

SUBJECT: Basic proposal for the revision of the European Patent Convention

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains the revised draft of the Basic Proposal for revision of the EPC, which takes into account the results of the discussions of the 14th meeting of the Committee on Patent Law from 3 - 6 July 2000. It will be presented to the Administrative Council as document CA/100/00 for discussion during its meeting from 5 - 8 September 2000.

Delegations are requested to send any comments regarding this document no later than 2 August 2000 directly to Mr G. Kolle (Fax: +49-89-2399 5219; e-mail: gkolle@epo.org; Tel: +49-89-2399 5220).

Part I

BASIC PROPOSAL FOR THE REVISION OF THE EUROPEAN PATENT CONVENTION

ARTICLE 11 EPC

Explanatory remarks

(Preparatory documents: CA/106/99 + Add. 1, CA/PL PV 12, points 3 to 10; CA/PL 31/00, point 3)

1. The participation of external legally qualified members from the EPC contracting states in proceedings before the Enlarged Board of Appeal has proved to be a success. It is expected that the involvement of national judges in important cases before the Enlarged Board will continue in future to provide valuable input, to help bring about international recognition of these decisions and, in so doing, to further the harmonisation of patent case law in Europe. The appointment of national judges from the contracting states as members of the Enlarged Board of Appeal will thus continue to be highly desirable.
2. The existing legal basis for the appointment of external members of the boards of appeal and the Enlarged Board of Appeal is a transitional provision: Article 160(2) EPC, which is to be deleted in the course of the revision of the EPC (see explanations on Article 160 EPC). **New Article 11(5) EPC will create a permanent legal basis for appointing external legally qualified members of the Enlarged Board of Appeal.** In accordance with current practice, they shall be appointed for three-year terms, with the possibility of reappointment.
3. The appointment of external technically qualified members of the technical or Enlarged boards and of external legally qualified members of the Legal and technical boards, which is currently still possible under Article 160(2) EPC shall be discontinued for the future. One reason why provision was made for appointing external board members was concern that the EPO, particularly in the early days, might not have the necessary wide range of specialist know-how available in-house. Today, this is no longer the case; experts are in place in all technical fields. So there is no longer any need to appoint external technically qualified members of the technical boards. The same applies to external technically qualified members of the Enlarged Board of Appeal. The participation of external members has in any case proved organisationally complicated (need to travel to and fro to attend board meetings, difficulties in arranging dates, etc) and increasingly inefficient. Recently, therefore, there have been very few cases of external members sitting on technical boards. And only in the EPO's very early years was there a need to appoint external legally qualified members to work on the Legal or technical boards.

Present wording

Article 11

Appointment of senior employees

- (1) The President of the European Patent Office shall be appointed by decision of the Administrative Council.
- (2) The Vice-Presidents shall be appointed by decision of the Administrative Council after the President has been consulted.
- (3) The members, including the Chairmen, of the Boards of Appeal and of the Enlarged Board of Appeal shall be appointed by decision of the Administrative Council, taken on a proposal from the President of the European Patent Office. They may be re-appointed by decision of the Administrative Council after the President of the European Patent Office has been consulted.
- (4) The Administrative Council shall exercise disciplinary authority over the employees referred to in paragraphs 1 to 3.

Revised wording

Article 11

Appointment of senior employees

- (1) *Unchanged*
- (2) *Unchanged*
- (3) *Unchanged*
- (4) *Unchanged*
- (5) **The Administrative Council, after consulting the President of the European Patent Office, may also appoint as members of the Enlarged Board of Appeal legally qualified members of the national courts or quasi-judicial authorities of the Contracting States, who may continue their judicial activities at the national level. They shall be appointed for a term of three years and may be reappointed.**

ARTICLE 14 EPC

Explanatory remarks

(Preparatory documents: CA/PL 25/00; CA/PL 31/00, point 5)

1. In the light of the provision of the **Patent Law Treaty 2000** (PLT) relating to the minimum requirements for the accordance of a filing date, it has proven necessary to amend Article 14 EPC.
2. **Article 14(1) EPC** only states what the official languages of the EPO are. The current second sentence is transferred to paragraph 2.
3. The new **Article 14(2) EPC** states that the application must be filed in one of the official languages, or be translated into one of these languages (if the application has been filed in another language). The Implementing Regulations to Article 90(1) EPC will allow for the filing of an application in any language for the purpose of obtaining a filing date. The Implementing Regulations to Article 14 EPC will lay down the applicable time limit for the filing of a translation in line with current Rule 6 EPC. The legal effect of the non-timely filing of the translation, which is currently laid down in Article 90(3) EPC, is now included in Article 14 EPC itself.
4. **Article 14(3) EPC** has been shortened to improve readability without any change in substance.

Present wording

Article 14

Languages of the European Patent Office

- (1) The official languages of the European Patent Office shall be English, French and German. European patent applications must be filed in one of these languages.
- (2) However, natural or legal persons having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad, may file European patent applications in an official language of that State. Nevertheless, a translation in one of the official languages of the European Patent Office must be filed within the time limit prescribed in the Implementing Regulations; throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the original text of the application.
- (3) The official language of the European Patent Office in which the European patent application is filed or, in the case referred to in paragraph 2, that of the translation, shall be used as the language of the proceedings in all proceedings before the European Patent Office concerning the application or the resulting patent, unless otherwise provided in the Implementing Regulations.

Revised wording

Article 14

Languages of the European Patent Office, **European patent applications and other documents**

- (1) The official languages of the European Patent Office shall be English, French and German. [...]
- (2) **A European patent application must be filed in one of the official languages or, in accordance with the Implementing Regulations, translated into one of these languages.**
Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the original text of the application. **If a required translation is not filed in due time, the application shall be deemed to be withdrawn.**
- (3) The official language of the European Patent Office in which the European patent application is filed or [...]
into which it is translated shall be used as the language of the proceedings in all proceedings before the European Patent Office, [...] unless otherwise provided in the Implementing Regulations.

5. **Article 14(4) EPC** has been redrafted and combined with current Article 14(5) EPC. In view of the fact that applications may in future be filed in any language, the special provisions for applicants from contracting states with a language other than English, French or German as an official language are now no longer applicable to the filing of the application itself, but only to subsequently filed documents. The provision that the translation must be filed in the language of the proceedings has been deleted to align the provision with the current Rule 1(1) EPC.

Present wording

(4) The persons referred to in paragraph 2 may also file documents which have to be filed within a time limit in an official language of the Contracting State concerned. They must however file a translation in the language of the proceedings within the time limit prescribed in the Implementing Regulations; in the cases provided for in the Implementing Regulations, they may file a translation in a different official language of the European Patent Office.

(5) If any document, other than those making up the European patent application, is not filed in the language prescribed by this Convention, or if any translation required by virtue of this Convention is not filed in due time, the document shall be deemed not to have been received.

(6) European patent applications shall be published in the language of the proceedings.

(7) The specifications of European patents shall be published in the language of the proceedings; they shall include a translation of the claims in the two other official languages of the European Patent Office.

Revised wording

(4) **Natural or legal persons having their residence or principal place of business within a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad**, may file documents which have to be filed within a time limit in an official language of **that State**. They must however file a translation in [...] **an** official language of the European Patent Office **in accordance with the Implementing Regulations**. If any document, other than those making up the European patent application, is not filed in the **prescribed language**, or if any **required translation** is not filed in due time, the document shall be deemed not to have been **filed**.

(5) **Deleted** - incorporated in paragraph 4

(6) *becomes* **(5)** Text unchanged

(6) Specifications of European patents shall be published in the language of the proceedings **and** shall include a translation of the claims in the two other official languages of the European Patent Office.

6. **Article 14(8) and (9) EPC are deleted.** The matter covered by these provisions can well be dealt with in the Implementing Regulations to Article 129 and 127 EPC, respectively. A separate mention of the EPO publications and the Register in Article 14 EPC is superfluous.

Present wording

(8) There shall be published in the three official languages of the European Patent Office:

- (a) the European Patent Bulletin;
- (b) the Official Journal of the European Patent Office.

(9) Entries in the Register of European Patents shall be made in the three official languages of the European Patent Office. In cases of doubt, the entry in the language of the proceedings shall be authentic.

Revised wording

(8) ***Deleted*** - to be incorporated into the *Implementing Regulations*

(9) ***Deleted*** - to be incorporated into the *Implementing Regulations*

ARTICLES 16 AND 17 EPC, SECTION I PROTOCOL ON CENTRALISATION**Explanatory remarks**

(Preparatory documents: CA/PL 2/98 and 10/98; CA/PL PV 6, points 9-41, and PV 7, points 85-90; CA/PL 31/00, point 3)

1. Currently, the EPC implies an organisational and geographical division between search and examination. Under Articles 16 and 17 the Receiving Section and Search Divisions are located in the branch at The Hague, and Section I(1)(b) of the Protocol on Centralisation refers to the taking over of the tasks of the former IIB by the branch at The Hague. There is no such geographical allocation of the other EPO departments referred to in Article 15 EPC.
2. When the Office was set up, it was agreed that searching should be carried out by the examiners in DG 1 at The Hague, and substantive examination by the DG 2 examiners in Munich. This geographical and material division of search and substantive examination was determined by political and historical factors, since the paper search documentation was located in the former IIB in The Hague.
3. Since electronic search tools now make it possible to carry out searches in Munich too, the Office set up a pilot project known as **BEST** (Bringing Examination and Search Together), with the aim of improving quality and efficiency. Under BEST, both search and examination are performed by the same examiner, who may be located in The Hague, Berlin or Munich. When the request for examination is received, the search examiner is appointed a member of the Examining Division and entrusted with the substantive examination of the application.
4. In order to enable the Office-wide implementation of the BEST procedure in Munich, The Hague and Berlin, **Articles 16 and 17 EPC and Section I Protocol on Centralisation are amended by removing the geographical allocation of the Receiving Section and Search Divisions to the branch at The Hague.**

ARTICLE 16 EPC

1. **The allocation of the Receiving Section to the branch at The Hague in Article 16 EPC has been deleted**, so that duties of that department can be run under the aegis of DG 2 in Munich and staff of the Receiving Section, who carry out the examination on filing and as to formal requirements, can be assigned to either DG 1 or DG 2, depending on where the search is carried out.
2. Quite in line with these considerations and to ensure greater flexibility in determining when competence passes within the Office from one department to another, the **limitation in time of the Receiving Section's responsibility** contained in the **second sentence of Article 16 EPC has been deleted** (see also Article 18 EPC).
3. As under Articles 92 and 93 EPC as amended the responsibility for the publication of the application and search report lies with the EPO, **the last sentence of Article 16 EPC has been deleted** as well in order to ensure greater flexibility in allocating specific tasks of the Office.

Present wording

Article 16
Receiving Section

The Receiving Section shall be in the branch at The Hague. It shall be responsible for the examination on filing and the examination as to formal requirements of each European patent application up to the time when a request for examination has been made or the applicant has indicated under Article 96, paragraph 1, that he desires to proceed further with his application. It shall also be responsible for the publication of the European patent application and of the European search report.

Revised wording

Article 16
Receiving Section

The Receiving Section [...] shall be responsible for the examination on filing and [...] as to formal requirements of **any** European patent application [...].

ARTICLE 17**Explanatory remarks**

1. **The allocation of the Search Divisions to the branch at The Hague in Article 17 EPC has been deleted**, so that Search Divisions can also be set up at the Office's headquarters in Munich, allowing the Office-wide implementation - in Munich, The Hague and Berlin - of the BEST procedure (see explanatory remarks preceding Article 16 EPC).
2. See also the proposed **Protocol on Staff Complement** under Article 164 EPC which is to ensure that the ratio of staff at The Hague to the total EPO staff complement remains substantially unchanged after the Office-wide introduction of BEST.

Present wording

Article 17
Search Divisions

The Search Divisions shall be in the Branch at The Hague. They shall be responsible for drawing up European search reports.

Revised wording

Article 17
Search Divisions

The Search Divisions shall be [...] responsible for drawing up European search reports.

ARTICLE 18 EPC

Explanatory remarks

(Preparatory documents: CA/PL 2/98; CA/PL PV 6, points 28-34; CA/PL 31/00, point 3)

To ensure greater flexibility in determining when competence passes within the Office from one department to another, the **last part of Article 18(1) EPC has been deleted**. This is consequential to the proposed amendment of Article 16 EPC.

Present wording

Article 18

Examining Divisions

- (1) An Examining Division shall be responsible for the examination of each European patent application from the time when the Receiving Section ceases to be responsible.
- (2) An Examining Division shall consist of three technical examiners. Nevertheless, the examination prior to a final decision shall, as a general rule, be entrusted to one member of the Division itself. If the Examining Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner. In the event of parity of votes, the vote of the Chairman of the Division shall be decisive.

Revised wording

Article 18

Examining Divisions

- (1) **The** Examining Divisions shall be responsible for the examination of **any** European patent application. [...]
- (2) *Unchanged*

ARTICLE 22 EPC

Explanatory remarks

(Preparatory documents CA/PL 17/00; CA/PL PV 13, points 65-70; CA/PL 31/00, point 31)

1. The **Enlarged Board** is to be given the **competence to decide on petitions for review** under the conditions laid down in Article 112a EPC. **New Article 22(1)(c) EPC** extends the jurisdiction of the Enlarged Board of Appeal accordingly.
2. **Article 22(2) EPC** relates to the **composition of the Enlarged Board of Appeal**. With regard to referrals of a point of law by a board or the President nothing shall be changed. However, measures are necessary in order to avoid the work of the Enlarged Board as a seven-member body being blocked by petitions for review.
3. First, a filter shall be set up to sort out at the outset clearly inadmissible or clearly ill-founded petitions for review: three-member panels shall have the power by unanimous vote not to entertain inadmissible, in particular, insufficiently substantiated, or ill-founded petitions for review. Second, if the petition is admitted by the three-member panel the body responsible for the decision shall be the Enlarged Board composed of four lawyers and one technically-qualified member. It does not seem necessary for the Enlarged Board to sit with seven members since the object of such a petition is the correction of defects in individual cases rather than setting the course for EPO practice as in the case of a referral of a point of law by a board or the President.
4. The **second sentence of the revised Article 22(2) EPC** provides the basis for the Implementing Regulations to set up smaller bodies acting as the Enlarged Board in proceedings relating to petitions for review. It is envisaged to provide in the Implementing Regulations that a panel of the Enlarged Board of Appeal composed of two legally and one technically qualified members shall reject by unanimous vote petitions for review which are clearly inadmissible or clearly not allowable; the Enlarged Board composed of four legally and one technically qualified members shall examine the petition for review if the latter is not rejected by the panel mentioned above.
5. In order to be able to react to future experience with the new legal remedy flexibility needs to be preserved. Therefore it is appropriate to lay down the composition of these smaller bodies of the Enlarged Board in the Implementing Regulations. To provide for their composition in the Convention would imply also laying down in the EPC itself the tasks of these smaller bodies of the Enlarged Board, ie their function within the procedure relating to petition for review. Such a regulation would anticipate and pre-establish the procedure to an extent which is not desirable.

Present wording

Article 22

Enlarged Board of Appeal

(1) The Enlarged Board of Appeal shall be responsible for:

(a) deciding points of law referred to it by Boards of Appeal;

(b) giving opinions on points of law referred to it by the President of the European patent Office under the conditions laid down in Article 112.

(2) For giving decisions or opinions, the Enlarged Board of Appeal shall consist of five legally qualified members and two technically qualified members. One of the legally qualified members shall be the Chairman.

Revised wording

Article 22

Enlarged Board of Appeal

(1) The Enlarged Board of Appeal shall be responsible for:

(a) *Unchanged*

(b) *Unchanged*

(c) **deciding on petitions for review of decisions of the Boards of Appeal under the conditions laid down in Article 112a.**

(2) **[...] In proceedings under paragraph 1(a) and (b),** the Enlarged Board of Appeal shall consist of five legally qualified [...] and two technically qualified members. **In proceedings under paragraph 1(c), the Enlarged Board of Appeal shall consist of three or five members as laid down in the Implementing Regulations.** One of the legally qualified members shall be the chairman **in proceedings before the Enlarged Board of Appeal.**

ARTICLE 23 EPC

Explanatory remarks

(Preparatory documents: CA/PL 11/98; CA/PL PV 7, points 91 and 92; CA/PL 31/00, point 3)

1. **Article 23(1) EPC** provides that members of the Enlarged Board of Appeal and the boards of appeal shall be appointed for a term of five years and may not be removed from office during that term. In the past, the President and the Administrative Council have been asked to make exceptions in individual cases, so that board members who had reached the age limit of 65 could nevertheless remain in office until the expiry of their five-year term. The Administrative Council has repeatedly emphasised that Article 54(1) of the Service Regulations for permanent employees of the European Patent Office (ServRegs), stipulating that a permanent employee shall be retired on the last day of the month in which he reaches the age of 65, also applies to the members of the boards of appeal and the Enlarged Board.

The purpose of the **new provision in paragraph 1, second sentence**, is to make clear when the service of board members is terminated prior to the expiry of their five-year term (see Article 50(a) and (c) ServRegs).

2. In the **German version**, the word "Funktion" **in paragraph 1, first sentence**, is replaced by "Amt". This is purely for the sake of clarity and does not affect the English and French versions.

Present wording

Article 23

Independence of the members of the Boards

(1) The members of the Enlarged Board of Appeal and of the Boards of Appeal shall be appointed for a term of five years and may not be removed from office during this term, except if there are serious grounds for such removal and if the Administrative Council, on a proposal from the Enlarged Board of Appeal, takes a decision to this effect.

(2) The members of the Boards may not be members of the Receiving Section, Examining Divisions, Opposition Divisions or of the Legal Division.

(3) In their decisions the members of the Boards shall not be bound by any instructions and shall comply only with the provisions of this Convention.

(4) The Rules of Procedure of the Boards of Appeal and the Enlarged Board of Appeal shall be adopted in accordance with the provisions of the Implementing Regulations. They shall be subject to the approval of the Administrative Council.

Revised wording

Article 23

Independence of the members of the Boards

(1) The members of the Enlarged Board of Appeal and of the Boards of Appeal shall be appointed for a term of five years and may not be removed from office during this term, except if there are serious grounds for such removal and if the Administrative Council, on a proposal from the Enlarged Board of Appeal, takes a decision to this effect. **Notwithstanding sentence 1, the term of office of members of the Boards shall end if they resign or are retired in accordance with the Service Regulations for permanent employees of the European Patent Office.**

(2) *Unchanged*

(3) *Unchanged*

(4) *Unchanged*

ARTICLE 33 EPC

Explanatory remarks

(Preparatory documents: CA/PL 3/00 + Add. 1 and 2; CA/PL PV 12, points 11-22; CA/PL PV 13, points 10-19; CA/PL 31/00, point 32)

1. **Editorial changes have been made in the English and French texts of Article 33(1) EPC** to harmonise the three versions and cut out unnecessary detail. With the amendment of Articles 94 and 95 EPC, the references to them in Article 33(1)(a) EPC no longer apply and should be deleted.
2. A **new paragraph (1)(b)** has been added granting the **Administrative Council competence to amend EPC provisions** concerning patent law and procedural law in order **to ensure that the EPC is in line with international treaties and Community legislation relating to patents**. It is understood that the Administrative Council can exercise this competence in the case of any treaty, convention or Community text containing provisions relating to patent law (for example, the provisions of Part II, Section 5 of Annex 1C (the TRIPs Agreement) to the Agreement Establishing the World Trade Organization of 15 April 1994).
3. This new competence would allow any consensus already achieved at EU, WIPO or WTO level to be directly echoed in the EPC and would thus avoid having to hold revision conferences for the sole purpose of adapting the EPC to texts already adopted by all or a majority of contracting states. Furthermore, national ratification procedures, which are always of uncertain duration and outcome and the failure of which means the end of a state's participation in the EPC, would no longer be indispensable for the amended wording of an EPC article to enter into force. In this way a significant risk is eliminated and time savings of the order of several years can be achieved.
4. It is noteworthy that Article 16(1) of the **new Patent Law Treaty (PLT 2000**, WIPO document PT/DC/47), adopted on 1 June 2000, contains a provision of the very same nature, whereby the PLT Assembly may decide that any revision, amendment or modification of the PCT will apply for the purposes of the PLT. Article 16(1) PLT reads as follows:

"Subject to paragraph (2), any revision, amendment or modification of the Patent Cooperation Treaty made after June 2, 2000, which is consistent with the Articles of this Treaty, shall apply for the purposes of this Treaty and the Regulations if the Assembly so decides, in the particular case, by three-fourths of the votes cast."
5. The voting procedures and entry into force of a decision under the new Article 33(1)(b) EPC have been specified in **new Article 35(3) EPC**.

Present wording

Article 33

Competence of the Administrative
Council in certain cases

(1) The Administrative Council shall be competent to amend the following provisions of this Convention:

(a) the time limits laid down in this Convention; this shall apply to the time limit laid down in Article 94 only in the conditions laid down in Article 95;

(b) the Implementing Regulations.

(2) The Administrative Council shall be competent, in conformity with this Convention, to adopt or amend the following provisions:

(a) the Financial Regulations;

(b) the Service Regulations for permanent employees and the conditions of employment of other employees of the European Patent Office, the salary scales of the said permanent and other employees, and also the nature, and rules for the grant, of any supplementary benefits;

Revised wording

Article 33

Competence of the Administrative
Council in certain cases

(1) The Administrative Council shall be competent to amend the following provisions [...]:

(a) the time limits laid down in this Convention; [...]

(b) **Parts II to VIII and Part X of this Convention to bring them into line with an international treaty or European Community legislation relating to patents;**

(b) *Becomes (c) - Wording unchanged*

(2) - (4) *Unchanged*

Present wording

(c) the Pension Scheme Regulations and any appropriate increases in existing pensions to correspond to increases in salaries;

(d) the Rules relating to Fees;

(e) its Rules of Procedure.

(3) Notwithstanding Article 18, paragraph 2, the Administrative Council shall be competent to decide, in the light of experience, that in certain categories of cases Examining Divisions shall consist of one technical examiner. Such decision may be rescinded.

(4) The Administrative Council shall be competent to authorise the President of the European Patent Office to negotiate and, with its approval, to conclude agreements on behalf of the European Patent Organisation with States, with intergovernmental organisations and with documentation centres set up by virtue of agreements with such organisations.

Revised wording

ARTICLE 35 EPC

Explanatory remarks

(Preparatory documents: see Article 33 EPC)

1. **Changes to several EPC provisions entail the deletion of the references** to Articles 87, 95, 134, 151(3), 154(2), 155(2), 156, 157(2) to (4), 160, 162, 163 and 167 EPC, and **the inclusion of references** to the new Articles 134a, 149a(2), 152 and 153(7) EPC in **Article 35(2) EPC**.
2. The **new Article 35(3) EPC** is introduced in response to the need to lay down a special provision governing the adoption and entry into force of a decision of the Administrative Council under Article 33(1)(b) EPC modifying the EPC.

Three guarantees are laid down in Article 35(3) EPC:

- an Administrative Council decision under Article 33(1)(b) EPC requires **unanimity among the voting Contracting States** (Article 35(3), first sentence);
- **all the Contracting States must be represented** when votes are being cast (Article 35(3), second sentence);
- **each Contracting State has a period of 12 months** from the time the decision is adopted by the Administrative Council **in which to declare that it does not wish to be bound by the decision, thus preventing the decision's entry into force**. This period allows representatives of the Contracting States on the Administrative Council to confer with the national legislative bodies to ensure that the change is acceptable (Article 35(3), third sentence).

Present wording

Article 35
Voting rules

- (1) The Administrative Council shall take its decisions other than those referred to in paragraph 2 by a simple majority of the Contracting States represented and voting.
- (2) A majority of three-quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Council is empowered to take under Article 7, Article 11, paragraph 1, Article 33, Article 39, paragraph 1, Article 40, paragraphs 2 and 4, Article 46, Article 87, Article 95, Article 134, Article 151, paragraph 3, Article 154, paragraph 2, Article 155, paragraph 2, Article 156, Article 157, paragraphs 2 to 4, Article 160, paragraph 1, second sentence, Article 162, Article 163, Article 166, Article 167 and Article 172.

- (3) Abstentions shall not be considered as votes.

