

M I N U T E S

of the
10th meeting of the

COMMITTEE ON PATENT LAW

(Munich, 8 July 1999)

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The Committee on Patent Law held its 10th meeting in Munich on 8 July 1999, with Mr Mühlens (DE) presiding. The list of participants is contained in Annex I.

I. ADOPTION OF THE AGENDA (CA/PL 15/99)

1. The committee adopted the provisional agenda set out in CA/PL 15/99. It was explained that CA/PL 22/99 (amendment of Rule 102 EPC) had not been distributed because consultations with the *epi* were still in progress; the matter would be dealt with at the committee's next meeting. Under item V, Info 2/PL 10 was added.

II. APPROVAL OF THE MINUTES OF THE COMMITTEE'S 9TH MEETING (CA/PL 13/99)

2. The committee approved the draft minutes of its 9th meeting, with minor amendments to points 25 and 32. The final version has since been issued as CA/PL PV 9.

III. AMENDMENTS TO THE EPC IMPLEMENTING REGULATIONS

IIIa. RULES 104b ff (CA/PL 16/99)

3. The Office presented CA/PL 16/99, explaining that this was a comprehensive reworking of CA/PL 4/99 (put to the committee at its 9th meeting).
4. The WIPO delegation expressed its agreement to the new proposal.
5. The United Kingdom delegation asked whether an applicant's failure to specify the application documents on which the European grant procedure was to be based (see new Rule 107(1)(b)) would entail any legal consequences, and whether this rule should not also mention payment of possible claims fees. It also suggested adding the word "exclusively" to the second sentence of Rule 107(2) ("... if examination is to be performed **exclusively** on the subject-matter covered by the report") and adding the words "second sentence" to new Rule 110(3) ("... under paragraph 2, **second sentence**, shall be refunded)". The Office replied that new Rule 107(1)(b) merely clarified the situation upon entry into the regional phase; applicants would not suffer any legal consequences if they failed to provide this information. It had felt that the legal arrangements for paying claims fees were best grouped together in a single rule, particularly since according to the PCT preparatory documents the "national fee" no longer included claims fees.

6. Replying to the *epi* delegation, the Office said new Rule 109 was a new service which would clarify the basis for any supplementary search; its text specifically stated that any amendment of the application during this non-extendable one-month period was without prejudice to Rule 86(2) to (4).
7. The German delegation suggested adding the word "erforderlich" to the German version of the second sentence of new Rule 109, and asked about the texts' structure, especially where applicants failed to pay designation fees as intended. The Office said that to clarify matters it had drawn a distinction between the procedural steps for entry into the regional phase and the new rules governing the claims fees; if insufficient designation fees were paid, Articles 7(2) and 9(2) RFees applied.
8. The Chairman then proposed that the committee adjourn to enable the Office to discuss the suggested editorial amendments with the delegations concerned.
9. After the Office's explanations, the committee gave a unanimous favourable opinion (present: 17; for: 17) on the proposals to amend Rules 104b ff (CA/PL 16/99), subject to the following amendments (indicated in bold):
 - the second sentence of Rule 109 (German version only) to read
"Die dementsprechend geänderte Anmeldung wird einer nach Artikel 157 Absatz 2 **erforderlichen** ergänzenden Recherche zugrunde gelegt."
 - new Rule 110(3) (English, French and German versions) to read "... under paragraph 2, **second sentence**, ...".

IIIb. RULE 18 (CA/PL 20/99)

10. The Office tabled CA/PL 20/99. Some delegations requested explanations about the wording. The Belgian delegation thought the inventor's address and nationality might be needed for statistical reasons. Replying to the various questions, the Office said applicants would still be obliged under Rule 17(1) to provide such inventor-related

information, which would therefore be available for statistical purposes if necessary. If however the inventor chose to waive his right to a mention in EPO publications (application, specification, or Register of European Patents), then these would not give his name and address, and under Rule 93(c) the relevant items would be excluded from file inspection.

