

CA/PL 12/98

Orig.: English

Munich, 15.04.1998

SUBJECT: Revision of the EPC: Articles 154(3) and 155(3) EPC

DRAWN UP BY: European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

The present document analyses the protest procedure under the PCT as applied by the EPO and proposes revising the EPC on this point by deleting Articles 154(3) and 155(3).

I. BACKGROUND

A. THE PROTEST PROCEDURE UNDER THE PCT

1. Under the PCT, where an ISA considers that an international application does not comply with the requirement of unity of invention, it invites the applicant to pay additional fees within a time limit which it sets (PCT Art. 17(3)(a) and Rule 40). An IPEA may also elect to deal in this manner with an international application which it deems to lack unity of invention (PCT Art. 34(3)(a) and Rule 68).
2. The applicant may pay the additional fees under protest and PCT Rules 40.2(c) and 68.3(c) provide that the protest shall then be examined by a three-member board, special instance or competent higher authority of the ISA or IPEA.

B. ARTS. 154(3) AND 155 (3): JUDICIAL REVIEW UNDER THE EPC

3. Articles 154(3) and 155(3) EPC provide that the boards of appeal shall be responsible to decide on a protest made by an applicant against an additional fee charged by the EPO, in its capacity as an ISA and an IPEA respectively.
4. By the early nineties, the sharp rise of PCT applications emanating from the US caused a glut of cases raising issues of lack of unity of invention. With the very purpose of relieving the workload of the EPO boards of appeal, pursuant to a proposal made by the EPO, Rules 40.2 (e) and 68.3 (e) were added to the PCT Regulations, allowing PCT authorities to create an intermediate review procedure, which would take place without cost to the applicant, and allowing a protest fee to be charged for a further examination of the protest, *ie* upon referral of the issue to the boards of appeal.
5. By decision of the Administrative Council in June 1992, Rule 104a EPC was then supplemented by a new paragraph (3) which provided the legal basis for a review by the EPO of the invitation to pay additional fees and introduced a protest fee for further referral to the boards of appeal (CA/7/92, no. 15 and CA/PV 44, no. 66).
6. Pursuant to this decision of the Administrative Council, the President of the EPO set up a 3-member review panel for the protest procedure under the PCT (OJ EPO 1992, 547). This review panel has proven to be a success and is capable of fully achieving the objectives of the PCT on this point.

7. Nevertheless, Arts. 154(3) and 155(3) EPC continue to provide final jurisdiction in such matters to the boards of appeal. Consequently, the EPO is the only PCT authority to provide a two-tiered review system. Not only does the EPC provide a review by a 3-member review panel, but it also affords a mechanism of judicial review going well beyond the requirements of the PCT. Although the introduction of the review panel has effectively lowered the cases which have to be dealt with by the boards of appeal, a number of cases are still referred to the boards. This two-tiered system is unwarranted. It is work-intensive, costly and leads to unjustifiable delays in an area where a more streamlined procedure is indispensable.
8. In order to remedy this situation, it is suggested that the possibility of a referral of the protest to the boards of appeal be removed by revising Arts. 154 and 155 EPC.

C. PROPOSAL

9. The EPO proposes that Arts. 154(3) and 155(3) be deleted, thereby making the review panels the final instance in protest proceedings under the PCT.
10. Once these provisions have been revised, Rule 104a (3) EPC and Art. 2 (item 21) of the Rules Relating to Fees would have to be amended, in order to reflect that the decisions of the 3-member review panel are final and to eliminate the protest fee payable upon examination of the protest by the boards of appeal.

II. PROPOSED AMENDMENTS

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.

Article 154

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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.

Article 155

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