

SUBJECT: Revision of the EPC: Articles 33 and 35 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document addresses the four issues raised during debate on the proposed revision of Articles 33 and 35 EPC (CA/PL 3/00) in the Committee on Patent Law (CA/PL 10/00, p. 2-4) and sets out a modified proposal.

I. GUARANTEEING EVERY STATE'S EFFECTIVE FREEDOM TO OPPOSE EPC ADAPTATION

1. The decisions that the Administrative Council would be empowered to take under the new Article 33(1)(c) EPC are of such importance that every state must be able to vote on them on the Council. It is absolutely essential for all contracting states to be present at the time of the vote, and Article 35(3) EPC must be formulated accordingly.
2. It is therefore proposed that the words "represented and" be deleted and a sentence added specifying that the Administrative Council shall exercise its powers under Article 33(1)(c) EPC only if all the contracting states are represented. This wording guarantees every state's effective freedom to oppose EPC adaptation. It also has the advantage of allowing a state to abstain.

II. BRINGING THE EPC INTO LINE WITH INTERNATIONAL AND COMMUNITY LAW "ON PATENTS"

3. Several states advocated extending the Administrative Council's competence to allow the EPC to be brought into line with international treaties and Community legislation in fields other than patent law.
4. It must however be stressed that any such extension increases the risk that revision of Article 33 EPC will fail. At the Diplomatic Conference or in national ratification proceedings, some states may well be reluctant to grant the Administrative Council such wide-ranging powers.
5. It therefore seems more appropriate to keep to the essential issue⁽¹⁾: bringing the EPC into line with patent-related international and Community law. Hence it is proposed that the restriction inherent in the words "on patents" be retained in the wording of Article 33(1)(c) EPC.

III. EXTENDING THE SCOPE OF ARTICLE 33(1)(c) TO THE ENTIRE EPC

6. A distinction must be drawn between the provisions of Parts I and XII of the EPC on the one hand and Part IX on the other.

(1) CA/PL 5/99 illustrated the way in which the EPO's boards of appeal regularly refer to international legal sources in fields other than patent law, such as the European Convention on Human Rights and the Vienna Convention on the Law of Treaties. This has played a major part in harmonising EPO practice with the international legal environment.

A. THE PROVISIONS OF PARTS I AND XII OF THE EPC

7. These two Parts contain provisions of a highly political nature. Some contracting states might understandably be unwilling to accept that such provisions are open to amendment without recourse to the revision procedure laid down in Article 172 EPC. The question is whether the advantages of extending the scope of Article 33(1)(c) EPC to Parts I and XII of the EPC justify putting the proposed revision of Article 33 EPC at risk.
8. It is not certain that any such extension would really be worthwhile. If the competence of the Administrative Council is restricted to bringing the EPC into line with international and Community law "on patents" (as advocated in section II above), the impact of this patent-specific legislation on the provisions of Parts I and XII is likely to be minimal.
9. Thus a sense of proportion is essential: it is far better to have an adaptation mechanism restricted to certain Articles of the EPC than to have the revision of Article 33 EPC founder on an attempt to extend it to the provisions of Parts I and XII. It is therefore proposed that Parts I and XII be excluded from the scope of Article 33(1)(c) EPC.

B. THE PROVISIONS OF PART IX OF THE EPC

10. CA/PL 7/00 presented two approaches to the revision of Part IX.
11. If the choice fell on the first option (CA/PL 7/00, section II), it might be tempting to include Part IX within the scope of Article 33(1)(c) EPC so that Articles 143 to 149 EPC could be brought into line with the future Regulation on the Community Patent.

However, creating the Community patent on the basis of a Regulation would be tantamount to true reform of the European patent system, involving for the EPO new responsibilities and the creation of new departments : the dovetailing of the EPC and the Regulation is likely to entail amendment of the EPC on a scale far greater than simply modifying Articles 143 to 149 EPC.

The new Article 33(1)(c) EPC is intended only to allow adaptation of the EPC; it is not designed to replace the procedure provided for in Article 172 EPC when revision is required. It is therefore proposed that Part IX of the EPC be excluded from the scope of Article 33(1)(c) EPC.