Revised wording

Article 35
Voting rules

- (1) The Administrative Council shall take its decisions other than those referred to in paragraphs 2 **and 3** by a simple majority of the Contracting States represented and voting.
- (2) A majority of three-quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Council is empowered to take under Article 7, Article 11, paragraph 1, Article 33, **paragraphs 1(a) and (c), and 2 to 4**, Article 39, paragraph 1, Article 40, paragraphs 2 and 4, Article 46, [...] **Article 134a, Article 149a, paragraph 2, Article 152, second sentence, Article 153, paragraph 7, Article 166 [...]** and Article 172.
- (3) **Unanimity of the Contracting States voting shall be required for the decisions which the Administrative Council is empowered to take under Article 33, paragraph 1(b). The Administrative Council shall take such decision only if all the Contracting States are represented. A decision taken on the basis of Article 33, paragraph 1(b), shall not take effect if a Contracting State declares, within 12 months of the date of the decision, that it does not wish to be bound by the decision.**

- (3) *Becomes (4) - Wording unchanged*

CHAPTER V: General

Explanatory remarks

(Preparatory documents: CA/49/00; CA/F 3/00; CA/74/00, points 174-179; CA/PL 31/00, point 3)

1. In their report for the 1998 accounting period, the Board of Auditors drew attention to the fact that the budgetary and accounting practice of the Organisation does not reflect the literal wording of the European Patent Convention.
2. The source of the problem lies in the present wording of Article 42 EPC. **New Article 42 EPC now introduces generally accepted accounting principles** as the sole basis of budgetary and financial practice. The further amendments to Articles 37, 38 and 50 EPC reflect this new approach and contain additional changes bringing these provisions into line with the current practice.

ARTICLE 37 EPC

1. **Article 37 EPC has been redrafted** and complemented so as to conform to the current practice of the Organisation. The sources of budgetary funding are now extended to third-party finance for specific restricted purposes (new letters (e) and (f)).

Present wording

Chapter V

Financial provisions

Article 37

Cover for expenditure

The expenditure of the Organisation shall be covered:

- (a) by the Organisation's own resources;
- (b) by payments made by the Contracting States in respect of renewal fees for European patents levied in these States;
- (c) where necessary, by special financial contributions made by the Contracting States;
- (d) where appropriate, by the revenue provided for in Article 146.

Revised wording

Chapter V

Financial provisions

Article 37

Budgetary funding

The **budget** of the Organisation shall be **financed**:

(a) - (d) *Unchanged*

(e) where appropriate, and for tangible assets only, by third-party borrowings secured on land or buildings;

(f) where appropriate, by third-party funding for specific projects.

ARTICLE 38 EPC

Explanatory remarks

1. The Board of Auditors also recommended that the pension liabilities of the Organisation should be recorded in the annual accounts.
2. **New Article 38** now includes the **Pension Reserve Fund as a special class of asset** of the Organisation and extends the definition of own resources.

Present wording

Article 38

The Organisation's own resources

The Organisation's own resources shall be the yield from the fees laid down in this Convention, and also all receipts, whatever their nature.

Revised wording

Article 38

The Organisation's own resources

The Organisation's own resources shall **comprise:**

- (a) all income from fees and other sources and also the reserves of the Organisation;**
- (b) the resources of the Pension Reserve Fund, which shall be treated as a special class of asset of the Organisation designed to lend support to the Organisation's pension scheme by providing the appropriate reserves.**

ARTICLE 42 EPC

Explanatory remarks

1. **New Article 42(1) EPC** makes it clear that the **budget must be balanced** and based on **generally accepted accounting principles** (GAAP) as defined in the Financial Regulations of the Organisation.

Present wording

Article 42
Budget

- (1) Income and expenditure of the Organisation shall form the subject of estimates in respect of each accounting period and shall be shown in the budget. If necessary, there may be amending or supplementary budgets.
- (2) The budget shall be balanced as between income and expenditure.
- (3) The budget shall be drawn up in the unit of account fixed in the Financial Regulations.

Revised wording

Article 42
Budget

- (1) **The budget** of the Organisation shall **be balanced. It shall be drawn up according to generally accepted accounting principles, as defined in the Financial Regulations.** If necessary, there may be amending or supplementary budgets.
- (2) ***Deleted***
- (3) *becomes (2) - Wording unchanged*

ARTICLE 50 EPC

Explanatory remarks

1. **The English version of Article 50(c) EPC** has been amended so as to conform to the actual text of the other official languages.
2. **New Article 50(g) EPC** is consequential to the amendments to Articles 38 and 42 EPC.

Present wording

Article 50

Financial Regulations

The Financial Regulations shall in particular establish:

- (a) the procedure relating to the establishment and implementation of the budget and for rendering and auditing the accounts
- (b) the method and procedure whereby the payments and contributions provided for in Article 37 and the advances provided for in Article 41 are to be made available to the Organisation by the Contracting States;
- (c) the rules concerning the responsibilities of accounting and paying officers and the arrangements for their supervision;
- (d) the rates of interest provided for in Articles 39, 40 and 47;
- (e) the method of calculating the contributions payable by virtue of Article 146;
- (f) the composition of and duties to be assigned to a Budget and Finance Committee which should be set up up by the Administrative Council.

Revised wording

Article 50

Financial Regulations

The Financial Regulations shall in particular establish:

- (a) *Unchanged*
- (b) *Unchanged*
- (c) the rules concerning the responsibilities of **authorising** and **accounting** officers and the arrangements for their supervision;
- (d) *Unchanged*
- (e) *Unchanged*
- (f) *Unchanged*
- (g) **the generally accepted accounting principles on which the budget and the annual financial statements shall be based.**

ARTICLE 51 EPC

Explanatory remarks

(Preparatory documents: CA/PL 8/00; CA/PL PV 13, points 25-30; CA/PL 31/00, point 7)

1. The fee system under the Convention is not entirely coherent and lacks transparency. Some fees are provided for in the Convention, with their time limits and the legal consequences for failure to pay in due time in the Convention itself. Other procedural fees are mentioned in the Convention along with the legal consequences of failure to pay in due time, but the time limits for payment are laid down in the Implementing Regulations. Finally, some procedural fees appear exclusively in the Implementing Regulations, along with their time limits and the legal consequences of failure to pay in due time.
2. Therefore, **Article 51 EPC** is amended to provide a more **coherent and systematic framework for the provisions governing fees**, thereby improving the transparency of the Convention in this respect.

Firstly, new Article 51(1) EPC provides a general clause enabling the European Patent Office to levy fees, since the Convention does not contain such a clause.

Secondly, under new Article 51(2) EPC, **time limits** for the payment of fees are **moved to the Implementing Regulations** with two exceptions: the time limits for payment of the opposition and appeal fees (Articles 99 and 108 EPC) remain in the Convention.

Thirdly, the amounts of the fees and the manner in which they are to be paid remain in the Rules relating to Fees pursuant to new Article 51(4) EPC.

3. Finally, there are only **two types of fees**: those provided for in the Convention itself, in which case the legal consequences of failure to pay in due time remain in the Convention; and those provided for in the Implementing Regulations, in which case the Implementing Regulations also lay down the consequences of failure to pay in a timely manner (new Article 51(3) EPC).

Present wording

Article 51

Rules relating to Fees

The Rules relating to Fees shall determine in particular the amounts of the fees and the ways in which they are to be paid.

Revised wording

Article 51

Fees

- (1) The European Patent Office may levy fees for any official task or procedure carried out under this Convention.**
- (2) Time limits for the payment of fees other than those fixed by this Convention shall be laid down in the Implementing Regulations.**
- (3) Where the Implementing Regulations provide that a fee shall be paid, they shall also lay down the consequences of failure to pay such fee in due time.**
- (4) The Rules relating to Fees shall determine in particular the amounts of the fees and the ways in which they are to be paid.**

ARTICLE 52 EPC

Explanatory remarks

(Preparatory documents: CA/PL 6/99; CA/PL PV 9, points 24-27; CA/PL 31/00, point 33)

1. **Article 52(1) EPC has been brought into line with Article 27(1), first sentence, of the TRIPs Agreement** with a view to: enshrining "technology" in the basic provision of substantive European patent law, clearly defining the scope of the EPC, and making it plain that patent protection is available to technical inventions of all kinds.
2. In light of the new wording of Article 52(1) EPC, it may be queried whether the provisions of **Article 52(2) and (3) EPC**, which enumerate subject-matter or activities not to be regarded as inventions are still needed.

In any event, the **deletion of computer programs from Article 52(2)(c) EPC** has met with broad consensus. The EPO and their Boards of Appeal have always interpreted and applied the EPC in such a way that this exception in no way excludes appropriate protection for software-related inventions, ie inventions whose subject-matter consists of or includes a computer program. Indeed, more recent decisions of the Boards of Appeal (see T 1173/97 - Computer program product/IBM, OJ EPO 1999, 609) have confirmed that computer programs producing a technical effect, as a rule, are patentable subject-matter under the EPC. Therefore, the current exception has become *de facto* obsolete.

3. Whilst the deletion of computer programs is unanimously approved, until now, there has been no agreement as to how to proceed with regard to Article 52(2) and (3) EPC. As a result, these provisions are included in the Basic Proposal in square brackets.

Present wording

Article 52

Patentable inventions

- (1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.
- (2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
- (a) discoveries, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
 - (d) presentations of information.
- (3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

Revised wording

Article 52

Patentable inventions

- (1) European patents shall be granted for any inventions **in all fields of technology, provided that they** are new, involve an inventive step and are susceptible of industrial application.
- [(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
- (a) discoveries, scientific theories and mathematical methods;
 - (b) aesthetic creations;
 - (c) schemes, rules and methods for performing mental acts, playing games or doing business [...];
 - (d) presentations of information.
- (3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.]

4. A small majority of delegations in the Patent Law Committee argue that these provisions should be left in the Convention, on the grounds that they constitute core elements of European patent law.
5. Some of the delegations in the Patent Law Committee, as well as the EPO (see CA/PL 6/99) support the deletion of Article 52(2) and (3) EPC altogether.

There is a long legal tradition in Europe that patent protection should be reserved for creations in the technical field. This is now clearly expressed in the new wording of Article 52(1) EPC. In order to be patentable, the subject-matter claimed must therefore have a "technical character" or to be more precise - involve a "technical teaching", ie an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means. It is on this understanding of the term "invention" that the patent granting practice of the EPO and the jurisprudence of the Boards of Appeal is based.

The list of items found in Article 52(2) EPC are simply examples of non-technical "inventions", which would remain unpatentable even in the absence of this provision. Simultaneously, the deletion of Articles 52(2) and (3) EPC would avoid all the problems the interpretation of any statutory exception entails. Thus, it should be incumbent on Office practice and case law to determine whether subject-matter claimed as an invention has a technical character and to further develop the concept of invention in an appropriate manner, in light of technical developments and the state of knowledge at the time.

6. A compromise solution endorsed by several delegations would be to transfer Article 52(2) and (3) EPC to the Implementing Regulations. There, these provisions would not be any less binding on the EPO, the Boards of Appeal, the national courts and authorities than they are at present under the Convention itself. However, the transfer to the Implementing Regulations would render these provisions easier to adapt where legal, economic or technical developments so require.
7. **Article 52(4) EPC is deleted and transferred to Article 53 EPC** (see explanatory remarks to Article 53(c) EPC).

Present wording

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods..

Revised wording

(4) **Deleted** - incorporated in Article 53 as new letter (c)

ARTICLE 53 EPC

Explanatory remarks

(Preparatory documents: CA/PL 8/99; CA/PL PV 9, points 32-34; CA/PL 31/00, point 34)

1. **Article 53(a) EPC has been brought into line with both Article 27.2 of the TRIPs agreement and with Article 6.1 of Directive 98/44/EC** relating to the legal protection of biotechnology inventions. The TRIPs agreement and the EC-Directive exclude from patentability only those inventions that must be barred from "**commercial exploitation**" to protect public order or morality. The word "**publication**" used in the current version of Article 53(a) EPC has therefore been deleted. This deletion entails no change to EPO practice.
2. From an editorial perspective, the **French wording of Article 53(a) EPC** has been brought into line with the German wording. The **German wording of Article 53(b) EPC** has been brought into line with the EC-Directive and Rule 23c (b) EPC.
3. **The exclusion of methods of treatment and diagnostic methods currently referred to in Article 52(4) EPC has been added to the two exceptions to patentability** which appear at present in Article 53(a) and (b) EPC. While these surgical or therapeutic methods constitute inventions, they have been excluded from patentability by the fiction of their lack of industrial applicability. It is undesirable to uphold this fiction since methods of treatment and diagnostic methods are excluded from patentability in the interests of public health. It is therefore preferable to include these inventions in the exceptions to patentability in order to group the three categories of exceptions to patentability together in Article 53(a), (b) and (c) EPC.
4. As Article 27(3)(a) TRIPs states that "diagnostic, therapeutic and surgical methods for the treatment of humans or animals" may be excluded from patentability, it is appropriate to transfer Article 52(4) to Article 53(c) with the aim of bringing the EPC into line with the TRIPs agreement.
5. The current wording of **Article 52(4) EPC reappears in the new Article 53(c) EPC**. A change in the EPO's current practice regarding these inventions is not envisaged.

Present wording

Article 53

Exceptions to patentability

European patents shall not be granted in respect of:

(a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

*(See current Article 52(4):
Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for the use in any of these methods.)*

Revised wording

Article 53

Exceptions to patentability

European patents shall not be granted in respect of:

(a) inventions the [...] **commercial** exploitation of which would be contrary to "ordre public" or morality, provided that **such** exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;

(b) *Unchanged*

(c) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body [...]; this provision shall not apply to products, in particular substances or compositions, for the use in any of these methods.

ARTICLE 54(4) EPC**Explanatory remarks**

(Preparatory documents: CA/PL 17/99; CA/PL PV 10, points 19-21; CA/PL 31/00, point 3)

1. Pursuant to Article 54(3) EPC, in order to preclude double patenting, European patent applications having an earlier filing or priority date than the filing or priority date of a second European patent application, and which are published on or after the filing date of that second application, are considered to form part of the state of the art for the purpose of examining the novelty of this second patent application. **Article 54(4) EPC** confines the prior art effect under Article 54(3) EPC to the minimum necessary to avoid a collision of rights, *ie* to those contracting states which are designated in both the earlier and the second application.
2. Originally, contracting states were designated upon filing the European application, and designation fees under Article 79(2) EPC were due well before the publication of the application, so that prior art under Article 54(3) was determinable for each contracting state by the time the second application was published.
3. Since the fee reform of 1997, applications as filed designate all contracting states and designation fees are payable within 6 months of the mention of the publication of the European search report. Pursuant to Rule 23a, a European application becomes prior art under Article 54(4) EPC for a given contracting state only once the designation fee has been validly paid. This postpones the time at which the Article 54(3) prior art can be determined by at least 6 months from the publication of the application, causing legal uncertainty and logistical problems, as an application may be ready for grant before it is possible to ascertain the relevant Article 54(3) prior art.
4. In 1999, a ceiling for the payment of designation fees was introduced, whereby upon payment of 7 designation fees, all 19 contracting states are deemed to be validly designated and paid for. Most applications now designate all contracting states, significantly reducing the number of cases in which Article 54(4) EPC brings advantages to the applicant.
5. As a result, **Article 54(4) EPC is deleted**, so that any European application falling under Article 54(3) constitutes prior art with effect for all the EPC contracting states at the time of its publication, eliminating the problems stemming from the 1997 fee reform. Accordingly, Rule 87 EPC shall be amended and Rule 23a EPC deleted.

Present wording

Article 54
Novelty

- (1) An invention shall be considered to be new if does not form part of the state of the art.
- (2) The state of the art shall be held to comprise everything made available to the public by means of an oral or written description, by use, or in any other way, before the date of filing of the European patent application.
- (3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.
- (4) Paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application, was also designated in respect of the earlier application as published.

Revised wording

Article 54
Novelty

- (1) *Unchanged*
- (2) *Unchanged*
- (3) *Unchanged*
- (4) ***Deleted***

ARTICLE 54(5) EPC

Explanatory remarks

(Preparatory documents: CA/PL 4/00 + Info 2/PL 12; CA/PL PV 12, points 23-31; Info 2/PL 14; CA/PL 31/00, point 39)

1. According to Article 54(5) EPC, by way of "compensation" for the exclusion from patentability of medical methods under Article 52(4), first sentence, EPC, known substances or compositions are deemed to be **new**, provided they are used **for the first time** in such a medical method. The Enlarged Board extended the novelty of the "**first** medical use", thus acknowledged in the legislation, to apply to **each further** medical use in the so-called "Swiss form of claim", ie to a claim "directed to the use of a substance or composition **for the manufacture** of a medicament for a specified new and inventive therapeutic application" (G 5/83, "Second medical indication/EISAI", OJ EPO 1985, 64; Legal Advice from the Swiss Federal Intellectual Property Office of 30 May 1984 (OJ EPO 1984, 581).
2. The national courts and appeal divisions of the patent offices of the contracting states have, for the sake of uniform jurisprudence, mainly followed this decision (UK High Court of Justice, "Second medical use/WYETH and SCHERING, OJ EPO 1986, 175; NL *Octrooiraad, Afdeling van Beroep* (Appeal Division of the Patent Office), "Second medical use/NL", OJ EPO 1988, 405; SE *Patentbesvärsträtten* (Court of Patent Appeals), *Hydropyridine/SE*", OJ EPO 1988, 198; FR *Cour de cassation*, "Alfuzosine", OJ EPO 1995, 252). However, the *Cour de cassation* held that a "second medical use" was not patentable. In the specific case in question, the *Octrooiraad* did not grant the patent. In a more recent decision, the UK High Court expressed substantial doubts as to the novelty of "Swiss claims" (Bristol-Myers Squibb Co. v. Baker Norton Pharmaceuticals Inc., R.P.C. 1999, 253).
3. The amendment to **Article 54(5) EPC (now paragraph 4)** eliminates this legal uncertainty. It unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine, in the same way as for a first medical use. This protection is equivalent, as far as the further uses are concerned, to that offered by the "Swiss form of claim".
4. **Putting the first medical use on a par with each further medical use in terms of novelty** does not have to affect the scope of the claims for the first medical use. Up till now, the case law of the boards of appeal and, consequently, the Office, has

Present wording

Article 54
Novelty

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52, paragraph 4, provided that its use for any method referred to in that paragraph is not comprised in the state of the art.

Revised wording

Article 54
Novelty

(4) Where the subject-matter of the invention is a substance or composition for use in a method referred to in Article 53(c), the substance or composition shall, without prejudice to paragraphs 2 and 3, be deemed to be new, provided that that use is not compromised in the state of the art.

granted a broad medical preparation claim for the first medical use, ie for a general therapeutical purpose, eg as a "pharmaceutical substance", a "therapeutic agent" or a "medicament", even if only one specific application is disclosed in the application (see T 128/82, "Pyrrolidine derivatives/HOFFMANN-LA ROCHE", OJ EPO 1984, 164; T 36/83, "Thenoyl peroxide/ROUSSEL-UCLAF" OJ EPO 1986, 295). The current version of Article 54(5) EPC neither prescribes nor proscribes the scope of the claims for the first medical use. The new version does not do so either, and therefore the permissible scope of the claims for a first medical use will continue to be a matter for case law.

5. Editorial amendments have also been made to this provision. The new version makes it clear that it relates to a **notional novelty** which does not affect the other requirements for "patentability". It also takes account of the deletion of Article 54(4) EPC and the incorporation of Article 52(4) EPC into Article 53(c) EPC.

ARTICLE 61 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, points 32-34; CA/PL 31/00, point 8)

1. Article 61 EPC deals with the remedies available where a person other than the applicant is held by a national court to be the person entitled to the grant of a European patent. Article 61(1) EPC specifies a number of conditions which must be met for such remedies to be available.
2. In line with the general streamlining of the Convention, the conditions contained in **Article 61(1) EPC** are transferred to the Implementing Regulations and an express reference to the Implementing Regulations is added to the article. This clause renders the enabling provision contained in Article 61(3) EPC redundant and **Article 61(3) EPC** is deleted accordingly.
3. The adding of the reference to sub-paragraph (b) in **Article 61(2) EPC** merely renders the provision more precise.

Present wording

Article 61

European patent applications by persons not having the right to a European patent

(1) If by a final decision it is adjudged that a person referred to in Article 60, paragraph 1, other than the applicant, is entitled to the grant of a European patent, that person may, within a period of three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention:

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused.

(2) The provisions of Article 76, paragraph 1, shall apply mutatis mutandis to a new application filed under paragraph 1.

(3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions applying to a new application filed under paragraph 1 and the time limit for paying the filing, search and designation fees on it are laid down in the Implementing Regulations.

Revised wording

Article 61

European patent applications **filed** by **non-entitled** persons

(1) If by a final decision it is adjudged that a person [...] other than the applicant, is entitled to the grant of **the** European patent, that person may [...] **in accordance with the Implementing Regulations:**

- (a) prosecute the application as his own application in place of the applicant,
- (b) file a new European patent application in respect of the same invention, or
- (c) request that the application be refused.

(2) The provisions of Article 76, paragraph 1, shall apply mutatis mutandis to a new application filed under paragraph 1**(b)**.

(3) ***Deleted*** - See revised wording of paragraph (1)

ARTICLE 65 EPC

Explanatory remarks

(Preparatory documents: CA/PL 29/99 Rev. 1; CA/PL PV 13, point 135; CA/PL 31/00, point 9)

1. The amendment to **Article 65 (1) EPC** includes the "amended European patent specification", to be published by the EPO within the context of the new limitation procedure (see Article 105a - 105c below). Thus each Contracting State can prescribe the filing of a translation of an amended European patent specification and sanction non-observance of such a provision under Article 65 (3) EPC.
2. Moreover Article 65 (1) and (2) are editorially simplified. A reference to the "applicant" seems to be unnecessary and misleading.

Present wording

Article 65

Translation of the specification of the European patent

(1) Any Contracting State may prescribe that if the text, in which the European Patent Office intends to grant a European patent or maintain a European patent as amended for that State, is not drawn up in one of its official languages, the applicant for or proprietor of the patent shall supply to its central industrial property office a translation of this text in one of its official languages at his option or, where that State has prescribed the use of one specific official language, in that language. The period for supplying the translation shall end three months after the date on which the mention of the grant of the European patent or of the maintenance of the European patent as amended is published in the European Patent Bulletin, unless the State concerned prescribes a longer period.

(2) Any Contracting State which has adopted provisions pursuant to paragraph 1 may prescribe that the applicant for or proprietor of the patent must pay all or part of the costs of publication of such translation within a period laid down by that State.

(3) Any Contracting State may prescribe that in the event of failure to observe the provisions adopted in accordance with paragraphs 1 and 2, the European patent shall be deemed to be void ab initio in that State.

Revised wording

Article 65

Translation of the [...] European patent

(1) Any Contracting State may, **if the European patent as granted, amended or limited by the European Patent Office** is not drawn up in one of its official languages, **prescribe that** the [...] proprietor of the patent shall supply to its central industrial property office a translation of the **patent as granted, amended or limited** in one of its official languages at his option or, where that State has prescribed the use of one specific official language, in that language. The period for supplying the translation shall end three months after the date on which the mention of the grant, **maintenance in amended form, or limitation** of the European patent is published in the European Patent Bulletin, unless the State concerned prescribes a longer period.

(2) Any Contracting State which has adopted provisions pursuant to paragraph 1 may prescribe that the [...] proprietor of the patent must pay all or part of the costs of publication of such translation within a period laid down by that State.

(3) *Unchanged*

ARTICLE 68 EPC

Explanatory remarks

(Preparatory documents: CA/PL 29/99 Rev. 1; CA/PL 19/00; CA/PL PV 13, points 105-107, 133; CA/PL 31/00, point 10)

1. The **new version of Article 68 EPC** incorporates limitation proceedings (see Article 105a-c below) and national revocation proceedings into the provisions governing opposition proceedings, whereby the European patent is deemed not to have had effect, as from the outset, to the extent that the patent has been revoked or limited.
2. **Article 68 EPC** thus uniformly establishes the **retroactive effect of limiting or revoking a European patent in opposition, limitation and (national) revocation proceedings**. The inclusion of national revocation proceedings reflects the fact that the revocation of European patents now has an *ex tunc* effect in all contracting states, and it formalises the harmonisation achieved in that respect.

Present wording

Article 68

Effect of revocation of the European patent

The European patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in Articles 64 and 67, to the extent that the patent has been revoked in opposition proceedings.

Revised wording

Article 68

Effect of revocation **or limitation** of the European patent

The European patent application and the resulting patent shall be deemed not to have had, as from the outset, the effects specified in Articles 64 and 67, to the extent that the patent has been revoked **or limited** in opposition, **limitation or revocation** proceedings.

