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SUBJECT: Revision of the EPC - Article 23(3) EPC

DRAWN UP BY: European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

The present document contains a number of considerations relating to the suggestion that Article 23(3) EPC be revised in such a way that the members of the boards of appeal are bound by the TRIPs Agreement and the European Convention for the Protection of Human Rights and Fundamental Freedoms.

I. INTRODUCTION

1. The Netherlands delegation suggested that a provision be incorporated into Article 23(3) EPC to the effect that the members of the boards of appeal are bound by the TRIPs Agreement and the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) (see CA/16/98, point I.C).

A. THE EPC AND EXTERNAL LEGAL SOURCES

2. The EPC provides an autonomous legal system for the granting of European patents. In legal terms, neither the legislation of the contracting states nor the international conventions signed by them are part of this autonomous legal system. Within the framework of the system established by the EPC, legislative power rests with the contracting states alone and is exercised by either an inter-governmental conference (Article 172 EPC) or the Administrative Council (Article 33 EPC).
3. The drafting of the EPC was influenced, however, by the national patent laws of the contracting states and by the international conventions signed by them. For example, the provisions relating to patentability contained in the Strasbourg Convention of 1963 and a number of provisions in the Paris Convention served as models for the relevant parts of the EPC. More recently, EU legislation on the supplementary protection certificate prompted the contracting states to carry out the first revision of the EPC. In future, certain provisions of the EU biotechnology directive or the TRIPs Agreement, as well as work on WIPO's Draft Patent Law Treaty, could well influence the way in which the EPC develops.

These influences always take the same form. A provision originating from a national law or an international convention is incorporated - with the necessary adaptations - in the EPC, but **no direct reference** is made in the EPC to the external legal source concerned. For example, Articles 87 and 88 EPC relating to the claiming of priority were largely inspired - in terms of both content and form - by the provisions of the Paris Convention, although there is no direct reference in the EPC to Article 4 of the Paris Convention. Similarly, Article 63(2)(b) EPC is based directly on the EU supplementary protection certificate, but makes no explicit reference to it.

This procedure has allowed the EPC to develop in harmony with the national laws of the contracting states and the international conventions signed by them, while at the same time guaranteeing the autonomous application of its provisions by the departments of the EPO.

4. The task of the boards of appeal of the EPO is to ensure compliance with the autonomous legal system established by the EPC. To do this, the boards also refer to legal sources outside the EPC: for example, the Vienna Convention (see G 6/83, OJ EPO 1985, 67, reasons 2-6), the ECHR (see T 27/92, OJ EPO 1994, 853, reasons 11; D 12/88, OJ EPO 1991, 591; D 11/91, OJ EPO 1995, 721, reasons 3.3) and the TRIPs Agreement (see T 557/94 of 12 December 1996, reasons 13; J 3/95, OJ EPO 1997, 493, reasons 6.3).

These references show the willingness of the boards to interpret the EPC in the light of international law. However, the boards have **never considered** these references to be **mandatory**. On the contrary: they have been able to call upon these external sources when they felt it was useful, without in any way being bound by them.

B. EXPLICIT REFERENCES IN THE EPC

5. In view of the satisfactory flexibility with which external legal sources have until now been able to influence the legal system established by the EPC, the insertion into the EPC of explicit references to the ECHR and the TRIPs Agreement would not improve the system for granting European patents. Rather, any link between the legal system established by the EPC and these international conventions which constrained the departments of the EPO would give rise to legal uncertainties, which must be avoided.
6. The departments of the EPO should therefore not be bound by international conventions whose future development can be neither forecast nor controlled by the Administrative Council or the EPO:
 - New protocols may well be added to the ECHR, and there will be developments in the jurisprudence of the European Court of Human Rights. It would be unwise to expose the departments of the European Patent Office to such unforeseeable circumstances.
 - Similarly, the TRIPs Agreement may be amended, and the WTO body which regulates disputes will in future years develop, on the basis of the provisions of the TRIPs Agreement, a jurisprudence the nature of which is impossible to foretell at the present time.
7. Moreover, a general reference to the TRIPs Agreement would lead to uncertainty about which provisions applied to European patent law. The Agreement contains provisions which relate to intellectual property as a whole (acquisition, maintenance and enforcement of intellectual property rights), and many provisions require implementing legislation in order to be applied. The relationship between these provisions and the legal system established by the EPC would not be clarified by a simple reference to the TRIPs Agreement in the EPC.

8. Furthermore, the insertion in the EPC of references to the TRIPs Agreement and the ECHR would inevitably cause questions to be asked about the lack of references to other relevant conventions such as, for example, the Paris Convention or the Vienna Convention.
9. Finally, it is not clear why the boards of appeal alone should be bound by the TRIPs Agreement and the ECHR, when the examining divisions and opposition divisions are also called upon to take decisions affecting the rights of parties.

II. CONCLUSION

10. For these reasons, the interested circles and SACEPO have said that they are definitely not in favour of the suggestion. However, the revision of the EPC offers a good opportunity to examine whether the legal system established by the EPC and the practice of the EPO's administrative and judicial departments are compatible with the principles laid down by the TRIPs Agreement and the ECHR, and if they are not, to amend the EPC accordingly.
11. The following points should be borne in mind in this connection:
 - Firstly, the legal "standards" contained in the ECHR and developed in the jurisprudence of the Court of Human Rights are generally felt to be reflected in the EPC (see Article 113 EPC, regarding the right to be heard) and observed by the departments of the EPO. The right to a fair hearing (Article 6(1) ECHR) and the right to an effective remedy before a judicial authority (Article 13 ECHR) are guaranteed in all procedures before the EPO.
 - Secondly, a number of efforts are currently being made to bring the provisions of the EPC into line with those of the TRIPs Agreement, namely in the proposals for the revision of the EPC currently under review, some of which refer to provisions in the TRIPs Agreement (CA/16/98 and Add. 1, point II.A (computer programs), point II.B (Article 53(a) EPC), point II.D (medical methods), point III.D (TRIPs priority)).
