

CA/PL 23/00

Orig.: French

Munich, 20.03.2000

SUBJECT: Revision of the EPC: Articles 135 to 137, 140 and 141

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains proposals for amending Articles 135 to 137 and 140 EPC with a view to transferring the provisions governing conversion procedure formalities to the Implementing Regulations and for amending Article 141 EPC to take account of the deletion of Article 86 EPC (see CA/PL 12/00).

I. ARTICLES 135 TO 137 EPC

1. These provisions govern the conversion of a European patent application or a European patent into a national patent application. As all the contracting states have used the option provided by Article 135(1) EPC, it seems appropriate to retain a legal basis for such national procedures in an article of the EPC.
2. Conversely, there is no need to retain the provisions governing the detailed formalities of the conversion procedure in Articles 135(2), 136 and 137 EPC. It is therefore proposed that the substance of these articles be transferred to the Implementing Regulations.

Article 135(2) EPC has been reworded to include a reference in square brackets to the detailed rules to feature in the future Implementing Regulations; but this reference may prove superfluous if there is a general provision stating that the Implementing Regulations may provide further details on any procedure established by the EPC (see CA/PL 20/00).

II. ARTICLES 140 AND 141 EPC

3. The only amendment that needs to be made to Article 140 EPC is to delete the reference to Articles 136 and 137 EPC.
4. Article 141(1) EPC specifies the year in which national patent offices may begin imposing renewal fees in respect of a European patent: a reference to Article 86(4) EPC defines this as the year which follows that in which the mention of the grant of the European patent is published.

Article 141(1) needs to be retained as an article of the EPC, but with an amendment to take account of the transfer of Article 86(4) EPC to the Implementing Regulations. The amendment involves replacing the reference to Article 86(4) EPC with the actual wording of the second half of Article 86(4) EPC, the new version therefore stating that:

"Renewal fees in respect of a European patent may only be imposed for the years which follow that **in which the mention of the grant of the European patent is published in the European Patent Bulletin**".

5. Article 141(2) EPC grants the patent proprietor a period of two months after publication of the mention of grant in which to pay any renewal fees falling due within that period.

It is not necessary to retain any such provision in an article of the EPC; it can be transferred to the Implementing Regulations.

III. TITLES OF THE CHAPTERS OF PART VIII OF THE EPC

6. Transferring the substance of Articles 136 and 137 EPC to the Implementing Regulations entails cutting Chapter I of Part VIII down to a single article. Logically speaking, the title of this single article should be the same as the title of the chapter, resulting in needless redundancy⁽¹⁾. It is therefore proposed that the title of Article 135 EPC be replaced with the title of Chapter I ("Conversion into a national patent application").
7. If the title of Chapter I is made the title of Article 135 EPC, there is no need to retain the division into Chapters II and III. It is therefore proposed that the titles of Chapters II and III of Part VIII of the EPC be deleted. The title of Part VIII ("Impact on national law") suffices to give a general indication of the substance of the five articles that it is proposed to retain in Part VIII of the EPC.

(1) Note further that no other chapter of the EPC contains only one article; conversely, the authors of the EPC occasionally elected not to divide a Part into chapters (eg Parts IV, V and VI of the EPC relating to procedure up to grant, opposition procedure and appeals procedure).

