

SUBJECT: Revision of the EPC: Articles 159-163 and 167 EPC

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

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SUMMARY

This document contains the following proposals for revision of the EPC:

1. The deletion of the transitional provisions of Arts. 159-162 and 167 EPC, which are now either obsolete or unnecessary;
2. The deletion of Art. 163 and the integration of its substance, governing the entering of national representatives of newly acceded contracting states onto the list of representatives maintained by the EPO, into Art. 134.

## **I. INTRODUCTION**

### **A. DELETE ARTICLES 159-162**

1. In creating the European Patent Organisation, a transitional period had to be provided for to allow the European Patent Office to be set up. Part XI of the EPC contained the necessary temporary measures allowing operations to begin.
2. Article 159 deals with the Administrative Council during a specified transitional period. All of its clauses are now without significance.
3. Article 160 governs the appointment of employees during a transitional period. Art. 160(1) deals with the recruitment of necessary employees on short-term contracts in an interim period before the adoption of the Service Regulations for permanent employees, and is therefore obsolete.
4. Article 160(2) 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 provision specifically mentions that this shall be done during a transitional period, the expiry of which shall be determined by the Administrative Council. Appointments are still made under this section, but it is suggested that the revision should put an end to the transitional period.

Whether the substance of Art. 160(2) should be retained in whole or in part as a permanent feature of the Convention is a point still being considered by the Administrative Council within the context of the present revision exercise. If so, an appropriate provision to this effect should be incorporated into the Convention and Art. 160(2) should be deleted, insofar as it remains, as currently framed, a provision of a transient nature.

5. Articles 161 and 162 deal respectively with the first accounting period and the progressive expansion of the activity of the EPO. These provisions have long lost their significance.
6. Therefore, it is proposed that Arts. 159-162 be deleted, as part of a "housekeeping" exercise aimed at eliminating largely dead-letter provisions and adapting the EPC to its third decade of existence.

**B. DELETE ART. 163 AND ADD THE SUBSTANCE OF ART. 163(6) TO ART. 134**

7. Article 163 governs the entitlement of professional representatives to be entered onto the list of professional representatives under Art. 134 during a transitional period which ended on 7 October 1981 (see OJ EPO 1978, 327).
8. However, Art. 163(6) provides for the entering on the list of professional representatives under Art. 134, 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 Art. 163(1)-(5). 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.
9. It is therefore proposed that Art. 163 be deleted, with the proviso that the substance of the "grandfather clause" of Art. 163 should be added to Art. 134 in streamlined form, as a permanent feature of the EPC such as proposed under II.

In this context, it should be mentioned that Art. 163(3), second sentence, permits the entering on the list of persons whose professional qualifications to represent clients in patent matters before the central industrial property office are officially recognised by the State acceding to the Convention, despite the fact that they have not exercised the profession for at least 5 years. This clause is redundant in light of the provision of Art. 163(1)(c). Hence, insofar as the substance of Art. 163(1)(c) is preserved, it is unnecessary to retain Art. 163(3), second sentence.

**C. DELETE ARTICLE 167 EPC**

10. Article 167 offered contracting states the possibility of making reservations regarding the implementation of the EPC, for a limited period of time. The objective of this provision was to allow the contracting states an opportunity to harmonize their national laws with the EPC.
11. In all, only three reservations were ever made. The reservations made by Austria under Art. 167(2)(a) and (d) expired on 7 October 1987. Those made by Ellas and Spain under Art. 167(2)(a) terminated on 7 October 1992. Thus, all the reservations have now expired and there is no provision allowing any reservations to be made by newly acceding contracting states.

12. Article 167(5) specifies that reservations made in accordance with Art. 167(2) 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. This signifies that, for instance, product claims for substances falling under a reservation do not take effect once the reservation has expired.

Art 167(5) has a clarification function and its deletion (on entry into force of the Revision Act) will not have retroactive effect. This provision therefore remains valid for all patent applications filed during the validity of a reservation and the ensuing patents granted, so that there is no need to maintain it separately.

13. It is therefore proposed that Art. 167 be deleted in its entirety.

## II. PROPOSED AMENDMENTS

### A. ADD TO ART. 134 THE SUBSTANCE OF ART. 163(6)

Present wording	Proposed wording
<b>Article 134</b> <b>Professional representatives</b>	<b>Article 134</b> <b>Professional representatives</b>
(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.	(1) unchanged
(2) Any natural person who fulfills the following conditions may be entered on the list of professional representatives:	(2) unchanged
(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.	
	<b>(3) During a period of one year from the date the accession of a State to this Convention takes effect, any natural person may be entered on the list of professional representatives if</b>
	<b>(a) he is a national of one of the contracting states;</b>
	<b>(b) he has his place of business or employment within that state having acceded to the Convention;</b>

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

(c) **he 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 must have habitually so acted for at least 5 years.**

(4) Entry shall be effected upon request, accompanied by certificates which must indicate that the conditions laid down in **either paragraph 2 or paragraph 3**, are fulfilled.

(5) renumbered, text unchanged

(6) renumbered, text unchanged

(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 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.

**(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) renumbered, text unchanged**

**(9) 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 persons entitled to act as professional representatives [...];**

**(c) any disciplinary power to be exercised by that institute or the European Patent Office on such persons.**

## **B. DELETE ARTICLES 159-163 AND 167**