laws recently drawn up at Strasbourg, had come into force by the time that the European Convention providing for a European patent takes effect.)

117.* Notification and publication

- (1) A national central industrial property office is required to inform the European Patent Office of the receipt of any application submitted in accordance with Article 114, when the grant of the European patent has been published. The application shall be entered in the European Register of Patents and published in the European Patent Bulletin.
- (2) The national central industrial office shall publish the documents referred to in Article 115, paragraph 1, when, under national law, the documents relating to proceedings for a national patent can be so published. The specification of the national patent shall refer to the application for the European patent and, to the European patent, if any.

118.* Conversion of secret applications

- (1) In the event of an application for a European patent being subjected to secrecy in accordance with Article 67, paragraph (3), and upon the request of the applicant made within a period of three months calculated from the placing of the application on the secret list, Article 114 shall apply, subject to the provisions of national legislation relating to secret inventions. The request shall contain a reference to the application for the European patent upon which it is based, and shall be accompanied by the fees payable on application for a national patent, or by proof of payment thereof.
- (2) A Contracting State may require a translation of an application for a European patent, under the conditions specified in Article 115, paragraph 2.
- (3) The application for a European patent shall constitute a valid national filing in so far as it complies with the formal requirements laid down by the present Convention.

PART VI RENEWAL OF EUROPEAN PATENTS

119. Renewal fees

The renewal fees to be paid in respect of the European patent shall be those laid down by the Rules relating to fees adopted pursuant to this Convention. Each renewal fee shall include a sum in respect of each country covered by the patent. These fees are due in respect of the third year and each of the following years, calculated from the date of filing of the application. Patents of addition are not subject to the payment of renewal fees.

120.* Date of payment of renewal fees

- (1) Renewal fees must be paid before the commencement of the year in respect of which they are due. Renewal fees due in respect of any period prior to the grant of a European patent must be paid not later than four months after such grant.
- (2) When a renewal fee has not been paid before the date indicated in paragraph (1), the fee may be validly paid within six months of the aforesaid date, provided that the additional fee prescribed by the Rules relating to fees is paid at the same time.
- (3) The lapse of a European patent for failure to pay a renewal fee within the due period shall be deemed to have occurred at the end of the year preceding that in respect of which the fee fell due.

121.* Proof of payment

Subject to the provisions of Article 113, the European Patent Office shall alone be competent to decide whether the renewal fees have been paid in due time. In the event of dispute, the Patent Administration Division will decide upon the matter, if so requested.

122.* Extension of time for the payment of renewal fees

- (1) The European Patent Office may, upon request, grant to any person who is the proprietor of a European patent supplementary extensions of time for the payment of renewal fees, provided that the applicant for such an extension proves, within the period prescribed for the payment of the fees, that he was prevented from paying them by lack of funds. Any

extension granted shall not exceed two years, and may be renewed, provided payment is not deferred beyond the two years following confirmation of the European patent. Extension can only be granted in respect of an amount not exceeding nine-tenths of the total fees payable. Further, the grant of an extension of time for payment may be made subject to the payment of a deposit.

- (2) Notwithstanding paragraph (1) above, the European Patent Office may authorize the proprietor of a patent, upon his request, to make, within a period of one year calculated from the expiry of the second year following the confirmation of the European patent, instalment payments of the total amount of renewal fees due at that date.
- (3) During the period of exemption from payment granted in accordance with Article 169, paragraph 1, the provisions of paragraph (1) (above) shall similarly apply, without it being necessary to prove lack of funds. Such provisions shall apply equally, and without proof, as from the date on which the request specified in Article 169, paragraph 1, is submitted. If this request is refused, the renewal fees must be paid within three months of such refusal. The provisions of paragraph 2 and of Article 123 are applicable under this procedure.

(Note: Paragraph 3 will only be effective if the first variant of Article 169 is adopted.)

123.* Failure to effect payment within the extended period

If renewal fees in respect of which an extension has been granted in accordance with Article 122 are not paid in due time, the European patent will lapse at the expiry of the said period. The renewal fees unpaid at the date of expiry remain due. Failure to pay will be established by a decision of the Patent Administration Division.

PART VII SURRENDER AND LAPSE OF EUROPEAN PATENTS

124. Surrender of the European patent

- (1) (a) A European patent may be surrendered as a whole.
- (b) A European patent may be surrendered in part by

(i) restricting the Contracting States covered thereby

or (ii) surrendering one or more claims.

(Note: This wording is intended to avoid the limiting of claims in respect of some countries only.)