ARTICLE 69 EPC and PROTOCOL ON ITS INTERPRETATION**Explanatory remarks**

(Preparatory documents: CA/PL 25/00 Add. 2; CA/PL 31/00, point 41)

1. Pursuant to the current version of **Article 69(1) EPC**, the extent of protection of a European patent is determined by the "**terms**" of the claims. The expressions "**Inhalt**", "**terms**", "**teneur**" are unclear in scope and do not have the same meaning in all three official languages. The corresponding provision in the WIPO Basic Proposal for a Patent Law Treaty of 1991 did not include this particular construction, and merely set forth that the extent of protection shall be determined by the claims. The reference to the "terms" of the claims can also be dispensed with in view of the Protocol on the Interpretation of Article 69 EPC. **Article 69 is therefore redrafted accordingly.**
2. **Article 69(2), first sentence, EPC** clarifies that the extent of protection of the European patent application is determined by the claims as contained in the **published application**. This is either the European patent application published under Article 93 EPC or the Euro-PCT application published pursuant to new Article 153(3) or (4) EPC.

Article 69(2), second sentence, EPC now not only refers to opposition proceedings, but also to the new limitation and to national revocation proceedings. A limitation of the European patent in any of these proceedings retroactively limits the extent of protection conferred by the application (see Article 68 EPC).

Present wording

Article 69

Extent of protection

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the latest filed claims contained in the publication under Article 93. However, the European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended.

Revised wording

Article 69

Extent of protection

(1) The extent of the protection conferred by a European patent or a European patent application shall be determined by [...] the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

(2) For the period up to grant of the European patent, the extent of the protection conferred by the European patent application shall be determined by the [...] claims contained in the **application as published**. However, the European patent as granted or as **limited** in opposition, **limitation or revocation** proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended.

3. The present provisions governing the **extent of protection** conferred by a European patent, ie **Article 69 EPC and the Protocol on its interpretation**, have turned out not to achieve, to the extent desired, the goal of ensuring as uniform an application and interpretation as possible. In particular, this is the case regarding the treatment of so-called **equivalents** and the importance of **prior statements** made by the applicant for or proprietor of a patent in the application or in the specification or during prosecution before the EPO or in proceedings concerning the validity of the patent.

In applying these provisions in litigation concerning the infringement of European patents, the national courts of the EPC contracting states have tried since the beginning to develop as harmonised a practice as possible. However, despite some progress, not least due to regular European Patent Judges' Symposia, case law has failed so far to develop Europe-wide uniform criteria and rules for the interpretation of European patents and the assessment of their extent of protection. This lack of uniformity especially applies to the two important issues referred to above.

4. In order to strengthen and clarify the extent of protection under Article 69 EPC, and to contribute to a more uniform court practice in Europe, **the Protocol on its interpretation should be supplemented by a few rules regarding the significance of equivalents and limiting statements in assessing the extent of protection.**

The proposed provisions are inspired from the WIPO Basic Proposal for a Patent Law Treaty of 1991 and placed in square brackets given the fact that definite opinions on the matter have not yet been formed. Nevertheless, these proposals have met with broad support in both the Standing Advisory Committee before the EPO (SACEPO) and the Committee on Patent Law.

Present wording

Protocol on the Interpretation of Article 69 EPC

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

Revised wording

*[New provisions supplementing the
Protocol on the interpretation of
Article 69 EPC]*

Equivalents

(1) For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of means which at the time of the alleged infringement are equivalent to the means specified in the claims.

(2) A means shall generally be considered as being equivalent if it would be obvious to a person skilled in the art that using such means would achieve substantially the same result as that achieved through the means specified in the claim.

Prior statements ("Prosecution history estoppel")

(3) For the purpose of determining the extent of protection, due account shall be taken of any statement unambiguously limiting the extent of protection, made by the applicant or the proprietor of the patent in the European patent application or patent, or during proceedings concerning the grant or the validity of the European patent, in particular where the limitation was made in response to a citation of prior art.]

ARTICLE 75 EPC

Explanatory remarks

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, point 34; CA/PL 31/00, point 3)

1. **Article 75(1)(a) EPC** restricts the filing of European patent applications to the Munich Office and to the branch at The Hague. The provision does not reflect the practice of the Office, since filing offices have been set up by decision of the President both in the Berlin sub-Office and in the Munich "Pschorrhöfe" building (see OJ EPO 1989, 218 and OJ EPO 1991, 223 respectively).
2. Therefore, **the geographic restriction to Munich and The Hague** is removed. Provisions determining where European patent applications shall be filed are more appropriately inserted into the Implementing Regulations.
3. In view of Article 76(1) EPC, which stipulates that any European divisional application shall be filed directly with the European Patent Office, **Article 75(3) EPC is redundant** and thus deleted as unnecessary, whilst a reminder referring to Article 76(1) EPC is added to **Article 75(1)(b) EPC**.
4. Further changes to the English version of Article 75(1) EPC are intended to render it more consistent with its French and German counterparts.

Present wording

Article 75

Filing of the European patent application

- (1) A European patent application may be filed:
- (a) at the European Patent Office at Munich or its branch at The Hague, or
- (b) if the law of a Contracting State so permits, at the central industrial property office or other competent authority of that State. An application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office.
- (2) The provisions of paragraph 1 shall not preclude the application of legislative or regulatory provisions which, in any Contracting State:
- (a) govern inventions which, owing to the nature of their subject-matter, may not be communicated abroad without the prior authorisation of the competent authorities of that State, or
- (b) prescribe that each application is to be filed initially with a national authority or make direct filing with another authority subject to prior authorisation.
- (3) No Contracting State may provide for or allow the filing of European divisional applications with an authority referred to in paragraph 1(b).

Revised wording

Article 75

Filing of the European patent application

- (1) **The** European patent application may be filed:
- (a) at the European Patent Office, [...] or
- (b) if the law of a Contracting State so permits, **and subject to Article 76 paragraph 1**, at the central industrial property office or other competent authority of that State. **Any** application filed in this way shall have the same effect as if it had been filed on the same date at the European Patent Office.
- (2) *Unchanged*
- (3) ***Deleted***

ARTICLE 76 EPC

Explanatory remarks

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, points 31-32 and 34; CA/PL 31/00, point 11)

1. Article 76 EPC governs the filing of European divisional applications. In order to increase the flexibility of the Convention in this respect and in line with the amendment to Article 75(1) EPC, the geographic restriction contained in **Article 76(1) EPC** to the effect that European divisional applications shall be filed in Munich or at the branch in The Hague is removed. Provisions determining where such divisional applications may be filed are more appropriately found in the Implementing Regulations. The further changes in the English version of Article 76(1) are stylistic in nature.
2. In the French version of Article 76(1) EPC, the word "initiale", referring to the application, has been replaced by the term "antérieure", which is closer to the terminology used in the English and German versions of the paragraph, in order to clarify that the Convention allows that a divisional application be derived from an earlier divisional application as well.
3. **Article 76 EPC is streamlined in that paragraph (3) is deleted and a standard clause** referring to the Implementing Regulations **is inserted in paragraph (1)**, regarding any further rules applicable to the procedure to be followed upon filing a divisional application.
4. The designation system contained in Article 79 EPC has been modified, thereby entailing a **consequential amendment of Article 76(2) EPC**. Whereas Article 79(1) EPC currently provides that contracting states for which protection is sought shall be designated in the request for grant, **new Article 79(1) EPC** stipulates that all the Contracting States party to this Convention at the time of the filing of a European patent application shall be deemed to be designated in the request for grant. However, the designation of a Contracting State may be withdrawn by the applicant at any time or deemed withdrawn through non-payment of the designation fee. Therefore, Article 76(2) EPC is amended accordingly, to ensure that only those Contracting States which remain designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application.

Present wording

Article 76

European divisional applications

- (1) A European divisional application must be filed directly with the European Patent Office at Munich or its branch at The Hague. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.
- (2) The European divisional application shall not designate Contracting States which were not designated in the earlier application.
- (3) The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions to be complied with by a divisional application and the time limit for paying the filing, search and designation fees are laid down in the Implementing Regulations.

Revised wording

Article 76

European divisional applications

- (1) **Any** European divisional application **shall** be filed directly with the European Patent Office [...] **in accordance with the Implementing Regulations**. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this **requirement** is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall **enjoy** any right of priority.
- (2) **All the Contracting States designated in the earlier application at the time of filing of a European divisional application, shall be deemed to be designated in the divisional application.**
- (3) ***Deleted*** - See revised wording of paragraph (1)

ARTICLE 77 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, points 31-32 and 34; CA/PL 31/00, point 12)

1. **Article 77 EPC** deals with the forwarding to the EPO of European patent applications filed at the central industrial property offices of the Contracting States.
2. In the interest of increasing the flexibility of the Convention, **paragraphs (2) and (3) and some details contained in paragraphs (1) and (5) of Article 77 EPC are deleted** within the context of the streamlining exercise **and their substance is to be transferred to the Implementing Regulations**.
3. The **English version of new Article 77(4) and (5) EPC** has been slightly redrafted to ensure consistency throughout the Convention.

Present wording

Article 77

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State shall be obliged to forward to the European Patent Office, in the shortest time compatible with the application of national law concerning the secrecy of inventions in the interests of the State, any European patent applications which have been filed with that office or with other competent authorities in that State.

(2) The Contracting States shall take all appropriate steps to ensure that European patent applications, the subject of which is obviously not liable to secrecy by virtue of the law referred to in paragraph 1, shall be forwarded to the European Patent Office within six weeks after filing.

(3) European patent applications which require further examination as to their liability to secrecy shall be forwarded in such manner as to reach the European Patent Office within four months after filing, or, where priority has been claimed, fourteen months after the date of priority.

(4) A European patent application, the subject of which has been made secret, shall not be forwarded to the European Patent Office.

Revised wording

Article 77

Forwarding of European patent applications

(1) The central industrial property office of a Contracting State shall [...] forward to the European Patent Office [...] any European patent application [...] filed with **it** or [...] **any** other competent **authority** in that State, **in accordance with the Implementing Regulations**.

(2) ***Deleted - To be incorporated in the Implementing Regulations***

(3) ***Deleted - To be incorporated in the Implementing Regulations***

(2) Any European patent application the subject of which has been made secret, shall not be forwarded to the European Patent Office.

(5) European patent applications which do not reach the European Patent Office before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority, shall be deemed to be withdrawn. The filing, search and designation fees shall be refunded.

(3) Any European patent application [...] not forwarded to the European Patent Office [...] in due time shall be deemed to be withdrawn. [...]

ARTICLE 78 EPC

Explanatory remarks

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, points 31-34; CA/PL 31/00, point 3)

1. **Article 78 EPC** governs the requirements which must be fulfilled by a European patent application.
2. The modifications brought to Article 78 EPC are not substantive in nature. Within the context of the streamlining exercise, **Article 78(3) EPC has been deleted and a similar clause inserted in new Article 78(1) EPC.**
3. The replacement of the indefinite article "A" in Article 78(1) and (2) EPC by the definite article "The" is intended to align the English version with its French and German counterparts.
4. Finally, the **legal consequence of the failure to pay** the filing or the search fee in due time, **currently found in Article 90(3) EPC**, is **added to new Article 78(2) EPC.**

Present wording

Article 78

Requirements of the European
patent application

(1) A European patent application shall contain:

- (a) a request for the grant of a European patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract.

(2) A European patent application shall be subject to the payment of the filing fee and the search fee within one month after the filing of the application.

(3) A European patent application must satisfy the conditions laid down in the Implementing Regulations.

Revised wording

Article 78

Requirements of the European
patent application

(1) [...] **The** European patent application shall contain:

- (a) a request for the grant of a European patent;
- (b) a description of the invention;
- (c) one or more claims;
- (d) any drawings referred to in the description or the claims;
- (e) an abstract,

and satisfy the conditions laid down in the Implementing Regulations

(2) **The** European patent application shall be subject to the payment of the filing fee and the search fee. [...] **If the filing fee or the search fee has not been paid in due time, the application shall be deemed to be withdrawn.**

(3) ***Deleted*** - See revised paragraph (1)

ARTICLE 79 EPC

Explanatory remarks

(Preparatory documents: CA/PL 13/00; CA/PL PV 13, points 35-37; CA/PL 31/00, point 3)

1. Article 3 EPC specifies that the grant of a European patent may be requested for one or more of the Contracting States. This is effected through the mechanism of **Article 79 EPC**, which provides that the request for the grant of a European patent shall contain the designation of the Contracting State(s) in which protection is desired.
2. Initially, Contracting States had to be positively designated in the request for grant. However, this practice caused problems since in principle, a later designation made after the filing date of the European patent application was inadmissible. In order to alleviate these difficulties, the Request for Grant form was amended to include a pre-crossed, precautionary designation of all Contracting States. With the 1997 fee reform, the pre-crossed box in the Request for Grant form became an express designation of all the Contracting States, and a system was introduced whereby applicants could indicate their intention to pay designation fees for specific countries. In the wake of the 1999 fee reform, which introduced a ceiling for the payment of designation fees, fixed at 7 designation fees, an ever-increasing number of applicants effectively validly designate all the Contracting States.
3. Therefore, the Convention is revised to reflect this practice more accurately, by **providing in Article 79(1) EPC that the applicant shall be deemed to have designated all the Contracting States which are party to the Convention at the time the application is filed**. Applicants continue to have the option of withdrawing designations pursuant to the provisions of Article 79(3) EPC and may do so at the outset, upon filing the European patent application, if they so wish.
4. **Article 79(2) EPC** is also amended by providing that the designation of a Contracting State **may** be subject to the payment of a designation fee, turning the clause from a mandatory to an enabling one and thereby increasing the flexibility of the Convention on this point.
5. Finally, the **time limit** for the payment of designation fees contained in **Article 79(2) EPC** and the **last 2 sentences of Article 79(3) EPC are deleted** and their substance is moved to the Implementing Regulations.
6. The amendments to the French and German versions of new Article 79(3) EPC aim to improve the consistency of the text in all three languages.

Present wording

Article 79

Designation of Contracting States

- (1) The request for the grant of a European patent shall contain the designation of the Contracting State or States in which protection for the invention is desired.
- (2) The designation of a Contracting State shall be subject to the payment of the designation fee. The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.
- (3) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application. Designation fees shall not be refunded.

Revised wording

Article 79

Designation of Contracting States

- (1) **All the Contracting States party to this Convention at the time of filing of the European patent application shall be deemed to be designated in the request for grant of a European patent.**
- (2) The designation of a Contracting State **may** be subject to the payment of a designation fee. [...]
- (3) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. [...]

ARTICLE 80 EPC

Explanatory remarks

(Preparatory documents: CA/PL 5/00; CA/PL PV 12, points 37-42; CA/PL 31/00, point 13)

Article 80 EPC no longer lists the requirements for the accordane of a date of filing; these are **transferred to the Implementing Regulations**, which will reflect the **worldwide standard laid down in Article 5 of the Patent Law Treaty, 2000**.

Present wording

Article 80
Date of filing

The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:

- (a) an indication that a European patent is sought;
- (b) the designation of at least one Contracting State;
- (c) information identifying the applicant;
- (d) a description and one or more claims in one of the languages referred to in Article 14, paragraphs 1 and 2, even though the description and the claims do not comply with the other requirements of this Convention.

Revised wording

Article 80
Date of filing

The date of filing of a European patent application shall be the date on which **the requirements laid down in the Implementing Regulations are fulfilled.**

ARTICLE 86 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 12/00; CA/PL PV 13, points 31-34; CA/PL 31/00, point 3)

1. **Article 86 EPC** governs the payment of renewal fees for European patent applications which are still pending after 2 years from the date of filing of the application.
2. The amendment of the first sentence of the English version of **Article 86(1) EPC** is a drafting improvement.
3. The French version of the second sentence of Article 86(1) EPC is amended, in order to ensure its consistency with the English and German texts.
4. **Article 86 EPC is streamlined by deleting paragraph (2)**, which deals with late payment of renewal fees within 6 months of the due date, and moving its substance to the Implementing Regulations.
5. **Article 86(3) EPC is also deleted and the legal consequence** of a failure to pay the renewal fee in due time is added to **Article 86(1) EPC**. It is emphasised that this does not modify the current situation, and pursuant to the future Implementing Regulations, the application shall only be deemed to be withdrawn if the renewal fee and any additional fee have not been validly paid within the prescribed grace period for payment.
6. The **second sentence of Article 86(3) EPC**, to the effect that the European Patent Office alone shall be competent to decide when the application is deemed to be withdrawn, is superfluous and therefore deleted.

Present wording

Article 86

Renewal fees for European
patent applications

(1) Renewal fees shall be paid to the European Patent Office in accordance with the Implementing Regulations in respect of European patent applications. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application.

(2) When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time.

(3) If the renewal fee and any additional fee have not been paid in due time the European patent application shall be deemed to be withdrawn. The European Patent Office alone shall be competent to decide this.

(4) The obligation to pay renewal fees shall terminate with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published.

Revised wording

Article 86

Renewal fees for European
patent applications

(1) Renewal fees **for European patent applications** shall be paid to the European Patent Office in accordance with the Implementing Regulations [...]. These fees shall be due in respect of the third year and each subsequent year, calculated from the date of filing of the application. **If a renewal fee has not been paid in due time, the application shall be deemed to be withdrawn.**

(2) **Deleted** - *To be incorporated in the Implementing Regulations.*

(3) **Deleted** - *See the amendment to paragraph (1)*

(4) *becomes (2) - Wording unchanged*

ARTICLE 87 EPC

Explanatory remarks

(Preparatory documents: CA/PL 16/98; CA/PL 9/99 and Rev.1; CA/PL PV 8, points 5-8; CA/PL PV 9, points 35-40; CA/PL PV 13, points 38-41; CA/PL 31/00, point 14)

1. **Article 87 EPC** deals with the recognition of priority rights. Article 87(1) EPC limits the automatic recognition of these rights to states which are party to the Paris Convention. Thus, **Article 87(1) EPC is amended to align it with Article 2 of the TRIPs Agreement**, which requires that priority rights also be extended to first filings made in any WTO member state.
2. Furthermore, the wording of Article 87(1) EPC is updated by **removing the reference to inventor's certificates**, which is now obsolete.
3. The French and German versions of new Article 87(1) EPC are brought into line with the more precise English expression referring to the "date of filing" of the application.

Present wording

Article 87
Priority right

(1) A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

(2) Every filing that is equivalent to a regular national filing under the national law of the State where it was made or under bilateral or multilateral agreements, including this Convention, shall be recognised as giving rise to a right of priority.

(3) By a regular national filing is meant any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application.

Revised wording

Article 87
Priority right

(1) A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property **or the Agreement Establishing the World Trade Organization**, an application for a patent, [...] a utility model or [...] a utility certificate [...], or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

(2) *Unchanged*

(3) *Unchanged*

4. **Article 87(5) EPC** prescribes a mechanism for the mutual recognition of priority rights with third countries where automatic recognition pursuant to Article 87(1) EPC does not apply. This mechanism is so unwieldy that it has never been activated. Hence, Article 87(5) EPC is amended in order to make its application a simple, rapid and viable option where the mutual recognition of priority rights between the EPO and a non-Paris Union, non-WTO state is deemed to be desirable.
5. **New Article 87(5) EPC** thus enables the President of the European Patent Office, rather than the Administrative Council, to issue the communication, and refers to industrial property authorities rather than to states. These two changes remove this essentially technical issue of recognition of priority rights from the political arena, and allow it to be dealt with more appropriately and effectively at a technical, working level.
6. In addition, since the terms for recognising a priority right are well laid down in the Paris Convention, there is no need to set up a comprehensive framework regarding such recognition, and a communication noting the *de facto* mutual recognition of priority rights in conformity with the Paris Convention should suffice. Therefore, the requirement that a bilateral or multilateral agreement be concluded is removed.
7. The requirement that the other country in question accord such priority rights for first filings made in or for any EPC contracting state is also removed, as the retaining of such a requirement would cause Article 87(5) EPC to remain completely unworkable.
8. Finally, in order to ensure greater consistency of the **English version** with its German and French counterparts, the word "notification" in the English version is replaced by "communication".

Present wording

(4) A subsequent application for the same subject-matter as a previous first application and filed in or in respect of the same State shall be considered as the first application for the purposes of determining priority, provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) If the first filing has been made in a State which is not a party to the Paris Convention for the Protection of Industrial Property, paragraphs 1 to 4 shall apply only in so far as that State, according to a notification published by the Administrative Council, and by virtue of bilateral or multilateral agreements, grants on the basis of a first filing made at the European Patent Office as well as on the basis of a first filing made in or for any Contracting State and subject to conditions equivalent to those laid down in the Paris Convention, a right of priority having equivalent effect.

Revised wording

(4) *Unchanged*

(5) If the first filing has been made **at an industrial property authority [...]** which is not [...] **subject to** the Paris Convention for the Protection of Industrial Property **or the Agreement Establishing the World Trade Organization**, paragraphs 1 to 4 shall apply [...] **if that authority**, according to a **communication issued by the President of the European Patent Office [...], recognises that** a first filing made at the European Patent Office [...] **gives rise to** a right of priority **under** conditions **and with effects** equivalent to those laid down in the Paris Convention.

ARTICLE 88 EPC

Explanatory remarks

(Preparatory documents: CA/PL 17/98; CA/PL PV 8, point 8; CA/PL 31/00, point 3)

1. **Article 88(1) EPC** governs some of the formal requirements for claiming priority. Applicants wishing to claim priority must file a declaration of priority, a copy of the previous application and, where the latter is not in an official language of the EPO, a translation of the previous application into one of those languages. Further formal conditions are contained in Rule 38 EPC.
2. The formal requirements for claiming priority have evolved in light of changing international standards and the ongoing progress in both electronic communication and international cooperation between patent offices. Thus, the recently concluded **Patent Law Treaty (PLT)** contains rules restricting the requirements for claiming priority which may be imposed on applicants by patent offices.
3. The requirement under Article 88(1) EPC that a copy of the previous application and its translation must be filed in all cases must be altered. Pursuant to both Rule 51 bis.1 (e) PCT (with regard to which the EPO had to make a reservation) and Rule 4(4) PLT, where the earlier application is not in a language accepted by the Office, a translation of the priority document may only be required where the validity of the priority claim is relevant to the determination of the patentability of the invention concerned.
4. Moreover, Rule 4(3) PLT specifies that where the earlier application was filed at the same Office or is available to that Office from a digital library it accepts, the Office may not require that a copy of the previous application be filed. Although Rule 38(4) EPC already relieves the applicant of this obligation under Article 88(1) EPC in certain specific cases (see the Decision of the President of the EPO dated 22.12.1998, OJ EPO 1999, 80), further alignment of Article 88(1) EPC is necessary to ensure full compliance with the PLT.
5. Therefore, in order to increase the **flexibility** of the Convention in this respect, **all formal requirements for claiming priority contained in Article 88(1) EPC are moved to the Implementing Regulations**, which will have to reflect the norms imposed by the PLT and the PCT.

Present wording

Article 88

Claiming priority

(1) An applicant for a European patent desiring to take advantage of the priority of a previous application shall file a declaration of priority, a copy of the previous application and, if the language of the latter is not one of the official languages of the European Patent Office, a translation of it in one of such official languages. The procedure to be followed in carrying out these provisions is laid down in the Implementing Regulations.

(2) Multiple priorities may be claimed in respect of a European patent application, notwithstanding the fact that they originated in different countries. Where appropriate, multiple priorities may be claimed for any one claim. Where multiple priorities are claimed, time limits which run from the date of priority shall run from the earliest date of priority.

(3) If one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed.

(4) If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements.

Revised wording

Article 88

Claiming priority

(1) An applicant for a European patent desiring to take advantage of the priority of a previous application shall file a declaration of priority **and any other document required in accordance with the Implementing Regulations.**

(2) *Unchanged*

(3) *Unchanged*

(4) *Unchanged*

ARTICLE 90 EPC

Explanatory remarks

(Preparatory documents CA/PL 5/00; CA/PL PV 12, points 37-42; CA/PL 31/00, point 3)

1. **Article 90(1) EPC** corresponds to the present Article 90(1)(a) EPC, and has been redrafted.
2. **Article 90(2) EPC** remains in essence the same. The opportunity to correct deficiencies is now laid down in new paragraph 4.
3. **New Article 90(3) EPC** replaces present Articles 90(1)(b) and 91(1) EPC. The details of carrying out the formalities' examination are transferred to the Implementing Regulations. The legal consequences addressed in current Article 90(3) EPC are now contained in Articles 14(2) and 78(2) EPC.

Present wording

Article 90

Examination on filing

- (1) The Receiving Section shall examine whether:
- (a) the European patent application satisfies the requirements for the accordance of a date of filing;
- (b) the filing fee and the search fee have been paid in due time;
- (c) in the case provided for in Article 14, paragraph 2, the translation of the European patent application in the language of the proceedings has been filed in due time.
- (2) If a date of filing cannot be accorded, the Receiving Section shall give the applicant an opportunity to correct the deficiencies in accordance with the Implementing Regulations. If the deficiencies are not remedied in due time, the application shall not be dealt with as a European patent application.
- (3) If the filing fee and the search fee have not been paid in due time or, in the case provided for in Article 14, paragraph 2, the translation of the application in the language of the proceedings has not been filed in due time, the application shall be deemed to be withdrawn.

