

CA/PL 9/99

Orig.: English

Munich, 11.2.1999

SUBJECT: Revision of the EPC: Article 87(5) EPC
DRAWN UP BY: President of the European Patent Office
ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains an amended proposal for the revision of Art. 87(5), taking into account the discussions and suggestions of the Committee regarding the original proposal for the revision of Art. 87(5) EPC contained in CA/PL 16/98.

I. INTRODUCTION

1. At its 8th meeting, the Committee on Patent Law examined the proposal for the revision of Art. 87 EPC, which deals with the recognition of priority rights under the EPC, contained in document CA/PL 16/99. The proposed amendment to Art. 87(1) EPC was unanimously approved, but that concerning Art. 87(5) EPC, which governs the reciprocal recognition of priority rights for applications filed in states which belong neither to the Paris Union nor to the WTO, gave rise to a number of suggestions for improvement.
2. The Committee agreed that the mechanism of Art. 87(5) EPC should be simplified. In particular, such recognition should no longer be based on an international agreement, and the other country should no longer be required to recognise priority rights for first filings in all the contracting states.
3. However, the proposed broadening of the provision to cover countries not universally recognised as "states" (eg Taiwan) could be improved upon. It was also suggested that the power to issue a communication under Art. 87(5) EPC could be left to the President of the EPO. Finally, the text should be kept simple. Consequently, the following amended proposal is submitted to the Committee for opinion.

A. REFER TO INDUSTRIAL PROPERTY AUTHORITIES INSTEAD OF "STATES"

4. The most elegant manner in which to solve problems of the sort raised by countries like Taiwan, appears to be to refer to the *de facto* recognition of priority rights not by another state, but by an industrial property authority which is not subject to the treaties mentioned in Art. 87(1) EPC. This solution is modelled on the recently enacted § 93b of the Austrian Patent Act.

B. EMPOWER THE PRESIDENT OF THE EPO TO ISSUE THE COMMUNICATION

5. The arrangement of reciprocal recognition of priority rights between two granting authorities is reduced to what it should be: a legal and technical issue. Therefore, it appears fitting that the power to issue the communication recognising the reciprocal granting of priority rights should lie with the President of the EPO. The recognition of priority rights abroad for first filings in Europe on a mutual basis will always be in the interest of European business.

C. SIMPLIFY THE TEXT

6. Although the adding of necessary locutions has resulted in a lengthening of the text, a simplification of the reference to priority rights under the Paris Convention has been attempted, in the English version.

II. PROPOSED AMENDMENTS

Article 87 Priority right

(1) A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property, an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate, or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

(2) - (4)

(5) If the first filing has been made in a State which is not a party to the Paris Convention for the Protection of Industrial Property, paragraphs 1 to 4 shall apply only insofar as that State, according to a notification published by the Administrative Council, and by virtue of bilateral or multilateral agreements, grants on the basis of a first filing made at the European Patent Office as well as on the basis of a first filing made in or for any Contracting State and subject to conditions equivalent to those laid down in the Paris Convention, a right of priority having equivalent effect.

Article 87 Priority right

(1) A person who has duly filed in or for any State party to the Paris Convention for the Protection of Industrial Property **or the Agreement Establishing the World Trade Organization**, an application for a patent or for the registration of a utility model or for a utility certificate [...], or his successors in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

[As per the changes adopted in CA/PL 16/98]

unchanged

(5) If the first filing has been made **at an industrial property authority** which is not [...] **subject to the provisions of** the Paris Convention for the Protection of Industrial Property **or of the Agreement Establishing the World Trade Organization**, paragraphs 1 to 4 shall apply only insofar as that **authority**, according to a **communication issued** by the **President of the European Patent Office**, [...] grants on the basis of a first filing made at the European Patent Office, [...] **a right of priority under conditions and with effects** equivalent to those laid down in the Paris Convention [...].