

CA/PL 13/00

Orig.: English

Munich, 13.03.2000

SUBJECT: Revision of the EPC: Article 79 EPC
DRAWN UP BY: President of the European Patent Office
ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

The present document contains a proposal to amend Art. 79 EPC in order to adjust it to better reflect the current practice of the Office regarding the designation of Contracting States.

I. INTRODUCTION

1. Article 79 EPC provides that the request for the grant of a European patent shall contain the designation of the Contracting State(s) in which protection is desired. Initially, Contracting States had to be positively designated in the request for grant. This practice caused problems since in principle, a later designation made after the filing date of the European patent application was inadmissible. Frequent errors were made by applicants in the designation of Contracting States, with only limited scope for correction afforded by Rule 88 EPC.

II. EVOLUTION OF THE DESIGNATION MECHANISM

2. In order to alleviate the difficulties for the applicant caused by this rule, the Request for Grant form was amended as early as 1980 to include a pre-crossed, precautionary designation of all Contracting States. Thus, the preliminary selection of the scope of geographical coverage of the patent was made at the time of payment of the designation fees.
3. With the fee reform of 1997, the pre-crossed box in the Request for Grant form became an express designation of all Contracting States, and a system was introduced whereby applicants could indicate their intention to pay designation fees for specific countries. In addition, the time limit for the payment of designation fees was moved forward, so that designation fees became due within 6 months of the date on which the European Patent Bulletin mentions the publication of the European search report.
4. In 1999, a further fee reform introduced a ceiling for the payment of designation fees, fixed at 7 designation fees. This is now reflected in the Request for Grant form, and should the applicant pay fewer than 7 designation fees, he should indicate for which Contracting States he intends to pay designation fees.
5. Thus, the present practice results in the formal designation of all Contracting States on the Request for Grant form, upon filing, with the payment of designation fees being effected much later.

III. REVISION PROPOSAL

6. Therefore, it is proposed to amend the Convention to reflect this applicant-friendly practice more accurately, by providing that upon filing a European application, the applicant shall be deemed to have designated all the Contracting States which are members of the EPO at the time the application is filed.
7. Article 79(2) EPC and the last sentence of Art. 79(3) EPC should be deleted, as they contain provisions relative to the payment of designation fees, the substance of which would be transferred unchanged to the Implementing Regulations, as *per* the proposal contained in CA/PL 8/00.
8. It is proposed to continue to allow applicants to withdraw designations pursuant to the provisions of Art. 79(3) EPC.

The Committee on Patent Law has already endorsed the suggested elimination of Art. 54(4) EPC (see CA/PL 17/99) which currently limits the prior art effect of prior European applications to those Contracting States which have been designated in both the earlier and the later application. Henceforth, pursuant to the conditions of Art. 54(3) EPC, European applications would have prior art effect for all subsequent European applications, regardless of the Contracting States designated. Therefore, the withdrawal of a designation would not modify the prior art effect of the European application for later European applications. Nevertheless, the applicant may have an interest in making clear before grant of the patent that protection in a particular Contracting State will not be sought, *eg* in order to avoid a conflict with a third party holding an earlier national patent.

9. As a consequence of the proposed modification to the designation system, Art. 76(2) EPC should be amended to provide that a European divisional application may only designate Contracting States which are validly designated in the earlier application *at the time of filing of the divisional application*.⁽¹⁾
10. Finally, Art. 79(3) EPC, second sentence, is devoid of practical significance. Insofar as it ascribes a legal consequence to the withdrawal of all designations, it constitutes matter which could be appropriately consigned to the Implementing Regulations.

(1) See the proposed amendment to Art. 76(2) EPC, Document CA/PL 12/00, p. 5.

IV. PROPOSED AMENDMENT

Present wording

Article 79

Designation of Contracting States

- (1) The request for the grant of a European patent shall contain the designation of the Contracting State or States in which protection for the invention is desired.
- (2) The designation of a contracting state shall be subject to the payment of the designation fee. The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.
- (3) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application. Designation fees shall not be refunded.

Proposed wording

Article 79

Designation of Contracting States

- (1) **All the Contracting States party to this Convention at the time of filing of the European patent application shall be deemed to be designated in the request for grant of a European patent.**

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

- (2) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. [...]

Move the substance of sentences 2 and 3 of current Art. 79 (3) EPC to the Implementing Regulations.