Revised wording

Article 90

Examination on filing **and as to formal requirements**

- (1) The **European Patent Office** shall examine **in accordance with the Implementing Regulations** whether the [...] application satisfies the requirements for the accordance of a date of filing.
- (2) If a date of filing cannot be accorded **following the examination under paragraph 1**, the application shall not be dealt with as a European patent application.
- (3) **If the European patent application has been accorded a date of filing, the European Patent Office shall examine in accordance with the Implementing Regulations whether the requirements in Articles 14, 78, 81 and, where applicable, 88, paragraph 1, and 133, paragraph 2, as well as any other requirement laid down in the Implementing Regulations, have been satisfied.**

4. **New Article 90(4) EPC** guarantees that the applicant will always be given the opportunity to correct deficiencies, as is presently laid down in Articles 90(2) and 91(2) EPC.
5. The legal effect of any deficiencies established by the EPO and not corrected by the applicant is now included in **new Article 90(5) EPC**. The wording corresponds to that of present Article 91(3) EPC.

The legal effect mentioned in present Article 91(4) EPC needs not to be retained in the Convention. Under new Article 79(2) EPC the levying of designation fees may be provided in the Implementing Regulations. Therefore, the effect of non-payment should also be regulated there.

The omission of the designation of inventor now also leads to a refusal of the application, and no longer to the application being deemed withdrawn as presently stated in Article 91(5) EPC. There appears to be no logical reason for the different legal effects in current Article 91(3) and (5) EPC. All deficiencies concern obligations that must, in principle, be fulfilled on filing.

Article 91(6) EPC needs not to be retained in the Convention either as it regulates a matter concerning the filing date, and should therefore be dealt with in the Implementing Regulations to Article 90(1) EPC.

Present wording

(See current Article 91(2):

(2) Where the Receiving Section notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them in accordance with the Implementing Regulations.)

(See current Article 91(3):

(3) If any deficiencies noted in the examination under paragraph 1(a) to (d) are not corrected in accordance with the Implementing Regulations, the application shall be refused; where the provisions referred to in paragraph 1(d) concern the right of priority, this right shall be lost for the application.

Revised wording

(4) Where the **European Patent Office in carrying out the examination under paragraphs 1 or 3** notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them [...].

(5) If any **deficiency** noted in the examination under paragraph **3** **is** not corrected [...], the application shall be refused. Where the **deficiency** concerns the right of priority, this right shall be lost for the application.

ARTICLE 91 EPC

Explanatory remarks

(Preparatory documents: CA/PL 5/00; CA/PL PV 12, points 37-42; CA/PL 31/00, point 3)

This article is deleted in its entirety. **All necessary matter is now covered by new Article 90 EPC.**

Present wording

Article 91

Examination as to formal requirements

(1) If a European patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Receiving Section shall examine whether:

- (a) the requirements of Article 133, paragraph 2, have been satisfied;
- (b) the application meets the physical requirements laid down in the Implementing Regulations for the implementation of this provision;
- (c) the abstract has been filed;
- (d) the request for the grant of a European patent satisfies the mandatory provisions of the Implementing Regulations concerning its content and, where appropriate, whether the requirements of this Convention concerning the claim to priority have been satisfied;
- (e) the designation fees have been paid;
- (f) the designation of the inventor has been made in accordance with Article 81;
- (g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.

(2) Where the Receiving Section notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them in accordance with the Implementing Regulations.

Revised wording

Deleted

(1) See new Article 90(3)

(2) See new Article 90(4)

Present wording

(3) If any deficiencies noted in the examination under paragraph 1(a) to (d) are not corrected in accordance with the Implementing Regulations, the application shall be refused; where the provisions referred to in paragraph 1(d) concern the right of priority, this right shall be lost for the application.

(4) Where, in the case referred to in paragraph 1(e), the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.

(5) Where, in the case referred to in paragraph 1(f), the omission of the designation of the inventor is not, in accordance with the Implementing Regulations and subject to the exceptions laid down therein, corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn.

(6) Where, in the case referred to in paragraph 1(g), the drawings were not filed on the date of filing of the application and no steps have been taken to correct the deficiency in accordance with the Implementing Regulations, either the application shall be re-dated to the date of filing of the drawings or any reference to the drawings in the application shall be deemed to be deleted, according to the choice exercised by the applicant in accordance with the Implementing Regulations.

Revised wording

(3) *See new Article 90(5)*

(4) *To be incorporated into the Implementing Regulations*

(5) *See new Article 90(5)*

(6) *To be incorporated into the Implementing Regulations*

ARTICLE 92 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 14/00; CA/PL PV 13, points 42-45; CA/PL 31/00, point 3)

1. **Article 92(1) EPC has been redrafted without any change in substance.** The purpose of the article is to indicate that the EPO is to draw up search reports on pending European applications for which the search fee has been paid. The present wording is, however, too restrictive and does not cover cases in which an application is no longer pending for other reasons than being deemed withdrawn under Article 90(3) EPC. Referring simply to "the European patent application" implies that a search is only performed on an application which has a filing date (otherwise it is not a European patent application, see Article 90(2) EPC) and is pending when the search is performed. The basis of the search report (the claims) is retained in the article. Article 92 EPC now expressly enshrines the obligation for the EPO to publish the search report so far contained in Article 93(2) EPC. Further details are a matter for the Implementing Regulations.
2. **Article 92(2) EPC is deleted.** It being self-evident that the Office is obliged to send the search report to the applicant, the transmittal of the search report and of copies of cited documents is a matter for the Implementing Regulations.

Present wording

Article 92

The drawing up of the European search report

(1) If a European patent application has been accorded a date of filing and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Search Division shall draw up the European search report on the basis of the claims, with due regard to the description and any drawings, in the form prescribed in the Implementing Regulations.

(2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

Proposed wording

Article 92

The drawing up of the European search report

[...] The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, with due regard to the description and any drawings. [...]

(2) ***Deleted - to be incorporated into the Implementing Regulations***

ARTICLE 93 EPC

Explanatory remarks

(Preparatory documents: CA/PL 14/00; CA/PL PV 13, points 42-45; CA/PL 31/00, point 15)

1. **Article 93(1) EPC has been redrafted** to shorten and clarify its meaning, **without any change in substance**. The internationally accepted standard of publication after 18 months, with the possible exceptions thereto, is retained in the Convention. The second sentence of Article 93(1) has become new paragraph 2.
2. **Article 93(2) EPC is deleted**, its substance being moved to the Implementing Regulations. The obligation for the EPO to publish the search report is now expressly mentioned in Article 92.

Present wording

Article 93

Publication of a European patent application

(1) A European patent application shall be published as soon as possible after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, as from the date of priority. Nevertheless, at the request of the applicant the application may be published before the expiry of the period referred to above. It shall be published simultaneously with the publication of the specification of the European patent when the grant of the patent has become effective before the expiry of the period referred to above.

(2) The publication shall contain the description, the claims and any drawings as filed and, in an annex, the European search report and the abstract, in so far as the latter are available before the termination of the technical preparations for publication. If the European search report and the abstract have not been published at the same time as the application, they shall be published separately.

Proposed wording

Article 93

Publication of **the** European patent application

(1) **The European Patent Office shall publish the** European patent application [...] as soon as possible

(a) after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, from the date of priority **or**

(b) at the request of the applicant [...] before the expiry of **that period**.

(2) **The European patent application** shall be published **at the same time as** the specification of the European patent when the **decision to grant** the patent **becomes** effective before the expiry of the period referred to in **paragraph (1)(a)**.

(2) ***Deleted - to be incorporated into the Implementing Regulations***

ARTICLE 94 EPC

Explanatory remarks

(Preparatory documents: CA/PL 6/00, CA/PL PV 12, points 43-47; CA/PL 31/00, point 16)

1. **New Article 94 EPC combines present Articles 94 and 96 EPC**, and deals with the initiation as well as the conduct of the examination procedure. The heading is amended accordingly. The obligation to pay a fee and the legal effect of non-payment of the fee or of non-compliance with any other obligation are retained in the Convention.
2. **New Article 94(1), first sentence, EPC** is nearly identical with current Article 94(1) EPC. Only the word "written" has been deleted and replaced by the words "in accordance with the Implementing Regulations". The Implementing Regulations will thus regulate the practical arrangements for filing the request for examination, including the form and the time limit. It is envisaged not to provide that the request must be made in writing (see CA/PL 6/00 for further explanations on this issue). The Implementing Regulations will also state who may file the request for examination. Normally, this will be the applicant. However, in view of the proposed deletion of Article 95 EPC, the possibility that a third party requests examination should not be excluded.
3. The principle that the request is not deemed filed until the fee for examination has been paid is retained in **Article 94(1), second sentence, EPC** and corresponds to similar provisions concerning opposition (Article 99), appeal (Article 108) and limitation (new Article 105a).
4. **Article 94(2) EPC** corresponds to present Article 94(3) EPC. The words "in due time" have, however, been inserted as the time limit for filing the request will no longer be laid down in the Convention.
5. Article 96(2) EPC has been taken over in **new Article 94(3) EPC**. In line with EPO practice, it is now made clear that the EPO may not only invite the applicant to file his observations, but may also invite him to amend the application in accordance with Article 123 EPC.
6. **New Article 94(4) EPC** corresponds in essence to present Article 96(3) EPC, and states what the legal effect of the failure to reply to a communication from the Examining division is. The word "invitation" has been replaced by the more correct term "communication".

Present wording

Article 94

Request for examination

- (1) The European Patent Office shall examine, on written request, whether a European patent application and the invention to which it relates meet the requirements of this Convention.
- (2) A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request shall not be deemed to be filed until after the examination fee has been paid. The request may not be withdrawn.
- (3) If no request for examination has been filed by the end of the period referred to in paragraph 2, the application shall be deemed to be withdrawn.

(See current Article 96(2):

(2) If the examination of a European patent application reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period to be fixed by the Examining Division.)

(See current Article 96(3):

(3) If the applicant fails to reply in due time to any invitation under paragraph 1 or paragraph 2, the application shall be deemed to be withdrawn.)

Proposed wording

Article 94

Examination of the European patent application

- (1) The European Patent Office shall, **in accordance with the Implementing Regulations**, examine on [...] request whether **the** European patent application and the invention to which it relates meet the requirements of this Convention. [...] The request shall not be deemed to be filed until after the examination fee has been paid. [...]
- (2) If no request for examination has been **made in due time**, the application shall be deemed to be withdrawn.
- (3) If the examination [...] reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, [...] as often as necessary, to file his observations **and, subject to Article 123 paragraph 1, to amend the application.**
- (4) If the applicant fails to reply in due time to any **communication from the Examining Division**, the application shall be deemed to be withdrawn.

ARTICLE 95 EPC

Explanatory remarks

(Preparatory documents: CA/PL 6/00, CA/PL PV 12, points 43-47; CA/PL 31/00, point 3)

1. The time limit applicable to the filing of a request for examination is transferred to the Implementing Regulations (cf new Article 94(1) EPC). It is **not envisaged** at this stage to change the existing six-month time limit. The situation could however change in the future, and the rigorous limitation of the possibilities to adjust the time limit to unforeseeable developments presently laid down in Article 95 EPC is no longer desirable. It may e.g. be necessary to adapt the European examination procedure to changes in the PCT system. Also, an excessive increase in examiner workload may force the Organisation to introduce some sort of deferred examination. A certain amount of flexibility is therefore necessary. Any change in the system would as a matter of course only be made by decision of the Administrative Council, which would guarantee a proper decision-making process.
2. If ever some system of deferred examination were to be introduced, the Convention should leave open the possibility that third parties can request examination. As new Article 94(1) EPC does not state who may file the request for examination, the Implementing Regulations could foresee that a third party may file the request as well.
3. In view of the above, **Article 95 EPC is deleted**. Article 33(1)(a) EPC has been amended accordingly.

Present wording

Article 95

Extension of the period within which requests for examination may be filed

- (1) The Administrative Council may extend the period within which requests for examination may be filed if it is established that European patent applications cannot be examined in due time.
- (2) If the Administrative Council extends the period, it may decide that third parties will be entitled to make requests for examination. In such cases, it shall determine the appropriate rules in the Implementing Regulations.
- (3) Any decision of the Administrative Council to extend the period shall apply only in respect of applications filed after the publication of such decision in the Official Journal of the European Patent Office.
- (4) If the Administrative Council extends the period, it must lay down measures with a view to restoring the original period as soon as possible.

Proposed wording

Deleted

ARTICLE 96 EPC

Explanatory remarks

(Preparatory documents: CA/PL 6/00. CA/PL PV 12, points 43-47; CA/PL 31/00, point 3)

1. New Article 94 EPC combines present Articles 94 and 96 EPC. The situation now described in Article 96(1) EPC, which concerns a practicality in connection with the filing of the request for examination, will be dealt with in the Implementing Regulations to new Article 94(1) EPC.
2. **Article 96 is therefore deleted.**

Present wording

Article 96

Examination of the European patent application

- (1) If the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application.
- (2) If the examination of a European patent application reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period to be fixed by the Examining Division.
- (3) If the applicant fails to reply in due time to any invitation under paragraph 1 or paragraph 2, the application shall be deemed to be withdrawn.

Proposed wording

Deleted

- (1) To be incorporated into the Implementing Regulations*
- (2) See new Article 94(3)*
- (3) See new Article 94(4)*

ARTICLE 97 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 6/00, CA/PL PV 12, points 43-47; CA/PL 31/00, point 3)

1. Paragraphs 1 and 2 of present Article 97 EPC are swapped. **New Article 97(1) EPC now deals with the grant of a patent.** All formal requirements that must be fulfilled before the Examining Division can decide to grant the patent are transferred to the Implementing Regulations. These formal requirements are already currently dealt with in detail in Rule 51 EPC. It is not necessary to list them in the Convention as well, in particular because it prevents the EPO from adjusting flexibly to future developments. If, for example, the Office were to decide to publish granted patents only electronically in future, a printing fee would no longer be appropriate. This proposal also involves the deletion of current Article 97(3) and (5). The obligation to file translations of the claims will in any case be maintained in the Implementing Regulations. The legal effect of non-fulfilment of the formal requirements will also be laid down in the Implementing Regulations.
2. **Article 97(2) EPC has been redrafted** to bring the wording in line with paragraph 1, without any change in substance.

Present wording

Article 97
Refusal or grant

(1) The Examining Division shall refuse a European patent application if it is of the opinion that such application or the invention to which it relates does not meet the requirements of this Convention, except where a different sanction is provided for by this Convention.

(2) If the Examining Division is of the opinion that the application and the invention to which it relates meet the requirements of this Convention, it shall decide to grant the European patent for the designated Contracting States provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in which the Examining Division intends to grant the patent;

Proposed wording

Article 97
Grant or refusal

(1) If the Examining Division is of the opinion that the **European patent** application and the invention to which it relates meet the requirements of this Convention, it shall decide to grant **a** European patent [...] provided that **the conditions laid down in the Implementing Regulations are fulfilled.**

(2) **If** the Examining Division [...] is of the opinion that **the European patent** application or the invention to which it relates does not meet the requirements of this Convention, **it shall refuse the application unless** a different sanction is provided for by this Convention.

(2) *See new paragraph 1*

3. **New Article 97(3) EPC** is essentially identical to current Article 97(4), first sentence, EPC. It has only been **reformulated in a positive sense**. The provisions concerning the minimum period that must lapse before the grant can take effect have been deleted from the Convention. With the other grant formalities being transferred to the Implementing Regulations, this matter too is more appropriately regulated at a lower legislative level.

Present wording

(b) the fees for grant and printing are paid within the time limit prescribed in the Implementing Regulations;

(c) the renewal fees and any additional fees already due have been paid.

(3) If the fees for grant and printing are not paid in due time, the application shall be deemed to be withdrawn.

(4) The decision to grant a European patent shall not take effect until the date on which the European Patent Bulletin mentions the grant. This mention shall be published at least 3 months after the start of the time limit referred to in paragraph 2 (b).

(5) Provision may be made in the Implementing Regulations for the applicant to file a translation, in the two official languages of the European Patent Office other than the language of the proceedings, of the claims appearing in the text in which the Examining Division intends to grant the patent. In such case, the period laid down in paragraph 4 shall be at least five months. If the translation has not been filed in due time, the application shall be deemed to be withdrawn.

(6) At the request of the applicant, mention of grant of the European patent shall be published before expiry of the time limit under paragraph 4 or 5. Such request may only be made if the requirements pursuant to paragraphs 2 and 5 are met.

Proposed wording

(3) **Deleted** - *to be incorporated into the Implementing Regulations*

(3) The decision to grant a European patent shall [...] take effect **on** the date on which **the mention of the grant is published in** the European Patent Bulletin. [...]

(5) **Deleted** - *to be incorporated into the Implementing Regulations*

(6) **Deleted** - *to be incorporated into the Implementing Regulations*

ARTICLE 98 EPC

Explanatory remarks

(Preparatory documents: CA/PL 14/00, CA/PL PV 13, points 42-45; CA/PL 31/00, point 3)

1. **Article 98 EPC has been redrafted without any change in substance.** The wording is brought into line with that of Article 93 EPC. The contents of the specification are transferred to the Implementing Regulations.
2. Article 98 EPC now contains the words "as soon as possible" in order to indicate that it is not always technically possible to publish the specification on the same day as the mention of the grant is published.

Present wording

Article 98

Publication of a specification of the European patent

At the same time as it publishes the mention of the grant of the European patent, the European Patent Office shall publish a specification of the European patent containing the description, the claims and any drawings.

Proposed wording

Article 98

Publication of **the** specification of the European patent

[...] The European Patent Office shall publish **the specification of the European patent **as soon as possible after** the mention of the grant of the European patent **has been published in the European Patent Bulletin.****

PART V

Explanatory remarks

The **limitation procedure** (see new Articles 105a - 105c EPC) has been inserted in the title of part V.

ARTICLE 99 EPC

Explanatory remarks

(Preparatory documents: CA/PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 17)

1. **Article 99(1) EPC** remains in essence the same, only the second sentence of Article 99(1) EPC is transferred to the Implementing Regulations. Article 99(1), first sentence EPC has been redrafted and clarified, without change in substance.
2. Article 99(1) EPC contains some requirements for admissibility. Further requirements for admissible oppositions are laid down in Rule 55 EPC. As many as possible of these requirements should be dealt with uniformly in the Implementing Regulations, especially as the legal consequences of an inadmissible opposition are already dealt with in Rule 56 EPC. However, since the time limit of nine months and the payment of the opposition fee appear to be of an essential nature, these requirements remain in the Convention. Only the formal requirement for the written reasoned statement in **Article 99(1), second sentence is transferred to the Implementing Regulations.**
3. Article 99(3) EPC makes it clear that an opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated states. There is no need for this to be in the Convention itself. A similar situation is already covered by Rule 60(1) EPC, which stipulates that, if the European patent has been surrendered or has lapsed, the opposition proceedings may be continued by the EPO on request. Therefore, **Article 99(3) EPC is deleted and incorporated into the Implementing Regulations.**

Present wording

PART V OPPOSITION PROCEDURE

Article 99 Opposition

(1) Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid.

(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.

(3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.

(4) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.

(5) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. By derogation from Article 118, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request.

Revised wording

PART V OPPOSITION **AND LIMITATION** PROCEDURE

Article 99 Opposition

(1) Within nine months from the publication of the mention of the grant of the European patent **in the European Patent Bulletin**, any person may give notice to the European Patent Office of opposition to **that** patent [...] **in accordance with the Implementing Regulations.** [...] Notice of opposition shall not be deemed to have been filed until **after** the opposition fee has been paid.

(2) *Unchanged*

(3) ***Deleted*** - *to be incorporated into the Implementing Regulations.*

(4) Becomes **(3)** *wording unchanged*

(5) Becomes **(4)** *wording unchanged*

ARTICLE 101 EPC

Explanatory remarks

(Preparatory documents: CA/PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 18)

1. **New Article 101 EPC** combines present Articles 101(1), (2) and 102(1), (2) and (3) EPC, and is partly re-structured for clarification. The details of the opposition procedure currently contained in Article 102(3)(a), (b) - (5) EPC are incorporated into the Implementing Regulations.
2. **Article 101(1) EPC** is amended to make it clear that the opposition division is **not obliged** to consider **all** the grounds for opposition referred to in Article 100 EPC. This clarification reflects the case law of the Enlarged Board of Appeal (G 10/91, OJ EPO 1993, 420), on which current practice is based.
3. The examination of grounds for opposition is guided by the following principles developed by the Enlarged Board:

The opposition division **is obliged** to examine only those grounds for opposition listed in the opponent's statement under Rule 55(c) EPC. In addition to this, the opposition division **may** in accordance with Article 114(1) EPC examine **of its own motion** any ground for opposition under Article 100 EPC not invoked by the opponent **where said ground is relevant and prejudices the maintenance of the European patent**. These principles should be reflected in the Rules implementing Article 101(1) EPC.

4. Article 101(2) EPC is deleted and moved to the new paragraph 1. New **Article 101(2) EPC** corresponds to present Article 102(1) and (2) EPC, but also contains a clarification. For the European patent to be revoked, it is sufficient for **one** of the grounds for opposition to prejudice its maintenance. The patent is maintained where **none** of the grounds for opposition prejudices its maintenance. This clarification relates exclusively to the substantive issue of when a patent should be revoked and when it should be maintained. The question of the details of how an opposition should be examined during the opposition procedure and which grounds for opposition must be dealt with in the opposition division's decision will be covered in the Implementing Regulations.

Present wording

Article 101

Examination of the opposition

(1) If the opposition is admissible, the Opposition Division shall examine whether the grounds for opposition laid down in Article 100 prejudice the maintenance of the European patent.

(2) In the examination of the opposition, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Opposition Division shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself.

(See current Article 102(1):

(1) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 prejudice the maintenance of the European patent, it shall revoke the patent.

and current Article 102(2):

(2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 do not prejudice the maintenance of the patent unamended, it shall reject the opposition.)

Revised wording

Article 101

Examination of the opposition Revocation or maintenance of the European patent

(1) If the opposition is admissible, the Opposition Division shall examine **in accordance with the Implementing Regulations** whether [...] **at least one ground** for opposition **under** Article 100 prejudices the maintenance of the European patent. **During this examination**, the Opposition Division shall invite the parties, as often as necessary, to file observations [...] on communications from another party or issued by itself.

(2) ***Deleted*** - incorporated into paragraph 1.

(2) If the Opposition Division is of the opinion that **at least one ground** for opposition prejudices the maintenance of the European patent, it shall revoke the patent. **Otherwise it shall reject the opposition.**

Explanatory remarks

5. **New Article 101(3)(a) EPC** corresponds to present Article 102(3) EPC, the formal requirements currently referred to in Article 102(3)(a) and (b), (5) EPC being moved to the Implementing Regulations.
6. **New Article 101(3)(b) EPC** adds a clarifying point. If the proprietor of the patent requests amendments during the opposition proceedings, the opposition division examines whether, with reference to **all** the provisions of the EPC, the substantive requirements for maintaining the patent are met. If the examination shows that they are, the patent is maintained as amended. If these requirements are **not** met, the patent is revoked. Article 102(1) EPC provides for revocation of the patent only if the grounds for opposition prejudice its maintenance. This means that, strictly speaking, Article 102(1) EPC does not provide the legal basis for revoking the patent if the patent as amended does **not** meet, for example, the requirements of Articles 84 or 123(3) or Rules 27 or 29 EPC. In such cases it has been the practice at the EPO to revoke the patent under Article 102(3) EPC, even though this provision does not expressly so provide.

For the purposes of clarification, **new Article 101(3)(b) EPC expressly** provides for the revocation of the patent as amended.

Present wording

Revised wording

(3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates

(a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that **the conditions laid down in the Implementing Regulations are fulfilled;**

(b) do not meet the requirements of this Convention, it shall revoke the patent.

ARTICLE 102 EPC

Explanatory remarks

(Preparatory documents: CA PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 3)

Article 102 EPC is partly combined with Article 101 EPC (see explanatory remarks to Article 101 EPC, point 1). Article 101(2) EPC contains present Article 102(1) and (2) EPC (see for details explanatory remarks to Article 101 EPC, point 4). The **details of the opposition procedure covered by current Article 102(3)(a), (b) - (5) EPC are to be incorporated into the Implementing Regulations.**

Present wording

Article 102

Revocation or maintenance of the European patent

- (1) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 prejudice the maintenance of the European patent, it shall revoke the patent.
- (2) If the Opposition Division is of the opinion that the grounds for opposition mentioned in Article 100 do not prejudice the maintenance of the patent unamended, it shall reject the opposition.
- (3) If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that:
- (a) it is established, in accordance with the provisions of the Implementing Regulations, that the proprietor of the patent approves the text in which the Opposition Division intends to maintain the patent;
- (b) the fee for the printing of a new specification of the European patent is paid within the time limit prescribed in the Implementing Regulations.
- (4) If the fee for the printing of a new specification is not paid in due time, the patent shall be revoked.

