

CA/PL 21/00

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SUBJECT: Revision of the EPC: Articles 150-158

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains proposals for amending Part X of the Convention (International applications pursuant to the Patent Cooperation Treaty). Certain details can be transferred to the Implementing Regulations, unwanted provisions deleted and the remainder consolidated into four articles.

I. INTRODUCTION

A. GENERAL

1. Part X of the Convention (EPC), comprising Articles 150 to 158, relates to international applications pursuant to the Patent Cooperation Treaty (PCT), details of which are dealt with in Part IX of the Implementing Regulations to the EPC (Rules 104 to 112). The following is an introduction to the proposed revision of Articles 150 to 158. The individual amendments are shown in detail in the table in Section II. Section III contains a consolidated version of the proposed revision.
2. Generally speaking, the proposed amendments (like similar proposals for other parts of the EPC) are aimed at clearing the Convention of provisions relating to details and transferring them to its Implementing Regulations. After more than twenty years of interaction between EPC and PCT, some provisions have clearly become superfluous and are therefore candidates for deletion. To avoid repetition and redundancies, it is further proposed that the remaining articles be re-organised in line with the procedures in question. They would thus be combined to form one **basic** provision, the EPO's functions in the **international** phase of the PCT being contained in two articles only, and those of the **regional** phase in one.

B. BASIC PROVISION

3. The **principles** governing the interaction between EPC and PCT will continue to be laid down in paragraphs (1) and (2) of Article 150 EPC. The use of "PCT" in place of the unwieldy and seldom-used "Cooperation Treaty", as proposed for all three language versions of the EPC, merely confirms what has long been standard usage.
4. A further amendment relates to the current fourth sentence in Article 150(2), where with regard to the time limit for the request for examination, the precedence of the PCT is asserted yet again. In the light of the previous sentence, this is an unnecessary repetition. However, in view of the proposed revision of Article 94 EPC⁽¹⁾, the details relating to the time limit in question should be incorporated into the Implementing Regulations.
5. Finally, the important provision contained in paragraph (3), which, in addition to Article 11(3) PCT, governs the conditions to be fulfilled for an international application to be deemed a European patent, is to be incorporated into new Article 153 EPC because of the relationship of the subject-matter.

⁽¹⁾ see CA/PL 6/00.

C. THE EPO AS RECEIVING OFFICE

6. The role of the EPO as **PCT receiving Office** and the regulations governing the filing and transmittal of international applications (currently Articles 151 and 152) may be combined into one provision (new Article 151), if the individual provisions of Article 152 are transferred to the Implementing Regulations. Experience has shown that there is no need for paragraphs (2) and (3) of Article 151, and they can therefore be deleted or, if appropriate, incorporated into the Implementing Regulations.

D. THE EPO AS INTERNATIONAL AUTHORITY

7. The EPO's role as **International Searching Authority and International Preliminary Examining Authority** is currently treated separately in the largely repetitive Articles 154 and 155. One of the reasons for this is the two-stage nature of the PCT, which differentiates between Chapter I and Chapter II. However, PCT Chapter II has been binding on **all** the contracting states to both the Convention **and** the Treaty since 1997, so there is no longer any reason to treat the two differently (see current paragraph (1) in both cases). It would therefore make sense to do away with any superfluity and combine the two in the form of a new provision (new Article 152).
8. The "subject to" clause relating to the PCT in Articles 154(1) and 155(1) is unnecessary (see Articles 9(1) and (2) as well as 31(2)(a) and (b) PCT). The requirement for the prior approval of the Administrative Council contained in Articles 154(2) and 155(2) is also unnecessary, as this results in any case from Article 33(4). Paragraphs (1) and (2) may be consolidated. The deletion of Article 154(3) and 155(3) has already been approved⁽²⁾.

E. THE EPO AS DESIGNATED OFFICE AND ELECTED OFFICE

9. The EPO's role as designated Office and elected Office, in particular the initiation of the "European phase", as well as the effect of the international search report and the international publication, are currently dealt with in Articles 153, 156, 157 and 158. Current Articles 153 and 156 in particular could be consolidated. As already mentioned, Chapters I and II PCT are equally binding on all the contracting states to the EPC and the PCT, which renders the second and third sentences of Article 156 superfluous. Moreover, the ever smaller number of applications entering the European phase after Chapter I does not justify dealing with the EPO's activities as designated Office and elected Office separately.

⁽²⁾ See CA/PL 14/98.

10. The cross-reference to Article 149 in Article 156, first sentence, would seem to be unnecessary. The reference (if it is to be included at all) should be dealt with as part of the revision of Articles 142 to 149⁽³⁾.
11. Details such as the requirements for entry into the European phase, the main provisions for which are already contained in the Implementing Regulations, and matters relating to EPO publication and areas of responsibility, should be covered by the Implementing Regulations. This also applies to the provisions relating to the function of the international search report and the international publication (current Articles 157 and 158), where these are not incorporated as paragraphs 3 - 5 into new Article 153.
12. The table in Section II below shows the current text and the proposed amendments, together with further explanations. Section III contains the consolidated text of the proposed revision.