- (1A) A group of States as referred to in Article 2A(3) may stipulate that any restriction under paragraph 1(b)(i) shall not result in a patent covering only some States in the group.
- (2)* The surrender of a European patent must be declared in writing to the European Patent Office by the proprietor entered in the Register of European Patents. It will not have effect until it is entered in the Register of European Patents.
- (3) If () licences under the European patent have been entered in the Register of European Patents, surrender will only be entered upon production of declarations in which third parties having such rights consent to the entry.
- (4) Partial surrenders effected during the procedure for granting of final patents may relate to any part of the patent. The provisions of paragraphs 2 and 3 do not apply to such surrenders.

125. Lapse of European patent

- (1) Apart from the cases specified in Article 16, paragraph 5, a European patent will lapse:
- (a)* if no request for examination is submitted within the period of five years specified in Article 88, paragraph 2;
- (b) if the proprietor of the patent surrenders it in accordance with Article 124(1)(a);
- (c)* if the renewal fees are not paid within the proper period.
- (2)* When a European patent lapses, it shall be considered as not having had, from the outset, the effects specified in Article 20.
- (3)* The lapse of a European patent or its partial surrender in accordance with Article 124(1)(b)(1) will be recorded in the Register of European Patents and published in the European Patent Bulletin.

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126. - 135. Omitted

PART VIII COMPULSORY LICENCES

136. - 143. Omitted

144. Reservation in favour of national legislation

- (1) Any provision in the laws of a Contracting State which enables () the grant of compulsory licences in respect of national patents shall be applicable to European patents, so far as that States in concerned. ()

(2) and (3) Omitted

145. - 152. Omitted

PART IX COMMON PROCEDURAL PROVISIONS OF THE EUROPEAN
PATENT OFFICE

153. Membership of Boards of Appeal and
challenges thereto

- (1) Members of Boards of Appeal () may not take part in the settlement of any matter if they have any personal interest therein, if they have previously been involved as representatives of one of the parties, or if, at an earlier stage, they contributed towards the final decision in the matter. ()
- (2) If, for one of the reasons mentioned in paragraph 1, or for any other reason, a member of a Board of Appeal () considers that he should not take part in the resolution of a matter, he shall inform the Board accordingly.
- (3) Members of a Board of Appeal () may be objected to by any party for one of the reasons mentioned in paragraph (1), or if suspected of partiality. No objection can be based upon the nationality of members or upon the fact that none of them is of the same nationality as the applicant.
- (4)* The Board will decide as to the action to be taken in the cases specified in paragraphs (2) and (3). In cases of the kind referred to in paragraph (3), the decision will be taken without the participation of the member concerned.

154. Obtaining evidence

- (1)* Evidence may be obtained in proceedings before the European Patent Office under the present Convention by means including:
 - (a) the personal appearance of the parties;
 - (b) interrogatories and the discovery of documents;
 - (c) examination of witnesses;
 - (d) expert opinion;
 - (e) inspection of premises.
- (2) An Examining Division, a Patent Administration Division, a Board of Appeal () will proceed to take the necessary investigating action, or will commission one of their members to do so.
- (3) A Board of Appeal () or any member duly commissioned to undertake investigations, may hear witnesses and experts on oath.
- (4) A Board of Appeal () may impose a fine not exceeding upon any witness who fails to appear after service of a summons on him in proper form. A similar penalty may be imposed upon any witness who, without proper reason, refuses to testify or take an oath.
- (5)* Each Contracting State will treat any perjury on the part of witnesses and experts as if the offence had been committed before a national court dealing with civil proceedings. On notification by the President of the European Patent Office, it will take proceedings before the competent national court against such persons.
- (6) Interested parties, witnesses and experts may be heard by the judicial authorities of their country of residence. Witnesses and experts may be heard, under oath, where applicable, by the judicial authorities of their country of residence, even when the hearing has been requested by an Examining Section, an Examining Division or the Patent Administration Division.

155.* Time-limits

When the present Convention or the Implementing Regulations specify a period to be determined by the European Patent Office, such period shall not be less than two months or more than four months. In certain special cases, the period may be extended upon request, but its total extent shall not exceed six months.

156.* Observation of time-limit prevented by force majeure

- (1) The applicant for or the proprietor of a European patent who is prevented by force majeure from observing a time-limit imposed by the European Patent Office will, upon application, have his rights re-established, if the non-observance in question has had the direct consequence, by virtue of the provisions of the present Convention or of the Implementing Regulations, of causing the refusal of the application for a patent, or of a request, or the loss of any other right or means of redress.
- (2) The application must be submitted within the two months following the removal of the cause of non-compliance with the time-limit. The omitted act must be completed within this period. The application will only be admissible within the year immediately following the expiration of the unobserved time-limit. In the case of non-payment of a renewal fee, the period specified in paragraph (2) of Article 120 will be deducted from the period of one year.
- (3) The application must state the grounds on which it is based, and must set out the facts and evidence on which it relies.
- (4) The authority competent to decide on the omitted act will decide upon the application. Any decision refusing an application must set out the grounds upon which it is based.
- (5) The provisions of the present Article are not applicable to the time-limits specified in Article 68, paragraphs 3 and 4, Article 72, paragraph 1, Article 74, paragraph 1, Article 80, paragraphs 3 and 4 and Article 88, paragraph 2.

