

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

of the  
11th meeting of the

## **COMMITTEE ON PATENT LAW**

(Munich, 18th November 1999)

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The Committee on Patent Law held its 11th meeting in Munich on 18 November 1999, with Mr LAURENT (BE) presiding. The list of participants is contained in Annex I.

**I. ADOPTION OF THE PROVISIONAL AGENDA (CA/PL 25/99)**

1. The committee adopted the provisional agenda set out in CA/PL 25/99, with the addition of a sub-item 5(a), "Progress report on discussions regarding electronic filing", under "Other business".

**II. APPROVAL OF THE DRAFT MINUTES OF THE COMMITTEE'S 10TH MEETING (CA/PL 24/99)**

2. The committee approved the draft minutes of the 10th meeting unamended. They have since been issued as CA/PL PV 10.

**III. WORK PROGRAMMES FOR FUTURE MEETINGS**

3. The Office began with an oral progress report regarding work on articles of the Convention which still needed to be discussed by the committee. It also proposed the dates for committee meetings which had been agreed with the Chairman.
4. In response to a request from the Belgian delegation, the Office said that the list of points already dealt with and yet to be dealt with would be presented at the December 1999 meeting of the Administrative Council [see CA/110/99].
5. The Netherlands and Austrian delegations expressly indicated their agreement with the proposed timetable.
6. The committee then noted that the timetable and the work programmes would be discussed at the December 1999 meeting of the Administrative Council.

**IV. REVISION OF THE EPC**

**IVa. ARTICLES 84, 100 AND 138 (CA/PL 27/99)**

7. The Office tabled CA/PL 27/99.
8. The UK delegation began by giving its view of the matter, pointing out that the committee had already debated a similar proposal on the basis of CA/PL 4/96. Since that debate, a House of Lords ruling had established a close relationship between support by description and sufficiency of disclosure. The UK Office had refused to grant a second, differing medical use for compounds because no indication had been given that the claimed invention had been tried and tested; the absence of such indications had led the UK Office to refuse such applications on the ground of lack of support for the claims. The UK Office's practice of refusing speculative claims had been adopted by the courts. Furthermore, the decision of a technical board of

appeal in T 939/92, which had ruled out application of Article 84 EPC and examined the scope of a technical effect not credible for all the claimed alternatives under Article 56 EPC, seemed to be a questionable ruling. Lastly, in February 1999 interested communities in the UK had again spoken out in favour of the proposed amendment. Introducing such a ground for opposition would not create legal uncertainty and would allow a gap in the European system to be filled.

9. The Irish delegation, supporting the UK delegation's proposal, said it was in favour of introducing lack of support in the sense of Article 84 as a ground for opposition or revocation. A national court could reject the argument that sufficiency of disclosure and support by description are so closely linked that over-broad claims can be invalidated on the grounds that the description is insufficient.
10. The BE, DK, DE, GR, ES, FI, FR, IT, LU, MC, NL, PT, AT and SE delegations supported the Office's proposal, stressing in particular that the absence of ground for opposition/revocation did not cause them any particular problems and that the existing legal armoury was adequate. The Austrian delegation said that its national legislation included a provision similar to Article 84 governing the relationship between the description and the claims, which was regarded as an administrative rule ("Ordnungsvorschrift").
11. The *epi* delegation reported that the issue had been debated within the *epi*, and the arguments put forward by the UK delegation had been discussed at length. It supported any proposal designed to make lack of support by the description a ground for opposition or revocation. It was not yet possible to say whether the case law of the boards of appeal regarding application of Articles 83 and 56 EPC would be followed by national courts. Moreover, inclusion of Article 84 as a ground for opposition or revocation would allow claims which were neither clear nor concise to be challenged during post-grant proceedings.
12. The UNICE delegation stressed that the real problem was knowing whether national courts would accept the case law of the boards of appeal. It proposed to submit its position on the issue later, as internal consultation was still required.
13. The Office then pointed out that changing the EPC in this respect would have repercussions both for the Organisation and worldwide. Hence it might be advisable to discuss the issue at WIPO or WTO level in connection with the harmonisation treaty, and appropriate solutions might be found in that environment. It said there was at present no case law in the EPO member states in which national judges mentioned the absence of a legal provision enabling them to revoke claims which were clearly too broad. It proposed that the delegations concerned (GB, IE, *epi*)