⁽³⁾ See also CA/PL 7/00.

II. PROPOSED REVISED VERSION

Present wording

PART X INTERNATIONAL APPLICATION PURSUANT TO THE PATENT COOPERATION TREATY

Article 150

Application of the Patent Cooperation Treaty

(1) The Patent Cooperation Treaty of 19 June 1970, hereinafter referred to as the Cooperation Treaty, shall be applied in accordance with the provisions of this Part.

(2) International applications filed under the Cooperation Treaty may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of that Treaty shall be applied, supplemented by the provisions of this Convention. In case of conflict, the provisions of the Cooperation Treaty shall prevail. In particular, for an international application the time limit within which a request for examination must be filed under Article 94, paragraph 2, of this Convention shall not expire before the time prescribed by Article 22 or Article 39 of the Cooperation Treaty as the case may be.

(3) An international application, for which the European Patent Office acts as designated Office or elected Office, shall be deemed to be a European patent application.

Proposed wording

PART X INTERNATIONAL APPLICATIONS PURSUANT TO THE PATENT COOPERATION TREATY - **EURO-PCT PROCEDURE**

Article 150

Application of the Patent Cooperation Treaty

(1) The Patent Cooperation Treaty of 19 June 1970, hereinafter referred to as the [...] **PCT**, shall be applied in accordance with the provisions of this Part.

(2) International applications filed under the [...] **PCT** may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of the [...] **PCT** shall be applied, supplemented by the provisions of this Convention. In case of conflict the provisions of the [...] **PCT [including its Regulations]** shall prevail. [...]

Delete fourth sentence and move substance (in accordance with the proposed revision of Article 94) to the Implementing Regulations - see Rule 107(1)(f) EPC.

(3) **Delete and incorporate into new Article 153(1).**

(4) Where reference is made in this Convention to the Cooperation Treaty, such reference shall include the Regulations under that Treaty.

Article 151

The European Patent Office as a receiving Office

- (1) The European Patent Office may act as a receiving Office within the meaning of Article 2(xv) of the Cooperation Treaty if the applicant is a resident or national of a Contracting State to this Convention in respect of which the Cooperation Treaty has entered into force.
- (2) The European Patent Office may also act as a receiving Office if the applicant is a resident or national of a State which is not a Contracting State to this Convention, but which is a Contracting State to the Cooperation Treaty and which has concluded an agreement with the Organisation whereby the European Patent Office acts as a receiving Office, in accordance with the provisions of the Cooperation Treaty, in place of the national office of that State.
- (3) Subject to the prior approval of the Administrative Council, the European Patent Office may also act as a receiving Office for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(4) **Delete:** *but see paragraph 2, 3rd sentence.*

Article 151

The European Patent Office as a receiving Office

[...] The European Patent Office [...] **shall act [in accordance with the Implementing Regulations] as a receiving Office within the meaning of the [...] PCT. Article 75(2) shall apply mutatis mutandis. [...]**

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

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

Article 152

Filing and transmittal of the international application

(1) If the applicant chooses the European Patent Office as a receiving Office for his international application, he shall file it directly with the European Patent Office. Article 75, paragraph 2, shall nevertheless apply *mutatis mutandis*.

(2) In the event of an international application being filed with the European Patent Office through the intermediary of the competent central industrial property office, the Contracting State concerned shall take all necessary measures to ensure that the application is transmitted to the European Patent Office in time for the latter to be able to comply in due time with the conditions for transmittal under the Cooperation Treaty.

(3) Each international application shall be subject to the payment of the transmittal fee, which shall be payable within one month after receipt of the application.

Article 153

The European Patent Office as designated Office

[See present Article 150:

(3) An international application, for which the European Patent Office acts as designated Office or elected Office, shall be deemed to be a European patent application.]

For new Article 152 see page 9

Delete (1) - (3) *and incorporate into Rule 104 EPC; see also new Article 151.*

Article 153⁽⁴⁾

The European Patent Office as a designated Office **and elected Office**

(1) Unchanged as present Art. 150(3).

⁽⁴⁾ New Article 153 also replaces Articles 156 -158.

(1) The European Patent Office shall act as a designated Office within the meaning of Article 2(xiii) of the Cooperation Treaty for those Contracting States to this Convention in respect of which the Cooperation Treaty has entered into force and which are designated in the international application if the applicant informs the receiving Office in the international application that he wishes to obtain a European patent for these States. The same shall apply if, in the international application, the applicant designates a Contracting State of which the national law provides that designation of that State shall have the effect of the application being for a European patent.