- (6) Any person who, in a Contracting State, has, in good faith, in the course of the period between the lapse of a European patent and its restoration, exploited or made effective and serious preparations for exploiting the invention which is the subject of the patent, may freely continue such exploitation in the course of his business or for the needs thereof.

157.* Death of applicant or proprietor

- (1) If the applicant for or the proprietor of a European patent dies, and if his heirs cannot be located, the European Patent Office may, by public notice, invite the heirs to establish, within a reasonable time, their rights in respect of the application or the European patent.
- (2) If no person establishes a right of succession within the due time, or if persons who have laid claim to the rights within such time fail to produce proof within a reasonable period, the application will be deemed to have been withdrawn or the patent to have lapsed.

158. Mentioning of the inventor as such

- (1) If the applicant for or the proprietor of a European patent names the inventor to the European Patent Office, the person so named will be mentioned as inventor in the European Register of Patents, in the notice publishing the grant of the European patent, and in that publishing the confirmation of this patent as final patents and in the printed specification. The applicant for or the proprietor of the European patent may, at any time, amend the notification. The European Patent Office will not check the accuracy of the information given.
- (2)* The provisions of paragraph (1) will not be applied when the inventor named by the applicant addresses to the European Patent Office a written renunciation of his title as inventor.
- (3)* Paragraph (1) will apply similarly:
 - (a) when a third party produces to the European Patent Office a final judgment from which it transpires that the applicant or proprietor is required to name such third party as inventor;

- (b) when a third party submits to the European Patent Office a request for rectification of the name of the inventor and supports it with the consent of the applicant or proprietor and of the person wrongly named, or produces evidence of a final judgment.

- (4)* Printed specifications will not be corrected after publication.

159.* Reference to general principles

In the absence of procedural provisions in the present Convention or the Implementing Regulations, the European Patent Office will take into account the principles of procedure generally practised in such matters in the Contracting States.

160. Admission of public

- (1)* Hearings before the Examining Sections, the Examining Divisions and the Patent Administration Divisions are not public.
- (2) Oral proceedings, including delivery of the decision, are public as regards the Boards of Appeal, after publication of a European Patent; ()

161.* Notifications

The European Patent Office will, as a matter of course, notify those concerned of decisions and summons, and of any notice or other communication from which a time-limit is reckoned, or of which those concerned must be notified under the present Convention or its Implementing Regulations, or by order of the President of the European Patent Office. Such notifications may be given through the intermediary of the central industrial property offices of the Contracting States.

162.* Inspection of files

- (1) Before publication of the grant of a European patent, the files relating to applications for European patents and to European patents shall not be made available for inspection without the consent of the applicant for or the proprietor of the European patent.

- (2) After publication of the grant of a European patent, or in the case specified in Article 117, paragraph 2, documents relating directly to the proceedings for grant, confirmation or revocation of a European patent may be inspected by any person upon request.
- (3) Inspection as referred to in the preceding paragraphs is subject to the payment of the fee prescribed by the Rules relating to fees adopted pursuant to this Convention.

163.* Notification of objections raised by national authorities

- (1) The proprietor of a European patent shall state, within a period to be determined, and upon request of an Examining Division or of a Board of Appeal, the States in which applications for national patents have been made for the whole or part of the invention which is the subject of the European patent, and to give the reference numbers of the said applications. He may likewise be required to state, within a period to be determined, any objections raised in the course of proceedings before the national authority and the decisions of such authority, in so far as such objections and decisions relate to the novelty of the invention.
- (2) The Examining Division or the Board of Appeal will cancel the European patent if the proprietor of the said patent fails to comply with the requirements of paragraph 1.

(Note: A minority of the working party was unable to give approval to the provisions of this Article. It considered that the sanction specified in paragraph 2 was excessive, and that a substantially equivalent result could be obtained by the conclusion of agreements providing for the mutual exchange of information between the European Patent Office and the principal national offices.)

(Note: For purposes of the two-part scheme, the solution stated in the Note to the EEC text is also acceptable.)