submit a memorandum to the committee giving supporting examples demonstrating that the existing provisions, ie Articles 56, 57 and 83 EPC, were inadequate.

14. Summing up the debate, the Chairman of the committee concluded that a clear majority of the delegations had supported the Office's proposal as set out in CA/PL 27/99. He proposed that the UK and Irish delegations should inform their interested communities that the issue had been debated by the committee and that at present any proposal designed to make lack of support by the description within the meaning of Article 84 EPC a ground for opposition or revocation would be rejected.

#### **IVb. ARTICLE 123 (CA/PL 26/99)**

15. The Office tabled CA/PL 26/99, emphasising that any revision of the EPC with a view to removing the "trap" created by the joint application of paragraphs 2 and 3 of Article 123 EPC would cause many problems and much legal uncertainty. It was also mentioned that Germany's Federal Court of Justice (FCJ) was currently considering a case in which the provisions of German patent law had resulted in a "trap" similar to the one in European patent law.
16. The *epi* delegation felt that the "footnote solution" adopted by some of the FCJ's senates was an appropriate solution to the "inescapable trap", provided that the footnote was very carefully formulated. Leaving things as they were was not a satisfactory solution.
17. The UK delegation said there was no case law on the issue in the United Kingdom. It further pointed out that it was more in favour of the second solution ("deletion solution") proposed in CA/PL 26/99, because the "footnote solution" - the offending feature can remain in the text of the patent, but no rights can be derived from it - risked causing confusion. It supported the second solution proposed, which had the virtue of clarity, Article 123 needing to be supplemented with a provision authorising the continuation of use begun in good faith by third parties.
18. The Austrian delegation first pointed out that it had not yet had the opportunity to discuss the issue with its interested communities. In internal debate it had nonetheless concluded that neither the first nor the second proposal should be adopted, so it was provisionally supporting the Office's position on grounds of legal certainty. It wondered whether deferring the date of priority might be a conceivable solution. The Office then said it would consider that suggestion.

19. The BE, CY, DK, ES, GR, FI, FR, MC, PT and SE delegations were in favour of maintaining Article 123 in its current wording, in particular citing legal certainty for third parties.
20. The German delegation, supported by the Netherlands delegation, felt that the present situation was unsatisfactory and that further reflection was needed on ways of solving the problem, emphasising that a solution derived from case law should not be ruled out.
21. The Italian delegation said the issue required further consultation on its part, but it was provisionally in favour of maintaining the current wording.
22. Summing up, the Chairman first found that a clear majority of the delegations favoured maintaining Article 123 in its current wording and that therefore revision of Article 123 was for the present no longer on the agenda. The Office for its part undertook to reflect on the Austrian delegation's suggestion of deferring the date of priority and would submit a proposal to the committee if it came to a suitable conclusion in consultation with the Austrian delegation.

#### **IVc. LIMITATION PROCEDURE (CA/PL 29/99)**

23. The Office tabled CA/PL 29/99.
24. Nearly all the delegations spoke on the proposal to introduce a limitation procedure in the EPC, all supporting its introduction while pointing out problems and raising questions with regard to the debated proposal.
25. The Hellenic delegation said the wording of Article 105 C (supplementary European patent specification) was inconsistent with Article 65(1), last sentence, which would need to be modified; only the filing of a new translation of the entire European patent specification with the amended claims would have any effect in Ellas. The Spanish and Portuguese delegations supported this view. The Netherlands delegation felt that translation requirements at the end of the limitation procedure should be the same as when a European patent is granted; the work of the Working Party on Cost Reduction should be closely monitored. The Netherlands, Swedish, Luxembourg and Finnish delegations stressed that it was vital for any proposal to take the debate within that working party into account.
26. The Hellenic delegation asked what effect a European decision taken under the limitation procedure would have on pending national revocation proceedings and what would be the fate of national revocation proceedings pending in Ellas. The Irish delegation raised the issue of the coexistence of national proceedings and the

European limitation procedure, wondering if the national proceedings would effectively be stayed.

