

# **M I N U T E S**

of the  
8th meeting of the

## **COMMITTEE ON PATENT LAW**

(Munich, 3 and 4 November 1998)

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The 8th meeting of the Committee on Patent Law, chaired by Mr Mühlens (DE), took place on 3 and 4 November 1998 in Munich. The list of participants is given in Annex I.

**I. ADOPTION OF THE PROVISIONAL AGENDA (CA/PL 15/98 Rev. 1)**

1. The Committee adopted the provisional agenda as set out in CA/PL 15/98 Rev. 1.

**II. APPROVAL OF THE DRAFT MINUTES OF THE 7TH MEETING (CA/PL 14/98)**

2. The Committee approved the draft minutes of the 7th meeting. [Reference: CA/PL PV 7]

**III. REVISION OF THE EPC**

**IIIa. POINTS FOR REVISION (CA/16/98 Add. 1)**

3. The EPO presented the document containing the further points to be considered in revising the EPC. Regarding the adaptation of the EPC to conform with Directive 98/44/EC on the legal protection of biotechnological inventions, the Office emphasised that the Directive merely reflected the existing practice of the EPO and the boards of appeal. For the time being, it would be sufficient to amend the Implementing Regulations; the Administrative Council would have to authorise the Committee to study the necessary modifications.<sup>(1)</sup> Revision of the relevant EPC Articles would only be envisaged as a further step if it proved necessary in the light of the decision of the Enlarged Board of Appeal in T 1054/96 ("Transgenic plant/Novartis", OJ EPO 1998, 511).
4. The representative of the European Commission emphasised that the appeal by the Netherlands against Directive 98/44/EC before the European Court of Justice would not have a suspensive effect on the obligation of EU member states to implement the Directive under national law by 30 July 2000.

**IIIb. ARTICLE 87(1) AND (5) EPC (CA/PL 16/98)**

5. The proposal for the revision of Art. 87(1) EPC to extend the automatic recognition of priority rights under the EPC to all member states of the WTO, and to delete the reference to inventor's certificates, was unanimously approved by the Committee.

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<sup>(1)</sup> Cf. CA/155/98

6. However, the proposal concerning Art. 87(5) EPC, which deals with the mechanism for mutual recognition of priority rights, gave rise to a number of comments. Suggestions were made to avoid referring to arrangements between states. Concern was expressed by the Irish delegation in relation to the proposal for the removal of the requirement that priority rights be recognised in all contracting states. The possibility of a mechanism affording *de facto* recognition of priority rights through communications issued by the respective patent offices should be explored further. It was also suggested that the President of the EPO might be empowered to issue the communication, but some delegations opined that the reciprocal recognition of priority rights was a political matter which should stay within the powers of the Administrative Council. It was emphasised that priority rights should only be extended to countries which applied the principle of national treatment in full conformity with the Paris Convention.
7. The EPO would prepare a revised proposal for the next meeting.

**IIIc. ARTICLE 88(1) EPC (CA/PL 17/98)**

8. The Committee unanimously approved the proposal to transfer the formal requirements for claiming priority from Art. 88(1) EPC to the Implementing Regulations, and to insert a corresponding reference to these requirements into Art. 88(1) EPC.

**IIId. ARTICLES 159 TO 163 AND 167 EPC (CA/PL 18/98)**

9. The proposal for the deletion of Arts. 159-163 and 167, which dealt with temporary measures allowing operations to begin in the transitional period during which the European Patent Office was set up, was unanimously approved by the Committee. It was agreed that the removal of Art. 167(5) EPC would have no retroactive effect. Whether the substance of Art. 160(2) EPC should be retained was a matter to be discussed by the Administrative Council. However, Art. 160(2) EPC as worded remained of a transitory nature, and as such, it should be deleted.
10. With regard to the proposal to integrate the substance of the grandfather clause contained in Art. 163(6) EPC into Art. 134 EPC, the *epi* queried whether the power of the President to grant exemptions from Art. 134(3)(c) EPC as proposed in Art. 134(7)(b) EPC was justified. The EPO explained that the intent was to integrate the substance of Art. 163 EPC into Art. 134 EPC as it was, and not to introduce any substantive changes; hence, the power of the President mentioned in Art. 134(7)(b) was taken over from Art. 163(4)(a) EPC. The heterogeneous formulation of Arts. 134(2) and (3) EPC was noted and it was suggested that employing a similar grammatical construction in both paragraphs might be a more elegant drafting technique. The *epi* announced that it would present a proposal to anchor the existence of the *epi* in the Convention, possibly under Art. 134(9)(b) EPC.