164.* Costs in examination proceedings

- (1) Each party to proceedings for the grant or examination of a European patent must meet the costs he has incurred, unless a decision of an Examining Section or Division orders an equitable apportionment of costs incurred in hearing the parties, or during a preliminary investigation.
- (2) Apportionment of costs will be dealt with in the decision relating to the grant or to the confirmation of a European patent. It can similarly be dealt with when an application for a patent is withdrawn, or when a European patent lapses.
- (3) The apportionment of costs, including the remuneration of representatives of the parties, shall be limited to the expenses necessary to assure proper protection of the rights involved.
- (4) Upon request, an Examining Section will tax costs to be paid under a decision apportioning them. A bill of costs, with supporting evidence, shall be attached to the request. The request will only be admissible if the decision in respect of which the taxing of costs is required is a final one. Costs may be taxed once their credibility is established.

165.* Costs in proceedings on appeal

- (1) Each party proceeding on appeal must meet the costs he has incurred unless a decision of a Board of Appeal orders an equitable apportionment of costs, other than fees prescribed by the Rules relating to fees under the Convention.
- (2) Apportionment of costs will be dealt with in the decision on the appeal. It can similarly be dealt with when an application for a European patent or the appeal has been withdrawn, or when the European patent lapses.
- (3) The provisions of Article 164, paragraphs 3 and 4, are applicable to costs in appeal proceedings.

166. Omitted

167. Omitted

168. Omitted

169. Assistance

1st Variant

- (1)* In proceedings for the grant and confirmation of a European patent, and in appeal proceedings, the applicant or the proprietor shall, upon request, be exempt from the payment of fees, other than the application fee and renewal fees, and from the payment of other costs of proceedings as described by the present Convention and its Implementing Regulations, if the competent department of a Contracting State certifies that he is not in a position to pay owing to lack of sufficient means. Such exemption will be total or partial in accordance with the certificate which shall specify what portion of the fees and other costs, if any, the person submitting the request is able to pay.
- (2) Omitted
- (3)* Exemption will only be granted if the application and the certificate referred to in paragraph (1) are submitted before the expiration of the period fixed for payment. However, when the applicant establishes within the said period that he has applied for the certificate from the competent authority, the period will be extended by three months. If the certificate is not submitted within the extended period of three months, the extension will be deemed to have been refused.
- (4)* The competent authority of a Contracting State will only issue certificates to physical persons who are nationals of said State or ordinarily resident on its territory.
- (5)* The fees and other expenses from which an applicant secures exemption will be reimbursed to the European Patent Office by the Contracting State whose competent authority issued the certificate.
- (6)* Contracting States are not bound to issue the certificates provided for by this Article.

2nd Variant

Contracting States may take any measures designed to assist applicants for and proprietors of European patents () in respect of the payment of fees, other than application fee and renewal fees, and for the payment of other costs of proceedings, in so far as such persons are not in a position to

pay them, owing to insufficient means. These measures can only be taken in favour of physical persons who are nationals of the State concerned, or ordinarily resident on its territory.

170.* Enforcement of costs and fines

- (1) Decisions of the European Patent Office taxing costs of proceedings, imposing a fine, or establishing failure to pay renewal fees within the meaning of Article 123, are themselves enforceable; this provision does not apply to States.
- (2) Enforcement shall be regulated by the rules of civil procedure in the Contracting State in whose territory the enforcement takes place. The enforcement order will be issued, without further requirement other than that of the authenticity of the document, by the national authority which the government of each of the Contracting States will designate for this purpose, and of which the European Patent Office shall be informed.
- (3) After the completion of these formalities at the request of the interested party, the latter may levy distraint by direct application to the competent authority in accordance with national law.
- (4) Enforcement can only be stayed by a decision of the European Patent Office or the European Patent Court. However, national courts shall be competent to investigate the validity of such enforcement measures.

171.* Professional patent agents

- (1) Representation of natural and legal persons in proceedings before the European Patent Office can only be undertaken by natural persons whose names appear in the list maintained for this purpose by the said office.
- (2) Any person having his registered place of business within the territory of one of the Contracting States and who, according to a certificate furnished by the central industrial property office of one of such States, is entitled to act as a professional patent agent before that office, may be entered in the list. Entry is effected upon request, accompanied by the certificate referred to above, which must specify the extent of such entitlement.

- (3) When, in a Contracting State, the qualification to act as an agent is not conditional upon the requirement of special professional qualifications, persons who act as agents before the central industrial property office of the said State must have habitually acted as such for at least five years. In such cases, the certificate specified in the preceding paragraph must indicate that the applicant satisfies this requirement.
- (4) Agents 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 patent agents in the Contracting State in which they exercise their profession.
- (5) Representation before the European Patent Office may be undertaken by any lawyer called to the Bar in one of the Contracting States, and having his professional office within such State, to the extent that he is able, within the said State, to act as a representative in patent matters.

(Note: This Article may have to be modified to take account of new or amended national provisions in the matter of representation before national industrial property offices.)

