

CA/PL 31/00

Orig.: English/French

Munich, 20.07.2000

SUBJECT: Summary of conclusions of the 14th meeting of the Committee on
Patent Law (Munich, 3 to 6 July 2000)

DRAWN UP BY: Council Secretariat

ADDRESSEES: Committee on Patent Law (for information)

I. ADOPTION OF THE AGENDA (CA/PL 30/00 Rev. 1)

1. The committee adopted the agenda as set out in CA/PL 30/00 Rev. 1.

II. APPROVAL OF THE MINUTES OF THE COMMITTEE'S 13TH MEETING (CA/PL 27/00)

2. The committee approved the minutes of its 13th meeting subject to amendments proposed by the Belgian, Swedish, Swiss and UK delegations and the staff representatives. They have since been issued as CA/PL PV/13.

IIIa. BASIC PROPOSAL (CA/PL 25/00 + Add. 1 + Add. 2 + Info 2/PL 14 e)

3. The committee gave a unanimous favourable opinion on the list of **CATEGORY A** points: Articles 11, 16, 17, 18, 23, 38, 42, 50, 54(4), 75, 78, 79, 86, 88, 90, 91, 92, 95, 96, 97, 98, 102, 103, 104, 108, 110, 115, 119, 126, 128, 129, 130, 135, 136, 150-158, 159-160, 161, 162 and 163, the Protocol on Staff Complement, and Article 167.
4. Next the list of **CATEGORY B** points was discussed: Articles 14, 37, 51, 61, 65, 68, 76, 77, 80, 87, 93, 94, 99, 101, 105, 106, 117, 120, 123, 124, 127, 133, 134, 134a and 138(2) and (3), and the Protocol on Centralisation.
5. Regarding **Article 14**, the committee gave a unanimous favourable opinion on the proposal as set out in the Basic Proposal, provided that the revised text retained paragraph 7 in its present wording.
6. Regarding **Article 37**, the German delegation stated that its Ministry of Finance was not yet prepared to agree to the proposed new wordings for Article 37 (primarily because of the reference in Article 37(e) to financing "by third-party borrowings") and Article 42. The committee then noted this statement and concluded by giving a favourable opinion on the proposal for Article 37.
7. Regarding **Article 51**, the committee gave a unanimous favourable opinion on the proposal, with the addition to paragraph 2 of an express reference to time limits other than those set in the European Patent Convention.
8. Regarding **Article 61**, the German delegation stated that it preferred the present wording of paragraph 1, on the principle that the essential criteria for applying a provision should be kept in the EPC itself. The committee then noted the German delegation's statement and gave a favourable opinion on the proposal.

9. Regarding **Article 65**, the committee gave a unanimous favourable opinion.
10. Regarding **Article 68**, the committee gave a favourable opinion, the Swiss and Danish delegations having voiced reservations; as proposed by the Monegasque delegation, it was agreed that the new French wording of Article 68 was in need of improvement (replacing "dans la mesure où" with "dans la mesure dans laquelle").
11. Regarding **Article 76**, the Monegasque delegation proposed that the phrase "conformément au règlement d'exécution" be replaced with "selon les dispositions prescrites par le règlement d'exécution"; it suggested using the same formulation systematically for references to the Implementing Regulations in other EPC provisions. Following an intervention by the UK delegation, the Office suggested stressing the "lex specialis" nature of Article 76(2) in the "Explanatory remarks" and clarifying the territorial scope that can be achieved by paying the designation fees in the divisional application as opposed to the earlier application. The *epi* delegation wondered if the wording clearly allowed applicants to file a divisional application on the basis of an earlier divisional application, given that the French version of Article 76(1), second sentence, used the term "demande initiale" (initial application). The same problem arose with the English and German versions. The Office then proposed clarifying the issue, if necessary in the Implementing Regulations or perhaps in the "Explanatory remarks". The committee then gave a unanimous favourable opinion, subject to the amendment proposals suggested by the Office and to the Monegasque delegation's general comment.
12. Regarding **Article 77**, the committee gave a unanimous favourable opinion on the wording of the Basic Proposal.
13. Regarding **Article 80**, it was unanimously agreed that a provision relating to the date of filing should be retained in the Convention; the new wording would simply state that the requirements for according a date of filing were defined in the Implementing Regulations.
14. Regarding **Article 87**, the committee gave a unanimous favourable opinion on the proposed wording.
15. Regarding **Article 93**, the committee gave a favourable opinion on the proposal. The French delegation felt that the present paragraph 2 should feature in the revised version; the Office then pointed out that the elements of the patent application were already expressly mentioned in Article 78(1).
16. Regarding **Article 94**, the committee gave a unanimous favourable opinion.

