M I N U T E S

of the

9th meeting of the

COMMITTEE ON PATENT LAW

(Munich, 16-17 March 1999)

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C O N T E N T S

The ninth meeting of the Committee on Patent Law was held in Munich on 16 and 17 March 1999, with Mr P. Mühlens (DE) presiding. For the list of participants, see Annex I.

I. ADOPTION OF THE AGENDA (CA/PL 1/99 Rev. 1)

1. The provisional agenda in CA/PL 1/99 Rev. 1 was adopted.

II. ELECTION OF THE COMMITTEE'S DEPUTY CHAIRMAN

2. The chairman raised this point following the retirement of Mr W. Neervoort (NL), and Mr H. J. Edwards (GB) was unanimously elected (present: 18; for: 17; abstention: FR) as the committee's deputy chairman for a term of three years as from 1 June 1999. The chairman paid tribute to Mr Neervoort, thanking him warmly for his work on the committee and the *ad hoc* Working Party on Harmonisation.

III. APPROVAL OF THE MINUTES OF THE 8TH MEETING (CA/PL 23/98)

3. The committee approved the draft minutes of its 8th meeting (CA/PL 23/98) after making minor amendments to points 6 and 22. The final version has since been issued as CA/PL PV 8.

4. Replying to the Danish delegation, the secretariat said a summary of conclusions was sent to delegations shortly after each meeting. This was followed by more detailed draft minutes, which the secretariat would try to issue as quickly as possible in future.

IV. IMPLEMENTATION OF EU BIOTECHNOLOGY DIRECTIVE (CA/PL 3/99)

5. Tabling CA/PL 3/99, the Office said one obvious solution would be to incorporate the directive's relevant provisions into the EPC Implementing Regulations. The directive's rapid implementation via the EPC was in the interest of a unitary system of European patent law, and not achievable through the revision process. The Implementing Regulations were an integral part of the Convention, so the rules proposed would be equally binding on the Office, the boards of appeal and national courts.

6. Delegations were agreed that the terms of the directive had to be implemented also in European patent law. Views differed on whether this could be done through the Implementing Regulations alone. The French, Spanish, Danish and Swedish delegations stressed that biotechnology was a controversial topic of great political and social relevance. These were important changes to patent law, and could be introduced constitutionally only through formal legislation. To try and regulate them via the Implementing Regulations was questionable, and a revision process for Article 53 EPC should therefore be initiated.

7. Other delegations (especially GR, AT, PT) said the directive was a fact - also in national law. Insofar as it was based on EPC provisions and EPO practice, it could indeed be brought in via the Implementing Regulations. Also, amending the Implementing Regulations could be done fairly quickly and would maintain flexibility for the future. Supplementary revision of the EPC would certainly be unnecessary if the Enlarged Board of Appeal confirmed (in the Novartis case) the interpretation of Article 53(b) EPC, in line with the directive, underlying EPO practice until 1995.

8. The Irish delegation said Ireland was able to implement Community law rapidly and efficiently, because no formal legislative procedure was required. During revision of the EPC, thought should be given to including a comparable provision in the Convention (see also point 22).

9. Some delegations said EPC revision was a complex and time-consuming process; the directive should therefore be brought in by amending the Implementing Regulations, at least as a first step. The Commission representative endorsed this view.

10. The UNICE representatives said European and national law should not be allowed to diverge, and the Office's proposals were a feasible, pragmatic and efficient way to implement the directive. Whether a revision was also necessary was doubtful; the important first step was to bring European patent law into line with the directive by amending the Implementing Regulations.

11. The chairman noted that all delegations wanted to see the directive immediately implemented in European patent law. The Spanish, French, Danish and Swedish delegations were in favour of revising the Convention. Ten delegations (BE, DE, IE, FI, LU, MC, NL, PT, CH, UK) thought the first step was to supplement the Implementing Regulations, with consideration then being given, during the ongoing revision process, to perhaps amending the actual Convention as well. Four delegations (AT, IT, GR, CY) thought only the Implementing Regulations should be amended.

12. There was agreement that the wording of the provisions which the Office proposed to incorporate into the Implementing Regulations should be as close as possible to that used in the directive. This was important in ensuring a uniform interpretation of these provisions throughout Europe, in line with the reference, proposed in Rule 23b(1), to the directive as a supplementary means of interpretation.