11. The proposal that Art. 163 EPC be deleted, but that the substance of the grandfather clause be integrated in Art. 134 EPC, was approved in principle. However, the EPO would look again into the drafting of the proposal and submit a revised proposal which would take into account the *epi* suggestions regarding this provision.

### **IIIe. ARTICLE 129(a) EPC (CA/PL 19/98)**

12. The Committee generally approved the proposal for amending Article 129(a) EPC with a view to separating the European Patent Bulletin from the Register of European Patents.

### **IV. AMENDMENT OF ARTICLE 109(2) EPC (CA/113/98)**

13. The EPO explained that the extension of the time limit was designed to accelerate the procedure. The new limit would prevent referrals to the boards of appeal based purely on time reasons. However, as in the past, rectification would only be possible where the facts of the case were clear.
14. The *epi* representative emphasised his (personal) view that the Office's proposal was greatly to be welcomed, as it would help to avoid many time-consuming appeals.
15. The Committee approved the Office's proposal for amendment.

### **V. AMENDMENTS TO THE EPC IMPLEMENTING REGULATIONS<sup>(1)</sup>**

#### **Va. IMPLEMENTATION OF PHOENIX (CA/111/98)**

16. The EPO introduced the document while explaining the history, objectives and functioning of PHOENIX. The overall reaction of the Committee was positive. The large majority of questions and observations made by the delegations concerned the fate of paper documents within the framework of PHOENIX. The Office explained that paper documents would be maintained and referred to in cases of dispute or insecurity as to the completeness of a specific document for at least another five years until sufficient experience had been gathered with the new procedure. The long term objective was however to be able to eliminate paper as soon as the electronic file had been created (upon filing of an application) or updated (in the case of later filed documents).

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<sup>(1)</sup> The Office's proposals, as approved by the Committee, have been distributed as CA/159/98 and placed before the Council for decision.

17. The wording of the proposed Rule changes was discussed, slightly modified and adopted by the Committee.

**Vb. RULE 78 EPC (CA/116/98)**

18. The EPO explained the proposal to delete the second paragraph of Rule 78 EPC, emphasising that all notifications under this Rule would now have to be effected by registered letter, irrespective of the applicant's principal place of business. The last paragraph made it clear that national law would apply in cases concerning, for example, the issue of which persons were authorised to take delivery of registered letters.

19. The Committee approved the proposed amendment.

**Vc. RULE 84a EPC (NEW) (CA/127/98)**

20. Introducing the proposal, the Office explained that its purpose was to provide a means of remedying failures to observe time limits where the failure was due to delivery problems, in line with the existing provisions for international applications (Rule 82.1 PCT). Under the new Rule 84a, documents received late at the EPO would be considered to have been received in due time if they were despatched in due time before the expiry of the relevant time limit.

21. The Committee approved the Office's proposal after minor editorial changes.

**VI. CONVERTING EPO FEES TO EURO/AMENDING THE RULES RELATING TO FEES (CA/104/98 + Info 2/PL 8)**

22. The EPO explained the amendments of the Rules relating to Fees necessitated by the advent of the euro and the relevant EU regulations. The *epi* announced that it would enquire whether its members considered it important for payments in cash and by money-order to remain possible.

23. The Committee approved the proposed amendments.

**VII. ELECTRONIC COMMERCE/epoline (Info 4/PL 8)**

24. Following a presentation of the epoline project as to its content, its technical concept and its practical implications, the Office briefly presented its considerations as to the legal issues involved in the project's implementation. In summary, electronic filing

could be introduced by a decision of the President on the basis of Rule 24(1), second sentence. This decision would lay down the conditions governing the use of electronic means of communication and define the formal requirements to be fulfilled in such a case. Issues like signature or notification modalities would also be dealt with in this decision.

25. It was underlined that any decisions to be taken in the immediate future were to be based on as broad a consensus as possible, as applicants should not be confronted with conflicting requirements at national and European level. To this end, the delegations were requested to forward to the Office any relevant material, particularly in terms of existing or projected legislation in the matter, by 30 November. A progress report on the legislative aspect of the project would be presented by the Office for discussion at the next meeting of the Committee.

## **VIII. ANY OTHER BUSINESS**

### **VIIIa. LANDMINES (CA/PL 20/98 + CA/PL 21/98)**

26. The Belgian delegation and the EPO commented on the problems arising from applications for patents on inventions relating to anti-personnel mines. Although such applications were extremely rare, they posed a challenge to the EPO and to the patent offices of the contracting states. The EPO took the view that inventions relating to anti-personnel mines *per se* should be excluded from patentability as contrary to "ordre public" and morality; administrative measures to this effect had already been taken.
27. The Office would provide the Committee with a document explaining existing practice in this area and analysing the problems discussed in the document from the Belgian delegation.

