

CA/PL 12/00

Orig.: English

Munich, 13.03.2000

SUBJECT: Revision of the EPC: Articles 61, 71, 72, 75 to 78 and 86 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains the proposals for the streamlining of Articles 61, 71, 72, 75, 76, 77, 78, and 86 EPC.

I. INTRODUCTION

1. In Part IV.B of document CA/16/98, in order to increase the flexibility of the EPC, it was proposed to streamline it by transferring details and elements of a nature to change from time to time from the Convention into the Implementing Regulations. This approach was approved in principle by the Administrative Council (See CA/110/99, no. 28).
2. The present document applies this exercise specifically to Arts. 52-89 EPC and concerns itself exclusively with proposals to delete elements, the substance of which is either obsolete or should be transferred to the Implementing Regulations.
3. Since the purpose of this document is not to give an overview of the changes to date, this document does not reproduce all the articles of Parts II and III, focusing only on those actually being streamlined.
4. Some streamlining proposals are consequential to other suggested amendments yet to be discussed by this Committee, such as the transfer of provisions governing fees to the Implementing Regulations, pursuant to the general proposal contained in CA/PL 8/00 (see Arts. 61(3), 76(3), 78(2) and 86 EPC). Likewise, the suggested deletion of Art. 76(2) EPC is brought about by the proposed overhaul of the designation system contained in CA/PL 13/00.
5. Short explanatory notes justifying the suggested modifications are included in italics.

II. PROPOSED AMENDMENTS

Present wording

Article 61

European patent applications by persons not having the right to a European patent

(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention:

(a) prosecute the application as his own application in place of the applicant,

(b) file a new European patent application in respect of the same invention, or

(c) request that the application be refused.

(2) The provisions of Article 76, paragraph 1, shall apply mutatis mutandis to a new application filed under paragraph 1.

Proposed wording

Article 61

European patent applications **filed** by **non-entitled** persons

(1) If by a final decision it is adjudged that a person [...] other than the applicant is entitled to the grant of **the** European patent, that person may, [...] **in accordance with the conditions and procedure laid down in the Implementing Regulations:**

(a) prosecute the application as his own application in place of the applicant,

(b) file a new European patent application in respect of the same invention, or

(c) request that the application be refused.

(2) The provisions of Article 76, paragraph 1, shall apply mutatis mutandis to a new application filed under paragraph 1**(b)**.

(3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions applying to a new application filed under paragraph 1 and the time limit for paying the filing, search and designation fees on it are laid down in the Implementing Regulations.

Article 71

Transfer and constitution of rights

The European patent application may be transferred or give rise to rights for one or more of the designated Contracting States

Article 72

Assignment

An assignment of a European patent application shall be made in writing and shall require the signature of the parties to the contract.

Article 75

Filing of the European patent application

(1) A European patent application may be filed:

(a) at the European Patent Office at Munich or its branch at The Hague, or

(3) **Delete** - Move substance to the *Implementing Regulations*. See proposal contained in CA/PL 8/00.

Article 71

Transfer and constitution of rights

The European patent application may be **assigned**, transferred or give rise to rights for one or more of the designated Contracting States

Delete - *With the advent of electronic data and files, all references to writing or signature are obsolete and should be eliminated from the Convention. The reference to assignment should be added to Art. 71 EPC.*

Article 75

Filing of the European patent application

(1) **The** European patent application may be filed:

(a) at the European Patent Office, [...] or

Note re: Art. 75(1)(a): The current geographical restriction to Munich and The Hague should be removed. Provisions determining where such applications shall be filed could be inserted in the Implementing Regulations.

(b) 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 filed on the same date at the European Patent Office.

(2) The provisions of paragraph 1 shall not preclude the application of legislative or regulatory provisions which, in any Contracting State:

(a) govern inventions which, owing to the nature of their subject-matter, may not be communicated abroad without the prior authorisation of the competent authorities of that State, or

(b) prescribe that each application is to be filed initially with a national authority or make direct filing with another authority subject to prior authorisation.

(3) No Contracting State may provide for or allow the filing of European divisional applications with an authority referred to in paragraph 1(b).

Article 76

European divisional applications

(1) A European divisional application must be filed directly with the European Patent Office at Munich or its branch at The Hague. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier

(b) if the law of a Contracting State so permits **and subject to Article 76 paragraph 1**, at the central industrial property office or other competent authority of that State. **Any** application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office.

(2) *Unchanged*

(3) **Delete** - *Unnecessary in view of Art. 76(1) EPC.*

Article 76

European divisional applications

(1) **Any** European divisional application **shall** be filed directly with the European Patent Office [...]. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this

application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.

(2) The European divisional application shall not designate Contracting States which were not designated in the earlier application.

(3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions to be complied with by a divisional application and the time limit for paying the filing, search and designation fees are laid down in the Implementing Regulations.

Article 77

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State 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 European patent applications which have been filed with that office or with other competent authorities in that State.

provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.

(2) The European divisional application **may only** designate Contracting States which **at the time of filing of that application are also** designated in the earlier application.

Clarifying amendment, consequential to the proposal to revise Art. 79 EPC; see CA/PL 13/00.

(3) **Delete** - Unnecessary. See CA/PL 8/00 and CA/PL 20/00.

Article 77

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State shall [...] forward to the European Patent Office, [...] any European patent application [...] filed with **it** or [...] **any** other competent **authority** in that State, **in accordance with the Implementing Regulations.**

(2) The Contracting States shall take all appropriate steps to ensure that European patent applications, 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 six weeks after filing.

(3) European patent applications which require further examination as to their liability to secrecy shall be forwarded in such manner as to reach the European Patent Office within four months after filing, or, where priority has been claimed, fourteen months after the date of priority.

(4) A European patent application, the subject of which has been made secret, shall not be forwarded to the European Patent Office.

(5) European patent applications which do not reach the European Patent Office before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority, shall be deemed to be withdrawn. The filing, search and designation fees shall be refunded.

Article 78

Requirements of the European patent application

(1) A European patent application shall contain:

(a) a request for the grant of a European patent;

(2) **Delete** - Move substance to the Implementing Regulations.

(3) **Delete** - Move substance to the Implementing Regulations.

(2) **Any** European patent application the subject of which has been made secret, shall not be forwarded to the European Patent Office.

(3) **Any** European patent application [...] **which is not forwarded** to the European Patent Office [...] **in due time** shall be deemed to be withdrawn [...].

Note: Move the substance of paragraph 5, second sentence, to the Implementing Regulations.

Article 78

Requirements of the European patent application

[...] **The** European patent application shall contain:

(a) a request for the grant of a European patent;

- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

(2) A European patent application shall be subject to the payment of the filing fee and the search fee within one month after the filing of the application.

(3) A European patent application must satisfy the conditions laid down in the Implementing Regulations.

Article 86

Renewal fees for European patent applications

(1) Renewal fees shall be paid to the European Patent Office in accordance with the Implementing Regulations in respect of European patent applications. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application.

(2) When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time.

- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract,

and satisfy the conditions laid down in the Implementing Regulations.

(2) **Delete** - Move substance to the Implementing Regulations. See CA/PL 8/00.

(3) **Delete** - See revised paragraph above.

Delete - Move substance to the Implementing Regulations. See CA/PL 8/00.

(3) If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn. The European Patent Office alone shall be competent to decide this.

(4) The obligation to pay renewal fees shall terminate with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published.