13. Regarding the definition of "plant variety" in Rule 23b(4), the Office was urged to consider whether not only paragraph 2 of Article 5 of the EU regulation on plant variety rights but also its paragraphs 1, 3 and 4 should be included in the rule. Article 2(3) of the directive contained a general reference to Article 5 of the regulation.

14. On Rule 23c, it was suggested that the issues relating to patentability of the human body be covered by a separate provision, as in the directive. The Implementing Regulations should also stipulate concrete description of the commercial applicability of gene sequences claimed in patent applications.

15. The committee noted the text proposed in Annex I to CA/PL 3/99 ("Extent of protection"). There was agreement that this was a matter for national law.

16. Summing up, the chairman noted that a revised version of the Office's proposals would be submitted to the Administrative Council with a view to immediate implementation of the directive [for information: for the revised proposals, see CA/7/99], and thought should be given, during the ongoing revision process, to whether the Convention needed to be amended.

V. AMENDMENTS TO THE IMPLEMENTING REGULATIONS TO THE EPC (CA/PL 4/99 Rev. 1)

17. The Office tabled CA/PL 4/99 Rev. 1, highlighting some of the changes made. The committee then discussed these proposals, especially those relating to the time limits for paying the designation fees for Euro-PCT applications entering the regional phase (and their effects on prior-right provisions), computation of the claims fees, and the applicant's right to amend his Euro-PCT application before receiving the supplementary search report. Replying to WIPO, the Office said the proposed rules were not intended to limit the applicant's right under Rule 86 EPC to amend his application during examination proceedings.

18. The committee unanimously approved the proposals to amend Rules 15(2), 25(2), 85a, 85b and 104b of the Implementing Regulations. The Office said it would be submitting a document on new Rule 104c for the committee's approval under the written procedure. [For information: a consolidated and revised document will be resubmitted at the committee's next meeting, for opinion.]

VI. REVISION OF THE EPC

VIa. SUMMARY OF SACEPO'S COMMENTS (CA/PL 2/99)

19. The Office tabled a document summarising the main comments arising from consultation of the interested circles in September 1998, and showing in condensed form where SACEPO members agreed and disagreed on the EPC revision proposals.

20. The committee noted CA/PL 2/99.

VIb. ARTICLE 23(3) EPC - INDEPENDENCE OF THE MEMBERS OF THE BOARDS (CA/PL 5/99)

21. The Netherlands proposal that Article 23(3) EPC be amended so that members of the boards of appeal were bound by the European Convention on Human Rights and the TRIPs agreement was examined on the basis of CA/PL 5/99, which drew attention to legal uncertainties to which such amendment might give rise. However,

the need to retain the present wording of Article 23(3) EPC - to guarantee board members' independence from instructions of the President - should not prevent other initiatives designed to make it easier to keep European patent law in line with future developments in international industrial property law.

22. A proposal from the Irish delegation, seeking to strengthen the Council's legislative powers to permit greater flexibility in adapting European patent law to developments in international industrial property law, was noted attentively by several delegations.

23. The committee gave a favourable opinion on the Office's proposal in CA/PL 5/99. The Office would prepare a proposal to revise the EPC, taking the Irish proposal into account.

VIc. ARTICLE 52(1) - (3) EPC - PATENTABLE INVENTIONS (CA/PL 6/99)

24. The Office presented its proposal to amend Article 52(1) EPC and delete Article 52(2) and (3) EPC, stressing that although this might seem radical the aim was more to deregulate the EPC than to change Office practice on patentability. The wording of Article 27(1) TRIPs, and the likelihood of an EU legislative initiative on the patentability of computer programs, were further incentives to amend the EPC.

25. Delegations' interventions on the various aspects of the proposal were as follows:

- The idea of bringing Article 52(1) EPC into line with Article 27(1) TRIPs was approved in principle by most delegations, but the discussion showed certain doubts about the fact that the French wording proposed for Article 52(1) EPC ("dans tous les domaines de la technique") differed from that used in Article 27(1) TRIPs ("dans tous les domaines technologiques"), and about including a definition of “invention” in the Implementing Regulations.