11. The WIPO delegation said there was no corresponding provision in the PCT, and information about the inventor would therefore be published with the international application (80% of applications are published in English, French or German, and the said publication replaces the European one (Article 158(1)). It also explained that Rule 94.1(b) PCT as in force since 1 July 1998 required the International Bureau to furnish copies of any document contained in its file; hence the PCT contained no provision like Rule 93(c).
12. The committee then gave a unanimous favourable opinion (present: 17; for: 17) on the proposal to amend Rule 18 *et al.* (publication of the mention of the inventor) as set out in CA/PL 20/99.

IIIc. RULE 38 (CA/PL 21/99)

13. The Office tabled CA/PL 21/99 with an amended new Rule 38(4) reading as follows: "The copy of the previous application shall be deemed duly filed if the European Patent Office, in accordance with a decision of its President, adds a copy available to it to the file of the European patent application."
14. The Austrian delegation, noting that the administrative fee had been abolished, thought this should be specifically mentioned in the grounds for the Council decision. Also, new paragraph 4 as proposed gave the impression that the President had to take an individual decision in each case. The Office explained that in fact, as the wording "in accordance with a decision of its President" implied, the President would take a general decision, to be published in the Official Journal. To clarify the German version, and in agreement with the Austrian delegation, it was decided to use the word "Beschluss" rather than "Entscheidung".
15. In response to various delegations' proposals for other editorial amendments, the Office submitted a new paragraph 4 worded as follows: "The copy of the previous application shall be deemed duly filed if a copy available to the European Patent

Office is to be included in the file of the European patent application under the conditions laid down by the President of the European Patent Office". The UNICE delegation said it preferred this new formulation. The *epi* delegation thought applicants would not know whether the copy of the earlier application had actually been added to the file; to prevent subsequent discussions about validity of priority rights, the Office should notify them accordingly. The Office said this was a practical issue which could be looked into during work on the *epoline* project.

16. The staff representatives wondered how this provision would be applied once electronic filing came in. The Office said Rule 95a had already been amended to accommodate PHOENIX (see Administrative Council decision CA/D 9/98 of 10 December 1998).
17. The committee then gave a unanimous favourable opinion (present: 18; for: 18) on the text proposed for Rule 38 in CA/PL 21/99, after amending its paragraph 4 as proposed by the Office (see point 15 above).
18. Replying to the United Kingdom delegation, the Office said the present amendments to the Implementing Regulations - plus those to Rules 15(2), 25(2), 85a and 85b (and the corresponding RFees provisions) agreed at the committee's 9th meeting (see CA/PL PV 9, point 18) - would be submitted to the Council for decision in October 1999. The relevant CA document (CA/22/99) would be issued in due course to committee members, for information and any comment. The draft Council decision would provide for all the amendments to enter into force on 1 January 2000.

IV. REVISION OF THE EPC

IVa. ARTICLE 54 (CA/PL 17/99)

19. Tabling CA/PL 17/99, the Office explained that this proposal had been unanimously approved by SACEPO, and if adopted would mean amending Rules 23a and 87 accordingly. It had no bearing on national prior rights.

20. The United Kingdom delegation and the UNICE representatives fully supported the proposal; it would simplify the legal position and end any uncertainty. The Danish, Irish and Austrian delegations said it would mean amending their national legislation. The Austrian delegation wanted to discuss the idea with its interested circles.
21. The committee gave a favourable opinion (present: 18; for: 17; abstention: 1) on the proposal made in CA/PL 17/99 ; the Austrian delegation reserved its position. Deletion of Article 54(4) would form part of the proposed EPC revision.