27. The UK delegation stated that the decision taken under a limitation procedure should arguably take effect on the date when the grant of the European patent was mentioned (effect retroactive to date of grant). The European limitation procedure would have to be simple and fast; there would have to be express provisions defining the duration of the procedure (eg four months) to allow national judges to stay national proceedings. It would also be desirable to provide the option of amending the description if the proprietor amended the claims (amended claims for instance entailing deletion of an example from the description), a proposal expressly supported by the Swedish delegation. Moreover, Article 105 A (3) should be worded as follows: "Limitation shall apply to the European patent in all the Contracting States in which that patent has effect", the words "The request for" needing to be deleted.
28. The Irish delegation pointed out that Irish law provided for a limitation procedure; point 6 of CA/PL 29/99 should be amended to that effect. The effect of the limitation decision would have to be retroactive to the date of grant of the European patent.
29. The French delegation asked if the words "amending the claims" in the first sentence of Article 105 A (1) also covered the deletion of a claim. Furthermore it was in favour of: a European limitation procedure requiring handling by the examining division; an *ex tunc* effect for the decision of the examining decision; and centralised filing of the amended claims and the description.
30. The Austrian delegation voiced reservations at the introduction of a European limitation procedure in the proposed form. It pointed out that, except in opposition proceedings, the EPO had hitherto been responsible only up to the time of grant. For that reason a central limitation procedure, too, should be requestable only within the time limit for filing notice of opposition. There were also other problems associated with the proposal, for example in the case of earlier national partial surrenders or when a national application for revocation had already been granted with final effect or the European patent had been transferred to different proprietors in individual countries.
31. The Spanish delegation asked why the European limitation procedure would only affect the claims and not the description/drawings, as provided for in the Agreement relating to Community patents (ACP) of 1989.
32. The Netherlands delegation said it would like to see provisions which established consistency between the European limitation procedure and the limitation procedure as planned for the Community patent (Article 51 et seq CPC), a view supported by the Luxembourg delegation. The Netherlands delegation asked if Article 84 EPC was a ground for limitation and wondered exactly what was meant by the words "... is **clearly** not patentable ..." (Article 105b(1)).

33. The German delegation stressed that the issue of the effect of a European limitation procedure on a European patent which had taken effect in the various contracting states needed to be clarified. It was in favour of the limitation decision for the European patent having an *ex tunc* effect.
34. The Swedish delegation was in favour of an *ex nunc* effect for the European limitation procedure. Regarding Article 105 B (1), it was in favour of an approach proposed by the Office which involved clarifying the notion of "clearly not patentable" in a footnote. The wording of Article 105 A (3) needed to be revised to cover cases where national revocation proceedings, for example, had revoked the European patent in a contracting state.
35. The Finnish delegation wished the Austrian delegation's proposal to be examined in more depth; it was also against the centralised filing of translations.
36. The Belgian delegation was in favour of the translation scheme proposed by the Office, an *ex nunc* effect for the European limitation procedure, and a strict time limit for the European limitation procedure.
37. The *epi* delegation, like the Swedish delegation, felt that to make the introduction of a limitation procedure worthwhile the notion of "clearly not patentable" (see Article 105 B (1)) would have to be clarified. In addition, there would have to be an option of adapting the description at the request of the proprietor, as well as a provision authorising a third party who had had the patent revoked in a contracting state before the limitation decision was taken to continue exploiting it even if he has infringed the claim as limited.
38. The staff representatives stressed that in the event of rejection of the request for limitation there would have to be mechanisms for accelerating limitation proceedings before the boards of appeal and that if the proprietor of the European patent filed new prior art, the description would have to be amended to meet public information requirements.
39. The UNICE delegation agreed with the *ep*'s remarks. Moreover, at its last meeting the committee had been in favour of deleting Article 54(4); UNICE proposed that this be taken into account in Article 105a(3).
40. The Office then gave its view of the various statements made by the delegations and offered to incorporate the remarks and suggestions in a revised proposal.