Revised wording

Deleted

Title has been added to the title of Article 101 EPC

- (1) *Becomes **Article 101(2)**, first sentence*
- (2) *Becomes **Article 101(2)**, second sentence*
- (3) *Becomes **Article 101(2)(a)***
- (a) ***Deleted*** - *to be incorporated into the Implementing Regulations*
- (b) ***Deleted*** - *to be incorporated into the Implementing Regulations*
- (4) ***Deleted*** - *to be incorporated into the Implementing Regulations*

Present wording

(5) Provision may be made in the Implementing Regulations for the proprietor of the patent to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings. If the translation has not been filed in due time the patent shall be revoked.

Revised wording

(5) ***Deleted*** - *to be incorporated into the Implementing Regulations*

ARTICLE 103 EPC

Explanatory remarks

(Preparatory documents: CA/PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 3)

1. **Article 103 EPC has been redrafted** without any substantive changes. Reference is made to new Article 101(3)(a) EPC replacing Article 102(3) EPC and the wording has been brought into line with that of new Articles 93 and 98 EPC. The contents of a new patent specification will be laid down in the Implementing Regulations.
2. The new text contains the words "as soon as possible" in order to indicate that it is not always technically possible to publish the new specification on the same day as the mention of the opposition decision is published.

Present wording

Article 103

Publication of a new specification of the European patent

If a European patent is amended under Article 102, paragraph 3, the European Patent Office shall, at the same time as it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form.

Revised wording

Article 103

Publication of a new specification of the European patent

If a European patent is **maintained as** amended under Article **101**, paragraph 3**(a)**, the European Patent Office shall [...] publish a new specification of the European patent [...] **as soon as possible after** the mention of the opposition decision **has been published in the European Patent Bulletin**.

ARTICLE 104 EPC

Explanatory remarks

(Preparatory documents: CA/PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 3)

Article 104(1) EPC has been slightly redrafted. Furthermore **Article 104(1) and (2) EPC** are amended in such a way that the details of a decision ordering a different apportionment of costs and the procedure for fixing costs are transferred to the Implementing Regulations.

Present wording

Article 104
Costs

(1) Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or Board of Appeal, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings.

(2) On request, the registry of the Opposition Division shall fix the amount of the costs to be paid under a decision apportioning them. The fixing of the costs by the registry may be reviewed by a decision of the Opposition Division on a request filed within the period laid down in the Implementing Regulations.

(3) Any final decision of the European Patent Office fixing the amount of costs shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of such decision shall be limited to its authenticity.

Revised wording

Article 104
Costs

(1) Each party to the **opposition** proceedings shall **bear** the costs **it** has incurred, unless **the** decision of **the** Opposition Division [...] for reasons of equity orders, in accordance with the Implementing Regulations, a different apportionment of costs [...].

(2) **The procedure for fixing costs shall be laid down in the Implementing Regulations.**

(3) *Unchanged*

ARTICLE 105 EPC

Explanatory remarks

(Preparatory documents: CA/PL 15/00; CA/PL PV 13, points 47-58; CA/PL 31/00, point 19)

Article 105 EPC has been redrafted to clarify its meaning. The word "court" is to be deleted entirely, since not in all states an action for declaration of non-infringement must be instituted before a court. The details relating to intervention in present Article 105 EPC are transferred to the Implementing Regulations.

Present wording

Article 105

Intervention of the assumed infringer

(1) In the event of an opposition to a European patent being filed, any third party who proves that proceedings for infringement of the same patent have been instituted against him may, after the opposition period has expired, intervene in the opposition proceedings, if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. The same shall apply in respect of any third party who proves both that the proprietor of the patent has requested that he cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent.

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid. Thereafter the intervention shall, subject to any exceptions laid down in the Implementing Regulations, be treated as an opposition.

Revised wording

Article 105

Intervention of the assumed infringer

(1) **Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired if that third party proves**

(a) that proceedings for infringement of the same patent have been instituted against **that third party**, [...] **or**

(b) that, **following a request of** the proprietor of the patent **to** cease alleged infringement, **that third party** has instituted proceedings for a [...] ruling that **that third party** is not infringing the patent.

(2) [...] **An admissible** intervention [...] shall [...] be treated as an opposition.

NEW ARTICLES 105a, 105b, 105c EPC (limitation procedure)**Explanatory remarks**

(Preparatory documents: CA/PL 11/96; CA/PL 29/99; CA/PL 29/99 Rev. 1; CA/PL PV 4, points 95-107; CA/PL PV 11, points 23-40; CA/PL PV 13, points 128-138; CA/PL 31/00, point 35)

1. Under the **extended limitation procedure proposed in the new Articles 105a-c, the European patent may be limited or revoked ab initio** (see Article 68 EPC above) **at the request of the patent proprietor**. Limitation or revocation may be requested at any time, although precedence must always be given to opposition proceedings. Making the limitation procedure ex parte and doing away with an examination of the patentability of the residual patent guarantees a speedy decision from the EPO.
2. Under **Article 105a (1) EPC**, a European patent may be revoked or limited (by an amendment of the claims) at the request of the proprietor, subject to payment of a fee. The Implementing Regulations will set out in particular the criteria for admissibility (written request, joint filing by multiple proprietors, documentation to be filed with request, etc.)
3. **Article 105a (2) EPC** governs the relation between the limitation procedure and opposition proceedings. The priority it gives to opposition proceedings prevents limitation procedures occurring where opposition has already been lodged. The procedure to be followed in the cases, in practice rare, where opposition proceedings are initiated following the valid lodging of a request for limitation or revocation will be laid down in the Implementing Regulations. In that respect the intention is that, if revocation is requested, limitation proceedings are to continue and the patent is to be revoked or not as appropriate. If amendment of the patent is requested, limitation proceedings are to be stayed until opposition proceedings have been completed.
4. The European limitation procedure does not however take precedence over National proceedings (revocation proceedings in particular). Where parallel cases do occur, the national proceedings can be suspended or continued in accordance with the provisions of the relevant national law. Where national proceedings resulting in limitation have already been concluded, the limitation can be extended to further contracting states via European limitation proceedings. It is also emphasised that limitation of a European patent in proceedings before the EPO does not preclude further limitation in national proceedings.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

Article 105a

Request for limitation or revocation

(1) At the request of the proprietor the European patent may be revoked or be limited by an amendment of the claims. The request shall be filed with the European Patent Office in accordance with the Implementing Regulations. It shall not be deemed to have been filed until after the limitation or revocation fee has been paid.

(2) The request may not be filed while opposition proceedings in respect of the European patent are pending.

Explanatory remarks

5. Under **Article 105b(1) EPC**, the limitation procedure requires the EPO to examine whether the requirements laid down in the Implementing Regulations for a requested limitation or revocation have been met. With limitation, this means in particular establishing whether the requested amendment of the claims actually limits the patent or is designed to protect something else, and whether the requirements of Article 84 EPC are met. Here too, moreover, the EPO has to apply the Convention's relevant general rules of procedure, in particular Article 123(2) and (3) EPC.
6. The EPO is not required to examine whether the aim of the limitation - eg delimitation with respect to a particular prior art - is achieved, or whether the subject-matter of the limited patent is patentable under Articles 52-57 EPC.
7. Under **Article 105b(2) EPC**, the EPO (examining division) is required to limit or revoke the European patent, provided the prescribed conditions under Article 105b(1) EPC are met. Otherwise the request must be rejected.
8. The procedure to be followed is to be laid down in detail in the Implementing Regulations. In particular, limitation should be based on the revised version of the claims submitted by the proprietor. The communication notifying the patent proprietor that the request for limitation can be allowed will invite him to file a translation of the amended claims and to pay the fee for printing. He thus has the opportunity to check the version of the patent intended for publication. Any obvious mistakes or typing errors may be rectified on request. On the other hand, he may no longer make any substantive amendments to the claims, as the request for limitation has already been examined and allowed.
9. Decisions of the examining divisions in limitation proceedings are subject to appeal in accordance with Articles 106 ff EPC.
10. When the decision to revoke or limit the European patent in accordance with **Article 105b(3) EPC** is published, the effects of the European patent are cancelled ab initio (see Article 68 EPC above) in full or in part in respect of all the contracting states in which it is or was valid. If, however, prior European or national rights are cited during the limitation procedure in respect of certain contracting states, the patent may be limited for these states in accordance with Rule 87 EPC by means of a separate set of claims.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

Article 105b

Limitation or revocation of the European patent

(1) The European Patent Office shall examine whether the requirements laid down in the Implementing Regulations for limiting or revoking the European patent have been met.

(2) If the European Patent Office considers that the request for limitation or revocation of the European patent meets these requirements, it shall decide to limit or revoke the European patent in accordance with the Implementing Regulations. Otherwise, it shall reject the request.

(3) The decision to limit or revoke the European patent shall apply to the European patent in all the Contracting States in respect of which it has been granted. It shall take effect on the date on which the European Patent Bulletin mentions the decision.

Explanatory remarks

11. Under **Article 105c EPC**, when the EPO publishes the decision to limit the European patent, it will publish an amended European patent specification containing, in accordance with the Implementing Regulations, the new version of the claims, a translation thereof into the official languages of the EPO and, where appropriate, the description and drawings as amended.
12. If the amended European patent specification is not available in an official language of the contracting state in which the patent is valid, under Article 65 EPC (new) that state may demand that a translation be filed (see Article 65 EPC above).

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

Article 105c

Publication of the amended specification of the European patent

If the European patent is limited under Article 105b, paragraph 2, the European Patent Office shall publish the amended specification of the European patent as soon as possible after the mention of the limitation has been published in the European Patent Bulletin.

ARTICLE 106 EPC

Explanatory remarks

(Preparatory documents CA/PL 16/00; CA/PL PV 13, points 60-63; CA/PL 31/00, point 20)

1. **Article 106(1) EPC** in conjunction with **Article 106(3) EPC** defines which decisions are appealable, ie only final decisions, unless a separate appeal is allowed by a decision which is not final. This is an essential structural feature of the means of legal redress at the EPO and therefore kept in the Convention.
2. **Article 106(2) EPC** is to be **incorporated into the Implementing Regulations** for the same reasons as set out in the explanatory notes to Article 99(3) EPC.
3. **Article 106 (4) and (5) EPC** contain restrictions on appeals relating to the apportionment and fixing of costs. The regulation in Article 106(4) has generally proved effective; however, in rare cases it can lead to hardship, eg if a party who has to bear a proportion of high costs cannot appeal because in other respects he or she is not adversely affected by the decision ordering the apportionment of costs. Thus, it appears sensible to leave open the option to amend this regulation. Moreover, those provisions do not relate to fundamental aspects of the appeal procedure. Therefore they should be **included in the Implementing Regulations** - with a basis for the limitation of the right to appeal in the Convention.

Present wording

Article 106

Decisions subject to appeal

(1) An appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division. It shall have suspensive effect.

(2) An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.

(3) A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

(4) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal.

(5) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount is in excess of that laid down in the Rules relating to Fees.

Revised wording

Article 106

Decisions subject to appeal

(1) *Unchanged*

(2) ***Deleted*** - *to be incorporated into the Implementing Regulations*

(3) *Becomes (2) - wording unchanged*

(3) The right to file an appeal against decisions relating to the apportionment or fixing of costs in opposition proceedings may be restricted in the Implementing Regulations.

ARTICLE 108 EPC**Explanatory remarks**

(Preparatory documents CA/PL 16/00; CA/PL PV 13, points 60-63; CA/PL 31/00, point 3)

1. **Article 108 EPC** relates to time limits and the form of appeals. The time limits for filing the notice of appeal and the statement setting out the grounds for appeal should remain in the Convention while **formal requirements** should be laid down **in the Implementing Regulations** as is already the case under the current Convention (see Rules 64 and 65 EPC). However, in view of the future use of electronic means of communication it is useful to avoid references to "in writing" or "in written form" and leave such regulation to the Implementing Regulations.

Present wording

Article 108

Time limit and form of appeal

Notice of appeal must be filed in writing at the European Patent Office within two months after the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

Revised wording

Article 108

Time limit and form of appeal

Notice of appeal **shall** be filed **in accordance with the Implementing Regulations** at the European Patent Office within two months after the date of notification of the decision appealed from. Notice **of appeal** shall not be deemed to have been filed until after the fee for appeal has been paid. Within four months after the date of notification of the decision, a [...] statement setting out the grounds of appeal **shall** be filed **in accordance with the Implementing Regulations**.

ARTICLE 110 EPC

Explanatory remarks

(Preparatory documents CA/PL 16/00; CA/PL PV 13, points 60-63; CA/PL 31/00, point 3)

1. **Article 110(1) EPC** provides that an appeal shall be examined on its merits only if it is admissible. At present, the requirements of admissibility of an appeal are governed partly by the Convention, partly by the Implementing Regulations. Examination of an appeal as to admissibility is governed by present Rule 65 EPC. There it is stated that the legal consequence of an appeal being inadmissible is its rejection. This regulation will be kept on the level of the Implementing Regulations.
2. Present **Article 110(2) EPC** already provides that the examination of the appeal shall be conducted in accordance with the provisions of the Implementing Regulations. This provision will be **retained in revised Article 110(1) EPC**. The concept already applied under the present Convention, namely that the Implementing Regulations contain comprehensive provisions on the examination of appeals, is further illustrated by present Rule 66(1) EPC. This Rule lays down that, unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.
3. Present **Article 110(2) EPC** also provides a practical application of the "right to be heard" enshrined in Article 113 EPC and thus need not be kept in the Convention. Present **Article 110(3) in conjunction with Article 110(2) EPC** only concerns the examination of ex-parte appeal proceedings. The deemed withdrawal of the application laid down in present Article 110(3) EPC is, as a rule, the most advantageous legal consequence for the applicant since under the present practice governed by Rule 69(1) EPC the applicant will be informed on the loss of rights and thereby enabled to choose the suitable legal remedy, ie request an appealable decision under Rule 69(2) EPC concerning the loss of rights or further processing under Article 121 EPC or re-establishment of rights under Article 122 EPC. However, if the ex-parte appeal only concerns an isolated issue, eg the designation of a certain Contracting State, deemed withdrawal of the appeal would be a more appropriate legal consequence. This shows that there is a need for flexibility to be able to take into account future developments of the granting procedure. Therefore, the provisions in present Article 110(2) and (3) EPC are to be **transferred to the implementing Regulations**.

Present wording

Article 110

Examination of appeals

(1) If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable.

(2) In the examination of the appeal, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself.

(3) If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision under appeal was taken by the Legal Division.

Revised wording

Article 110

Examination of appeals

If the appeal is admissible, the Board of Appeal shall examine whether the appeal is allowable. The examination of the appeal [...] shall be conducted in accordance with the Implementing Regulations.

(2) **Deleted** - to be incorporated into the Implementing Regulations

(3) **Deleted** - to be incorporated into the Implementing Regulations

NEW ARTICLE 112a EPC**Explanatory remarks**

(Preparatory documents CA/PL 17/00; CA/PL PV 13, points 65-70; CA/PL 31/00, point 31)

1. In order to make possible a limited judicial review of decisions of the boards of appeal, the **Enlarged Board of Appeal should be given the competence to decide on petitions for review.**
2. As provided for in the **new Article 112a(1) EPC** a petition for review shall only lie from decisions of the boards of appeal
 - (a) if during the appeal proceedings a **fundamental procedural defect** occurred or
 - (b) if a **criminal act** may have had an impact on the decision.These exhaustive grounds for review will be defined in more detail in the Implementing Regulations.
3. Only a party adversely affected by the decision under attack shall have the right to file a petition for review.
4. The filing of a petition for review will be entered in the European patent register.
5. The wording of proposed **Article 112a(1)(a) EPC** implies that only **fundamental** (but not minor) **procedural defects** can be the basis for a petition for review. Under no circumstances shall the petition for review be a means to review the application of substantive law. This restriction is justified because the function of the petition for review is to remedy **intolerable deficiencies** occurring in individual appeal proceedings but not to further develop the practice in proceedings before the EPO or to ensure the uniform application of the law.
6. It is intended that the Rule implementing Article 112a(1)(a) EPC provide that a petition for review under Article 112a(1)(a) EPC may only be based on the following grounds:
 - a member of the board took part in the decision in breach of Article 24(1) EPC or despite being excluded pursuant to a decision under Article 24(4) EPC,
 - the Board of Appeal comprised a person not appointed as a member of the Boards of Appeal,
 - a fundamental violation of Article 113 EPC,
 - a fundamental procedural defect arising from failure to take into account a request made by a party.

Such a Rule should further provide that a petition for review shall only be admissible if the defect was objected to during appeal proceedings and the objection rejected by the Board of Appeal, unless the objection could not have been raised during appeal proceedings.

Present wording

At present there is nothing equivalent to this provision in the EPC.

At present there is nothing equivalent to this provision in the EPC.

Revised wording

**Article 112a
Petition for review by the Enlarged
Board of Appeal**

(1) Any party to proceedings before a Board of Appeal adversely affected by the decision of the Board of Appeal may file a petition for review by the Enlarged Board of Appeal

(a) if a fundamental procedural defect as defined in the Implementing Regulations occurred in appeal proceedings, or

7. One of the most serious defects from which a decision might suffer is that **criminal behaviour might have had an impact on the decision**. Also in these cases the possibility of review by the Enlarged Board of Appeal should exist. However, the EPO has no power to establish whether a certain behavior was an offence within the meaning of criminal law. Thus criminal behaviour can only be a valid ground for a petition for review following conviction of the person concerned by a criminal court. It is envisaged that for the purpose of Article 112a(1)(b) EPC a criminal act can only be established in criminal proceedings by a sentence which is *res judicata*.
8. Implementing regulations under **new Article 112a(1)(b) EPC** shall lay down how the existence of a criminal act is to be established. It is envisaged to provide that a criminal act shall only be a ground for a petition for review under Article 112a(1)(b) following conviction of the person concerned by a final decision of a competent court.
9. If criminal proceedings against the person concerned are not possible, in particular in the event of the death of this person, no petition for review is possible: even an implicit examination of the issue whether there is a criminal act fails because the boards which are only subject to the EPC have no international penal code at hand suitable as yardstick in order to decide on criminally relevant behaviour.
10. In view of national differences relating to the definition of behaviour which is "criminal" within the meaning of penal law or subject to other sanctions, the definition of what constitutes a "criminal act" within the meaning of Article 112a(1)(b) EPC should be left to the case law of the Enlarged Board of Appeal.
11. **Article 112a(2) EPC** makes it clear that the petition for review is an extraordinary legal remedy the filing of which does not affect the force of *res judicata* of the decision under attack. Implicitly it follows that a successful petition for review results in a decision of the Enlarged Board of Appeal which sets aside the decision of the board of appeal, ie overturns its *res judicata* effect, and re-opens appeal proceedings. This is further clarified in Article 112a(4) EPC.

Present wording

At present there is nothing equivalent to this provision in the EPC.

At present there is nothing equivalent to this provision in the EPC.

Revised wording

(b) if a criminal act as established in accordance with the Implementing Regulations may have had an impact on the decision.

(2) The petition for review shall have no suspensive effect.

12. **Article 112a(3) EPC** provides for the form, the time limits and the fee for the petition for review. Further details should be left to the Implementing Regulations. The contents of the statement setting out the grounds for the petition for review shall be further defined in the Implementing Regulations which in particular will clarify that it must be sufficiently substantiated.
13. The Rule implementing Article 112a(3), first sentence, EPC, shall provide that the petition for review shall contain:
 - the name and address of the petitioner as provided in Rule 26, paragraph 2(c);
 - a statement identifying the decision to be reviewed;
 - a statement setting out the grounds on which the petition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds.
14. The possibility of filing a petition for review must not cause long-lasting legal uncertainty for third parties. The outcome of the new appeal proceedings following successful review proceedings might be that a failed patent or patent application is revived so that protection already lost will be re-established. Thus, it is important that the deadline for filing such petitions is short.
15. The short time limit under Article 112a(3), second sentence, EPC, ie two months after the notification of the decision of the Board of Appeal, would make it nearly impossible to base a petition for review on criminal behaviour. In these exceptional and particularly serious cases, the time-limit should therefore start when the conviction by the criminal court became final. The protection of a party adversely affected by criminal behaviour should prevail over legal certainty for third parties. However, there shall be an absolute time limit after the expiry of which no petition for review will be admissible; a period of five years seems appropriate.
16. The time limits under Article 112a(3) EPC should be excluded from further processing and re-establishment of rights under revised Articles 121 and 122 EPC.
17. A high fee for a petition for review, eg EUR 2 500, should be payable. However, it is intended to provide in the Implementing Regulations that the fee for the petition for review shall be reimbursed if the Enlarged Board re-opens the proceedings before the Board of Appeal, unless reimbursement is not considered equitable.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

(3) The petition for review shall be filed in accordance with the Implementing Regulations and accompanied by a reasoned statement setting out the grounds for the petition. If based on paragraph 1(a), the petition shall be filed within two months after the date of notification of the decision of the Board of Appeal. If based on paragraph 1(b), the petition shall be filed within two months after the criminal act has been established and in any event not later than five years after the date of notification of the decision of the Board of Appeal. The petition shall not be deemed to have been filed until after the fee for the petition has been paid.

18. Implementing rules under **Article 112a(4) EPC** on the examination of the petition for review shall contain the following provisions:

- (1) The petition for review shall be rejected as inadmissible if
- it is not filed by a party adversely affected by the decision under attack;
 - it has not been filed in due time;
 - the reasoned statement setting out the grounds for the petition does not sufficiently substantiate the reasons why the decision under attack should be set aside;
 - the alleged procedural defect was not objected to as prescribed in the Implementing Regulations (see point 6); or
 - the alleged criminal act is not established as provided for in the Implementing Regulations (see point 8).

(2) If the petition for review is admissible, the Enlarged Board of Appeal shall examine whether the alleged procedural defect occurred in appeal proceedings or whether the established criminal act might have had an impact on the decision.

(3) If the petition for review is allowable, the Enlarged Board of Appeal shall set aside the decision of the Board of Appeal and shall re-open appeal proceedings before the Board of Appeal which rendered the decision. If appropriate the Enlarged Board of Appeal may order that the Board of Appeal be composed differently. In exceptional cases, the Enlarged Board of Appeal may re-open appeal proceedings before another Board of Appeal.

19. A further Rule on examination of the petition for review should provide that in deciding on a petition for review, the Enlarged Board of Appeal shall apply the rules of procedure applicable to proceedings before the Boards of Appeal, unless otherwise provided.

In the interest of a quick and effective screening of petitions for review which are clearly inadmissible or not allowable special procedural provisions must apply to the three-member panel of the Enlarged Board established under the Rule implementing Article 22(2), second sentence, EPC (see explanatory remarks on Article 22, point 4). The proceedings before this panel shall be as simple and short as possible. Therefore, this body shall decide in written summary proceedings; no oral proceedings shall take place before the panel. Decisions of this panel rejecting a petition do not need to be reasoned. However, in practice the panel may give a brief explanation why the petition is rejected. A quick screening procedure at the outset of review proceedings to sort out petitions which clearly cannot be successful is essential in order to avoid an inappropriate prolongation of legal uncertainty for third parties. It is also of great importance to counteract effectively intentional prolongation of proceedings by filing a petition for review.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

(4) The Enlarged Board of Appeal shall examine the petition for review in accordance with the Implementing Regulations. If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision under review and shall re-open proceedings before the Boards of Appeal as provided for in the Implementing Regulations.

20. If the petition for review is successful, ie if the alleged defect is proven, the consequence shall be that the decision of the board of appeal is set aside and appeal proceedings reopened before the boards of appeal. This decision overturns the *res judicata* effect of the previous decision. The result of the second appeal proceedings may be the same as in the first appeal proceedings or different.
21. The revival of lost patent protection may prejudice third-party interests. Thus, provision must be made for intervening rights. **Article 112a(5) EPC** governs this issue in terms similar to those of Article 122(6) EPC concerning the protection of third-party interests in case of re-establishment of rights after missing a time limit despite observance of all due care. The requirement of good faith guarantees that no rights can be acquired in an abusive way.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

(5) Any person who, in a designated Contracting State, in good faith has used or made effective and serious preparations to use the invention which is the subject of a published European patent application or a European patent in the period between the decision of the Board of Appeal under review, and publication of the mention of the decision of the Enlarged Board of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.