IVb. ARTICLES 121 AND 122 (CA/PL 19/99)

22. The Office tabled CA/PL 19/99. The large majority of delegations gave their views on the proposals put forward. The German delegation thought the EPC articles should perhaps continue to specify certain cases where further processing or re-establishment of rights would not apply. The French delegation supported the proposals' underlying principles, but asked the Office for more details about how further processing and re-establishment would operate in practice (eg retention of the two-month period for the former), and whether the two provisions could be cumulative. It also asked whether the proposals were compatible with the corresponding PLT provisions under discussion.
23. The Hellenic delegation thought there was a contradiction in the proposed wording of Article 121: paragraph 1 referred to "any other loss of right" whilst paragraph 2 said the Implementing Regulations could allow exceptions. Nor was any express provision made for the rights of third parties in the event of further processing. The Austrian, United Kingdom and *epi* delegations endorsed the latter point; new Article 121 should include a provision preserving third-party rights.
24. The Netherlands delegation said it had not reached a definitive position on this proposal, which however should also take account of the outcome of the intergovernmental conference as regards shorter processing times.
25. The United Kingdom delegation thought Article 121 should perhaps allow the Office some discretion in applying these procedures.

26. Congratulating the Office on its initiative, the Portuguese, Danish, Italian, Spanish and Austrian delegations said they supported the principles set out in the document. The Italian delegation added that a discussion with its interested circles was still necessary.
27. Endorsing the statements from the other delegations, the *epi* delegation said the two-month period should be triggered by removal of the cause of non-compliance rather than notification of the communication, the one-year time-bar should be retained, and a provision along the lines of existing Article 122(6) should be included in new Article 121. Thought should also be given to how this provision would apply to opposition proceedings and opponents.
28. The WIPO representative then explained the International Bureau's approach to the matter [see PLT/SCP/3/7].
29. The UNICE representative too endorsed the Office's general approach, and said a balance had to be found between flexibility - to permit re-establishment when time limits were missed - and legal certainty (also for third parties).
30. After this initial "tour de table" on the Office's proposals, the chairman noted that the committee could give a favourable opinion. The Office noted the delegations' comments, remarks and suggestions, which it would take into account in a subsequent document for submission to the committee.

V. OUTCOME OF THE INTERGOVERNMENTAL CONFERENCE ON REFORM OF THE EUROPEAN PATENT SYSTEM (PARIS, 24-25 JUNE 1999) (Info 2/PL 10)

31. The committee noted Info 2/PL 10.

VI. TRANSLATION OF EUROPEAN PATENTS (CA/PL 18/99)

32. The committee noted CA/PL 18/99 about translation of European patent specifications. At the suggestion of the Austrian delegation, the document was not discussed; this issue would be dealt with by working party I (on reducing the cost of European patents) set up at the intergovernmental conference referred to in point V above.

VII. OTHER BUSINESS - DATES AND VENUE OF NEXT MEETING

33. The committee fixed 18 and 19 November 1999 as the dates for its next meeting.

VIII. CLOSURE OF MEETING

34. The committee's deputy chairman and the Vice-President DG 5 paid tribute to Mr Mühlens, who was chairing the committee for the last time following his appointment as legal member of the boards of appeal at the Council's June 1999 meeting. Mr Mühlens, responding to prolonged applause, gave a speech of thanks.

The Committee on Patent Law approved the draft minutes set out in this document on 18 November 1999.

Munich, 18 November 1999

For the Committee on Patent Law
The Chairman

Paul LAURENT

EUROPÄISCHE PATENTORGANISATION - EUROPEAN PATENT ORGANISATION

- ORGANISATION EUROPEENNE DES BREVETS -

- Ausschuß "Patentrecht" - Committee on Patent Law -

- Le comité "Droit des brevets" -

Info 1 Rev.1

10. Sitzung / 10th meeting / 10ème session (München/Munich, 8.07.1999)

München/Munich, 08.07.1999

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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Union des Confédérations de l'Industrie et des Employeurs d'Europe

Mr J.E.M. GALAMA	Vice-Chairman of the Working Group on "Patents"
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