

CA/PL 10/98

Orig.: German

Munich, 20.04.1998

SUBJECT: Revision of the EPC: Articles 16 and 17 EPC, Section I of the
Protocol on Centralisation

DRAWN UP BY: European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains proposals for the revision of Articles 16 and 17 EPC and Section 1(1) and (3) of the Protocol on Centralisation, in order to place the Office-wide introduction of BEST on a sound legal footing. The document replaces CA/PL 2/98.

I. INTRODUCTION

A. ORGANISATIONAL AND GEOGRAPHICAL DIVISION OF FIRST-INSTANCE DEPARTMENTS IN GRANT PROCEEDINGS BEFORE THE EPO

1. Currently, the EPC implies an organisational and geographical division between search and examination. Article 6(2) provides that the EPO shall be set up in Munich, which may be interpreted as implying that the departments enumerated in Article 15, which include the Examining Divisions, should be in Munich unless otherwise expressly provided in the Convention. This is the case in Articles 16 and 17, which stipulate that the Receiving Section and Search Divisions shall be in the branch at The Hague. It is also the case in Section I(1)(b) of the Protocol on Centralisation, which refers to the taking over of the tasks of the IIB by the branch located at The Hague.
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 at The Hague.
3. Under the EPC, the grant of a patent involves two essential procedural steps: search and substantive examination. Article 92(1) provides that the Search Division shall draw up the European search report for every European patent application. It is only after this that the EPO, under Article 94(1), is required to examine, on written request, whether a European patent application and the invention to which it relates meet the requirements of the Convention.
4. 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. However, there was never any intention of changing the two-step procedure under the Convention, and there are no such plans for the future (CA/64/97, point 3).

B. WORK TO DATE ON INTRODUCING BEST OFFICE-WIDE

5. At its 67th meeting in June 1997, the Administrative Council unanimously approved in principle the Office-wide introduction of BEST on the basis of the project review presented by the President (CA/64/97), and mandated the Committee on Patent Law to study the project in the context of the Convention and submit its conclusions and recommendations to the Council (see CA/115/97, point 21, and CA/116/97, points 87-103).
6. In accordance with the Council's wishes, the Committee on Patent Law discussed these issues at its 5th meeting in July 1997 and gave careful consideration to the question whether the Office-wide introduction of BEST requires a revision of the Convention or whether there might be some alternative way of putting the project on a sound legal footing. After detailed examination of all the possible options, a large majority of the Committee's members were in favour of recommending to the Administrative Council that a diplomatic conference be prepared, with a view to creating a secure, legally unassailable basis for BEST before its Office-wide introduction (CA/PL PV 5, points 64-85).
7. At its 69th meeting in December 1997, the Council considered the President's proposal that the Committee on Patent Law be mandated to prepare for a revision conference (CA/156/97). The Council generally supported the BEST project and concluded that, though this was just one item on a lengthy "EPC revision catalogue", it should be given a certain priority when preparing for the diplomatic conference. The matter was therefore referred to the Committee on Patent Law for further examination (CA/169/97, point 8).
8. At its 6th meeting in January 1998, the Committee on Patent Law discussed and endorsed in principle the Office's draft proposals for deleting references to the geographical location of departments from Articles 16 and 17 EPC and Section I, paragraphs (1) and (3), of the Protocol on Centralisation. Further proposals for creating greater flexibility in the distribution of responsibilities between Office departments were deferred for discussion at a later stage (CA/PL 2/98 and CA/PL 5/98, point 6).
9. The discussions of the Committee on Patent Law have resulted in the proposals set out below, with brief explanations, for amending Articles 16 and 17 EPC and Section I, paragraphs (1) and (3) of the Protocol on Centralisation. The proposals, replacing those in CA/PL 2/98, are limited to the changes which are strictly necessary for the implementation of BEST.

II. SPECIFIC PROPOSALS

A. DELETION OF REFERENCES TO THE GEOGRAPHICAL LOCATION OF EPO DEPARTMENTS

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 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.

Explanations

The stipulation allocating responsibility for the Receiving Section to the branch at The Hague has been deleted, so that part of the department can be run under the aegis of DG 2 at the Office's headquarters in Munich. The intention is to ensure that the staff of the Receiving Section, who carry out the examination on filing and as to formal requirements under Articles 90 and 91 EPC, and who also play a supporting role in drawing up the search report under Article 92 EPC, can be assigned to either DG 1 or DG 2, whichever is responsible for searching in respect of the application concerned.

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 17
Search Divisions

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

Explanations

The stipulation assigning exclusive responsibility for the Search Divisions to the branch at The Hague is to be deleted, so that Search Divisions can also be set up at the Office's headquarters in Munich. The purpose of this is to facilitate the Office-wide implementation - in Munich, The Hague and Berlin - of the BEST procedure.

B. REMOVAL FROM THE PROTOCOL ON CENTRALISATION OF THE RESTRICTION ON COMPETENCE OF THE BRANCH AT THE HAGUE AND OF THE BERLIN SUB-OFFICE TO THE FIELD OF SEARCHING

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

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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 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

(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

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.

Council of the European Patent Organisation may allocate further duties in the field of searching to **the European Patent Office**.

Explanations

The amendment removes the stipulation allocating sole responsibility for duties performed before 7 October 1977 by the International Patent Institute to the branch at The Hague. This allows searches for national patent applications to be carried out by examiners in Munich too.

On the same basis, the Administrative Council is 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.

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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.

(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.

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(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.

Explanations

The amendment removes the restriction on the duties of the Berlin sub-office and enables it to carry out BEST procedures, involving substantive examination as well as searching.

(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 [-].

Explanations

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

(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.

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(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.

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