ARTICLE 115 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 73, 83, 84; CA/PL 31/00, point 3)

1. **Article 115(1) EPC** remains substantially unchanged, its **second sentence being transferred to the Implementing Regulations**. Article 115(1), first sentence, EPC contains a clarification to the effect that, in proceedings before the European Patent Office, it is now also possible to present observations concerning the patentability of the invention to which **the patent** relates. This reflects current practice, which takes into consideration observations presented in opposition proceedings (see also present Article 115(2) EPC).
2. **Article 115(2) EPC is deleted, its substance being moved to the Implementing Regulations.**

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.

Revised wording

Article 115

Observations by third parties

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

(2) ***Deleted*** - *to be incorporated into the Implementing Regulations.*

ARTICLE 117 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 74, 83, 84 CA/PL 31/00, point 21)

1. In proceedings before the European patent Office, the following EPO departments have the power to take evidence: the Receiving Section (see decision J 20/85, OJ EPO 1987, 102), the Examining Divisions, the Opposition Divisions, the Legal Division, the Boards of Appeal and the Enlarged Board of Appeal (see also new Article 112a EPC). New **Article 117(1) EPC** no longer lists the individual departments concerned, and instead refers to "**proceedings before the European Patent Office**" in general.
2. New **Article 117(2) EPC** replaces the present **Article 117(2) - (6) EPC**. The **details of the procedure for taking evidence** are transferred to the **Implementing Regulations**.

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

Article 117

Means and taking of evidence

(1) In any proceedings before **the European Patent Office** the means of giving or obtaining evidence shall include the following:

(a) - (g) *Unchanged*

(2) The Implementing Regulations shall specify the procedure for taking such evidence.

(2) ***Deleted*** - *to be incorporated in the Implementing Regulations.*

(3) ***Deleted*** - *to be incorporated in the Implementing Regulations.*

Present wording

(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.

(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.

Revised wording

(4) **Deleted** - to be incorporated in the *Implementing Regulations*.

(5) **Deleted** - to be incorporated in the *Implementing Regulations*.

(6) **Deleted** - to be incorporated in the *Implementing Regulations*.

ARTICLE 119

Explanatory remarks

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 75, 83, 84; CA/PL 31/00, point 3)

1. **Article 119(1), first sentence EPC has been redrafted** to make it clear that the details of notification are laid down in the Implementing Regulations, as has always been the case (cf. Rules 77-82 EPC).
2. In the English text of **Article 119(1), second sentence EPC** the word "given" has been substituted by the word "effected".

Present wording

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.

Revised wording

Article 119
Notification

Decisions, summonses, notices and communications shall be notified by the European Patent Office of its own motion in accordance with the Implementing Regulations. Notifications may, where exceptional circumstances so require, be **effected** through the intermediary of the central industrial property offices of the Contracting States.

ARTICLE 120 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 76, 83, 84; CA/PL 31/00, point 22)

1. **Article 120 EPC** has been redrafted to clarify its meaning.
2. New **Article 120(a) EPC** states now that any time limits **which are not fixed in the Convention** and which have to be observed in proceedings before the EPO are to be specified in the Implementing Regulations.
3. New **Article 120(b) EPC** corresponds to present Article 120(a), the reasons for extension of time limits currently referred to, being moved to the Implementing Regulations.

Present wording

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.

Revised wording

Article 120

Time limits

The Implementing Regulations shall specify:

(a) time limits to be observed in proceedings before the European Patent Office other than those fixed by this Convention;

(b) the manner of computation of time limits and the conditions under which time limits may be extended [...];

(b) *becomes (c) - wording unchanged*

ARTICLE 121 EPC

Explanatory remarks

(Preparatory documents: CA/PL 19/99; CA/PL PV 10, points 22-30; CA/PL 31/00, point 36)

1. The **new version of Article 121 EPC broadens the scope of application of further processing and makes it the standard legal remedy in cases of failure to observe time limits in the European patent grant procedure**. It takes account of practical requirements, according to which further processing should, in the interests of procedural economy and legal certainty, be given priority over the classical re-establishment of rights. The latter has proved to be too complex and unwieldy, and does not fulfil the requirements of a largely standardised "mass procedure".
2. According to **Article 121(1) EPC**, applicants may, following failure to observe a time limit vis-à-vis the EPO, request the further processing of their application. The possibility of further processing is thus as a rule available, subject to the excluding provision of Article 121(4) EPC (see point 5 below), in respect of all time limits which applicants fail to observe in the **grant procedure** or in related ex-parte appeal proceedings. As before, Article 121 EPC does not apply to time limits to be observed by parties in opposition proceedings or in appeal proceedings following opposition. Hence, in contrast to the current provisions, further processing can be applied in particular to the time limits for the payment of filing, search and designation fees, the national basic fees and the examination fee and the time limit for filing the request for examination.
3. **Article 121(2) EPC** stipulates that a request for further processing is to be granted where the requirements laid down in the Implementing Regulations are met. As far as the conditions for filing a request (written form, fee, time limit) are concerned, it is planned to incorporate the current provisions of Article 121(2) EPC into the Implementing Regulations. The time limit for filing the request will continue to be two months and will be triggered by notification of the failure to observe the time limit or of the loss of rights brought about by the omitted act. The omitted act must be completed within this time limit. In line with present Article 121(3) EPC, the request will be decided on by the department competent to decide on the omitted act.
4. If a request for further processing is granted, according to **Article 121(3) EPC** the European patent application must be treated as if the non-observance of the time limit had not happened.

Present wording

Article 121

Further processing of the European patent application

(1) If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit set by the European Patent Office, the legal consequence provided for shall not ensue or, if it has already ensued, shall be retracted if the applicant requests further processing of the application.

Revised wording

Article 121

Further processing of the European patent application

(1) If an applicant fails to observe a time limit vis-à-vis the European Patent Office, he may request further processing of the European patent application.

(2) The European Patent Office shall grant the request provided that the requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.

(3) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.

5. According to **Article 121(4) EPC**, further processing is ruled out for the priority period under Article 87(1) EPC, the time limits for appeal in Article 108 EPC, the time limits in Article 112a(3) EPC (new) and the time limits for requests for further processing and re-establishment of rights.
6. Further exceptions to this principle may be provided for in the Implementing Regulations. This will afford the flexibility needed to adapt the scope of application of Article 121 EPC to changing practical requirements and new time limits. The time limits for payment of renewal fees (Article 86(2), Rule 37 EPC) are also to be excluded from further processing.

Present wording

(2) The request shall be filed in writing within two months of the date on which either the decision to refuse the application or the communication that the application is deemed to be withdrawn was notified. The omitted act must be completed within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.

(3) The department competent to decide on the omitted act shall decide on the request.

Revised wording

(4) Further processing shall be ruled out in respect of the time limits in Articles 87, paragraph 1, 108 and 112a, paragraph 3, as well as the time limits for requesting further processing or re-establishment of rights. The Implementing Regulations may rule out further processing for other time limits.

(2) ***Deleted*** - to be incorporated into the *Implementing Regulations*.

(3) ***Deleted*** - to be incorporated into the *Implementing Regulations*.

ARTICLE 122 EPC

Explanatory remarks

(Preparatory documents: CA/PL 19/99; CA/PL PV 10, points 22-30; CA/PL 31/00, point 36)

1. The amendments to Article 122 EPC take account of the **broadening of the scope of application of further processing** (see Article 121 above) and also aim to **remove from this article details relating to procedure and time limits**. The requirements for re-establishment of rights (**Article 122(1) EPC**), the procedure involved and the current provisions governing the right of continued use will remain unchanged. The scope of application of re-establishment of rights, however, is narrowed down in view of the new provisions governing further processing (see point 4 below).
2. According to **Article 122(2) EPC**, the Office will grant a request for re-establishment of rights provided that the conditions of Article 122(1) EPC and the other requirements laid down in the Implementing Regulations have been met. Present Article 122(2)-(4) EPC will therefore be incorporated into the Implementing Regulations. Thus the period for filing the request will continue to be two months from the removal of the cause of non-compliance with the time limit and the one-year period for admissibility of the request will continue to apply. For re-establishment of the priority period in accordance with Article 87(1) EPC it is intended to incorporate **the minimum time limits fixed by the PLT 2000** (see Rule 14(4) PLT). The time limit for such requests would therefore end two months after expiry of the priority period.
3. **Article 122(3)** corresponds to the equivalent proposal for further processing and makes the principle underlying the re-establishment of rights quite clear, ie that the consequences of failure to observe a time limit will be deemed not to have ensued where a request for re-establishment of rights is granted.

Present wording

Article 122

Restitutio in integrum

(1) The applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of this Convention, of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-payment of a renewal fee, the period specified in Article 86, paragraph 2, shall be deducted from the period of one year.

Revised wording

Article 122

Restitutio in integrum

(1) The applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon **request**, have his rights re-established if the non-observance **of this time limit** has the direct consequence [...] of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) **The European Patent Office shall grant the request provided that the conditions of paragraph 1 and any other requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.**

(3) **If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.**

(2) ***Deleted - to be incorporated into the Implementing Regulations.***

4. In accordance with the present provision (Article 122(5) EPC), **Article 122(4) EPC** provides for re-establishment to be ruled out in respect of the time limit for requesting re-establishment. The Implementing Regulations may rule out re-establishment for other time limits as well. In view of the broader scope of application of further processing (see Article 121 above), it is proposed to rule out the possibility of re-establishment above all for those time limits in respect of which further processing can be requested.
5. Further processing would therefore be ruled out for the following in particular:
 - time limits for payment of fees under Articles 78(2), 79(2), 94(1), (2), Rule 107(1)(c)-(e) EPC
 - time limits in Article 94(2), Rule 107(1)(f) EPC for filing the request for examination
 - time limits in Article 14(2) and (4), Rule 6(1) and (2) EPC for filing translations
 - time limits set by the EPO.
6. As far as the **grant procedure** is concerned, re-establishment will thus be largely replaced by further processing and will only be applied direct where the priority period or the time limit for requesting further processing have not been observed. The extensive loss of the possibility of re-establishment of rights in the grant procedure will however be offset to some extent by the fact that, under the new provisions, re-establishment of rights with respect to the time limit for further processing will continue to be possible. As before, applicants will continue to be able to request re-establishment of rights in the event of failure to observe the time limit for filing the notice of appeal under Article 108 EPC.
7. Patent proprietors will continue to be the only parties able to request re-establishment of rights as a legal remedy in opposition proceedings and appeal proceedings following opposition.

Present wording

(3) The application must state the grounds on which it is based, and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for re-establishment of rights has been paid.

(4) The department competent to decide on the omitted act shall decide upon the application.

(5) The provisions of this Article shall not be applicable to the time limits referred to in paragraph 2 of this Article, Article 61, paragraph 3, Article 76, paragraph 3, Article 78, paragraph 2, Article 79, paragraph 2, Article 87, paragraph 1, and Article 94, paragraph 2.

(6) Any person who, in a designated Contracting State, in good faith has used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the course of the period between the loss of rights referred to in paragraph 1 and publication of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(7) Nothing in this Article shall limit the right of a Contracting State to grant restitutio in integrum in respect of time limits provided for in this Convention and to be observed vis-à-vis the authorities of such State.

Revised wording

(3) **Deleted** - *to be incorporated into the Implementing Regulations.*

(4) **Deleted** - *to be incorporated into the Implementing Regulations.*

(4) Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights. The Implementing Regulations may rule out re-establishment for other time limits.

(6) Becomes **(5)** - *wording unchanged.*

(7) Becomes **(6)** - *wording unchanged.*

ARTICLE 123 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, point 77; CA/PL 31/00, point 23)

1. The applicant's right to make amendments to the application (and, where applicable, the patent) is maintained in the new version of **Article 123(1) EPC**. The first sentence has been redrafted in order to make it clear that not only the conditions under which amendments may be made are laid down in the Implementing Regulations (Rule 86 EPC), but also other matters such as the form of the amendments (see Rule 36(1), first sentence, EPC). The new version leaves open the possibility for the Implementing Regulations to limit, under certain circumstances, the right to make amendments to the description.
2. **Article 123(2) EPC** has been brought into line with Article 123(1) by means of an editorial amendment.
3. **Article 123(3) EPC contains both a substantive and an editorial clarification.** According to the new version, the **European patent as a whole** (ie the claims, description and drawings, if any) may not be amended in such a way as to extend the protection it confers (see T 1149/97 - Fluid transducer/SOLARTRON, OJ EPO 2000, 259). This principle is applicable in all proceedings before the European Patent Office, as well as in national proceedings. This new wording brings Article 123(3) into line with Article 138(1)(d) EPC.

Present wording

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.

Revised wording

Article 123
Amendments

- (1) [...] **The** European patent application or **the** European patent may be amended in proceedings before the European Patent Office **in accordance with** the Implementing Regulations. In any case, **the** applicant shall be **given** at least one opportunity of amending the **application** of his own volition.
- (2) **The** European patent application or **the** 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 [...] European patent may not be amended [...] in such a way as to extend the protection **it confers**.

ARTICLE 124 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 78, 83; CA/PL 31/00, point 24)

1. According to the present wording of Article 124(1) EPC, the applicant can be invited to indicate the states in which he has filed national patent applications and to give the reference numbers for such applications. **The amendment to Article 124(1) EPC is intended to extend its scope of application**, so that the EPO can also obtain from the applicant **information about the prior art** considered in proceedings concerning corresponding patent applications for an invention to which the European patent application relates.
2. Since the priority of a national patent application is claimed for about 90% of European patent applications, the EPO should be in a position to request more information about corresponding national or regional applications - particularly first filings on which the priority is based - than is possible under existing Article 124 EPC. In particular, the search results for these applications or other data concerning the relevant prior art considered in proceedings before a national or regional office can be helpful to the EPO when processing the corresponding European patent applications. If the EPO does not already have such information (cf. Article 130 EPC), it should be able to obtain from the applicant any data relating to the prior art which he can easily access. By providing such information, the applicant can help to speed up the European grant procedure and enhance the quality of search and substantive examination.
3. **The Implementing Regulations** will define **the prior art information** the EPO can require, particularly data on **search reports** drawn up on corresponding national or regional applications, or **other relevant prior art** taken into account when processing the application. The period within which the applicant has to respond to the Office's invitation will also be laid down in the Implementing Regulations.

Present wording

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.

(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.

Revised wording

Article 124

Information **on the prior art**

(1) **The European Patent Office may, in accordance with the Implementing Regulations, invite the applicant to provide information on the prior art taken into consideration in national or regional patent proceedings and concerning an** invention to which the European patent application relates.

(2) *Unchanged*

ARTICLE 126 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 8/00, point 14; CA/PL PV 13, points 25-30; CA/PL 31/00, point 3)

1. **Article 126 EPC** relates to the termination of financial obligations, both in terms of fees owed to the European Patent Organisation and in terms of rights to refunds against the European Patent Organisation.
2. This provision is oddly included in the common provisions governing the internal procedures of the European Patent Office. The preparatory documents to the European Patent Convention show that initially, Article 126 EPC began as a provision in the draft Implementing Regulations, together with the content of Rule 91 EPC, which allows the President to waive enforced recovery procedures. (See: *First Preliminary Draft of the Implementing Regulations to the Convention establishing a European System for the Grant of Patents*, 1971, p. 256, No. 10, re: Article 145.)
3. The historical materials expressly state that in practice, the scope of application of Article 126 EPC was expected to be confined to those fees laid down by the President of the Office in accordance with Article 3 RFees. (See *Bericht über die Sitzung der Arbeitsgruppe I, 14-17 September 1971 in Luxemburg*, BR/132 d/71, p. 25.) The reason is that procedural fees prescribed under the EPC are generally due before the Office performs the act for which the fee is charged. The sanction for failure to pay is generally either total or partial loss of rights. At any rate, if the procedural act is not performed, the fee ceases to be due to the Office. In particular, Article 126 EPC does not apply to payments by Contracting States in respect of renewal fees for European patents under Article 39 EPC.
4. Therefore **Article 126 EPC is deleted** and its substance is to be **moved** to the appropriate place, **ie the Rules relating to Fees**.

Present wording

Article 126

Termination of financial obligations

- (1) Rights of the Organisation to the payment of a fee to the European Patent Office shall be extinguished after four years from the end of the calendar year in which the fee fell due.
- (2) Rights against the Organisation for the refunding by the European Patent Office of fees or sums of money paid in excess of a fee shall be extinguished after four years from the end of the calendar year in which the right arose.
- (3) The period laid down in paragraphs 1 and 2 shall be interrupted in the case covered by paragraph 1 by a request for payment of the fee and in the case covered by paragraph 2 by a reasoned claim in writing. On interruption it shall begin again immediately and shall end at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; in this case the period shall end at the earliest one year after the judgment enters into force.

Revised wording

Deleted

ARTICLE 127**Explanatory remarks**

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 79, 83, 84; CA/PL 31/00, point 25)

1. The **title of Article 127 EPC** has been redrafted in order to clarify that the Register kept by the EPO is called "**European Patent Register**". This is also reflected now in Article 127 EPC itself.
2. **Article 127, first sentence EPC has been redrafted without any change in substance.** The present wording is, however, too restrictive with regard to the particulars of the European Patent Register. Thus it is now clarified that the Implementing Regulations specify in detail which particulars of European patent applications and patents including the proceedings concerning them are to be recorded in the European Patent Register (see Rule 92 EPC).

Present wording

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.

Revised wording

Article 127

European Patent Register

The European Patent Office shall keep a **European Patent Register, in which the particulars specified in the Implementing Regulations shall be recorded.** 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

Explanatory remarks

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 80, 83, 84; CA/PL 31/00, point 3)

1. Article 128(1) - (4) EPC remains unchanged.
2. **Article 128(5) EPC** is amended in such a way that the particulars which the EPO may communicate to third parties or publish are to be specified in the Implementing Regulations. Thus **Article 128(5)(a) - (e) is to be transferred to the Implementing Regulations.**

Present wording

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) 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.

Revised wording

Article 128

Inspection of files

(1) - (4) *Unchanged*

Present wording

(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.

Revised wording

(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) ***Deleted*** - to be incorporated into the *Implementing Regulations*.

ARTICLE 129 EPC

Explanatory remarks

(Preparatory documents: CA/PL 19/98; CA/PL PV 8, point 12; CA/PL 31/00, point 3)

1. Under **Article 129(a) EPC as currently worded**, the European Patent Bulletin includes entries made in the Register of European Patents (Article 127 EPC). The information which has to be entered in the Register is listed in Rule 92(1) EPC; other provisions relating to Register entries are contained in Rules 19, 20-22 and 61 EPC. Under Rule 92(2) EPC, the President of the EPO can also include other information in the Register, but so far has made little use of this power(see OJ EPO 1983, 458; 1986, 61 and 327), because under Article 129(a) EPC such additional information would also have to go into the Bulletin, making the printed version too unwieldy.
2. Ever since the EPO opened, users (especially documentation specialists) have been making suggestions for improving and expanding the Register. To implement these ideas and make much more procedural data available online without (in view of Article 129(a) EPC) unduly inflating the Bulletin, the EPO has been publishing this data in a separate, unofficial "Information register (epidos)". However, splitting up the data between two separate registers is not user-friendly and should therefore be discontinued. **To combine both registers without affecting the Bulletin means amending Article 129(a) EPC accordingly.**
3. Hence the amendment proposed below. This would separate Register and Bulletin data, thereby ensuring that entries prescribed directly or indirectly by the EPC, now or in the future (Articles 65(1), 79(2), 94(2), 97(4), 158(1); Rules 19(2), 96(2), 105), would have to appear in the Bulletin. It would also empower the President to specify further entries as appropriate. The Bulletin's contents could then be laid down direct by the President, after consulting the users as necessary.
4. Using modern electronic systems, the EPO could then tailor the Register to users' growing information needs. It would no longer be obliged to publish, at great expense, the same information in the Bulletin in printed form as is contained in the Register. If demand for hard-copy data continues to fall the President could quickly and easily adjust the Bulletin as necessary.

Present wording

Article 129

Periodical publications

The European Patent Office shall periodically publish:

(a) a European Patent Bulletin containing entries made in the Register of European Patents, as well as other particulars the publication of which is prescribed by this Convention;

(b) an Official Journal of the European Patent Office, containing notices and information of a general character issued by the President of the European Patent Office, as well as any other information relevant to this Convention or its implementation.

Revised wording

Article 129

Periodical publications

The European Patent Office shall periodically publish:

(a) a European Patent Bulletin containing **particulars the publication of which is prescribed by this Convention, the Implementing Regulations or by the President of the European Patent Office;**

(b) *Unchanged*

ARTICLE 130**Explanatory remarks**

(Preparatory documents: CA/PL 18/00; CA/PL PV 13, points 81, 83, 84; CA/PL 31/00, point 3)

1. **Article 130(1) EPC** has been redrafted in such a way that the EPO and the central industrial property office of any Contracting State communicate to or request from each other any useful information not only regarding European or national patent applications, but also regarding European or national **patents**. The wording has also been brought into line with that of present Article 131(1) EPC, clarifying that such an exchange of information takes place, **unless the EPC or the national law provides otherwise**. Due to this clarification the present reference to Article 75(2) EPC is no longer necessary.
2. **Article 130(2) EPC** remains basically unchanged. Only **Article 130(2)(a) EPC** is redrafted for clarification.

Present wording

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

Revised wording

Article 130

Exchange of information

(1) **Unless otherwise provided in this Convention or in national laws**, 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**.

(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*

ARTICLE 133 EPC

Explanatory remarks

(Preparatory documents: CA/PL 22/00; CA/PL PV 13, points 85-89 and 92-93; CA/PL 31/00, point 26)

1. Article 133 EPC contains the general principles governing representation with respect to proceedings under the Convention. It remains unchanged subject to **minor editorial streamlining** and changes aimed at increasing the **consistency** of the text of the Convention.
2. In particular, the deleting of the words "within the territory of" does not purport to change the geographical area of application of the provision. The territorial field of application of the EPC generally is defined by the contracting states themselves, pursuant to Article 168 EPC.

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 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.

Revised wording

Article 133

General principles of representation

- (1) *Unchanged*
- (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 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 have their principal place of business [...] **in a** Contracting State and which have economic connections with the first legal person.
- (4) **Deleted** - *Unnecessary in view of the proposed amendment to Article 164 EPC*

ARTICLE 134 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/98 and 22/00; CA/PL PV 8, points 10-11; and PV 13, points 85-90 and 93, CA/PL 31/00, point 26)

1. **Article 134 EPC** deals with issues of professional representation, determining who may represent persons in proceedings established under the Convention and in particular, the conditions under which a person may be entered on the list of professional representatives. Furthermore, Article 163 EPC deals with the entitlement of national representatives of a state acceding to the EPC to be entered on that list.
2. Article 163 EPC forms part of the transitional provisions of Part XI of the Convention, which are now superseded. It is therefore deleted. However, Article 163(6) EPC governs the entitlement of national representatives in a state having newly acceded to the EPC after the expiry of the transitional period (which ended on 7 October 1981, see OJ EPO 1978, 327) to be entered onto the list of professional representatives. This provision is not transitional in nature and retains its entire significance as a "grandfather clause".
3. As a result, the **substance of the "grandfather clause" of Article 163 EPC is added to Article 134 EPC** as a permanent feature of the Convention, in order to deal with the situation of national representatives of States acceding to the Convention in the future.
4. The wording of Article 134 EPC has been streamlined and minor editorial changes have been made with the objective of improving the consistency of the text.
5. Finally, Article 134(8)(b) EPC deals with the establishment of an institute constituted by persons entitled to act as professional representatives. The *epi* having been established, this provision as framed is obsolete. Therefore, **Article 134(8) EPC** has been severed and turned into a **new Article 134a EPC** anchoring the existence of the *epi* in the Convention.

Present wording

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.

Revised wording

Article 134

Professional **representation**

- (1) *Unchanged*
- (2) Any natural person who [...]:
- (a) **is** a national of one of the Contracting States;
- (b) **has** his place of business or employment [...] in a Contracting State; and
- (c) **has** passed the European qualifying examination,
- may be entered on the list of professional representatives.
- (3) **During a period of one year from the date on which the accession of a State to this Convention takes effect, entry on that list may also be requested by any natural person who:**
- (a) **is** a national of one of the contracting states;
- (b) **has** his place of business or employment in the state having acceded to the Convention; and

Present wording

(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 this Convention.

(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 such action is taken, the President of the European Patent Office shall be consulted.

Revised wording

(c) is 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 in that state 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) - Wording unchanged*

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

Present wording

(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 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 the 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.