**V. OTHER BUSINESS**

**Va. PROGRESS REPORT ON DISCUSSIONS REGARDING ELECTRONIC FILING OF PATENT APPLICATIONS**

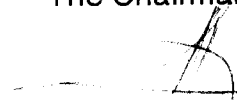
41. The Office gave an oral report on discussions, in particular at the Trilateral Conference held in Berlin in early November 1999, regarding electronic filing of patent applications. This report is reproduced in Annex II of these minutes. The UNICE and Netherlands delegations thanked the Office for this presentation. The WIPO delegation said that these issues would also be dealt with at the Diplomatic Conference on the PLT.

42. The committee noted this oral report.

The Committee on Patent Law approved the draft minutes set out in this document on 1 February 2000.

Munich, 1 February 2000

For the Committee on Patent Law  
The Chairman



P. LAURENT

EUROPÄISCHE PATENTORGANISATION - EUROPEAN PATENT ORGANISATION  
- ORGANISATION EUROPEENNE DES BREVETS -

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

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**Info 1 Rev. 1**

11. Sitzung / 11th meeting / 11ème session (München/Munich, 18.11.1999)

München/Munich, 19.11.1999

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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Directeur (0.2)  
Supervisor  
Assistentin

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**PROGRESS REPORT ON *epoline*-RELATED LEGAL ISSUES;  
ELABORATION OF STANDARDS FOR THE ELECTRONIC FILING, PROCESSING,  
STORAGE AND RECORDS MANAGEMENT OF PATENT APPLICATIONS**

**I. INTRODUCTION**

The electronic filing of patent applications has been on the agenda of trilateral co-operation for a number of years (under Project A1). At the Trilateral Technical Meeting in The Hague in May 1999, the Japanese Patent Office (JPO) reported on tests it had conducted as part of this project, and more specifically on the filing of patent applications via the Internet. The presentation raised a number of mainly legal questions and issues - including possible redefinition of the date of filing (Article 11 PCT), and definition of the record copy (Article 12 PCT) in an electronic environment - as the discussion was related to elaboration of a standard for the electronic filing of international (PCT) applications, a task entrusted to the Trilateral Offices (led by the EPO) by WIPO's Standing Committee on Information Technology (SCIT). As a result, a working group of technical and legal experts from the Trilateral Offices and WIPO's International Bureau (IB) was created, with a mandate to clarify the outstanding issues sufficiently for a draft standard to be submitted to the SCIT for adoption whilst at the same time being used by the Trilateral Offices to test their own implementations. Timewise the goal was to submit the standard first to the Trilateral Conference in November 1999 for approval, then to the SCIT in December 1999 (Plenary Session) for discussion and adoption as a WIPO Standard (ST.XX).

**II. THE WORKING GROUP**

The Working Group (WG) held a number of meetings in July, October and November 1999. The issues debated ranged from the purpose of the proposed standard (not only electronic filing but also processing, storage and records management using electronic means), its scope (ie only for communication between Offices/Authorities, only with applicants, or for both), its structure (ie which elements should be part of the standard, which should preferably be laid down in the Administrative Instructions (AIs); the relationship between the standard and the AIs; one or more standards, with or without annexes, appendices, etc) and its inherent characteristics (open or proprietary solutions, simple or complex to use, availability) through technical issues such as the specific mechanisms, protocols and tools to be adopted for creating, packaging and transmitting the documents concerned, to purely legal problems relating to the use of the "ticket" mechanism for filing (and obtaining a filing date), definition of the record copy, and selection of a form of "signature" performing the traditional functions of a handwritten signature at both ends of the procedure (sender: applicant or representative, and receiver: Industrial Property [IP] Office) and equally simple to use.