17. Regarding **Article 99**, the German delegation proposed that the present paragraph 3 be retained in the revised version of Article 99, as it concerned a significant opportunity for initiating opposition proceedings. The Monegasque delegation made two editorial points: the formulation chosen in paragraph 1 ("date à laquelle la mention") needed to be revised, and "selon les dispositions prescrites par le règlement d'exécution" should be used instead of "... conformément au règlement du règlement d'exécution". The committee then gave a favourable opinion on the proposed wording, subject to editorial amendments along the lines proposed by the Monegasque delegation and to the German delegation's proposal.
18. Regarding **Article 101**, the committee gave a unanimous favourable opinion, subject to editorial amendments proposed by the UK delegation, ie changing "a ground for opposition" in paragraph 1 to "at least one ground for opposition" and deleting the words "to be examined" from paragraph 2. With a view to consistency with the new wording of Article 94 it was also agreed that the present paragraph 2 of Article 101 should be retained in the revised text.
19. Regarding **Article 105**, the committee gave a unanimous favourable opinion on the proposed version, subject to substitution of "the third party" for the word "it" in sub-paragraphs 1(a) ("... against it,") and 1(b) ("..., it has ...").
20. Regarding **Article 106**, the German delegation felt that the present paragraph 2 should be retained in the proposed new version. The committee then noted the German delegation's statement and gave a favourable opinion on the proposed wording of Article 106.
21. Regarding **Article 117**, the committee gave a unanimous favourable opinion, provided that paragraph 1 expressly named "the Enlarged Board of Appeal" as a body competent to take evidence or used a more general formulation.
22. Regarding **Article 120**, the committee gave a unanimous favourable opinion, subject to minor editorial amendments to the English wording (deletion of the word "such"; "EPO" written out in full).
23. Regarding **Article 123**, the Office proposed a new wording for paragraph 3, ie: "The [...] European patent may not be amended". The committee gave a unanimous favourable opinion on the amended proposal for Article 123.
24. Regarding **Article 124**, the committee gave a unanimous favourable opinion on the proposed wording, subject to three amendments:
 - regarding "such information as shall be specified in the Implementing Regulations", it should be made clear that this refers only to "information relating to the relevant state of the art"

- in point 3 of the "Explanatory remarks" (French version), the word "notamment" should be replaced with "à savoir"
 - in the "Explanatory remarks", point 3(iii) should be deleted.
25. Regarding **Article 127**, the committee gave a unanimous favourable opinion on the proposed wording, subject to deletion of the words "all useful".
26. Regarding **Articles 133 and 134**, the committee gave a unanimous favourable opinion, suggesting that the "Explanatory remarks" should indicate that removal of the reference to "territory" in Article 133(2) was not intended to alter the scope of the provision. Also, following an intervention by the German delegation, the committee noted that the formulation of the second sentence of Article 134(3)(c) needed to be brought into line with the first sentence of the present Article 163(3). The editorial amendment proposed by the Monegasque delegation, which entailed replacing "conformément" in the French version of Article 133(3) with "conforme", was also noted.
27. Regarding **Article 134a**, the committee gave a unanimous favourable opinion on the proposed wording and noted an *epi* proposal to add a new sub-paragraph 1(d) formulated as follows: "the necessary confidentiality of the correspondence and the legal opinions of professional representatives". The committee requested the *epi* delegation to supply it as soon as possible, via the secretariat, with full argumentation to back up this proposal.
28. Regarding **Article 138**, the committee gave a favourable opinion, subject to editorial reorganisation of paragraph 3 (deleting the word "corresponding"; replacing "in revocation proceedings" with "in proceedings concerning the validity of the patent"; adapting the title of the article) and to clarifications and additions to points 3 and 5 of the "Explanatory remarks". The committee also noted reservations on the part of the Swedish and French delegations.
29. Regarding the **Protocol on Centralisation**, the German delegation had reservations about the proposed deletion from Section I(3)(a) and (b) of the passages restricting the Berlin sub-office's duties to searching, since the financing costs that could be assigned to Germany would no longer be clearly defined. The German delegation made the following statement on this subject (text to follow). The committee then gave a favourable opinion on the proposal at issue and noted the German delegation's statement.
30. The committee next reviewed the **CATEGORY C** points.
31. Regarding **Articles 22 and 112a**, the committee gave a unanimous favourable opinion on the proposals as submitted, subject to an amendment concerning the minimum number of board of appeal members in Article 22(2). The German and Swedish delegations voiced scrutiny reservations.