172.* Compulsory representation

- (1) Subject to the provisions of the following paragraphs, no person is compelled to be represented before the European Patent Office.
- (2) Natural and legal persons who have neither a place of business nor residence within the territory of one of the Contracting States must be represented in all proceedings before the European Patent Office by a patent agent. Upon conclusion of the proceedings, the authority of the patent agent to receive all communications concerning the patent, shall be legally maintained, unless the proprietor of the European patent has acquired an address for service within the territory of one of the Contracting States.

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- (3) Applications for patents, requests and appeals by persons referred to in paragraph (2) can only be lodged through a patent agent. Failure to observe this requirement will result in the application for a patent, the request, or the appeal being deemed not to have been made.
- (4) The patent agent referred to in paragraph (2) will be entered in the European Register of Patents. Any agent so entered and who ceases to be authorized will continue to be regarded as the patent agent for such time as his name remains entered on the Register.

173.*

Authorizations

- (1) Patent agents acting as such before the European Patent Office must produce an authorization in writing.
- (2) If several agents are authorized they may, notwithstanding any contrary provisions in the authorization, act either jointly or individually.
- (3) Unless an authorization contains provision to the contrary, it will not terminate upon the death of the person who issued it.

/PART X

PART X PROCEDURE IN INFRINGEMENT AND OTHER CIVIL PROCEEDINGS

174.* Competence of the national courts

- (1) Actions for infringement of a European patent shall be dealt with by the national courts of the Contracting States, who are competent, *ratione loci et ratione materiae*, as in the case of actions for the infringement of a national patent.
- (2) The Contracting States are entitled to remit actions for infringement of European patents in respect of their entire territory or parts thereof to a national court, competent *ratione materiae*.

175.* Procedure in actions for infringement

To the extent that the present Convention does not otherwise provide, infringement actions in respect of a European patent are subject to the rules of procedure applicable by virtue of national law to infringement actions in respect of national patents.

176. Dispute as to the validity of a European patent

If, in proceedings for the infringement of a European patent, the validity of the patent is questioned, a decision establishing infringement can only be issued after confirmation of the European patent ().

(Note: It is intended that a national court should be able to give a decision establishing non-infringement, without remitting the European patent for confirmation, where it is satisfied that the patent is for subject matter (e.g. food or drugs) which is excluded from patentability in that country.)

177. Omitted

178. Omitted

179.* Interlocutory decision by the European Patent Court

- (1) In proceedings for infringement of a European patent, the European Patent Court shall have jurisdiction to render an interlocutory decision:
 - (a) in the matter of interpretation of this Convention;
 - (b) in the matter of the validity and interpretation of provisions enacted in implementation of this Convention, to the extent to which they are not national provisions.

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- (2) When such a question is raised before a national court, that court may, if it considers a decision on the point to be necessary to enable it to pass judgment, request the European Patent Court to render such a decision.
- (3) When such a question is raised before a national court whose decisions are not subject to appeal under national law, that court shall be bound to refer the question to the European Patent Court.

180. Opinion by the European Patent Office

At the request of the competent national court to which the infringement action has been referred, the European Patent Office shall be obliged to produce a technical opinion concerning the final () patent in question.

181. Omitted

182. Omitted

183. Proceedings before the national courts in matters other than infringement

- (1)* Actions concerning European patents other than those referred to in Article 174, paragraph 1, come under the jurisdiction of those national courts of Contracting States which are competent, *ratione loci* and *ratione materiae*, in matters relating to national patents. Article 174, paragraph 2 and Articles 175, 179 and 180 apply correspondingly.
- (2) The validity of a European patent may only be challenged, by way of exception, in proceedings instituted in respect of the above-mentioned actions, if the validity of a national patent may similarly be challenged in the same proceedings. In such cases, the provisions of Article 176 () shall apply correspondingly.

184. Omitted

PART XI TRANSITIONAL PROVISIONS

185.* Meeting of the /Administrative Council/

The Government /with whom instruments of ratification are deposited/ shall convene a meeting of the /Administrative Council/ within one month after the entry into force of this Convention.

186.* Progressive expansion of the field of activity of the European Patent Office

- (1) Applications for European patents shall not be accepted before the day on which the European Patent Office opens. To begin with, the acceptance of applications shall be restricted to certain technical fields subsequently to be progressively extended to other fields.
- (2) The date of the opening of the European Patent Office and the technical fields for which applications for European patents will be accepted shall be fixed by the /Administrative Council/ on the recommendation of the President of the Office.
- (3) The technical fields for which applications for European patents will be accepted shall be fixed with reference to the International Classification referred to in Article 62.