### III. THE RESULTS

At its November meeting, immediately prior to the Trilateral Pre-conference, the WG finalised its work on the standard which - as it is expected to become part of the AIs (to be drafted by the IB) implementing Rule 89<sup>bis</sup> PCT - is called Annex F, is entitled "Standard for electronic filing, processing, storage and records management of international applications under the PCT", and currently has two technical appendices: Appendix I (the trilateral technical standard for the on-line exchange of intellectual property documents using Public Key Infrastructure [PKI]) and Appendix II (the XML Document Type Definitions [DTD] for IP document exchange).

The main part of Annex F is still a **DRAFT**, because it is directly related to the filing of PCT applications and dependent on the existence of AIs. It will be finalised once the AIs are prepared by the IB.

Appendix I sets out the technical requirements for on-line filing in a PKI environment and is supplemented by Appendix II. The appendices are drafted in such a way that they can be implemented immediately, and also independently of the main part of Annex F but supplemented by national/regional legal provisions for the purposes of national/regional online filing of patent applications.

The Trilateral Offices agreed to implement the standards set out in Appendices I and II in their own procedures, starting with interoperability pilots in 2000. They will start accepting electronic filings once their legal provisions have been amended to accommodate this (between 2000 and 2002).

In parallel to adoption by the Trilateral Conference, Annex F and the appendices have also been forwarded to the SCIT for consideration and discussion at its forthcoming (December 1999) meeting. It is expected that the SCIT will adopt the appendices as WIPO Standard ST.XX in June 2000.

It was also agreed to submit the standards to the Intergovernmental Conference convening in May 2000 to adopt the Patent Law Treaty (PLT), for adoption as the relevant PLT standards.

Lastly, it was agreed with WIPO that a new draft of the AIs will be circulated for final comments in the very near future (end of 1999), so that the consultation process can be concluded in the early spring 2000, and the AIs issued by the Director General around June 2000. This timetable should permit pilot tests of PCT online filings in the second half of 2000, with the aim of having this procedure operational by the second quarter of 2001.

#### **IV. MAIN ASPECTS OF CERTAIN CORE ISSUES**

##### **A. SECURITY**

Data security - not only during transmission but also after receipt at the filing Offices - is one of the concerns most often voiced by the users. According to the technical experts from the Trilateral Offices and WIPO, in respect of transmission the use of PKI addresses those concerns most adequately by today's standards. Moreover, transmission is taking place within a secure session using a secure channel between the client's computer and the filing Office's system. Finally, as a matter of course, encryption - based on PKI - will also be used for transmission.

The security of stored data (records) - ie protection of the Offices' computer systems from unauthorised penetration - was acknowledged to be the responsibility of each Office concerned, which they can meet in a number of different ways. The lowest common denominator is to erect "firewalls" - a common protective measure for computer systems - but the general part of Annex F also contains a number of standards related to records security, and the Offices participating in electronic filing will be required to undergo external audit for compliance.

##### **B. SIGNATURES**

In the early stages, work was based on the simplest possible constellation, namely only one signature on any single document and on the bundle of documents submitted. In such circumstances, use of an "enhanced" (UNCITRAL terminology) or "advanced" (draft EU directive terminology) electronic signature - one implementation of which is a "digital signature" produced using a PKI-generated certificate and corresponding private key - is perfectly adequate to fulfil all the functions of a handwritten signature on a paper document, and equally simple to perform.

