

CA/PL 18/00

Orig.: German

Munich, 28.03.2000

SUBJECT: Revision of the EPC: Articles 115, 117, 119, 120, 123, 124, 127,
128 and 130

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

The present document contains proposals to remove a number of details from the above articles and transfer them to the Implementing Regulations.

I. INTRODUCTION

1. Part VII of the European Patent Convention (EPC) sets out the Common Provisions. The revision proposals aim to remove a number of details from Articles 115, 117, 119, 120, 123, 124, 127, 128 and 130 EPC and transfer them to the Implementing Regulations.
2. Also proposed, in addition to a restructuring and clarification of certain provisions, is that the scope of Article 124 EPC be widened so that the EPO can require applicants to submit search reports on corresponding national applications or to give details of relevant prior art known to them.

II. PROPOSED AMENDMENTS

Present wording

Article 115

Observations by third parties

(1) Following the publication of the European patent application, any person may present observations concerning the patentability of the invention in respect of which the application has been filed. Such observations must be filed in writing and must include a statement of the grounds on which they are based. That person shall not be a party to the proceedings before the European Patent Office.

(2) The observations referred to in paragraph 1 shall be communicated to the applicant for or proprietor of the patent who may comment on them.

Proposed wording

Article 115

Observations by third parties

[...] Following the publication of the European patent application, any person may, **in accordance with the Implementing Regulations**, present observations concerning the patentability of the invention **to which the application relates**. [...] That person shall not be a party to the proceedings before the European Patent Office.

(2) **Delete**

Article 117

Taking of evidence

(1) In any proceedings before an Examining Division, an Opposition Division, the Legal Division or a Board of Appeal the means of giving or obtaining evidence shall include the following:

- (a) hearing the parties;
- (b) requests for information;
- (c) the production of documents;
- (d) hearing the witnesses;
- (e) opinions by experts;
- (f) inspection;
- (g) sworn statements in writing.

(2) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.

(3) If the European Patent Office considers it necessary for a party, witness or expert to give evidence orally, it shall either:

(a) issue a summons to the person concerned to appear before it, or

(b) request, in accordance with the provisions of Article 131, paragraph 2, the competent court in the country of residence of the person concerned to take such evidence.

Article 117

Means of evidence and taking of evidence

[...] The Implementing Regulations shall specify the means of evidence admitted in proceedings before the European Patent Office, and the procedure for taking such evidence.

(2) - (6) **Delete**

(4) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow his evidence to be heard by a competent court in his country of residence. On receipt of such a request, or if there has been no reply to the summons by the expiry of a period fixed by the European Patent Office in the summons, the European Patent Office may, in accordance with the provisions of Article 131, paragraph 2, request the competent court to hear the person concerned.

(5) If a party, witness or expert gives evidence before the European Patent Office, the latter may, if it considers it advisable for the evidence to be given on oath or in an equally binding form, request the competent court in the country of residence of the person concerned to re-examine his evidence under such conditions.

(6) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence on oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert either through the intermediary of the court or directly.

Article 119
Notification

The European Patent Office shall, as a matter of course, notify those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of this Convention, or of which notification has been ordered by the President of the European Patent Office. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States.

Article 120
Time limits

The Implementing Regulations shall specify:

(a) the manner of computation of time limits and the conditions under which such time limits may be extended, either because the European Patent Office or the authorities referred to in Article 75, paragraph 1(b), are not open to receive documents or because mail is not delivered in the localities in which the European Patent Office or such authorities are situated or because postal services are generally interrupted or subsequently dislocated;

(b) the minima and maxima for time limits to be determined by the European Patent Office.

Article 119
Notification

[...] Decisions, summonses, notices and communications from the European Patent Office [...] shall be notified in accordance with the Implementing Regulations.

Article 120
Time limits

The Implementing Regulations shall specify the time limits applicable in proceedings before the European Patent Office, their duration and computation and the legal consequences of failure to observe a time limit.

Article 123
Amendments

(1) The conditions under which a European patent application or a European patent may be amended in proceedings before the European Patent Office are laid down in the Implementing Regulations. In any case, an applicant shall be allowed at least one opportunity of amending the description, claims and drawings of his own volition.

