

CA/PL 5/00

Orig.: English

Munich, 26.01.2000

SUBJECT: Revision of the EPC: Articles 80, 90 and 91

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains a proposal to delete Article 80 EPC and amend Articles 90 and 91 EPC, combining their basic contents into a single new provision and referring any details to the Implementing Regulations.

I. INTRODUCTION

A. DELETION OF ARTICLE 80 EPC

1. Article 80 EPC will need to be amended in the light of the Patent Law Treaty (PLT) once it has been adopted at the forthcoming Diplomatic Conference in May/June 2000. Draft Article 5 PLT (see CA/PL 2/00) lists the maximum requirements a Contracting Party may prescribe for according a date of filing. These maximum requirements are: (a) an indication that the elements received are intended to be a patent application, (b) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office, and (c) a part which on the face of it appears to be a description. The part which appears to be a description may be in any language.
2. With the present proposal, the listing of the requirements would be deleted from the Convention and a reference to the filing date would only be contained in the proposed new Article 90 EPC. Details concerning the accordance of a filing date, including the re-dating of an application if parts are received at a later date, would then be included in the Implementing Regulations, whereby the standard of the PLT would always need to be met. This allows flexibility in choosing from the PLT list of requirements and in particular the ability to adapt to changes in the PLT.

B. COMBINATION OF ARTICLES 90 AND 91 EPC

3. The examination that the Office must carry out after an application has been filed is presently governed by Articles 90 and 91 EPC. The examination whether a filing date can be accorded and whether all formal requirements are fulfilled can well be dealt with in a single article. Furthermore there is no need in the Convention itself for a detailed listing of the formalities to be examined, the legal effect of any deficiencies and the procedure to be followed. It is therefore proposed to shift the details presently contained in Articles 90 and 91 to the Implementing Regulations. Paragraph 4 guarantees that the applicant will get an opportunity to correct deficiencies, and corresponds in essence to the present Articles 90, paragraph 2, and 91, paragraph 2.
4. The mention in paragraph 3 that the procedural aspects of the formalities examination will be dealt with in the Implementing Regulations has been placed in square brackets. The necessity of this wording will depend on the adoption of a general provision in the Convention, allowing the Implementing Regulations to give further details on any procedure provided for in the Convention.

II. PROPOSED AMENDMENTS

Present wording	Deleted
<p>Article 80 Date of filing</p> <p>The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:</p> <p>(a) an indication that a European patent is sought;</p> <p>(b) the designation of at least one Contracting State;</p> <p>(c) information identifying the applicant;</p> <p>(d) a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2, even though the description and the claims do not comply with the other requirements of this Convention.</p>	

Article 90
Examination on filing

(1) The Receiving Section shall examine whether:

(a) the European patent application satisfies the requirements for the accordance of a date of filing;

(b) the filing fee and the search fee have been paid in due time;

(c) in the case provided for in Article 14, paragraph 2, the translation of the European patent application in the language of the proceedings has been filed in due time.

(2) If a date of filing cannot be accorded, the Receiving Section shall give the applicant an opportunity to correct the deficiencies in accordance with the Implementing Regulations. If the deficiencies are not remedied in due time, the application shall not be dealt with as a European patent application.

(3) If the filing fee and the search fee have not been paid in due time or, in the case provided for in Article 14, paragraph 2, the translation of the application in the language of the proceedings has not been filed in due time, the application shall be deemed to be withdrawn.

Article 90
Examination on filing and as to formal requirements

(1) The **European Patent Office** shall examine whether the European patent application satisfies the requirements for the accordance of a date of filing **as laid down in the Implementing Regulations**.

(2) If a date of filing cannot be accorded **following the examination referred to in paragraph 1**, the application shall not be dealt with as a European patent application.

(3) If a European patent application has been accorded a date of filing, the European Patent Office shall examine whether the requirements in Articles 14, 78, 81 and, where applicable, 88, paragraph 1, and 133, paragraph 2, as well as any other requirement laid down in the Implementing Regulations, have been satisfied. [The procedure to be followed in carrying out this examination and the legal consequences of the applicant's failing to observe an applicable time limit or to comply with any other requirement shall be laid down in the Implementing Regulations.]

(4) Where the European Patent Office in carrying out the examination under paragraphs 1 or 3 notes that there are

deficiencies which may be corrected, it shall give the applicant an opportunity to correct them in accordance with the Implementing Regulations.

Deleted

Article 91
Examination as to formal
requirements

(1) If a European patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Receiving Section shall examine whether:

(a) the requirements of Article 133, paragraph 2, have been satisfied;

(b) the application meets the physical requirements laid down in the Implementing Regulations for the implementation of this provision;

(c) the abstract has been filed;

(d) the request for the grant of a European patent satisfies the mandatory provisions of the Implementing Regulations concerning its content and, where appropriate, whether the requirements of this Convention concerning the claim to priority have been satisfied;

(e) the designation fees have been paid;

(f) the designation of the inventor has been made in accordance with Article 81;

(g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.

(2) Where the Receiving Section notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them in accordance with the Implementing Regulations.

(3) If any deficiencies noted in the examination under paragraph 1(a) to (d) are not corrected in accordance with the Implementing Regulations, the application shall be refused; where the provisions referred to in paragraph 1(d) concern the right of priority, this right shall be lost for the application.

(4) Where, in the case referred to in paragraph 1(e), the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.

(5) Where, in the case referred to in paragraph 1(f), the omission of the designation of the inventor is not, in accordance with the Implementing Regulations and subject to the exceptions laid down therein, corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn.

(6) Where, in the case referred to in paragraph 1(g), the drawings were not filed on the date of filing of the application and no steps have been taken to correct the deficiency in accordance with the Implementing Regulations, either the application shall be re-dated to the date of filing of the drawings or any reference to the drawings in the application shall be deemed to be deleted, according to the choice exercised by the applicant in accordance with the Implementing Regulations.