- A majority of delegations supported the proposed deletion of computer programs from the list of non-patentable subject-matter in Article 52(2)(c) EPC. The other delegations thought Article 52(2) and (3) should be deleted altogether, as proposed by the Office, to make clear that the concept of "invention" was not being widened. The European Commission representative said the EC directive currently being prepared went in the same direction as the Office's proposal.

- Several delegations had reservations about leaving it to the case law to exclude the subject-matter currently listed in Article 52(2) EPC. It was suggested that a definition of "invention" be drafted with reference to that list. This definition should go into the Implementing Regulations.

26. The Office said deleting computer programs on their own might give the wrong impression that they were patentable regardless of their technical contribution to the art. It was doubtful whether any definition of invention would be workable in practice. Shifting the Article 52(2) list - minus the reference to computer programs - into the Implementing Regulations seemed a suitable way of addressing the reservations expressed about complete deletion of Article 52(2) and (3).

27. Summing up, the chairman noted that in the light of the discussion the Office would submit a revised proposal for a new Article 52 EPC.

VId. ARTICLE 52(4) EPC - PATENTABLE INVENTIONS - AND ARTICLE 54(5) EPC - NOVELTY (CA/PL 7/99)

28. The Office began by saying it had deliberately refrained from proposing a text in the document, the intention being to have an initial discussion about the legal effect of deleting the prohibition on patents for medicinal methods, as urged by the interested circles.

29. During the discussion it was argued that allowing patents for medical methods whilst protecting individual medical treatments from patent law restrictions would merely shift the problem to infringement proceedings. The Commission representative said the biotechnology directive did not stand in the way of amending Article 52(4) EPC. To protect individual treatments, one possibility would be to limit the effect of such patents, eg as in Article 27(c) CPC 1989. The *epi* and UNICE representatives said the priority was improved protection for second medical uses of known substances. It certainly seemed doubtful that Article 54(5) EPC could be deleted altogether.

30. The Office said the purpose of Article 52(4) EPC - to keep medical practice free from patent law restrictions - was not in fact achieved in practice. As the discussion proceeded, more thought would also have to be given to patents for second medical use.

31. It was agreed to consider, during the ongoing revision process, how to revise the rules governing patents for new medical uses of known substances.

VIe. ARTICLE 53(a) EPC - EXCEPTIONS TO PATENTABILITY (CA/PL 8/99, Info 2/PL 9 + Info 3/PL 9)

32. Further to the discussions at the committee's 8th meeting, the Office tabled CA/PL 8/99 analysing in detail the legal mechanisms in place to prevent publication or patenting of inventions contrary to "ordre public" or morality. In view of the conclusions reached in this document the Office was disinclined to take on the laborious task of creating a procedure for the systematic verification of all incoming applications. Its wish to avoid such a procedure - which would not only be difficult to apply but also unwieldy and, ultimately, ineffectual (cf. the existing procedure under the PCT which WIPO's International Bureau has not so far had to apply in respect of any published PCT application) - was endorsed by the delegations.

33. The Office's proposal to amend Article 53(a) EPC was unanimously accepted by the committee. Deleting the words "publication" (English and French texts) and “Veröffentlichung” (German text) from Article 53(a) would define more clearly how and when the Office should intervene to preserve "ordre public" and morality, and at the same time bring the wording of the EPC into line with Article 27(2) TRIPs. Also, replacing "la mise en oeuvre" (cf. existing French text of Article 53(a) EPC) by "l'exploitation commerciale" (cf. Article 27(2) TRIPs) would exclude any risk of divergent interpretation of the two. The English and German texts of Article 53(a) EPC already referred to “exploitation” and “Verwertung”, so aligning them with Article 27(2) TRIPs merely involved adding the adjective “commercial” and “gewerbliche” respectively.

34. The committee noted the documents submitted to it for information by the Belgian and Austrian delegations (Info 2/PL 9 and Info 3/PL 9).

VIf. ARTICLE 87(5) EPC - PRIORITY RIGHTS (CA/PL 9/99)

35. The Office presented CA/PL 9/99, containing an amended proposal for revision of Article 87(5) EPC (regarding reciprocal recognition of priority rights for non-Paris Union, non-WTO states) which took into account the suggestions made at the last meeting regarding the original proposal in CA/PL 16/98.

36. The Irish delegation reiterated its opposition to removal of the requirement that priority rights be recognised by the reciprocating state in or for any EPC contracting state, and added that the power to issue the notification should remain with the Administrative Council.