(2) A European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

(3) The claims of the European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred.

Article 124
Information concerning national patent applications

(1) The Examining Division or the Board of Appeal may invite the applicant to indicate, within a period to be determined by it, the States in which he has made applications for national patents for the whole or part of the invention to which the European patent application relates, and to give the reference numbers of the said applications.

Article 123
Amendments

(1) [...] A European patent application or a European patent may be amended in proceedings before the European Patent Office **in accordance with the Implementing Regulations [...]**.

(2) and (3) *Unchanged*

Article 124
Information concerning national patent applications

[...] The European Patent Office may [...], in accordance with the Implementing Regulations, require the applicant to [...] provide it with any useful information about national patent applications for [...] an invention to which the European patent application relates, [...] and about proceedings concerning such applications and the resulting patents.

(2) If the applicant fails to reply in due time to an invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.

Article 126

Termination of financial obligations

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Article 127

Register of European Patents

The European Patent Office shall keep a register, to be known as the Register of European Patents, which shall contain those particulars the registration of which is provided for by this Convention. No entry shall be made in the Register prior to the publication of the European patent application. The Register shall be open to public inspection.

Article 128

Inspection of files

(1) The files relating to European patent applications, which have not yet been published, shall not be made available for inspection without the consent of the applicant.

(2) **Delete**

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Article 127

European Patent Register

The European Patent Office shall, **in accordance with the Implementing Regulations**, keep a [...] **European Patent Register**, [...] **in which it shall record all useful particulars of European patent applications and patents and the proceedings concerning them**. No entry shall be made in the **European Patent Register** prior to the publication of the European patent application. The **European Patent Register** shall be open to public inspection.

Article 128

Inspection of files

(1) - (4) *Unchanged*

(2) Any person who can prove that the applicant for a European patent has invoked the rights under the application against him may obtain inspection of the files prior to the publication of that application and without the consent of the applicant.

(3) Where a European divisional application or a new European patent application filed under Article 61, paragraph 1, is published, any person may obtain inspection of the files of the earlier application prior to the publication of that application and without the consent of the relevant applicant.

(4) Subsequent to the publication of the European patent application, the files relating to such application and the resulting European patent may be inspected on request, subject to the restrictions laid down in the Implementing Regulations.

(5) Even prior to the publication of the European patent application, the European Patent Office may communicate the following bibliographic data to third parties or publish them:

(a) the number of the European patent application;

(b) the date of filing of the European patent application and, where the priority of a previous application is claimed, the date, State and file number of the previous application;

(c) the name of the applicant;

(d) the title of the invention;

(e) the Contracting States designated.

(5) Even prior to the publication of the European patent application, the European Patent Office may communicate [...] to third parties or publish **the particulars specified in the Implementing Regulations.**

(a) to (e) **Delete**

Article 129

Periodical publications

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Article 130

Exchanges of information

(1) The European Patent Office and, subject to the application of the legislative or regulatory provisions referred to in Article 75, paragraph 2, the central industrial property office of any Contracting State shall, on request, communicate to each other any useful information regarding the filing of European or national patent applications and regarding any proceedings concerning such applications and the resulting patents.

(2) The provisions of paragraph 1 shall apply to the communication of information by virtue of working agreements between the European Patent Office and:

(a) the central industrial property office of any State which is not a party to this Convention;

(b) any inter-governmental organisation entrusted with the task of granting patents;

(c) any other organisation.

(3) The communications under paragraphs 1 and 2(a) and (b) shall not be subject to the restrictions laid down in Article 128. The Administrative Council may decide that communications under paragraph 2(c) shall not be subject to

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Article 130

Exchange of information

(1) The European Patent Office and [...] the central industrial property office of any Contracting State shall, on request, communicate to each other any useful information regarding [...] European or national patent applications **and patents** and [...] any proceedings concerning [...] **them, unless this Convention or the national law provides otherwise.**

(2) The provisions of paragraph 1 shall apply to the communication of information by virtue of working agreements between the European Patent Office and

(a) the central industrial property offices **of other States [...];**

(b) and (c) *Unchanged*

(3) *Unchanged*

such restrictions, provided that the organisation concerned shall treat the information communicated as confidential until the European patent application has been published.