### **VIIIb. MUTUAL RECOGNITION OF PRIORITY RIGHTS FOR TAIWAN (Info 3/PL 8)**

28. The EPO presented Info 3/PL 8, which contained the results of the Office's survey of the requirements for reciprocal recognition of priority rights under the national laws of the EPC contracting states, with a special view to the application of these provisions to Taiwan. In addition, the EPO reported that Taiwanese authorities had indicated a keen interest in concluding arrangements for the reciprocal recognition of priority rights with both the EPO and the EPC contracting states.



29. The *epi* welcomed these developments and stressed the economic importance of this issue for the users. The Austrian delegation related that a new provision dealing with this issue had been passed in Austria, circumventing the issue of statehood by referring to filing offices rather than states. The Spanish and Finnish delegations reported difficulties in the application of their legislation to Taiwan since the latter was not considered to be a "state". The Swedish delegation indicated that Sweden could not grant priority rights on a reciprocal basis with Taiwan as it appeared that Taiwanese law did not respect the principle of national treatment, and was therefore considered not to be in line with the Paris Convention. The Chairman asked that additional comments on this point be sent to the EPO.

**VIIIc. WORK PROGRAMME, DATE AND VENUE FOR THE 9TH MEETING OF THE COMMITTEE**

30. The EPO suggested that the Committee should meet three times a year, to give the Office time for careful preparation of the proposals for revising the EPC. The work programme for the next meeting was to include, in particular:
- the legal issues arising from implementation of the *epoline* project
  - various amendments to the Implementing Regulations (Rule 104b EPC, designation fees)
  - three or four proposals for revising the EPC.
31. The next meeting was scheduled for 16 to 18 March 1999, in Munich.

The Committee on Patent Law approved the draft minutes set out in this document on 16 March 1999.

Munich, 16 March 1999

For the Committee on Patent Law  
The Chairman

P. Mühlens

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- ORGANISATION EUROPEENNE DES BREVETS -

- Ausschuß "Patentrecht" - Committee on Patent Law -  
- Le comité "Droit des brevets" -

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**Info 1 Rev.1**

8. Sitzung / 8th meeting / 8ème session (München/Munich, 03. - 05.11.1998)

München/Munich, 3.11.1998

Orig.: d,e,f

BETRIFFT:	Teilnehmerliste
SUBJECT:	List of participants
OBJET:	Liste des participants
VERFASSEN:	Ratssekretariat
DRAWN UP BY:	Council Secretariat
ORIGINE:	Le secrétariat du Conseil
EMPFÄNGER:	Ausschuß "Patentrecht" (zur Unterrichtung)
ADDRESSEES:	Committee on Patent Law (for information)
DESTINATAIRES:	Le comité "Droit des brevets" (pour information)

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**VORSITZENDER - CHAIRMAN - PRESIDENT**

Herr P. MÜHLENS  
Ministerialrat  
Bundesministerium der Justiz  
(Deutschland)

**VIZEPRÄSIDENT - DEPUTY CHAIRMAN - VICE-PRESIDENT**

Mr W. NEERVOORT  
Vice-President  
Netherlands Industrial Property Office

**MITGLIEDSTAATEN - MEMBER STATES - ETATS MEMBRES**

**BELGIQUE**

M. P. LAURENT  
Conseiller adjoint  
Office de la Propriété Industrielle

M. G. BAILLEUX  
Conseiller adjoint  
Office de la Propriété Industrielle

**DENMARK**

Ms A.-R. JÖRGENSEN  
Head of Legal Department  
Danish Patent Office

Mr S. HEIN-MAGNUSSEN  
Head of Division  
Danish Patent Office

**DEUTSCHLAND**

Frau S. BECK  
Bundesministerium der Justiz

Herr L. VAN RADEN  
Leiter der Rechtsabteilung  
Deutsches Patent- und Markenamt

Frau C. HÜBENETT

Referatsleiterin, ausländischer gewerbl.  
Rechtsschutz  
Deutsches Patent- und Markenamt

Herr H. BARDEHLE

Patentanwalt

### **ELLAS**

Ms C. MARGELLOU

Director  
International Affairs and Legal Matters  
Industrial Property Organisation (OBI)

### **ESPAGNE**

Mr D. A. CARRASCO PRADAS

Director  
Legal Coordination and International  
Relations Department  
Spanish Patent and Trademark Office