(2) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.

[See present Article 158(1), first sentence:

Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall, subject to paragraph 3, take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin.]

[See present Article 158(3):

(3) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 2. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall be

(2) [...] The European Patent Office shall act as a designated Office and where appropriate as an elected Office within the meaning of [...] the [...] PCT for those Contracting States to this Convention in respect of which the [...] PCT is in force, which are [...] designated and where appropriate elected in the international application and for which the applicant [...] wishes to obtain a European patent.[...]

Delete second sentence, as it is unnecessary in the light of Article 45 PCT.

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

(3) Publication [...] of **the** international application [...] **in one of the official languages of the European Patent Office** shall [...] take the place of the publication of **the** European patent application and shall be mentioned in the European Patent Bulletin.

If the international application is published in a language other than **an** official language of the European Patent Office, that Office shall publish the international application supplied [...] **in one of its official languages**. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall

effective from the date of that publication.]

[See current Article 157:

(1) Without prejudice to the provisions of paragraphs 2 to 4, the international search report under Article 18 of the Cooperation Treaty or any declaration under Article 17, paragraph 2(a), of the Treaty and their publication under Article 21 of that Treaty shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.

(2) Subject to the decisions of the Administrative Council referred to in paragraph 3

(a) a supplementary European search report shall be drawn up in respect of all international applications;

(3) The Administrative Council may decide under what conditions and to what extent:

(a) the supplementary European search report is to be dispensed with;

(b) the search fee is to be reduced.]

[See present Article 158(1), second sentence:

Such an application shall not however be considered as comprised in the state of the art in accordance with Article 54, paragraph 3, if the conditions laid down in paragraph 2 are not fulfilled.]

be effective from the date of that publication.

(4) [...] The international search report [...] or [...] the declaration replacing it and their international publication [...] shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.

[...] A supplementary European search report shall be drawn up in respect of any international application.

The Administrative Council may decide **[...] that this** search report is to be dispensed with **[...] or** that the search fee is to be reduced.

(5) [...] The international application shall **only** be considered as comprised in the state of the art **under** Article 54, paragraph 3, if the conditions laid down **[...] [in the Implementing Regulations]** are **[...]** fulfilled.

Article 154

The European Patent Office as an
International
Searching Authority

(1) The European Patent Office shall act as an International Searching Authority within the meaning of Chapter I of the Cooperation Treaty for applicants who are residents or nationals of a Contracting State in respect of which the Cooperation Treaty has entered into force, subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Searching Authority for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(3) The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 17, paragraph 3(a), of the Cooperation Treaty.

Article 155

The European Patent Office as an
International
Preliminary Examining Authority

(1) The European Patent Office shall act as an International Preliminary Examining Authority within the meaning of Chapter II of the Cooperation Treaty

Article 152⁽⁵⁾

The European Patent Office as an International Searching Authority **and International Preliminary Examining Authority**

[...] The European Patent Office shall act as an International Searching Authority **and as an International Preliminary Examining Authority** within the meaning of [...] the [...] PCT [...] **in accordance with** an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization, for

(a) applicants who are nationals or residents of a Contracting State;

(b) [...] any other applicant [...].

(3) **Delete**; to be covered in *Implementing Regulations* (see CA/PL 14/98).

Delete - See new Article 152; where appropriate, move substance to the *Implementing Regulations*.

⁽⁵⁾ Article 152 (new) replaces Articles 154 and 155.

for applicants who are residents or nationals of a Contracting State bound by that Chapter, subject to the conclusion of an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization.

(2) Subject to the prior approval of the Administrative Council, the European Patent Office shall also act as an International Preliminary Examining Authority for any other applicant, in accordance with an agreement concluded between the Organisation and the International Bureau of the World Intellectual Property Organization.

(3) The Boards of Appeal shall be responsible for deciding on a protest made by an applicant against an additional fee charged by the European Patent Office under the provisions of Article 34, paragraph 3(a), of the Cooperation Treaty.

Article 156

The European Patent Office as an elected Office

The European Patent Office shall act as an elected Office within the meaning of Article 2(xiv) of the Cooperation Treaty if the applicant has elected any of the designated States referred to in Article 153, paragraph 1, or Article 149, paragraph 2, for which Chapter II of that Treaty has become binding. Subject to the prior approval of the Administrative Council, the same shall apply where the applicant is a resident or national of a

Delete - See new Article 153(2). The reference to Article 149(2) is superfluous. If necessary, an appropriate cross-reference should be included in Article 149. Present second and third sentences unnecessary.

State which is not a party to that Treaty or which is not bound by Chapter II of that Treaty, provided that he is one of the persons whom the Assembly of the International Patent Cooperation Union has decided to allow, pursuant to Article 31, paragraph 2(b), of the Cooperation Treaty, to make a demand for international preliminary examination.