12. If the choice were to fall on the second option (CA/PL 7/00, section III), there would be no need to include Part IX within the scope of Article 33(1)(c) EPC.
13. A further issue requiring attention here is whether Article 33(1)(c) EPC should refer to "Articles" or "Parts" of the EPC. It seems more flexible to have Article 33(1)(c) EPC referring to "Parts" of the EPC: in particular, one or more new Articles could then be inserted in a given Part, and new Article numbering could be adopted. Thus the proposal is to have Article 33(1)(c) EPC referring to the provisions of Parts of the EPC.

IV. THE WORD "REQUIRED" IN ARTICLE 33(1)(c) EPC

14. This word was chosen from a series of alternatives ranging from "useful", "desirable" and "required" to "indispensable" and "obligatory". The EPO feels "required" is a happy medium which emphasises the objective need for the EPC to conform to international and Community legislation on patents without allowing debate to get sidetracked onto the degree of necessity that everyone considers appropriate. This conformity is "required", from a legal and objective viewpoint, to avoid discrepancies between, on the one hand, international and Community law on patents - and hence the patent law of the contracting states and, on the other, European patent law .
15. Lastly it must be stressed that the fundamental guarantee of unanimity provided by Article 35(3) EPC lessens the significance of this terminological issue, as no state can be compelled to agree to an amendment of the EPC even if all the others consider that there is an obvious need. It is therefore proposed that "required" be retained in the wording of Article 33(1)(c) EPC.
16. Section V below contains the new proposal for the revision of Articles 33 and 35 EPC. Changes vis-à-vis CA/PL 3/00 are underlined.

V. PROPOSED AMENDMENTS

Present wording

Article 33

Competence of the Administrative
Council in certain cases

(1) The Administrative Council shall be competent to amend the following provisions of this Convention:

(a) the time limits laid down in this Convention; this shall apply to the time limit laid down in Article 94 only in the conditions laid down in Article 95;

(b) the Implementing Regulations.

(2) - (4) ...

Proposed wording

Article 33

Competence of the Administrative
Council in certain cases

(1) The Administrative Council shall be competent to amend the following provisions of this Convention:

(a) the time limits laid down in this Convention; this shall apply to the time limit laid down in Article 94 only in the conditions laid down in Article 95;

(b) the Implementing Regulations;

(c) the provisions of Parts II to VIII and Part X of this Convention when amendment is required to bring them into line with an international treaty or European Community legislation on patents.

(2) - (4) *Unchanged*

Article 35
Voting rules

- (1) The Administrative Council shall take its decisions other than those referred to in paragraph 2 by a simple majority of the Contracting States represented and voting.
- (2) A majority of three-quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Council is empowered to take under Article 7, Article 11, paragraph 1, Article 33, Article 39, paragraph 1, Article 40, paragraphs 2 and 4, Article 46, Article 87, Article 95, Article 134, Article 151, paragraph 3, Article 154, paragraph 2, Article 155, paragraph 2, Article 156, Article 157, paragraphs 2 to 4, Article 160, paragraph 1, second sentence, Article 162, Article 163, Article 166, Article 167 and Article 172.
- (3) Abstentions shall not be considered as votes.

Article 35
Voting rules

- (1) The Administrative Council shall take its decisions other than those referred to in paragraphs 2 **and 3** by a simple majority of the Contracting States represented and voting.
- (2) A majority of three-quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Council is empowered to take under Article 7, Article 11, paragraph 1, Article 33, **paragraph 1(a) and (b), and paragraphs 2 to 4**, Article 39, paragraph 1, Article 40, paragraphs 2 and 4, Article 46, Article 87, Article 95, Article 134, Article 151, paragraph 3, Article 154, paragraph 2, Article 155, paragraph 2, Article 156, Article 157, paragraphs 2 to 4, Article 160, paragraph 1, second sentence, Article 162, Article 163, Article 166, Article 167 and Article 172.
- (3) **Unanimity of the Contracting States [...] voting shall be required for the decisions which the Administrative Council is empowered to take under Article 33, paragraph 1(c). The Administrative Council shall take such decisions only if all the Contracting States are represented.**
- (3) becomes (4) *Wording unchanged*