

CA/PL 24/00

Orig.: English

Munich, 05.04.2000

SUBJECT: Revision of the EPC: new provision in Part IX

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains a proposal for a new EPC provision to be inserted in Part IX of the Convention, creating a clear legal basis for any future agreements between the EPC contracting states concerning such matters as translation requirements or litigation concerning European patents, which are currently under consideration within the Working Parties on Cost Reduction and on Litigation mandated by the Paris Intergovernmental Conference of 1999.

I. INTRODUCTION

1. The Paris Intergovernmental Conference held in June 1999 has mandated two working parties to submit to the governments of the EPC contracting states and to the EPC Revision Conference proposals aiming at reducing the cost of European patents and improving litigation concerning European patents (see OJ EPO 1999, 545ff.). The mandate includes the task of drawing up optional protocols to the EPC with a view to limiting translation requirements and to creating an integrated judicial system.
2. The two Working Parties on "Cost Reduction" (WPR) and on "Litigation" (WPL) have since held two meetings and made considerable progress in accomplishing their tasks.

WPR is on its way to finalise a draft protocol on the application of Article 65 EPC (see WPR/6/00) and WPL is likely to complete in June 2000 a comprehensive paper showing the structure of an optional protocol on litigation (see WPL/9/99).

3. In the light of these developments and the possible outcome that in future such optional protocols could be concluded between the EPC contracting states, involving also the European Patent Organisation and the EPO, it appears appropriate to provide for a clear legal basis in the EPC dealing with such special agreements and their interface with EPC and EPO. At its Dublin meeting in February this year, the Administrative Council therefore agreed that the question of how the proposed optional protocols should be anchored in a revised EPC be referred to the Committee on Patent Law for further examination (see CA/36/00).
4. A proposal for a new EPC provision to be inserted in Part IX of the Convention is submitted below.

II. PROPOSAL FOR A NEW EPC PROVISION TO BE INSERTED IN PART IX OF THE CONVENTION

Part IX

SPECIAL AGREEMENTS

New Article XX

Other agreements between the Contracting States

- (1) Nothing in this Convention shall be construed to limit the right of the Contracting States to conclude special agreements on any matters concerning European patent applications or European patents which are subject to and governed by national law, such as in particular
 - (a) an agreement on the establishment of a European patent court common to the Contracting States party to it, competent to settle litigation concerning European patent applications or patents;
 - (b) an agreement on the establishment of an entity common to the Contracting States party to it, competent to deliver opinions on issues of European patent law, referred to it by a national court of such a State trying an action concerning a European patent application or patent;
 - (c) an agreement under which the Contracting States party to it provide that translations of European patents, as may be required under Article 65, be dispensed with fully or in part or may be filed with, and published by, the European Patent Office.
- (2) The Administrative Council shall be competent to decide that
 - (a) the members of the Boards of Appeal or the Enlarged Board of Appeal may also serve on a common European patent court or a common entity established under any such agreement and take part in any proceedings before that court or entity in accordance with the terms of that agreement;
 - (b) the European Patent Office provide a common entity with such support staff, premises and equipment as may be necessary for the performance of its duties or the expenses incurred by that entity be borne fully or in part by the Organisation.