37. The Finnish, Portuguese and United Kingdom delegations focused on the concrete political difficulties encountered by their respective foreign ministries with respect to Taiwan, and did not support the Office's proposal. It was also doubted that substituting "industrial property authority" for "state" would have the desired effect of circumventing these difficulties.

38. The Office said the proposal should be discussed on its general merits, not strictly in the context of Taiwan. Article 87(5) EPC was a safety valve which allowed the safeguarding of European industrial interests in states which remained outside international industrial-property agreements. It needed to be simplified in order to be made usable. The issuing of any notification by the President would remain under the control of the Administrative Council, and action would not be taken without considering the situation in the contracting states. The present mechanism of Article 87(5) EPC was such that even if most contracting states were interested in achieving recognition of priority rights with a particular country, they could be hindered by a single state unwilling to follow suit. This was a matter of external commerce, not foreign policy, and the Office's proposal depoliticised the process. It was noted that this issue should be of interest to the European Commission.

39. The Office's proposal was supported by the Austrian, Belgian, Swiss, German, Danish, French, Italian, Netherlands and Swedish delegations.

40. The chairman asked the delegations to make another attempt to represent the interests of European industry within their respective foreign ministries, focusing on

the substance of the Office's proposal for revising the mechanism of Article 87(5) EPC as such, and insisting on the fact that a revision of Article 87(5) EPC would not entail its automatic application to Taiwan. It was agreed that the Office's proposal would be put on the committee's provisional agenda at a later date.

VII. E-COMMERCE (*epoline*) (CA/PL 10/99)

41. The committee noted the Office's presentation on *epoline* technical developments and regarding a legal framework for electronic filing.

42. The Belgian delegation, expressing approval of the Office's conclusions on the legal aspects, asked whether national offices would be able to obtain a smart card for use on behalf and in the name of individual applicants who lacked access to the necessary equipment. The Office explained that it would make smart cards and connection facilities available to applicants otherwise unable to obtain them.

43. The Greek delegation asked whether a particular procedure would be set up for national offices receiving European patent applications. Referring to the presentation given to the Administrative Council in December 1998, the Office said it would provide links to the national offices, and between those offices and the EPO.

44. UNICE raised the issue of transmission security, which was particularly important for first filings. Consideration and amendment of Articles 55, 87 and 89 EPC were proposed. The Office promised to re-examine this issue thoroughly, and report back to the committee.

45. The committee noted with approval the Office's study on the legal feasibility of electronic filing of European applications, and asked the Office to bear in mind the data security aspects also.

VIII. RECIPROCAL RECOGNITION OF PRIORITY RIGHTS WITH TAIWAN (CA/PL 11/99 e)

46. The Office presented CA/PL 11/99 e, which merely presented updated information about the situation with Taiwan. The Office said the Taiwanese authorities had been

advised that the prevailing view was that priority rights under Taiwanese patent law were not in conformity with the Paris Convention, as the principle of national treatment was not applied. This would be a legal obstacle to recognition of priority rights under Article 87(5) EPC. At the request of the Taiwanese authorities, the Office had formulated suggestions as to how Taiwanese patent law should be amended to bring it into line with the Paris Convention on this point.

47. The committee noted the document and the Office's explanations. It was emphasised that the economic dimensions of the issue of recognition of priority rights with Taiwan were of major importance for European industry.

IX. WORK PROGRAMME, DATE AND VENUE FOR THE COMMITTEE'S 10TH MEETING

48. For this meeting, the Office would again prepare several proposals for revision of the EPC and its Implementing Regulations. The original dates (1 and 2 July 1999) had had to be changed; the committee's 10th meeting would now be held in Munich on 8 July (commencing at 11.00 hrs) and 9 July 1999.

The Committee on Patent Law approved the draft minutes set out in this document on 8 July 1999.

Munich, 8 July 1999

For the Committee on Patent Law
The Chairman

P. MÜHLENS

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Info 1 Rev.1

9. Sitzung / 9th meeting / 9ème session (München/Munich, 16. - 18.03.1999)

München/Munich, 17.03.1999

Orig.: d,e,f

BETRIFFT:	Teilnehmerliste
SUBJECT:	List of participants
OBJET:	Liste des participants
VERFASSER:	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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