

CA/PL 22/00

Orig.: English

Munich, 16.03.2000

SUBJECT: Revision of the EPC: Articles 133-134 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains proposals amending Art. 133 and 134 EPC and incorporating some modifications suggested by the Committee with respect to an earlier proposal regarding Art. 134 EPC (see CA/PL 18/98).

I. INTRODUCTION

1. Article 133 EPC contains the general principles governing representation and remains unchanged subject to minor editorial streamlining and changes aimed at increasing the consistency of the text.
2. In CA/PL 18/98, it was proposed to insert into Art. 134 EPC the substance of the "grandfather clause" contained in Art. 163(6) EPC, which governs the entitlement of national representatives in a state having newly acceded to the EPC to be entered onto the list of professional representatives pursuant to Art. 134 EPC.
3. This proposal was examined and endorsed in principle by the Committee at its 8th meeting, subject to two modifications. First, it was suggested that the wording of the proposed Art. 134(3) EPC and that used in Art. 134(2) EPC should be consistent. Secondly, it was pointed out that Art. 134(8)(b) EPC as framed was obsolete and advocated that the existence of the **epi** be anchored in the EPC. The amendments suggested are incorporated in the concrete proposal below. For ease of reference, modifications with regard to the proposed new text of Art. 134 EPC contained in CA/PL 18/98 are underlined.
4. Finally, it is proposed to create a new Art. 134a EPC, which would contain the provisions pertaining specifically to the **epi**.

II. PROPOSED AMENDMENTS

Present wording

Article 133

General principles of representation

- (1) Subject to the provisions of paragraph 2, no person shall be compelled to be represented by a professional representative in proceedings established by this Convention.
- (2) Natural or legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing the European patent application; the Implementing Regulations may permit other exceptions.
- (3) Natural or legal persons having their residence or principal place of business within the territory of one of the Contracting States may be represented in proceedings established by this Convention by an employee, who need not be a professional representative but who must be authorised in accordance with the Implementing Regulations. The Implementing Regulations may provide whether and under what conditions an employee of such a legal person may also represent other legal persons which

Proposed wording

Article 133

General principles of representation

- (1) Subject to the provisions of paragraph 2, no person shall be compelled to be represented by a professional representative in proceedings established by this Convention.
- (2) Natural or legal persons not having **their** residence or [...] principal place of business [...] **in a Contracting State shall** be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing the European patent application; the Implementing Regulations may permit other exceptions.
- (3) Natural or legal persons having their residence or principal place of business [...] **in a Contracting State** may be represented in proceedings established by this Convention by an employee, who need not be a professional representative but who **shall be duly** authorised. [...] The Implementing Regulations may provide whether and under what conditions an employee of such a legal person may also represent other legal persons which have their principal place of business

have their principal place of business within the territory of one of the Contracting States and which have economic connections with the first legal person.

(4) The Implementing Regulations may prescribe special provisions concerning the common representation of parties acting in common.

Article 134

Professional representatives

(1) Professional representation of natural or legal persons in proceedings established by this Convention may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the European Patent Office.

(2) Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he must be a national of one of the Contracting States;

(b) he must have his place of business or employment within the territory of one of the Contracting States;

(c) he must have passed the European qualifying examination.

[...] in a Contracting State and which have economic connections with the first legal person.

(4) **Delete** - *Unnecessary in view of proposed new Art. 164 (see CA/PL 20/00).*

Article 134

Professional representation

(1) *Unchanged*

(2) Any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he **shall** be a national of one of the Contracting States;

(b) he **shall** have his place of business or employment **[...] in a Contracting State**;

(c) he **shall** have passed the European qualifying examination.

(3) Entry shall be effected upon request, accompanied by certificates which must indicate that the conditions laid down in paragraph 2 are fulfilled.

(4) Persons whose names appear on the list of professional representatives shall be entitled to act in all proceedings established by the Convention.

(3) During a period of one year from the date on which the accession of a State to the Convention takes effect, any natural person who fulfils the following conditions may be entered on the list of professional representatives:

(a) he shall be a national of one of the contracting states;

(b) he shall have his place of business or employment within that state having acceded to the Convention;

(c) he shall be entitled to represent natural or legal persons in patent matters before the central industrial property office of that State. Where such entitlement is not conditional upon the requirement of special professional qualifications, the person shall have habitually so acted for at least 5 years.

(4) Entry shall be effected upon request, accompanied by certificates which **shall** indicate that the conditions laid down in **either** paragraph 2 **or** paragraph 3 are fulfilled.

(4) *becomes (5) - text unchanged*

(5) For the purpose of acting as a professional representative, any person whose name appears on the list referred to in paragraph 1 shall be entitled to establish a place of business in any Contracting State in which proceedings established by this Convention may be conducted, having regard to the Protocol on Centralisation annexed to this Convention. The authorities of such State may remove that entitlement in individual cases only in application of legal provisions adopted for the purpose of protecting public security and law and order. Before any such action is taken, the President of the European Patent Office shall be consulted.

(6) The President of the European Patent Office may, in special circumstances, grant exemption from the requirement of paragraph 2(a).

(7) Professional representation in proceedings established by this Convention may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the Contracting States and having his place of business within such State, to the extent that he is

(5) becomes **(6)** - text unchanged

(7) The President of the European Patent Office may grant exemption from:

(a) the requirement of paragraphs 2(a) or 3(a) in special circumstances;

(b) the requirement of paragraph 3(c), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way.

(8) Professional representation in proceedings established by this Convention may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the Contracting States and having his place of business within such State, to the extent that he is

entitled, within the said State, to act as a professional representative in patent matters. Paragraph 5 shall apply mutatis mutandis.

(8) The Administrative Council may adopt provisions governing:

(a) the qualifications and training required of a person for admission to the European qualifying examination and the conduct of such examination;

(b) the establishment or recognition of an institute constituted by persons entitled to act as professional representatives by virtue of either the European qualifying examination or the provisions of Article 163, paragraph 7;

(c) any disciplinary power to be exercised by that institute or the European Patent Office on such persons.

entitled, within the said State, to act as a professional representative in patent matters. Paragraph 6 shall apply mutatis mutandis.

Article 134a
Institute of Professional
Representatives before the European
Patent Office

(1) The Administrative Council **shall be competent to** adopt **and amend** provisions governing:

(a) the Institute of Professional Representatives before the European Patent Office, established under this Convention, hereinafter referred to as the Institute;

(b) the qualifications and training required of a person for admission to the European qualifying examination and the conduct of such examination;

Note: Present Art. 134(8)(a) and (b) should be inverted.

(c) any disciplinary power to be exercised by **the Institute** or the European Patent Office on **professionnal representatives**.

(2) All persons entered on the list of professional representatives referred to in Article 134(1) shall be members of the Institute.