IV. PROPOSED AMENDMENTS

Present wording	Proposed wording
PART VIII	PART VIII
IMPACT ON NATIONAL LAW	IMPACT ON NATIONAL LAW
Chapter I	Delete
Conversion into a national patent application	
Article 135	Article 135
Request for the application of national procedure	Conversion into a national patent application
(1) The central industrial property office of a designated Contracting State shall apply the procedure for the grant of a national patent only at the request of the applicant for or proprietor of a European patent, and in the following circumstances:	(1) The central industrial property office of a designated Contracting State shall apply the procedure for the grant of a national patent only at the request of the applicant for or proprietor of a European patent, and in the following circumstances:
a) when the European patent application is deemed to be withdrawn pursuant to Article 77, paragraph 5, or Article 162, paragraph 4;	a) when the European patent application is deemed to be withdrawn pursuant to Article 77, paragraph 3 [...]; <i>Note: The reference to Article 77, paragraph 5, has to be replaced with a reference to Article 77, paragraph 3 (see CA/PL 12/00). The reference to Article 162, paragraph 4, is to be deleted (see CA/PL 18/98).</i>
b) in such other cases as are provided for by the national law in which the European patent application is refused or withdrawn or deemed to be withdrawn, or the European patent is revoked under this Convention.	b) in such other cases, as are provided for by the national law, in which the European patent application is refused or withdrawn or deemed to be withdrawn, or the European patent is revoked under this Convention.

(2) The request for conversion shall be filed within three months after the European patent application has been withdrawn or after notification has been made that the application is deemed to be withdrawn, or after a decision has been notified refusing the application or revoking the European patent. The effect referred to in Article 66 shall lapse if the request is not filed in due time.

Article 136

Submission and transmission of the request

(1) A request for conversion shall be filed with the European Patent Office and shall specify the Contracting States in which application of the procedure for the grant of a national patent is required. The request shall not be deemed to be filed until the conversion fee has been paid. The European Patent Office shall transmit the request to the central industrial property offices of the Contracting States specified therein, accompanied by a copy of the files relating to the European patent application or the European patent.

(2) However, if the applicant is notified that the European patent application has been deemed to be withdrawn pursuant to Article 77, paragraph 5, the request shall be filed with the central industrial property office with which the application has been filed. That office shall, subject to the provisions of national security, transmit the request, together with a copy of the European patent application, directly to the central industrial property

(2) **[The Implementing Regulations shall specify the time limit and the procedure for submission and transmission of the request for conversion and shall also define the formal requirements for conversion.]**

Delete

offices of the Contracting States specified by the applicant in the request. The effect referred to in Article 66 shall lapse if such transmission is not made within twenty months after the date of filing or, if a priority has been claimed, after the date of priority.

Article 137

Formal requirements for conversion

(1) A European patent application transmitted in accordance with Article 136 shall not be subjected to formal requirements of national law which are different from or additional to those provided for in this Convention.

(2) Any central industrial property office to which the application is transmitted may require that the applicant shall, within not less than two months:

- a) pay the national application fee;
- b) file a translation in one of the official languages of the State in question of the original text of the European patent application and, where appropriate, of the text, as amended during proceedings before the European Patent Office, which the applicant wishes to submit to the national procedure.

Chapter II Revocation and prior rights

Article 138

Grounds for revocation

...

Delete

} **Delete**

See CA/PL 19/00

Article 139

Rights of earlier date or the same date

...

Unchanged

Chapter III
Miscellaneous effects

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Delete

Article 140

National utility models and utility
certificates

Article 140

National utility models and utility
certificates

Article 66, Article 124, Articles 135 to 137
and Article 139 shall apply to utility
models and utility certificates and to
applications for utility models and utility
certificates registered or deposited in the
Contracting States whose laws make
provision for such models or certificates.

Articles 66, 124, 135 [...] and 139 shall
apply to utility models and utility
certificates and to applications for utility
models and utility certificates registered
or deposited in the Contracting States
whose laws make provision for such
models or certificates.

Article 141

Renewal fees for European patents

Article 141

Renewal fees for European patents

(1) Renewal fees in respect of a
European patent may only be imposed
for the years which follow that referred to
in Article 86, paragraph 4.

[...] Renewal fees in respect of a
European patent may only be imposed
for the years which follow that **in which
the mention of the grant of the
European patent is published in the
European Patent Bulletin.**

(2) Any renewal fees falling due within
two months after the publication of the
mention of the grant of the European
patent shall be deemed to have been
validly paid if they are paid within that
period. Any additional fee provided for
under national law shall not be charged.

(2) **Delete**