187.* First accounting period of the European Patent Office

- (1) The first accounting period of the European Patent Office shall extend from the date of opening of the Office to 31st December of the same year. If the day of opening falls within the second half of the year, the accounting period shall extend until 31st December of the year following the opening of the Office.
- (2) Until the budget relating to the first accounting period has been drawn up, the Contracting States shall make interest-free loans which shall be deducted from their financial contributions pertaining to the carrying out of this budget.
- (3) Until such time as the conditions of service for officials and other employees of the European Patent Office provided for under Article 38 have been drawn up, the /Administrative Council/ and the President of the Office, each within their respective powers, shall recruit the necessary staff and shall conclude short-term contracts to that effect.

(Note: For the period between the entry into force of this Convention and the opening of the European Patent Office, the general convention or an additional protocol, should include financial provisions allowing for the operation of the Administrative Council, the salaries of the President of the European Office and of its officials who have begun their duties before the opening of the Office, and to cover the costs of its initial equipment.)

188. Preliminary national filing

- (1)* Each Contracting State may prescribe that persons ordinarily resident or having their registered place of business on its territory may not file an application for a European patent except where that application is based on one or more applications for national patents filed in the said State and constituting first filings within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property. This stipulation shall not apply to persons who, at the time of their first filing, were not ordinarily resident or did not have a registered place of business in the territory of that State.
- (2)* A Contracting State making use of the reservation referred to in paragraph 1, shall notify the European Patent Office accordingly.
- (3)* The application for a European patent may only relate to the invention which forms the subject of an application or applications for a national patent or patents.
- (4)* At the request of the European Patent Office, and within a period prescribed by the latter of at least four months after the date of filing of the application for a European patent, the applicant shall submit to the Office the documents referred to in Article 74, paragraph 2. If these documents are not submitted in due time, the Examining Section shall refuse the application for a European patent. Article 77, paragraphs 1, 3 and 4 shall apply correspondingly.
- (5) A European patent shall not be confirmed and a final () patent may be liable to revocation if the provision laid down in paragraph 3 has not been complied with.

189.* Joint filing at the European Patent Office

- (1) With effect from the opening of the European Patent Office, joint filings involving a request for the grant of national patents in each of the Contracting States may be made in those technical fields for which applications for European patents are not yet accepted.
- (2) A joint filing shall be made in conformity with the provisions of Article 66, paragraphs 1 and 2.
- (3) A joint filing shall be deemed to be a national filing in each of the Contracting States.

190.* Conversion of the application

- (1) When an application for a European patent relates to a technical field in which applications are not yet accepted, the filing shall be deemed to be and treated as a joint filing, provided the applicant, on being notified by the Examining Section, gives his consent thereto within a prescribed period. If consent is not given within the prescribed period, the application will be considered as withdrawn.
- (2) When a joint filing relates to a technical field in which applications for European patents are accepted, the filing shall be deemed to be an application for a European patent and treated as such, provided the applicant, on being notified by the Examining Section, gives his consent within a prescribed period. If consent is not given within the prescribed period, the application will be considered as withdrawn.
- (3) When an application for a European patent relates in part only to a technical field in which applications are not yet accepted, the filing shall be deemed to be a joint filing and treated as such, unless the applicant, on being notified by the Examining Section and within a prescribed period, divides his application, in accordance with the provisions of Article 68, into an application for a European patent and into a joint filing. This provision shall similarly apply in the case of a joint filing relating in part to a technical field in which applications for European patents are accepted.

191.* Procedure for joint filing

Apart from the provisions of this chapter, the following Articles shall apply to the procedures for a joint filing at the European Patent Office:

Article 66, paragraph 3; Articles 67 - 74; Article 76, paragraphs 1 and 2(d), in so far as the provision of sub-paragraph (d) refers to Article 70, paragraph 2; Article 76, paragraph 2(e) and Articles 77, 78, 105 - 113, 153 - 173, and the provisions of any relevant Implementing Regulations.

192.* Notification to national offices and to the applicant

- (1) The European Patent Office shall despatch to the central industrial property offices of the Contracting States:
 - (a) as soon as possible and not later than six months after the filing thereof, a copy of the patent application forming the subject of a joint filing and of any claim for priority under a prior filing;
 - (b) a copy of the novelty report and of any documents received pursuant to Articles 77, paragraph 1, and 81.
- (2) The European Patent Office shall also despatch a copy of the novelty report to the applicant.
- (3) Within a period of three months from the date of despatch of the novelty report, the applicant may, by notifying the European Patent Office, withdraw the request for joint filing.
- (4) The European Patent Office shall immediately inform the central industrial property offices if the application has been withdrawn or refused.

193.* Commencement of national proceedings

- (1) The central industrial property offices of Contracting States may not commence proceedings for the grant of a national patent until four months after receipt of the novelty report.
- (2) Any Contracting State may require the production of a translation of the documents referred to in Article 192, paragraph 1, in one of the official languages recognized by its central industrial property office, accompanied by an official certificate of conformity with the original text. The period granted for the production of these documents may not be less than two months and may not terminate before the expiration of the period prescribed in paragraph 1.

