

SUBJECT: Revision of the EPC: Article 142 ss. EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document constitutes the first step in dealing with the articulation of the European patent system and the expected Community patent within the framework of the EPC. Since the details of a future Community patent are unknown at present, this document does not constitute a concrete proposal *per se*. Rather, it is queried whether this point should be dealt with at the upcoming Diplomatic Conference. If so, two alternate paths for adapting Art. 142 ss. EPC in preparation for the creation of a Community patent through the awaited EU Regulation are sketched out as a basis for preliminary discussion.

I. INTRODUCTION

1. Part IX of the EPC, entitled "Special Agreements", was conceived with the 1975 Community Patent Convention in mind. However, once it became clear that the 1989 Agreement on Community Patents might suffer the same fate as the CPC 1975 and never be ratified, the European Commission issued its *Green Paper on the Community Patent and the Patent System in Europe* in 1997, initiating a broad-based consultation process on the matter. This led to the adoption by the Commission of the Communication: *Promoting Innovation through Patents*, in February 1999, in which it was announced that a proposal for an EU Regulation on the Community Patent pursuant to Art. 308 EC Treaty (formerly Art. 235) would be prepared.
2. In June 1999, the Intergovernmental Conference on the reform of the patent system in Europe, considering that it was necessary to align the EPC rapidly with relevant international agreements and Community instruments, requested the European Patent Organisation to revise Part IX of the EPC on "Special Agreements" in consequence.
3. Considering the time-frame which must be envisaged for the adoption and implementation of an EU Regulation, which would be measured in years, there is clearly no urgency to deal with this point. Arguably, revising the EPC on this point at this juncture, where the shape and details of the Community patent system remain unknown, might be considered to be premature. In fact, it would be possible to remove this point from the agenda of the upcoming Diplomatic Conference entirely and delay the revision of Arts. 142 ss. EPC until the Community patent system assumes its final form and is ripe for implementation.
4. Nevertheless, should this point be kept on the agenda of the current revision exercise, in order to achieve the objectives of the Intergovernmental Conference mandate regarding Part IX of the EPC, Arts. 142 EPC *et seq.*, two avenues are possible.

II. FIRST OPTION FOR A REVISION OF PART IX:

5. The first revision method would be to keep amendments to a minimum. The situation whereby the Community patent would be created through an EU Regulation could be expressly addressed in an additional paragraph to be inserted in Art. 142 EPC.
6. The general clause of Art. 142(1) EPC would have to be retained as agreements between countries providing for unitary patents covering sub-sets of EU member states are not out of the question. A case in point is the Patent Treaty of 22 December 1978, concluded between CH and LI, creating a unified territory for the purposes of patent protection (see OJ EPO 1980, 407). Another is the existing

project for a Benelux patent convention, under which unitary patents could be granted covering the territory of the Benelux countries.

7. Articles 143-149 EPC would be kept as is, although in all likelihood, further revision would be necessary in light of the EU Regulation itself, once its content became known. In the course of this exercise, it should be borne in mind that Arts. 142 and 147-149 EPC form the legal basis of the CH/LI Patent Treaty mentioned above.

Current wording
PART IX
SPECIAL AGREEMENTS

Article 142
Unitary patents

(1) Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those States.

(2) Where any group of Contracting States has availed itself of the authorisation given in paragraph 1, the provisions of this Part shall apply.

Articles 143 - 149

Proposed wording
PART IX
SPECIAL AGREEMENTS

Article 142
Unitary patents

(1) Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those States.

(2) **Where the European Community has provided under the Community legal order that a European patent granted for its member states shall have a unitary character throughout the territory of the European Community, paragraph 1 shall apply *mutatis mutandis*.**

(3) Where any group of Contracting States **or the European Community** has **so provided**, the provisions of this Part shall apply.

Left unchanged at present. Should be verified and eventually adjusted when the modalities of the EU Regulation become known.

III. ALTERNATIVE OPTION FOR A REVISION OF PART IX

8. The second approach to the revision of Part IX would be to turn Art. 142 EPC into an umbrella provision, allowing the creation of patents having a unitary character and the conclusion of a special agreement between a group of Contracting States or the European Community and the European Patent Organisation, bestowing additional tasks on the EPO. Articles 143-149 EPC could then be deleted.
9. It is understood that any such agreement would not be subject to ratification by the EPC Contracting States, but would require unanimous consent by the Administrative Council with the consequence that Art. 35 would have to be amended accordingly.

Current wording
PART IX
SPECIAL AGREEMENTS

Article 142
Unitary patents

(1) Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those States.

(2) Where any group of Contracting States has availed itself of the authorisation given in paragraph 1, the provisions of this Part shall apply.

Proposed wording
PART IX
SPECIAL AGREEMENTS

Article 142
Unitary patents

(1) Any group of Contracting States which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, may provide that a European patent may only be granted jointly in respect of all those states.

(2) **Where the European Community has provided under the Community legal order that a European patent granted for its member states shall have a unitary character throughout the territory of the European Community, paragraph 1 shall apply *mutatis mutandis*.**

3) Any group of Contracting States or the European Community, having so provided, may entrust additional tasks to the European Patent Office, in accordance with a special agreement

to be concluded with the European Patent Organisation, laying down the conditions for the application of this Convention and governing in particular:

(a) any special departments to be set up within the European Patent Office, their supervision and representation before them;

(b) financial obligations and benefits, including the expenditure involved in carrying out these additional tasks and the payment of fees for such unitary patents;

(c) the European patent application as an object of property.

Delete

Articles 143-149