Revised wording

(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 [...] **a** Contracting State and having his place of business [...] **in that** State, to the extent that he is entitled [...] **in that** State to act as a professional representative in patent matters. Paragraph **6** shall apply mutatis mutandis.

(8) ***Deleted - Becomes new Article 134a EPC***

NEW ARTICLE 134a EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/98 and 22/00; CA/PL PV 8, points 10-11 and CA/PL PV 13, points 85-93; CA/PL 31/00, point 27)

1. **Article 134(8)(b) EPC** deals with the establishment of an institute constituted by persons entitled to act as professional representatives. With the *epi* in existence, this paragraph as framed is obsolete. The rest of Article 134(8) EPC sets forth the powers of the Administrative Council to adopt provisions governing the standards for admission as a professional representative, the conducting of qualifying examinations and the disciplinary powers to be exercised by that institute or the EPO.
2. In the interest of clarity, **these provisions are turned into a new Article 134a EPC**, containing the substance of existing **Article 134(8) EPC** and anchoring the existence of the *epi* in the Convention.
3. A **new sub-paragraph (d)** is added to **Article 134a EPC**. In the course of exercising their professional activities in relation to a European patent application or granted patent, European professional representatives will give and receive confidential information, the secrecy of which must be safeguarded.

Article 2 of the Regulation on Discipline for professional representatives adopted by the Administrative Council of the European Patent Organisation provides that secrecy relating to confidential information must be maintained by the professional representative.

American law distinguishes between the lawyer's obligation of confidentiality and the **evidentiary privilege** protecting the confidentiality of attorney-client communications. In a recent decision, (*Bristol-Myers Squibb v. Rhône Poulenc Rorer*, Southern District of New York, 21 April 1999), applying *lex loci*, the US District Court held that the *epi*'s Disciplinary Rule on secrecy did not confer on European professional representatives the equivalent of the US attorney-client privilege, with the result that the entire contents of the files of the European professional representatives of a French company were ordered to be produced in court by the American judge. The US attorney-client privilege applies only in limited circumstances, which may be summarised as follows:

where legal advice is sought from a professional legal advisor in his capacity as such the communication relating to that purpose made in confidence by the client [or attorney] are at his instance permanently protected from disclosure by himself or the legal advisor except if the privilege is waived.
(*Wigmore, Evidence*, 1961, § 2292 at 554, cited in *Bristol-Myers* at 22.)

Present wording

Article 134

Professional representatives

(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 the 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.

Revised wording

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, 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;

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

Therefore, the problem is that in US court proceedings, US domestic law refers to European law to decide whether any attorney-client privilege applies to communications between a European professional representative and his client or any other person. At present, no such evidentiary privilege exists, the reason being that neither the EPO nor its Boards of Appeal have the capacity to force a European professional representative to disclose such information. Thus, with a view to protecting - in the course of US proceedings - the confidence of communications between European professional representatives and their clients, it appears necessary to **introduce a representative-client privilege applicable in EPO proceedings**, equivalent to that existing in the US. This notion is not entirely foreign to the EPC contracting states insofar as a similar evidentiary privilege exists under certain circumstances *eg* in the United Kingdom (see the UK Patents Act, sec. 104).

Consequently, **new Article 134a(1)(d) EPC** confers on the Administrative Council the competence to create an evidentiary exception modelled on the US attorney-client privilege, applying solely to proceedings before the EPO.

4. **New Article 134a(2) EPC**, to the effect that any person entered on the list of professional representatives shall be a member of the *epi*, anchors in the Convention the principle clearly formulated in Article 5(1) of the Regulation on the Establishment of the Institute, and implied in current Article 134(8)(b) EPC.

(d) the obligation of confidentiality of the professional representative and the privilege from disclosure in proceedings before the European Patent Office in respect of communications between a professional representative and his client or any other person.

(2) Any person entered on the list of professional representatives referred to in Article 134, paragraph 1, shall be a member of the Institute.

ARTICLE 135 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 23/00; CA/PL PV 13, points 94-97; CA/PL 31/00, point 3)

1. **The content of the present Articles 135 and 136 EPC has been combined in one article** and certain elements of Articles 135(2) and 136(1) EPC are transferred to the Implementing Regulations.
2. There has been an editorial change to **Article 135(1)** EPC. It also reflects the new paragraph numbering in Article 77 EPC and the deletion of Article 162(4) EPC.
3. The content of **Article 135(2)**, first sentence, is transferred to the Implementing Regulations. An editorial change has been made to Article 135(2), second sentence, and it has been renumbered as Article 135(4). The **new Article 135(2)** reflects the content of what is currently Article 136(2), first and second sentences.

Present wording**Article 135**

Request for the application of national procedure

(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;
- 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.

Revised wording**Article 135**

Request for the application of national procedure

(1) The central industrial property office of a designated Contracting State shall apply the procedure for the grant of a national patent [...] at the request of the applicant for or proprietor of a European patent [...] in the following circumstances:

- a) when the European patent application is deemed to be withdrawn pursuant to Article 77, paragraph 3 [...];

b) *Unchanged*

(2) **In the case referred to in paragraph 1(a) [...]**, the request for conversion shall be filed with the central industrial property office with which the **European patent** application has been filed. That office shall, subject to the provisions of national security, transmit the request [...] directly to the central industrial property offices of the Contracting States specified **therein [...]**.

4. The **new Article 135(3)** contains the essential elements of Article 136(1) and makes it clear that the request for conversion must be made in accordance with the Implementing Regulations.
5. The **new Article 135(4)** makes one provision out of Article 135(2), second sentence, and Article 136(2), third sentence, and incorporates one editorial change.

Present wording**Revised wording**

(3) In the cases referred to in paragraph 1(b), the request for conversion must be submitted to the European Patent Office in accordance with the Implementing Regulations. It 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. [...]

(4) The effect of the European patent application referred to in Article 66 shall lapse if the request for conversion is not submitted in due time.

ARTICLE 136 EPC

Explanatory remarks

(Preparatory documents: CA/PL 23/00; CA/PL PV 13, points 94-97; CA/PL 31/00, point 3)

Article 136 EPC, whose **content is reflected** for the most part in the **new Article 135(2), (3) and (4) EPC**, **has been deleted**. The second part of the first sentence in Article 136(1) EPC and the last part of the third sentence in Article 136(1) EPC are transferred to the Implementing Regulations.

Present wording**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 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.

Revised wording**Deleted**

(1) *Transferred to Article 135(3) and to the Implementing Regulations.*

(2) *Transferred to Article 135(2) and (4).*

ARTICLE 138 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 19/00; CA/PL PV 13, points 98-107; CA/PL 31/00, point 28)

1. The aim of the amendments to Article 138 EPC is to have the proprietor's right to limit a European patent in national proceedings relating to its validity expressly enshrined in the Convention. This establishes self-limitation by the patent proprietor as a practice which is recognised in most contracting states and formalises and extends the degree of harmonisation achieved in that respect. This is necessary above all in view of the forthcoming accession of new contracting states.
2. The **new** title reflects the addition of paragraph 3.
3. The change to the introductory part of **Article 138(1) EPC** is primarily editorial in nature. It makes it easier for reference to be made to Article 138 EPC in other legal instruments such as any future Protocol on Litigation. However, the deletion also makes it clear that Article 138 EPC does not make national revocation of European patents conditional on the adoption of special national provisions. In that respect the principle behind Article 2(2) EPC applies: granted European patents, within the boundaries drawn by Article 138 EPC, are subject to the conditions applicable to national patents.
4. The changes to **Article 138(1)(b)** and **(c)** are also editorial in nature and serve to bring the English and French versions into line with the German.

Present wording**Article 138****Grounds for revocation**

- (1) Subject to the provisions of Article 139, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:
- (a) if the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;
- (b) if the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) if the subject-matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed;
- (d) if the protection conferred by the European patent has been extended;
- (e) if the proprietor of the European patent is not entitled under Article 60, paragraph 1.

Revised wording**Article 138****Revocation of European Patents**

- (1) Subject to [...] Article 139, a European patent may [...] be revoked [...] with effect for **a Contracting State only** on the following grounds:
- (a) if the subject-matter of the European patent is not patentable **under** Articles 52 to 57;
- (b) - *Unchanged*
- (c) if the subject-matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new applications filed **under** Article 61, beyond the content of the earlier application as filed;
- (d) - (e) *Unchanged*

5. The **new wording of Article 138(2) EPC** makes it clear that limitation and partial revocation of a European patent are always to take the form of a corresponding amendment to the patent claims. This does away with the opportunity previously provided for under Article 138(2), second sentence, EPC to pronounce partial revocation simply by amending the description or drawings.
6. In European opposition proceedings (see Article 102(3) EPC) and for most national revocation proceedings it is accepted that a patent proprietor faced with objections to the validity of his patent may limit it to those parts which are not affected by the objections. There is also provision for self-limitation in the revocation proceedings envisaged for Community patents (see Article 58(3) CPC 1989).
7. **New Article 138(3) EPC makes this principle explicit** and binding in proceedings relating to the validity of European patents. It is designed to give the patent proprietor the right in such proceedings to submit an amended, ie limited, version of his claims which in his view meets the objections to the validity of his patent. This limited version of the patent must then form the basis for subsequent proceedings. If the court or authority dealing with the case considers that the proprietor's own limitation is insufficient, it may further limit the patent or revoke it in full.
8. As in European opposition proceedings and in accordance with the proposed limitation procedure (see Article 105a ff above), the effect of limiting or revoking a European patent in national revocation proceedings is retroactive. A reference to national revocation proceedings is therefore to be added to Article 68 EPC (see Article 68 EPC above).

Present wording

(2) If the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

Revised wording

(2) If the grounds for revocation only affect the European patent in part, **the patent shall be limited by a corresponding amendment of the claims and revoked in part. [...]**

(3) **In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by an amendment of the claims. The patent as thus limited shall form the basis for the proceedings.**

NEW ARTICLE 149a EPC**Explanatory remarks**

(Preparatory documents: CA/PL 24/00; CA/PL PV 13, points 153-155; CA/PL 31/00, point 37)

1. **New Article 149a EPC is to create a clear legal basis for any future agreements between the EPC contracting states concerning such matters as translation requirements or litigation concerning European patents.**
2. The Paris Intergovernmental Conference of 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.

The two Working Parties on "Cost Reduction" and "Litigation" have since held three meetings and accomplished their tasks by respectively finalising a draft agreement on the application of Article 65 EPC (see WPR/6/00 Rev. 3) and completing a comprehensive paper on the structure of an optional protocol on litigation (see WPL/9/99 Rev. 1) as well as proposals for a so-called "common entity" (see WPL/10/00).

3. In the light of these developments and the possible outcome that in future such agreements could be concluded between the EPC contracting states, involving also the European Patent Organisation and the EPO, it appears necessary to provide for a clear legal basis in the EPC dealing with such special agreements and their interface with EPC and EPO.
4. **New Article 149a(1) EPC** expressly underlines that the Convention does not prevent any contracting state from concluding with other contracting states agreements on any matters which under the EPC are governed by national law (see Art. 2, 64(2) and 65 EPC). Letters (a) to (d) explicitly refer to those agreements which are currently under consideration, i.e.

- an agreement establishing a common European patent court of first and/or second instance, competent to settle litigation on infringement and validity of European patents;

- an agreement establishing a common entity, competent to deliver opinions on issues of European or harmonised national patent law referred to the common entity by national courts or quasi-judicial authorities of a contracting state party to such an agreement; and

- agreements under which a translation of the European patent under Article 65 EPC would be dispensed with fully or in part, or may be filed with the EPO.

Present wording

At present there is nothing equivalent to this provision in the EPC.

Revised wording

Part IX

SPECIAL AGREEMENTS

Article 149a

Other agreements between the Contracting States

(1) Nothing in this Convention shall be construed to limit the right of some or all of the Contracting States to conclude special agreements on any matters concerning European patent applications or European patents which under this Convention are subject to and governed by national law, such as in particular

(a) an agreement establishing a European patent court common to the Contracting States party to it;

(b) an agreement establishing an entity common to the Contracting States party to it to deliver, at the request of national courts or quasi-judicial authorities, opinions on issues of European or harmonised national patent law;

(c) an agreement under which the Contracting States party to it dispense fully or in part with translations of European patents under Article 65;

(d) an agreement under which translations of European patents as required under Article 65 may be filed with, and published by, the European Patent Office.

5. **New Article 149a(2)** addresses the involvement of the European Patent Organisation once an agreement under paragraph (1)(a) or (b) has been concluded and entered into force.

As it is most likely that any such agreement will provide that members of EPO Boards of Appeal may (and ought to) serve on the European patent court and/or common entity, while continuing to serve on the boards of appeal, there should be a clear legal basis in the Convention enabling the Administrative Council to decide that the members of the boards are entitled to do so. **Paragraph (2)(a) makes provision for this.**

Furthermore, the EPC contracting states signing an agreement on a common entity would most probably want the common entity to be established and to operate within the framework of the European Patent Organisation. Here again, a clear legal basis in the Convention should be created enabling the Administrative Council to decide that the EPO provides the common entity with the necessary staff, premises and equipment and that the expenses incurred by such an entity be borne fully or in part by the Organisation. **Paragraph (2)(b) makes provision for this.**

It should be noted that a common entity might be of a transitional nature since it is intended that their duties should be taken over by a common European appeal court once such a court has been set up. Any financing of the common entity by the European Patent Organisation would then have to cease.

Present wording

Revised wording

(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 serve on a European patent court or a common entity and take part in any proceedings before that court or entity in accordance with the terms of any such 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, and the expenses incurred by that entity be borne fully or in part by the Organisation.

ARTICLES 150 - 158 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 12/98; CA/PL 13/98, point 9; CA/PL PV 7, points 93-104; CA/PL 21/00; CA/PL PV 13, points 122-127; CA/PL 31/00, point 3)

1. The **revised version of Part X of the EPC** is chiefly 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 the EPC and PCT, some provisions have clearly become superfluous and are therefore candidates for deletion. Finally, to avoid repetition and redundancies, the remaining articles are re-organised in line with the procedures in question. A single basic provision is followed by two articles defining the EPO's functions as a receiving Office and an international authority in the **international** phase of the PCT and a final article combining the provisions relating to the **European** phase.
2. **The heading** of the revised Part X includes the term "**Euro-PCT applications**", which is now standard usage (see also **new Article 153(2) EPC**.)

Present wording

PART X
INTERNATIONAL APPLICATION
PURSUANT TO THE PATENT
COOPERATION TREATY

Revised wording

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

ARTICLE 150 EPC

Explanatory remarks

1. The **principles** governing the interaction between the EPC and PCT will continue to be laid down in **Article 150(1) and (2) 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.
2. **Article 150(2) EPC** expressly refers to the PCT Regulations, as the PCT itself lacks a provision corresponding to Article 164 EPC declaring the Regulations to be an integral part of the Treaty.
3. Also deleted is **Article 150(2), fourth sentence**, in which the precedence of the PCT is asserted yet again with regard to the **time limit for the request for examination**. In the light of the previous sentence, this is an unnecessary repetition. The time limit, moreover, is already defined in conformity with the PCT in **Rule 107(1) EPC**.
4. Because of the relationship of the subject-matter - EPO as designated Office or elected Office - **Article 150(3) EPC** is incorporated into **new Article 153(2) EPC**.
5. The substance of **Article 150(4) EPC** has been transferred to **Article 150(2) EPC** (see point 2 above).

Present wording

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

Revised wording

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 and its Regulations** shall be applied, supplemented by the provisions of this Convention. In case of conflict, the provisions of the **[...] PCT or its Regulations** shall prevail. [...]
- Fourth sentence **deleted** - To be incorporated in the Implementing Regulations (see Rule 107(1)(f))*
- (3) **Deleted**
- (4) **Deleted**

ARTICLE 151 EPC**Explanatory remarks**

1. The role of the EPO as **PCT receiving Office** and the regulations governing the filing and transmittal of international applications (Articles 151 and 152 EPC) may be **combined into one provision**.
2. The cross-reference to Article 75(2) EPC in Article 152(1) EPC has been moved to Article 151 EPC.
3. Rule 104 EPC will be extended to include details of the conditions under which the EPO acts as a receiving Office (in particular, the requirement that the applicant be a resident or national of an EPC and PCT contracting state, and the details of where and how the international application is to be filed with the EPO).
4. Experience has shown that there is no need for paragraphs (2) and (3) of Article 151 EPC, which can therefore be deleted or incorporated into the Implementing Regulations in case of future necessity.

Present wording

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.

Revised wording

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) ***Deleted***

(3) ***Deleted***

ARTICLE 152 EPC**Explanatory remarks**

1. The reference to Article 75(2) EPC in Article 152(2) EPC has been transferred to the revised Article 151 EPC.
2. The remaining provisions are to be incorporated in the Implementing Regulations, where Rule 104 EPC already governs the application of Article 152(2) EPC.
3. The provision regarding the transmittal fee in Article 152(3) EPC is deleted. In the interests of flexibility, it makes sense to move this rule on fees, which has its basis in Rule 14 PCT, to the Implementing Regulations. This brings the rule into line with the existing arrangements concerning the fees for international search and preliminary examination, which are not anchored in the Convention itself but in the Agreement between the EPO and WIPO and in Rule 105 EPC.

Present wording

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.

Revised wording

Deleted - *To be incorporated in Rule 104 EPC (see also new Article 151)*

ARTICLE 152 EPC (new)**Explanatory remarks**

1. 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 EPC. The main reason for this is the two-stage nature of the PCT, which differentiates between Chapter I and Chapter II. However, this distinction has become meaningless, as Chapter II has been binding on **all the contracting states to both the EPC and the PCT** since 1997. Its practical relevance is also dwindling: at present, around 80% of applicants opt for the procedure under Chapter II. Moreover, the consolidated treatment in Rule 105 EPC of the EPO's tasks as an international searching authority and preliminary examining authority has worked well for many years. This is to be reflected in the Convention itself by the joint provision of **new Article 152 EPC**.
2. The reservation clauses relating to the entering into force of Chapters I and II PCT in Articles 154(1) and 155(1) EPC are unnecessary, as they repeat the "contracting state" principle already laid down in Articles 9(1) and (2) and 31(2)(a) and (b) PCT.
3. The **requirement** in Articles 154(2) and 155(2) EPC **for the prior approval** of the Administrative Council is also superfluous, as this already results from Article 33(4) EPC. The **option** under the **EPC** for the Administrative Council to include applicants from non-EPC states in the agreement with WIPO is retained in **Article 152, second sentence, EPC**.
4. The EPO's two-tiered review system for the **PCT protest procedure**, provided for under Articles 154(3) and 155(3) EPC in conjunction with Rule 105 EPC, is unique amongst international authorities, is work-intensive, costly and leads to unjustifiable delays. Recent practice has shown that provision can be made in the Implementing Regulations for a simplified protest procedure which complies with Rules 40.2(c) and 68.3(c) PCT and continues to guarantee legal certainty. The President's decision of 25 August 1992 (OJ EPO 1992, 547) can serve as the basis for such a provision. **Articles 154(3) and 155(3) EPC are therefore deleted.**

Present wording

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.

Revised wording

Article 152

The European Patent Office as an
International Searching Authority **or**
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 applicants who are residents or nationals of a Contracting State **to this Convention [...]. This agreement may provide that** the European Patent Office shall also act [...] for [...] other applicants [...].

(2) **Deleted** - moved to second sentence, above

(3) **Deleted**

ARTICLE 155 EPC

Explanatory remarks

See the remarks on Article 152 EPC (new)

Present wording

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 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.

Revised wording

Deleted - Transferred to Article 152

ARTICLE 153 EPC

Explanatory remarks

1. The provisions governing entry into the "European phase", the subsequent proceedings before the **EPO as designated Office or elected Office**, the effects of the international publication and the international search report are currently contained in Articles 153, 156, 157 und 158 EPC.
2. **Articles 153 and 156 EPC** in particular can be **consolidated**: firstly, because Chapters I and II PCT are equally binding on all the contracting states to the EPC and PCT, which renders the second sentence of Article 156 meaningless; and secondly, because experience has shown that there is no need for two separate provisions dealing with the EPO's activities as designated Office and elected Office. The consolidation of the corresponding provisions in the Implementing Regulations (Rule 107 EPC) has also worked well for many years.
3. The key elements of Article 153(1), first sentence, EPC are now contained in **sub-paragraph (a) of new Article 153(1) EPC**; the substance of Article 156, first sentence, is transferred to **sub-paragraph (b)**.
4. The retention of Article 153(1), second sentence, EPC is unnecessary, as it merely reiterates Article 4(1)(ii), final clause, PCT ("... if under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent...."; see also Article 45 PCT). The second sentence of Article 156 EPC is also superfluous.
5. **New Article 153(2) EPC** governs, in addition to Article 11(3) PCT, the conditions under which an international application has the effect of a European application, and clarifies the principle deriving from Article 150(3) EPC. The term "Euro-PCT application" is also introduced. See also the explanatory remarks on the new paragraph 5.
6. The provision of Article 153(2) EPC governing competence for review under Article 25 PCT is transferred to the Implementing Regulations. There is no obvious reason why such competence should be defined in the Convention itself.

Present wording

Article 153

The European Patent Office as designated Office

(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.

*[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.]*

(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.

Revised wording

Article 153

The European Patent Office as designated Office **or elected Office**

(1) The European Patent Office shall **be**

(a) a designated Office [...] for **any** Contracting State to this Convention in respect of which the [...] **PCT is in force**, [...] which is designated in the international application **and for which** the applicant [...] wishes to obtain a European patent [...], **and**

(b) an elected Office, if the applicant has elected a state designated pursuant to (a).

(2) An international application [...] for which the European Patent Office **is** a designated or elected Office [...], **and which has been accorded an international date of filing, shall be equivalent to a regular European application (Euro-PCT application).**

(2) ***Deleted*** - *To be incorporated in the Implementing Regulations*

7. **New Article 153(3) EPC** incorporates the substance of Article 158(1), first sentence, EPC concerning the **effect of international publication** of a Euro-PCT application. The explicit reference to the relevant PCT provision has been removed in order to avoid discrepancies if the PCT is revised.
8. **New Article 153(4) EPC** largely corresponds to Article 158(3) EPC, stipulating when a translation of the Euro-PCT application is to be filed with the EPO and published by the EPO, and what effect such publication has.
9. **New Article 153(5) EPC** clarifies, following the new paragraph 2, the conditions for **entry into the European phase**, referring expressly to new paragraphs 3 and 4 and to the Implementing Regulations, where these conditions are specified (see Rules 106 ff). This is now combined with the stipulation, taken from Article 158(1), second sentence, EPC, that the Euro-PCT application shall only be considered as comprised in the state of the art in accordance with Article 54(3) if the conditions in question are fulfilled.
10. In accordance with the new structure, the provisions of Article 157(1) EPC regarding the function of the international search report, of any declaration replacing it under Article 17(2)(a) PCT and of their international publication have been transferred to **new Article 153(6) EPC**. As in the new paragraph 3, the explicit references to the relevant PCT provisions have been removed in order to avoid discrepancies if the PCT is revised.

Present wording

[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.

...

(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.]

[see also 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.]

[See present 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 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.]

Revised wording

(3) The international publication [...] of a [...] Euro-PCT 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.

(4) If the Euro-PCT application is published in another language [...], a translation into one of its official languages shall be filed with the European Patent Office Office, which shall publish it [...]. Subject to Article 67, paragraph 3, the provisional protection under Article 67, paragraphs 1 and 2, shall be effective from the date of that publication.

(5) The Euro-PCT application shall be treated as a European patent application and shall [...] be considered as comprised in the state of the art under Article 54, paragraph 3, if the conditions laid down in paragraphs 3 or 4 and in the Implementing Regulations are fulfilled.

(6) [...] The international search report drawn up in respect of a Euro-PCT application [...] 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.

11. The requirement under Article 157(2)(a) EPC for a **supplementary European search report** and the provision in Article 157(3) authorising the Administrative Council to make exceptions are transferred to **new Article 153(7) EPC**.
12. The fee provision in Article 157(2)(b) EPC is transferred to the Implementing Regulations, which will then contain **all** the fees that fall due on entry into the European phase, together with the provisions on the legal consequences of late payment (see Rules 106-108 and 110 EPC).

Present wording

[see present Article 157:

(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.

...

Revised wording

(7) [...] A supplementary European search report shall be drawn up in respect of **any Euro-PCT** application **under paragraph 5.**

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

ARTICLE 156 EPC

Explanatory remarks

See the remarks on Article 153

Present wording

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 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.

Revised wording

Deleted - *Transferred to Article 153(1)*

ARTICLE 157 EPC

Explanatory remarks

See the remarks on Article 153.

Present wording

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.
- (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.