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- (3) Unless the refusal or withdrawal of the joint filing has been notified in accordance with Article 192, paragraph 4, the documents pertaining to this filing, as forwarded by the European Patent Office and supplemented, if necessary, by the translation referred to in the preceding paragraph, shall constitute a regular national filing.
- (4) The fees which a Contracting State may require shall be limited to those payable under national law in respect of an application for a national patent, less the fee payable on filing.

(Note: These Articles are retained since they deal with matters relating to patent applications which are relevant to the present scheme as well as to the original EEC draft scheme. Nevertheless they appear to define a very complicated procedure which may not be the most suitable for a scheme of wider membership. Further they appear to present grave practical difficulties for certain countries.)

194. Simultaneous protection during a transitional period

During a transitional period which is to terminate on a date to be fixed by the Administrative Council, simultaneous protection prohibited by Article 7, shall be authorized under the conditions laid down in Articles 195 - 205. The provisions of Articles 100, paragraph 1(c) (), shall not apply to European patents applied for during that period.

195.* Basis for simultaneous protection

- (1) Simultaneous protection afforded for the same invention, within the meaning of Article 7, by a European patent and by one or more national patents, shall not be authorized except when these patents are based on a common claim of priority. In the absence of such a common basis, Article 19 shall apply.
- (2) The provisions of Articles 196 - 205 shall apply even if the patents referred to in paragraph 1 do not confer protection to the same extent.

196.* Compulsory declaration

- (1) The applicant for a European patent must indicate to the European Patent Office the serial numbers of national applications filed in Contracting States for

which the same priority date as that of the application for a European patent is claimed. This information shall be given within four months of filing the application for a European patent or, where national applications are filed after the European application, within four months of their filing. If this information is not given in the case of an application for a national patent within the specified period, the application for a European patent will be deemed to have been filed after the national application.

- (2) The European Patent Office shall communicate the serial number of the application for a European patent to the central industrial property offices of the Contracting States in which the applications referred to in paragraph 1 have been filed. This serial number shall be recorded in the national patent registers of the States concerned.

197. Omitted

198.* Assignment of and rights in rem relating to simultaneous patents

- (1) The assignment of a European patent shall carry with it the assignment of the national patents referred to in Article 195. No national patent may validly be assigned apart from the European patent.
- (2) Paragraph 1 shall similarly apply to mortgaging, distraints, and other contractual or legal rights in rem.

(See Note to Articles 26 - 28.)

199. Contractual licences under simultaneous patents

- (1)* The grant of a contractual licence in respect of a European patent shall automatically imply the grant of a licence in respect of the national patents referred to in Article 195. Subject to this, a simultaneous national patent may not form the subject of a contractual licence.
- (2) Omitted

200.* Transactions prior to the filing of an application
for a European patent

Transactions referred to in Articles 198 and 199 in respect of a national patent which occurred prior to the date of filing of the application for a European patent, shall cease to have effect on that date, unless these transactions extend to the European patent and to any other national patents referred to in Article 195.

201.* Compulsory licences under simultaneous patents

- (1) The national patents referred to in Article 195 shall not prevent the exercise of the rights attached to a compulsory licence granted in respect of the European patent.
- (2) The European patent shall not prevent the exercise of the rights attached to compulsory licences granted in respect of the national patents referred to in Article 195.

202.* National provisions relating to "licences of right"

Provisions of Contracting States providing for the voluntary endorsement of patents with the words "licences of right" shall not apply to national patents referred to in Article 195.

203.* Infringement actions in respect of simultaneous
patents

- (1) An action for infringement of a European patent and a national patent as referred to in Article 195, may be brought on the basis of the European patent, of the national patent or of both. If the action is brought on the basis of both patents and if the respondent raises the question of the validity of the European patent, infringement proceedings shall be stayed in respect of the two patents in accordance with Article 176. If the European patent is declared invalid, the national patent may not be used against the respondent to the extent to which it covers matter in respect of which the European patent was declared invalid.
- (2) Any person who, in one of the Contracting States, has brought an action on the basis of one of the two patents referred to in paragraph 1, may not, in the

same country and in respect of the same acts or later identical acts, bring a new action against the same respondent or his assignee based on the other patent.

204.* Determining rights in respect of simultaneous patents

The effect of decisions of the courts delivered in proceedings to determine or assign ownership or other rights referred to in Articles 198 and 199 in respect of a European patent, shall extend to the national patents referred to in Article 195. Subject to this, any decision of the courts which refers to the national patents shall be without effect.