32. Regarding **Articles 33** and **35**, the committee gave a unanimous favourable opinion, subject to the following amendments:
- Article 33(1): deletion of the words "the following provisions of this Convention" (in the English and French versions)
 - Article 33(1)(b): deletion of the square brackets and the words within them; "European Community legislation **relating to** patents" rather than "on patents"; an indication in the "Explanatory remarks" that the words "relating to patents" do not only refer to international treaties and Community legislation relating solely to patents
 - Article 35(3), third sentence: deletion of the words "für ihn" in the German version.
33. Regarding **Article 52**, the proposal was debated at length. The positions of the delegations may be summarised as follows:
- 15 delegations were in favour of removing "programs for computers" from the list of non-patentable inventions in Article 52(2): BE, DK, FI, FR, IE, IT, ES, MC, AT, PT, NL, CH, SE, GR and CY; of these 15 delegations:
 - + 9 were in favour of retaining Article 52(2) in the Convention: CY, DK, DE, ES, FI, FR, LU, MC and PT
 - + 7 were in favour of transferring the list of exceptions provided for in Article 52(2) to the Implementing Regulations: BE, IE, NL, AT, CH, GR and IT
 - + 4 were in favour of simply deleting the list of exceptions (no mention in either the Convention or the Implementing Regulations): GR, CH, AT and IT
 - 8 delegations were against the principle of defining an "invention": IE, ES, DE, GB, SE, AT, MC and FR
 - 3 delegations were in favour of a legally binding definition of an invention, provided that such a definition was necessary: PT, BE and LU
 - 3 delegations were against transferring Article 52(4) to Article 53: DK, FR and MC.

On a proposal from the chairman, it was agreed that:

- Article 52 in the wording appearing in the Basic Proposal was to be retained, subject to editorial adaptation of the French version to match the formulation of Article 27(1), first sentence, of the TRIPs Agreement
 - the words "programs for computers" were to be deleted
 - opinions were divided over retaining exceptions within the Convention or transferring them to the Implementing Regulations
 - the wording of the present Article 52(4) was to be transferred to Article 53.
34. Regarding **Article 53**, the committee gave a favourable opinion, the delegations' positions on the new sub-paragraph (c) (present Article 52(4)) having been noted during debate on Article 52.

35. Regarding **Articles 105A-C**, the committee gave a favourable opinion on the proposal, subject to the following clarifications/amendments:
- precise indication in point 2 of the "Explanatory remarks" that the limitation procedure is designed to limit only the protection conferred by the patent
 - indication in point 5 of the "Explanatory remarks" of the requirements of Article 123(3) (extension)
 - indication in a new point in the "Explanatory remarks" of the relations that may exist between national revocation proceedings and the European limitation procedure, particularly in terms of the suspension of proceedings
 - a new point in the "Explanatory remarks" defining the concept of "limitation"
 - express indication in the wording of Article 105A that limitation is restricted to the claims (see the related Article 138(3)).

The committee also noted reservations voiced by the Swedish and Danish delegations about the appropriateness of dealing with these articles at the Diplomatic Conference in November.