It soon became clear, however, that such straightforward cases would be the exception rather than the rule. Often, more than one signature is required on the same document, and packages regularly contain documents signed by different persons, and are themselves signed by somebody else again. In such cases, the use of enhanced or advanced electronic signatures is technically feasible, but also rather complicated and cumbersome, and therefore best avoided. This led the WG to work on the notion of a "basic electronic signature", which can be a facsimile image of the handwritten signature or a particular string of text chosen by the user to represent his/her signature preceded and followed by certain pre-defined characters, eg the forward slash [/].

The standards adopted contain definitions of both types of signature. However, whether the basic electronic signature will be acceptable to all Offices involved is the subject of ongoing discussion. The JPO for example has said that such a signature is too insecure (easy to "forge") to be acceptable at least under its current law.

### C. THE TICKET MECHANISM

This idea was introduced by the JPO as part of a testbed project on electronic filing via the Internet: the applicant first submits a small amount of data, namely the "digest" of his application, his identification data and his digital signature. This is the "request for ticket". He is then promptly issued with his ticket, namely the digest submitted, which the filing Office has date- and time-stamped, assigned an application number, and (digitally) signed. He then attaches this ticket to the application data and submits the two items together.

The original idea was that in case of accidental interruption of data transmission, and/or late receipt of the application by the patent office concerned, the application would get the "ticket date" as filing date.

Technically, the digest in the ticket can only correspond to a **unique** set of documents. If the person were subsequently to change even one comma, the ticket would no longer correspond to the final submission. So the filing Office can always verify that the applicant has indeed submitted the documents for which the ticket was issued. It should, however, be noted that it is **impossible** to reconstitute the documents on the basis of the digest.

This mechanism is of particular interest for very big applications (more than 10 MB of data) which require long transfer times and are more prone to transfer problems; the ticket procedure lasts only (milli-)seconds because the data size is minimal. The actual test was confined to a limited number of applications, of which very few were bigger than 10 MB (99% were in the 1 to 2 MB range), and it did not give rise to any technical problems. The testers' reaction to the concept was generally positive.

This issue has been discussed at length in the EPO with a view to *epoline*. The EPO position is that the concept as outlined above cannot be used under the current legal framework because the ticket contains nothing that could be used (by default) as a description or a claim, so neither Article 80 EPC nor Article 11 PCT (both based on the **receipt** of documents at a patent office) would be satisfied. Moreover, underlying both provisions is the fundamental patent-law requirement that at the date of filing there must be some kind of **disclosure** (Article 83 EPC); neither the ticket request nor the actual ticket could fulfil this requirement.

The draft PLT could also be a problem, as the article governing the date of filing is similarly based on the **receipt** of documents. This explains the eagerness of the Trilateral Offices to intervene at the PLT Intergovernmental Conference.

Nevertheless, in view of the concept's practical advantages - particularly the high security as regards identity of document content - the EPO has decided to implement (in *epoline*) the ticket procedure **technically** while investigating the possible legal uses of the concept. One such use (in view of the ticket's aforementioned technical characteristics) could be as proof of timely initiation of the submission procedure (analogous to proof of posting paper documents in due time).

WIPO too has taken a fairly negative position throughout the WG meetings, for the same reasons as the EPO. It did however indicate a willingness to submit the issue to the PCT Assembly to try and obtain an interpretation of Article 11 PCT which would allow implementation of the ticket.

The USPTO was initially as negative as the EPO and WIPO, but changed tack at the last meeting but one, stating that the ticket mechanism would be compatible with US national law as it stands. Indeed, for US national filings a filing date can be accorded on the basis of a postcard, as it can be corrected to the date the documents were remitted to the post.

Lastly, the JPO is prepared to adopt the ticket procedure even if no other Office follows suit.

The compromise struck was to have the mechanism described in the standards and implemented technically but in a legally neutral way, ie without allowing it to influence the filing date pending further discussion of the matter.

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