

**CA/PL 2/98**

Orig.: English

Munich, 30.12.97

SUBJECT: Revision of the EPC: BEST  
DRAWN UP BY: European Patent Office  
ADDRESSEES: Committee on Patent Law (for opinion)

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SUMMARY

The present document contains drafting proposals for the amendments to be brought to the EPC and the Protocol on Centralisation as far as BEST is concerned.

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*Originalversion - Übersetzung folgt in Kürze*

*Version originale - traduction sera envoyée incessamment*

## I. INTRODUCTION

The present document contains drafting proposals for the amendments to be brought to the EPC as outlined in Document CA/156/97. For ease of reference, the order of the list of proposed changes contained in that document has been retained. The present text of the relevant provisions of the EPC is contained in the left column, and the proposed amendments are set out in the right column.

## II. DRAFTING PROPOSALS:

### AMENDMENTS NECESSARY FOR OFFICE-WIDE IMPLEMENTATION OF BEST

- a) **Deletion of references to the geographical location of the EPO departments;  
Greater flexibility in determining when competence passes within the Office**

*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.

*Article 16*  
Receiving Section

The Receiving Section shall be [-] responsible for the examination on filing and as to formal requirements of European patent applications, [-] and for the publication of European patent applications and of European search reports.

*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.

*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. Oral proceedings shall be before the Examining 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.

*Article 17*  
Search Divisions

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

*Article 18*  
Examining Divisions

(1) The Examining Divisions shall be responsible for examining European patent applications [-].

**unchanged**

*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;

*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 **European Patent Office** shall examine whether:

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(f) the designation of the inventor has been made in accordance with Article 81;

**unchanged**

(g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.

**unchanged**

(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.

(2) Where the **European Patent Office** 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.

(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.

**unchanged**

(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.

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(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.

**unchanged**

(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.

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b) **Removal from the Protocol on Centralisation of the restriction on the competence of the branch located at The Hague and of the sub-office in Berlin to the field of searching**

*Section I*

(1)(a) Upon 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.

*Section I*

**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 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.

(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 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) 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.

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(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.

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(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. 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.

**(3)(a) A sub-office of the European Patent Office shall be maintained in Berlin; the Federal Republic of Germany shall bear any additional costs thereby incurred by the European Patent Organisation.**

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