

CA/PL 17/98

Orig.: English

Munich, 06.10.1998

SUBJECT: Revision of the EPC: Article 88(1) EPC

DRAWN UP BY: European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains a proposal amending Article 88(1) EPC to the effect that the formal requirements for claiming priority should be transferred from the Convention to the Implementing Regulations. Further substantive changes which might be subsequently brought to these requirements for claiming priority are briefly described.

I. INTRODUCTION

A. TRANSFER THE FORMAL REQUIREMENTS FOR CLAIMING PRIORITY TO THE IMPLEMENTING REGULATIONS

1. At present, applicants wishing to claim priority must fulfill the requirements set out in Art. 88, *ie* 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 the EPO official languages. Further formal conditions are contained in Rule 38.
2. In CA/16/98, it is proposed in Part IV.B that the flexibility of the EPC be increased by methodically transferring formal, technical and other provisions liable to change to the Implementing Regulations wherever possible. The requirements for claiming priority, as contained in Art. 88(1), constitute a prime example of the features of the Convention which should be shifted to the Implementing Regulations, to allow the EPO to adapt to emerging international standards¹ and the ongoing progress in electronic means of communication, should this be deemed to be appropriate.
3. It is therefore proposed that the formal requirements for claiming priority be moved from Art. 88(1) to the Implementing Regulations, and that a corresponding reference to these requirements be inserted into Art. 88(1).

¹ Reference is made here to the new draft Patent Law Treaty. See the current Art. 5(7) PLT, attached.

B. SUBSTANTIVE CHANGES TO BE CONSIDERED ONCE SUCH TRANSFER HAS TAKEN PLACE

4. It must be emphasised that at present, no substantive changes to these requirements are envisaged.
5. However, both technology and international cooperation in patent matters are marching on relentlessly. Once the infrastructure of modern patent offices, the cooperation between such patent offices and the technical support for the electronic preservation and exchange of documents will have reached an appropriate level, it will become thinkable to consider some substantive changes to the requirements thus transferred to the Implementing Regulations.
6. In line with the emerging international standard found on this point in Art. 5(7) of the new draft PLT, it might be considered whether the obligation to file systematically both the copy of the previous application and its translation should be removed. Such documents might only be required to be filed upon invitation by the EPO, and would not be deemed necessary where such earlier documents have already been filed with the EPO or are available in an official form to the EPO by electronic means, so that their availability is guaranteed for the duration of the life of the patent and beyond².

This would simplify application formalities and reduce costs not only for applicants but also for patent offices, without jeopardising the rigour of the mechanism for the recognition of priority.

² *E.g* during litigation where the validity of the patent is questioned.

II. PROPOSED AMENDMENTS

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) - (4)

Proposed 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 or declaration required by the Implementing Regulations, in accordance with the procedure and conditions prescribed therein.**

unchanged

ANNEX I: Draft Patent Law Treaty

Article 5 Application

[...]

- (7) [*Priority*] (a) Subject to subparagraph (c), where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application be furnished to the Office within the time limit prescribed in the Regulations.
- (b) A Contracting Party may require that the copy referred to in subparagraph (a) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.
- (c) No Contracting Party shall require the furnishing of a copy or a certified copy of the earlier application, or a certification of the filing date, as referred to in subparagraphs (a) and (b), where the earlier application was filed with its Office or is available in an official form to that Office by electronic means.
- (d) Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application be furnished by the applicant, upon invitation by the Office, within the time limit prescribed in the Regulations.
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