205.* Applications for simultaneous patents

The provisions of Articles 194 to 204 shall apply both to applications for European patents and to applications for the national patent referred to in Article 195..

PART XII FINAL PROVISIONS

206.* Application to national utility models

The provisions of this Convention which relate to applications for patents filed or to national patents granted in the Contracting States, shall equally apply to applications for utility models or to utility models deposited or registered in those States.

207.* Adaption of national law to the European Patent Law

- (1) A European patent published on or after the priority date of an application for a national patent, but having an earlier priority date, shall be deemed in each of the Contracting States, in regard to such application or to the national patent granted in respect thereof, to be the equivalent of a national patent based on an earlier filing.
- (2) If the law of a Contracting State provides for the grant of compulsory licences on earlier patents in favour of subsequent dependent patents, those provisions shall also apply in favour of European patents.

208.* Disputes between Contracting States

- (1) Any dispute between two or more Contracting States which concerns an obligation of Contracting States arising from this Convention shall, at the request of one of the States concerned, be submitted to the /Administrative Council/ which shall endeavour to bring about agreement between the said States.
- (2) If agreement is not reached within six months from the day of the dispute being referred to the /Administrative Council/, each of the Contracting States may appeal to an /International Court/.
- (3) If the /International Court/ finds that a Contracting State has failed to fulfil one of the obligations incumbent upon it by virtue of this Convention, that State shall take such steps as are necessary to carry out the judgment of the /International Court/.

209.* Territorial application of the Convention

This Convention shall apply to those territories of the Contracting States which the latter designate on signing the Convention or on depositing their instruments of ratification or accession. A declaration made to that end may be amended at any time by notification to the government /with which the instruments of ratification are deposited/. Such notification shall take effect thirty days after its receipt by the aforementioned government.

210. Revision

- (1) This Convention may be revised*(). Revision conferences shall be convened on the initiative of a majority of Contracting States.
- (2)* The preparation of revision conferences shall be the responsibility of the /Administrative Council/.
- (3)* A revised text of the Convention shall be adopted only by unanimous decision of the revision conference.
- (4)* A revised text of the Convention shall not come into force until all the Contracting States have ratified it. The provisions of Article 214 shall apply.
- (5) Omitted

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(Note: It is for consideration whether, in the context of a wider membership, the unanimity rules in paragraphs (3) and (4) should be relaxed in view of the rigidity involved. However, in any case a convention operating with two or more texts should be avoided. A possible solution would be to make a revision by a qualified majority, allowing the minority a certain period of time to accept the revised text or to leave the scheme.)

211. Accession

- (1) Any State which is a party to the Paris Convention for the Protection of Industrial Property may accede to this Convention by notification addressed to the Administrative Council
- (2) Omitted
- (3) Omitted

(Note: Provision will have to be made for:

- (a) addressing an instrument of accession;
- (b) notifying other Member States of such accession;
- (c) date of effectiveness of the accession;
- (d) terms of financial contributions, etc.)

212. Omitted

213.* Protocols

The protocols annexed to this Convention by common agreement of the Contracting States shall be an integral part thereof.

214.* Ratification

- (1) The present Convention shall be ratified by the High Contracting Parties in conformity with their respective constitutional practice. The instruments of ratification shall be deposited with the Government of
- (2) The present Convention shall come into force on the first day of the month following the deposit of the instruments of ratification of at least three-quarters of the signatory States. Nevertheless, if that deposit takes place less than fifteen days

before the beginning of the following month, the entry into force of the Convention shall be postponed to the first day of the second month following the date of that deposit.

215.*

Notifications by the Government with which instruments of ratification are deposited

The Ministry for External Affairs of the Government [with which instruments of ratification are deposited] shall notify States which have signed or acceded to the Convention:

- (a) of the deposit of instruments of ratification;
- (b) of the date on which the present Convention comes into force by virtue of the provisions of Article 214, paragraph 2;
- (c) of the declarations received pursuant to Article 209.

216.*

Duration of the Convention

The present Convention shall remain in force for an indefinite time.

(Note: A clause will need to be added providing for denunciation. This clause will apparently have to provide for a phased withdrawal of the country from membership on the following basis:

- (a) patent applications should immediately cease to be made in respect of that country;
- (b) applications already made and European patents already granted for that country should be unaffected;
- (c) withdrawal would not be complete while (b) still applied;
- (d) some financial contributions should continue to be made by that country until withdrawal is complete.)

(Note: Some provisions will also have to be made for the situation where a country defaults in payment of contributions.)

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217.

Original of the Convention

The present Convention shall be drawn up in a single original in the English, French and German languages, the three texts being equally authentic, and shall be deposited in the archives of the Government of which shall forward a certified true copy thereof, to each of the governments of the other signatory States.

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