Revised wording

Deleted

- (1) ***Deleted*** - Transferred to Article 153(6)
- (2) ***Deleted*** - Transferred to Article 153(7)
- (3) ***Deleted*** - Transferred to Article 153(7)
- (4) ***Deleted***

ARTICLE 158 EPC

Explanatory remarks

See the remarks on Article 153.

Present wording

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.

(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.

Revised wording

Deleted - Transferred to Article 153(3)-(5) and (8) or to be incorporated in the Implementing Regulations

ARTICLES 159 - 163**Explanatory remarks**

(Preparatory documents: CA/PL 18/98; CA/PL PV 8, points 9-11; CA/PL 31/00, point 3)

Upon the creation of the European Patent Organisation, transitional provisions had to be provided for to allow the European Patent Office to be set up. Part XI of the EPC, entitled "Transitional provisions" and consisting of Articles 159-163 EPC, contains the necessary temporary measures which allowed operations to begin. **All these Articles are obsolete and Part XI is thus deleted in its entirety.**

ARTICLE 159 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/98, points 1-2, 6; CA/PL PV 8, point 9; CA/PL 31/00, point 3)

Article 159 EPC deals with the constitution of the Administrative Council once the European Patent Convention entered into force. All of its clauses are now obsolete and the Article is therefore **deleted**.

Present wording

Revised wording

PART XI
TRANSITIONAL PROVISIONS

Deleted

Article 159
Administrative Council during a
transitional period

Deleted

(1) The States referred to in Article 169, paragraph 1, shall appoint their representatives to the Administrative Council; on the invitation of the Government of the Federal Republic of Germany, the Administrative Council shall meet no later than two months after the entry into force of this Convention, particularly for the purpose of appointing the President of the European Patent Office.

(2) The duration of the term of office of the first Chairman of the Administrative Council appointed after the entry into force of this Convention shall be four years.

(3) The term of office of two of the elected members of the first Board of the Administrative Council set up after the entry into force of this Convention shall be five and four years respectively.

ARTICLE 160 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/98, points 3-4, 6; CA/PL PV 8, point 9; CA/PL 31/00, point 3)

1. **Article 160(1) EPC** governs the appointment of EPO employees in an interim period before the adoption of the Service Regulations for permanent employees. It is **obsolete** and thus **deleted**.
2. **Article 160(2) EPC** provides that the Administrative Council may appoint as members of the Enlarged Board of Appeal or of the boards of appeal, legally or technically qualified members of national courts or authorities of the Contracting States. The Administrative Council has never determined the end of the transitional period under Article 160(2) EPC and appointments are still made under this section.
3. The appointment of legally qualified members from the national courts or authorities of the EPC contracting states to the Enlarged Board of Appeal has proven to be a success and is considered to contribute significantly to furthering the harmonisation of patent case law in Europe. Accordingly, this possibility is **retained** as a permanent feature of the Convention and **inserted into Article 11 EPC** (see explanatory remarks to Article 11).
4. Consequently, **Article 160(2) EPC** is **deleted**.

Present wording

Revised wording

Article 160

Deleted

Appointment of employees during a transitional period

- (1) Until such time as the Service Regulations for permanent employees and the conditions of employment of other employees of the European Patent Office have been adopted, the Administrative Council and the President of the European Patent Office, each within their respective powers, shall recruit the necessary employees and shall conclude short-term contracts to that effect. The Administrative Council may lay down general principles in respect of recruitment.
- (2) During a transitional period, the expiry of which shall be determined by the Administrative Council, the Administrative Council, after consulting the President of the European Patent Office, may appoint as members of the Enlarged Board of Appeal or of the Boards of Appeal technically or legally qualified members of national courts and authorities of Contracting States who may continue their activities in their national courts or authorities. They may be appointed for a term of less than five years, though this shall not be less than one year, and may be reappointed.

ARTICLE 161 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/98, points 5-6; CA/PL PV 8, point 9; CA/PL 31/00, point 3)

Article 161 EPC, dealing with the first accounting period of the Organisation, is obsolete and thus **deleted**.

Present wording

Revised wording

Article 161

Deleted

First accounting period

(1) The first accounting period of the Organisation shall extend from the date of entry into force of this Convention to 31 December of the same year. If that date falls within the second half of the year, the accounting period shall extend until 31 December of the following year.

(2) The budget for the first accounting period shall be drawn up as soon as possible after the entry into force of this Convention. Until contributions provided for in Article 40 due in accordance with the first budget are received by the Organisation, the Contracting States shall, upon the request of and within the limit of the amount fixed by the Administrative Council, make advances which shall be deducted from their contributions in respect of that budget. The advances shall be determined in accordance with the scale referred to in Article 40. Article 39, paragraphs 3 and 4, shall apply mutatis mutandis to the advances.

ARTICLE 162 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/98, point 5-6; CA/PL PV 8, point 9; CA/PL 31/00, point 3)

Article 162 EPC governing the progressive expansion of the activity of the EPO, is **deleted** as it no longer has any significance.

Present wording

Revised wording

Article 162

Deleted

Progressive expansion of the field of activity of the European Patent Office

(1) European patent applications may be filed with the European Patent Office from the date fixed by the Administrative Council on the recommendation of the President of the European Patent Office.

(2) The Administrative Council may, on the recommendation of the President of the European Patent Office, decide that, as from the date referred to in paragraph 1, the processing of European patent applications may be restricted. Such restriction may be in respect of certain areas of technology. However, examination shall in any event be made as to whether European patent applications can be accorded a date of filing.

(3) If a decision has been taken under paragraph 2, the Administrative Council may not subsequently further restrict the processing of European patent applications.

(4) Where, as a result of the procedure being restricted under paragraph 2, a European patent application cannot be further processed, the European Patent Office shall communicate this to the applicant and shall point out that he may make a request for conversion. The European patent application shall be deemed to be withdrawn on receipt of such communication.

ARTICLE 163 EPC

Explanatory remarks

(Preparatory documents: CA/PL 18/98, points 7-9; CA/PL PV 8, points 10-11; CA/PL 22/00; CA/PL PV 13, point 89; CA/PL 31/00, point 3)

1. Article 163 EPC governs the entitlement of professional representatives to be entered onto the list of professional representatives under Article 134 EPC during a transitional period which ended on 7 October 1981 (see OJ EPO 1978, 327.)
2. However, **Article 163(6) EPC** provides for the entering on the list of professional representatives under Article 134 EPC, of national representatives having their place of business or employment in a state having acceded to the EPC after the expiry of the transitional period, pursuant to the conditions set forth in Article 163(1)-(5) EPC. This provision retains its entire significance as a "grandfather clause". It should remain in the EPC in order to deal with the situation of national representatives of States acceding to the Convention in the future.
3. Therefore, **Article 163 EPC is deleted**, and the substance of the "**grandfather clause**" of Article 163 EPC is **added to Article 134 EPC** in streamlined form, as a permanent feature of the EPC: see the amendment to Article 134 EPC, particularly paragraph (3).

Present wording

Article 163

Professional representatives during a transitional period

- (1) During a transitional period, the expiry of which shall be determined by the Administrative Council, notwithstanding the provisions of Article 134, paragraph 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 a Contracting State;
- (b) he must have his place of business or employment within the territory of one of the Contracting States;
- (c) he must be entitled to represent natural or legal persons in patent matters before the central industrial property office of the Contracting State in which he has his place of business or employment.
- (2) Entry shall be effected upon request, accompanied by a certificate, furnished by the central industrial property office, which must indicate that the conditions laid down in paragraph 1 are fulfilled.

Revised wording

Deleted

- (1) *Conditions of Article 163(1)(a)-(c) EPC transferred to Article 134(3)(a)-(c) EPC*
- (2) *Substance of Article 163(2) EPC transferred to Article 134(4) EPC*

Present wording

(3) When, in any Contracting State, the entitlement referred to in paragraph 1(c) is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in patent matters before the central industrial property office of the said State must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in patent matters before the central industrial property office of one of the Contracting States is officially recognised in accordance with the regulations laid down by such State shall not be subject to the condition of having exercised the profession. The certificate furnished by the central industrial property office must indicate that the applicant satisfies one of the conditions referred to in the present paragraph.

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

(a) the requirement of paragraph 3, first sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way;

(b) the requirement of paragraph 1(a) in special circumstances.

(5) The President of the European Patent Office shall grant exemption from the requirement of paragraph 1(a) if on 5 October 1973 the applicant fulfilled the requirements of paragraph 1(b) and (c).

Revised wording

(3) *Substance of Article 163(3) EPC, first sentence, transferred to Article 134(3)(c) EPC, second sentence*

(4) *Substance of Article 163(4) EPC transferred to Article 134(7)*

(5) ***Deleted***

Present wording

(6) Persons having their places of business or employment in a State which acceded to this Convention less than one year before the expiry of the transitional period referred to in paragraph 1 or after the expiry of the transitional period may, under the conditions laid down in paragraphs 1 to 5, during a period of one year calculated from the date of entry into force of the accession of that State, be entered on the list of professional representatives.

(7) After the expiry of the transitional period, any person whose name was entered on the list of professional representatives during that period shall, without prejudice to any disciplinary measures taken under Article 134, paragraph 8(c), remain thereon or, on request, be restored thereto, provided that he then fulfils the requirement of paragraph 1(b).

Revised wording

(6) *Time limit of one year taken over in Article 134(3) EPC*

(7) ***Deleted***

ARTICLE 164 EPC AND PROTOCOL ON STAFF COMPLEMENT**Explanatory remarks**

(Preparatory documents: CA/6/00; CA/PL 20/00; CA/PL PV 13, points 4-9, 140-151; CA/PL 31/00, point 38)

1. **Article 164 EPC is amended to make it clear which requirements, procedures and other matters may be laid down in the Implementing Regulations**, and to expressly refer to the **new Protocol on Staff Complement**.
2. **New Article 164(1) EPC** has been modelled on Article 14(1) PLT 2000 and specifies the matters the Implementing Regulations may govern. Letter (a) makes clear that the Implementing Regulations contain any provisions necessary to implement the Convention where the latter expressly so provides, it being understood that such provisions may also include legal consequences of failure to comply with any such requirement or procedure governed by the Implementing Regulations unless the legal consequence is already provided by the Convention.

As regards letter (c), details useful in the Implementation of the Convention may also cover, where appropriate, rules interpreting the provisions of the Convention similar to those which do already exist under the present Convention such as Rules 23b-e, 28 or 30 EPC.

Present paragraph 2 of Article 164 EPC has been added to new paragraph 1 as second sentence.

3. **New Article 164(2) EPC** now mentions the existing Protocols under the EPC and **adds the new Protocol on the Staff Complement of the European Patent Office at The Hague**.
4. The aim of the Protocol on Staff Complement is to ensure that the ratio of staff at The Hague to the total staff complement under the table of posts for 2000 remains substantially unchanged after the Office-wide introduction of BEST.

Under the Protocol, the proportion of posts assigned to the duty station at The Hague in 2000 will be permanently fixed. However, minor deviations owing to fluctuations in staff or administrative changes (eg the creation of new directorates) will be permissible. More sizable fluctuations of up to 10% either side of the authorised complement at The Hague must be temporary only and necessary for the smooth running of the Office.

Present wording

Article 164

Implementing Regulations and Protocols

(1) The Implementing Regulations, the Protocol on Recognition, the Protocol on Privileges and Immunities, the Protocol on Centralisation and the Protocol on the Interpretation of Article 69 shall be integral parts of this Convention.

(2) In the case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail.

Revised Wording

Article 164

Implementing Regulations and Protocols

(1) The Implementing Regulations **shall be an integral part of this Convention and shall contain provisions concerning**

(a) any requirements, procedures, or other matters in respect of which the Convention expressly provides that they shall be governed by the Implementing Regulations;

(b) administrative requirements, matters or procedures;

(c) details useful in the implementation of the provisions of this Convention.

In the case of conflict between the provisions of this Convention and those of the Implementing Regulations, the provisions of this Convention shall prevail.

(2) The Protocol on Recognition, the Protocol on Privileges and Immunities, the Protocol on Centralisation, the Protocol on the Interpretation of Article 69 and **the Protocol on Staff Complement** shall be integral parts of this Convention.

**PROTOCOL ON THE STAFF COMPLEMENT OF THE EUROPEAN PATENT OFFICE
AT THE HAGUE (PROTOCOL ON STAFF COMPLEMENT)**

The European Patent Organisation shall ensure that the proportion of European Patent Office posts assigned to the duty station at The Hague under the 2000 establishment plan and table of posts remains substantially unchanged. Any temporary increase or decrease in the number of posts corresponding to that proportion which proves necessary for the proper functioning of the European Patent Office may not exceed ten per cent.

ARTICLE 167 EPC**Explanatory remarks**

(Preparatory documents: CA/PL 18/98, points 10-13; CA/PL PV 8, point 9; CA/PL 31/00, point 3)

1. Article 167 EPC offered contracting states the possibility of making certain reservations regarding the implementation of the EPC, for a limited period of time.
2. In all, only three contracting states made reservations and all of them have now expired. No further reservations can be made under Article 167 EPC by newly acceding contracting states and Article 167 EPC is now otiose.
3. **Article 167(5) EPC** specifies that any reservations made shall continue to apply throughout the term of any patent granted on a European application filed during the period when that reservation was in effect. According to the principle of non-retroactivity, even in the absence of Article 167(5) EPC, any reservation made under Article 167(2) EPC would remain binding for all European patents granted on applications which were filed whilst the reservation was in force.
4. Consequently, **Article 167 EPC** is **deleted** in its entirety.

Present wording

Revised wording

Article 167
Reservations

Deleted

(1) Each Contracting State may, at the time of signature or when depositing its instrument of ratification or accession, make only the reservations specified in paragraph 2.

(2) Each Contracting State may reserve the right to provide that:

(a) European patents, in so far as they confer protection on chemical, pharmaceutical or food products, as such, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable; this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of a chemical product or a process of manufacture of a pharmaceutical or food product;

(b) European patents, in so far as they confer protection on agricultural or horticultural processes other than those to which Article 53, sub-paragraph (b), applies, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable;

(c) European patents shall have a term shorter than twenty years, in accordance with the provisions applicable to national patents;

(d) it shall not be bound by the Protocol on Recognition.

(3) Any reservation made by a Contracting State shall have effect for a

Present wording

period of not more than ten years from the entry into force of this Convention. However, where a Contracting State has made any of the reservations referred to in paragraph 2(a) and (b), the Administrative Council may, in respect of such State, extend the period by not more than five years for all or part of any reservation made, if that State submits, at the latest one year before the end of the ten-year period, a reasoned request which satisfies the Administrative Council that the State is not in a position to dispense with that reservation by the expiry of the ten-year period.

(4) Any Contracting State that has made a reservation shall withdraw this reservation as soon as circumstances permit. Such withdrawal shall be made by notification addressed to the Government of the Federal Republic of Germany and shall take effect one month from the date of receipt of such notification.

(5) Any reservation made in accordance with paragraph 2(a), (b) or (c) shall apply to European patents granted on European patent applications filed during the period in which the reservation has effect. The effect of the reservation shall continue for the term of the patent.

(6) Without prejudice to paragraphs 4 and 5, any reservation shall cease to have effect on expiry of the period referred to in paragraph 3, first sentence, or, if the period is extended, on expiry of the extended period.

Revised wording

SECTION I PROTOCOL ON CENTRALISATION

Explanatory remarks

(Preparatory documents: CA/PL 10/98; CA/PL PV 7, points 85-90; CA/PL 31/00, point 29)

1. **The allocation of duties performed by the former IIB to the branch at The Hague in Section I(1)(b) has been removed.** This will allow searches for national patent applications to be carried out by examiners in Munich too.

On the same basis, the Administrative Council will be authorised to allocate further duties in the field of searching to the Office as a whole, not just to the branch at The Hague - in accordance with the objective of BEST to amalgamate closely connected tasks.

2. **The restriction on the duties of the Berlin sub-office in Section I(3) has been removed** as well. This will enable it to carry out BEST procedures, involving search and substantive examination.

The Administrative Council will be authorised to allocate further duties to the Berlin sub-office, not only in searching but also in substantive examination.

3. See also the explanatory remarks to Articles 16 and 17 EPC.

Present wording

Section I

(1)(a) Upon on entry into force of the Convention, States parties thereto which are also members of the International Patent Institute set up by the Hague Agreement of 6 June 1947 shall take all necessary steps to ensure the transfer to the European Patent Office no later than the date referred to in Article 162, paragraph 1, of the Convention of all assets and liabilities and all staff members of the International Patent Institute. Such transfer shall be effected by an agreement between the International Patent Institute and the European Patent Organisation. The above States and the other States parties to the Convention shall take all necessary steps to ensure that that agreement shall be implemented no later than the date referred to in Article 162, paragraph 1, of the Convention. Upon implementation of the agreement, those Member States of the International Patent Institute which are also parties to the Convention further undertake to terminate their participation in the Hague Agreement.

(b) The States parties to the Convention shall take all necessary steps to ensure that all the assets and liabilities and all the staff members of the International Patent Institute are taken into the European Patent Office in accordance with the agreement referred to in sub-paragraph (a). After the implementation of that agreement the tasks incumbent upon the International Patent Institute at the date on which the

Revised wording

Section I

(1)(a) *Unchanged*

(b) The States parties to the Convention shall take all necessary steps to ensure that all the assets and liabilities and all the staff members of the International Patent Institute are taken into the European Patent Office in accordance with the agreement referred to in sub-paragraph (a). After the implementation of that agreement the tasks incumbent upon the International Patent Institute at the date on which the

Present wording

Convention is opened for signature, and in particular those carried out vis-à-vis its Member States, whether or not they become parties to the Convention, and such tasks as it has undertaken at the time of the entry into force of the Convention to carry out vis-à-vis States which, at that date, are both members of the International Patent Institute and parties to the Convention, shall be assumed by the branch located at The Hague. In addition, the Administrative Council of the European Patent Organisation may allocate further duties in the field of searching to that branch.

(c) The above obligations shall also apply mutatis mutandis to the sub-office set up under the Hague Agreement under the conditions set out in the agreement between the International Patent Institute and the Government of the Contracting State concerned. This Government hereby undertakes to make a new agreement with the European Patent Organisation in place of the one already made with the International Patent Institute to harmonise the clauses concerning the organisation, operation and financing of the sub-office with the provisions of this Protocol.

(2) Subject to the provisions of Section III, the States parties to the Convention shall, on behalf of their central industrial property offices, renounce in favour of the European Patent Office any activities as International Searching Authorities under the Patent Cooperation Treaty as from the date referred to in Article 162, paragraph 1, of the Convention.

Revised wording

Convention is opened for signature, and in particular those carried out vis-à-vis its Member States, whether or not they become parties to the Convention, and such tasks as it has undertaken at the time of the entry into force of the Convention to carry out vis-à-vis States which, at that date, are both members of the International Patent Institute and parties to the Convention, shall be assumed by the **European Patent Office**. In addition, the Administrative Council of the European Patent Organisation may allocate further duties in the field of searching to **the European Patent Office**.

(c) *Unchanged*

(2) *Unchanged*

Present wording

(3)(a) A sub-office of the European Patent Office for searching European patent applications shall be set up in Berlin (West) as from the date referred to in Article 162, paragraph 1, of the Convention. It shall operate under the direction of the branch at The Hague.

(b) The Administrative Council shall determine the duties to be allocated to the sub-office in Berlin in the light of general considerations and of the requirements of the European Patent Office with regard to searching.

(c) At least at the beginning of the period following the progressive expansion of the field of activity of the European Patent Office, the amount of work assigned to that sub-office shall be sufficient to enable the examining staff of the Berlin Annex of the German Patent Office, as it stands at the date on which the Convention is opened for signature, to be fully employed.

(d) The Federal Republic of Germany shall bear any additional costs incurred by the European Patent Organisation in setting up and maintaining the sub-office in Berlin.

Revised wording

(3)(a) A sub-office of the European Patent Office [...] shall be set up in Berlin [...] as from the date referred to in Article 162, paragraph 1, of the Convention. It shall operate under the direction of the branch at The Hague.

(b) The Administrative Council shall determine the duties to be allocated to the sub-office in Berlin in the light of general considerations and of the requirements of the European Patent Office [...].

(c) *Unchanged*

(d) *Unchanged*

Part II

Draft

**ACT REVISING THE CONVENTION ON THE GRANT OF EUROPEAN PATENTS
(EUROPEAN PATENT CONVENTION)
OF 5 OCTOBER 1973, LAST REVISED AT 17 DECEMBER 1991**

Preamble

THE CONTRACTING STATES TO THE EUROPEAN PATENT CONVENTION,

CONSIDERING that the co-operation of the countries of Europe on the basis of the European Patent Convention and the single procedure for the grant of patents thereby established renders a significant contribution to the legal and economic integration of Europe,

WISHING to promote innovation and economic growth in Europe still more effectively by laying foundations for the further development of the European patent system,

DESIRING, in the light of the increasingly international character of the patent system, to adapt the European Patent Convention to the technological and legal developments which have occurred since it was concluded,

HAVE AGREED AS FOLLOWS:

Article 1

Amendment of the European Patent Convention

The European Patent Convention shall be amended as follows [according to Basic Proposal in Part I]:

1. **Article ... shall be amended to read as follows:**
2. **Article ... shall be deleted.**
3. **The following new Article ... shall be inserted after Article ... :**

Article 2

Amendment of the Protocol on Centralisation

1. **Section shall be amended to read as follows:**

Article 3

Insertion of a new Protocol

The following Protocol shall be inserted in the European Patent Convention as an integral part thereof:

PROTOCOL ON THE STAFF COMPLEMENT OF THE EUROPEAN PATENT OFFICE AT THE HAGUE (PROTOCOL ON STAFF COMPLEMENT)

The European Patent Organisation shall ensure that the proportion of European Patent Office posts assigned to the duty station at The Hague under the 2000 establishment plan and table of posts remains substantially unchanged. Any temporary increase or decrease in the number of posts corresponding to that proportion which proves necessary for the proper functioning of the European Patent Office may not exceed ten per cent.

Article 4

New text of the Convention

- (1) The Administrative Council of the European Patent Organisation is hereby authorised and instructed to draw up, at the proposal of the President of the European Patent Office, a new text of the European Patent Convention incorporating the amendments arising from this Revision Act. In the new text, the provisions of the Convention are to be renumbered consecutively and the references to other provisions of the Convention amended accordingly; the wording of the provisions in the three official languages is to be modified where necessary.
- (2) The Chairman of the Administrative Council shall transmit the draft of the new text to the governments of the Contracting States which took part as Contracting States in the European Patent Convention revision conference in November 2000, for their approval.
- (3) Subject to the approval of three quarters of the governments of the Contracting States referred to in paragraph 2, the new text of the Convention shall become an integral part of this Revision Act.

Article 5

Signature and ratification

- (1) This Revision Act shall be open for signature by the Contracting States until [1 July 2001] at the European Patent Office in Munich.
- (2) This Revision Act shall be subject to ratification; instruments of ratification shall be deposited with the Government of the Federal Republic of Germany.

Article 6 Accession

- (1) This Revision Act shall be open, until its entry into force, to accession by the Contracting States to the Convention and the States which ratify the Convention or accede thereto.
- (2) Instruments of accession shall be deposited with the Government of the Federal Republic of Germany.

Article 7 Provisional application

Article 1, items , and Articles 2, 3 and 4 of this Revision Act shall be applied provisionally [within the meaning of Article 25, paragraph 1(a), of the Vienna Convention on the Law of Treaties].

Article 8 Entry into force

- (1) The revised text of the European Patent Convention shall enter into force [two] years after the fifteenth [eleventh] Contracting State [being a party to the Convention on the date of adoption of this Revision Act] has deposited its instrument of ratification or accession, or on the first day of the third month following the deposit of the instrument of ratification or accession by the Contracting State taking this step as the last of all the Contracting States, if this takes place earlier.
- (2) Upon entry into force of the revised text of the Convention, the text valid until that time shall cease to apply.

Article 9 Transmission and notifications

- (1) The Government of the Federal Republic of Germany shall draw up certified true copies of this Revision Act and shall transmit them to the governments of the Contracting States and of the States able to accede to the European Patent Convention under Article 166, paragraph 1.
- (2) The Government of the Federal Republic of Germany shall notify the governments referred to in paragraph 1 concerning:
 - (a) the deposit of any instrument of ratification or accession;
 - (b) the date of entry into force of this Revision Act.

IN WITNESS WHEREOF, the Plenipotentiaries authorised thereto, having presented their Full Powers, found to be in good and due form, have signed this Revision Act.

DONE at Munich this day of November two thousand in a single original in the English, French and German languages, the three texts being equally authentic. This original text shall be deposited in the archives of the Federal Republic of Germany.