Mr J. CONGREGADO LOSCERTALES

Head of International Relations Division  
Spanish Patent and Trademark Office

### **FINLAND**

Mr B. RAPINOJA

Government Secretary  
Legal Affairs Division  
Ministry of Trade and Industry

Mrs M. LÖYTÖMÄKI

Deputy Director  
National Board of Patents and Registration

Mrs M. AALTO-SETÄLÄ

Coordinator of International Affairs  
National Board of Patents and Registration

### **FRANCE**

M. R. RICHTER

Adjoint au Chef du Département des brevets  
Institut National de la Propriété Industrielle

M. J.-L. GAL

Chargé de mission aux affaires  
internationales  
Institut National de la Propriété Industrielle

**IRELAND**

Mr J. RAJAN

Principal Examiner  
Intellectual Property Unit  
Department of Enterprise, Trade and  
Employment

Mr F. O'DUBHGHAILL

Legal assistant  
Office of the Attorney General

**ITALIE**

M. A. CAPONE

Chef de la Division "Brevet européen et  
PCT"  
Office italien des brevets et des marques

Mme D. PALMA

Directeur de division  
Office italien des brevets et des marques

**LUXEMBOURG**

M. C. SAHL

Chef de secteur  
Service de la Propriété Intellectuelle  
Ministère de l'Economie

**THE NETHERLANDS**

Mr W. NEERVOORT

Vice-President  
Netherlands Industrial Property Office

Mr H.M.H. SPEYART

Industrial Property Advisor  
Ministry of Economic Affairs

**ÖSTERREICH**

Herr H. KNITTEL

Vizepräsident  
Österreichisches Patentamt

Frau E. BAUMANN-BRATL

Vorstand der Rechtsabteilung A  
Österreichisches Patentamt

**PORTUGAL**

Mme I. AFONSO

Directeur du Service des Brevets  
Institut National de la Propriété Industrielle

**SCHWEIZ**

Herr P. BAECHTOLD

Leiter Rechtsdienst Patente  
Eidgenössisches Institut für Geistiges  
Eigentum

**SWEDEN**

Mr P. HOLMSTRAND

Chief Legal Counsel  
Swedish Patent and Registration Office

Ms M. ERIKSSON

Head of Legal Division, Patent Department  
Swedish Patent and Registration Office

**UNITED KINGDOM**

Mr H. J. EDWARDS

Deputy Director, Legal Division  
Patent Office

**BEOBACHTER - OBSERVERS - OBSERVATEURS**

**1. Staaten - States - Etats**

**BULGARIA**

Ms T. PETKOVA

Head of "Patent and Information Services"  
Department  
Bulgarian Patent Office

**CZECH REPUBLIC**

Mrs S. KOPECKÁ

Head of European Integration Section  
Industrial Property Office

**ESTONIA**

Mr R. KARTUS

Head of the Patent Department  
Estonian Patent Office

Mr T. KALMET

Juridical counsellor  
Estonian Patent Office

**HUNGARY**

Mrs M. SÜMEGHY

Head of the Legal and International  
Department  
Hungarian Patent Office

Ms M. ANGYAL

Head of Legal Section  
Hungarian Patent Office

Ms K. KOVÁCS

Legal Officer  
Hungarian Patent Office

**LATVIA**

Mr G. POLIAKOV

Deputy Director  
Patent Office

**NORWAY**

Ms R.M. WAHL

Head of Legal Section  
Norwegian Patent Office

**POLAND**

Ms E. NIZIŃSKA-MATYSIAK

Principal Expert  
Patent Office

**ROMANIA**

Mr L. BULGĂR

Director  
Legal and International Affairs

**SLOVENIA**

Mrs M. PEČAR

Director-Counsellor  
Legal Department

**2. Zwischenstaatliche Organisationen - Inter-Governmental Organisations -  
Organisations intergouvernementales**

**World Intellectual Property Organization  
Organisation Mondiale de la Propriété  
Intellectuelle (WIPO/OMPI)**

Mrs T. MIYAMOTO

Consultant  
Industrial Property Law Division

**Europäische Union - European Union  
Union européenne**

M. D. VANDERGHEYNST

Administrateur  
Commission de l'Union Européenne  
Direction générale XV

**3. Nichtstaatliche Organisationen - Non-Governmental Organisations -  
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M. A. CASALONGA

Président de la Commission pour la Pratique  
du brevet Européen

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Herr G. KOLLE	Direktor (5.2.2)
Herr R. STEFFEK	Verwaltungsrat (5.2.2)
Herr E. STOHR	Jurist (5.2.2)
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M. E. WAAGE	Juriste (5.2.2)

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Herr G. HEDEMANN	Personalvertreter

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Ms N. QUINLAN	Assistant
Frau P. MINNELLI	Assistentin

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