Article 157

International search report

- (1) Without prejudice to the provisions of paragraphs 2 to 4, the international search report under Article 18 of the Cooperation Treaty or any declaration under Article 17, paragraph 2(a), of that Treaty and their publication under Article 21 of that Treaty shall take the place of the European search report and the mention of its publication in the European Patent Bulletin.
- (2) Subject to the decisions of the Administrative Council referred to in paragraph 3:
- (a) a supplementary European search report shall be drawn up in respect of all international applications;
- (b) the applicant shall pay the search fee, which shall be paid at the same time as the national fee provided for in Article 22, paragraph 1, or Article 39, paragraph 1, of the Cooperation Treaty. If the search fee is not paid in due time the application shall be deemed to be withdrawn.

Delete - See new Article 153(4) and Implementing Regulations; paragraph 4 is self-evident and therefore superfluous.

(3) The Administrative Council may decide under what conditions and to what extent:

(a) the supplementary European search report is to be dispensed with;

(b) the search fee is to be reduced.

(4) The Administrative Council may at any time rescind the decisions taken pursuant to paragraph 3.

Article 158

Publication of the international application and its supply to the European Patent Office

(1) Publication under Article 21 of the Cooperation Treaty of an international application for which the European Patent Office is a designated Office shall, subject to paragraph 3, take the place of the publication of a European patent application and shall be mentioned in the European Patent Bulletin. Such an application shall not however be considered as comprised in the state of the art in accordance with Article 54, paragraph 3, if the conditions laid down in paragraph 2 are not fulfilled.

(2) The international application shall be supplied to the European Patent Office in one of its official languages. The applicant shall pay to the European Patent Office the national fee provided for in Article 22, paragraph 1, or Article 39, paragraph 1, of the Cooperation Treaty.

Delete - See new Article 153(3) and (5) and also Rule 107 EPC; where appropriate, to be dealt with in the Implementing Regulations.

(3) If the international application is published in a language other than one of the official languages of the European Patent Office, that Office shall publish the international application, supplied as specified in paragraph 2. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall be effective from the date of that publication.

III. CONSOLIDATED TEXT OF PROPOSED REVISION

PART X INTERNATIONAL APPLICATIONS PURSUANT TO THE PATENT COOPERATION TREATY - EURO-PCT PROCEDURE

Article 150

Application of the Patent Cooperation Treaty

- (1) The Patent Cooperation Treaty of 19 June 1970, hereinafter referred to as the PCT, shall be applied in accordance with the provisions of this part.
- (2) International applications filed under the PCT may be the subject of proceedings before the European Patent Office. In such proceedings, the provisions of the PCT shall be applied, supplemented by the provisions of this Convention. In case of conflict the provisions of the PCT [including its Regulations] shall prevail.

Article 151

The European Patent Office as a receiving Office

The European Patent Office shall act [in accordance with the Implementing Regulations] as a receiving Office within the meaning of the PCT. Article 75(2) shall apply *mutatis mutandis*.

Article 152

The European Patent Office as an International Searching Authority and International Preliminary Examining Authority

The European Patent Office shall act as an International Searching Authority and as an International Preliminary Examining Authority within the meaning of the PCT in accordance with an agreement between the Organisation and the International Bureau of the World Intellectual Property Organization, for

- (a) applicants who are nationals or residents of a Contracting State;
- (b) any other applicant.

Article 153

The European Patent Office as a designated Office and elected Office

- (1) Any international application for which the European Patent Office acts as a designated Office or elected Office shall be deemed to be a European patent application.
 - (2) The European Patent Office shall act as a designated Office and where appropriate as an elected Office within the meaning of the PCT for those Contracting States to this Convention in respect of which the PCT is in force, which are designated and where appropriate elected in the international application and for which the applicant wishes to obtain a European patent.
 - (3) Publication of the international application in one of the official languages of the European Patent Office shall take the place of the publication of the European patent application and shall be mentioned in the European Patent Bulletin. If the international application is published in a language other than an official language of the European Patent Office, that Office shall publish the international application supplied in one of its official languages. Subject to the provisions of Article 67, paragraph 3, the provisional protection in accordance with Article 67, paragraphs 1 and 2, shall be effective from the date of that publication.
 - (4) The international search report or the declaration replacing it and their international publication shall take the place of the European search report and the mention of its publication in the European Patent Bulletin. A supplementary European search report shall be drawn up in respect of any international application. The Administrative Council may decide that this search report is to be dispensed with or that the search fee is to be reduced.
 - (5) The international application shall only be considered as comprised in the state of the art under Article 54, paragraph 3, if the conditions laid down [in the Implementing Regulations] are fulfilled.
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