36. Regarding **Articles 121 and 122**, the committee gave a unanimous favourable opinion on the proposals, subject to an amendment to Article 121(1), last sentence, to the effect that at least the exclusions mentioned in point 3 of the "Explanatory remarks" should be expressly included in said paragraph, with the addition of an indication that other exclusions could be specified in the Implementing Regulations.
37. Regarding the **new Article 149a**, the committee gave a favourable opinion, subject to the following amendments:
- the proposed wording should be amended to include a reference to "harmonised national law"
 - the words "or judicial authority" should be inserted in the new Article 149a(1)(b) (compare with Article 11)
 - regarding Article 149a(1)(c), the option of filing translations with the European Patent Office should be dealt with in a separate provision (new sub-paragraph (d)), it being left to the Office to verify whether any such provision needed to be expressly included in Article 149a
 - the "Explanatory remarks" should indicate that the Administrative Council may discontinue financing of the common entity, for instance once the common European patent court goes into operation
 - regarding the provisions relating to the optional protocol on litigation, greater generalisation in the wording of Article 149a was sought.
38. Regarding **Article 164**, the committee gave a favourable opinion on the proposal. The French delegation was in favour of the present Article 164, with the addition of a reference to the Protocol on Staff Complement.

39. There was an in-depth debate on the proposal for **Article 54(5)**. Four proposals were discussed:
- retention of the existing provision
 - the version proposed by the Office in CA/PL 4/00
 - an *epi* proposal for Article 54(5) worded as follows: "The fact that its use for any method referred to in Article 53(c) is comprised in the state of the art shall not exclude the patentability of any substance or composition for another such use."
 - a new version of Article 54(5), put forward by the Office in the course of the debate and worded as follows: "Where the subject-matter of the invention is the use of a substance or composition in a method referred to in Article 53(c), the substance or the composition shall, [without prejudice to paragraphs 2 and 3], be deemed, for the purpose of that use, as not being comprised in the state of the art."

It was agreed that the Basic Proposal should retain the Office's last proposal in square brackets; it would be left to the Administrative Council to decide whether that proposal should be retained.

40. Turning next to **PART II OF THE BASIC PROPOSAL**, the committee gave a unanimous favourable opinion on the proposed wording. Some delegations raised the issue of the renumbering of the text of the Convention as provided for in Article 4(1), second sentence, feeling that a possible second Diplomatic Conference would be likely to raise the issue again; the Office said it would reflect on the matter.
41. The committee gave a unanimous favourable opinion on the Office's proposal for **Article 69** as set out in CA/PL 25/00 Add. 2; the proposed wording and the "Explanatory remarks" should be incorporated in the Basic Proposal in square brackets. It would be up to the Administrative Council to decide whether to retain the proposal.

IIIb. CONFERENCE OF MINISTERS OF THE CONTRACTING STATES (CA/83/00)

42. The Hellenic and Spanish delegations pointed out that they could not yet take up a position on the proposal, primarily because the proposal was not of a legal nature and because there had been no prior consultations with their authorities (Foreign Affairs Ministry). The Austrian delegation wondered how useful it would be to have such a resolution or provision in the Convention. The Swiss delegation was in favour of the proposed protocol, of a three-quarters quorum (see paragraph (3) of the protocol) and of a conference of ministers. The French delegation was in favour of a resolution, proposing the following amendments: in paragraph (1), replacement of "establish co-operation between contracting states in patent matters extending beyond the scope of the European Patent Convention" with "establish **extended** co-operation between contracting states **within the framework** of the European patent **system**", and deletion of paragraph (3). It also stressed the need to avoid

excessively formalised mechanisms. The UK delegation said its preference was for the new Article 4(4) EPC, which should be amended as follows: no formal invitation mechanism, ie deletion of the words "of the government"; indication of a frequency, eg "once every five years", in Article 4(4); deletion of the word "fundamental". It stressed that it would be in favour of a very succinct text to serve as a new Article 4(4); the proposed text for the protocol had been found too detailed. The Belgian and Netherlands delegations supported the UK delegation's proposal.

43. Summing up the debate, the chairman concluded that discussions would have to be taken up again by the Administrative Council at its meeting in September, the positions of the delegations being duly reported there.

IIIc. PREPARATIONS FOR THE REVISION CONFERENCE - DRAFT RULES OF PROCEDURE OF THE CONFERENCE (CA/26/00)

44. The committee noted CA/26/00.

IV. LEGAL FRAMEWORK FOR ELECTRONIC FILING (CA/PL 28/00)

45. The committee noted CA/PL 28/00.

V. AMENDMENT OF RULE 94 EPC (CA/PL 29/00)

46. The committee gave a unanimous favourable opinion on the proposed amendments to Rule 94 EPC.
