

M I N U T E S

of the
13th meeting of the

COMMITTEE ON PATENT LAW

(Munich, 3 to 6 April 2000)

CONTENTS

Subject	Page
I. ADOPTION OF THE AGENDA (CA/PL 11/00 Rev. 1)	1
II. APPROVAL OF THE MINUTES OF THE COMMITTEE'S 12TH MEETING (CA/PL 10/00)	1
III. PROTOCOL ON THE STAFF COMPLEMENT OF THE EUROPEAN PATENT OFFICE AT THE HAGUE (PROTOCOL ON STAFF COMPLEMENT) (CA/6/00)	1
IV. REVISION OF THE EPC: ARTICLES 33 AND 35 (CA/PL 3/00 + Add. 1 + Add. 2)	2
V. REVISION OF THE EPC: ARTICLES 37, 38, 42 AND 50 (CA/F 3/00)	4
VI. REVISION OF THE EPC: ARTICLES 51 AND 126 (CA/PL 8/00)	5
VII. REVISION OF THE EPC: ARTICLES 61, 71, 72, 75 TO 78 AND 86 (CA/PL 12/00)	6
VIII. REVISION OF THE EPC: ARTICLE 79 (CA/PL 13/00)	7
IX. REVISION OF THE EPC: ARTICLE 87(5) (CA/PL 9/99 Rev. 1)	7
X. REVISION OF THE EPC: ARTICLES 92, 93 AND 98 (CA/PL 14/00)	8
XI. REVISION OF THE EPC: ARTICLES 99 TO 105 (CA/PL 15/00)	8
XII. REVISION OF THE EPC: ARTICLES 106 TO 111 (CA/PL 16/00)	10
XIII. REVISION OF THE EPC: ARTICLES 22 AND 112a (CA/PL 17/00)	11
XIV. REVISION OF THE EPC: ARTICLES 115, 117, 119, 120, 123, 124, 127, 128 AND 130 (CA/PL 18/00)	13
XV. REVISION OF THE EPC: ARTICLES 133 AND 134 (CA/PL 22/00)	15
XVI. REVISION OF THE EPC: ARTICLES 135 TO 137, 140 AND 141 (CA/PL 23/00)	17
XVII. REVISION OF THE EPC: ARTICLE 138 (CA/PL 19/00)	17

Subject	Page
XVIII. REVISION OF THE EPC: ARTICLES 142 TO 149 (CA/PL 7/00 + Add. 1)	19
XIX. REVISION OF THE EPC: ARTICLES 150 TO 158 (CA/PL 21/00)	21
XX. REVISION OF THE EPC: LIMITATION PROCEDURE (CA/PL 29/99 Rev. 1)	22
XXI. REVISION OF THE EPC: ARTICLE 164 (CA/PL 20/00)	25
XXII. REVISION OF THE EPC: NEW PROVISION IN PART IX (CA/PL 24/00)	28
XXIII. OTHER BUSINESS	29
ANNEX: LIST OF PARTICIPANTS	30

I. ADOPTION OF THE AGENDA (CA/PL 11/00 Rev. 1)

1. The committee adopted the agenda as revised in CA/PL 11/00 Rev. 1. The list of participants is annexed.
2. The Belgian delegation found it surprising that implementation of the EU Biotechnology Directive in European patent law was not on the agenda, pointing out that incorporation of the Directive's provisions in the Implementing Regulations had been intended as only the first part of the process. At the committee's meeting in March 1999 ten delegations had expressed reservations about the Office's proposal to do no more than amend the Implementing Regulations, and the view had been taken that amendment of the provisions of the EPC was an issue the committee would examine again later. Nine other delegations agreed (DE, GB, FR, DK, NL, MC, ES, GR and PT). The Office replied that it now found itself faced with an entirely new situation, and at that time it was unable to comment. It was suggested that the matter be referred to the Administrative Council for it to decide how the committee should deal with the issue. The chairman noted that there were no objections to this suggestion.

II. APPROVAL OF THE MINUTES OF THE COMMITTEE'S 12TH MEETING (CA/PL 10/00)

3. The committee approved the minutes of its 12th meeting with the clarification requested by the German delegation at point 14. They have since been issued as CA/PL PV 12.

III. PROTOCOL ON THE STAFF COMPLEMENT OF THE EUROPEAN PATENT OFFICE AT THE HAGUE (PROTOCOL ON STAFF COMPLEMENT) (CA/6/00)

4. The Office tabled the document, explaining that the proposal was being submitted in agreement with the German and Netherlands delegations. With regard to the permissible range of fluctuation, it was the authorised complement of posts at The Hague that counted, not the EPO's total staff complement.
5. The Netherlands delegation welcomed the proposal, but suggested tightening up the wording to make it absolutely clear that the permissible range of fluctuation was to be calculated relative only to the number of posts at the duty station at The Hague.
6. The German delegation expressed its approval of the German version of the proposed provision.

7. The French delegation essentially approved the document, but wondered whether deleting the provision defining the Berlin sub-office as an integral part of the branch at The Hague might have implications for the availability of search reports drawn up in Berlin for the French Patent Office.

The staff representatives said that it would be more logical to wait for the negotiations between the EPO and the Netherlands on the agreement concerning the branch at The Hague to be concluded before taking a decision on the distribution of posts between the Netherlands and Germany. They also said that it would be more in keeping with the spirit of the current system to apply the distribution quota to staff in DGs 1 and 2 only, and not to Office staff as a whole.

8. The Office conceded that the translated text was not formulated with sufficient clarity and promised to have it clarified. It also said that, in view of the underlying objective of delocalising work in connection with the introduction of the BEST system, the issue of the Berlin sub-office's organisational status would have no impact on the work Berlin currently performed. At present the Office was not looking to modify the existing structure. It did however refer to a statement of the German delegation on the Administrative Council regarding the need to examine whether the Federal Republic would have to bear part of the costs of the Berlin sub-office if it ceased operating under the direction of The Hague.
9. Summing up, the chairman said the wording of the proposal as circulated in CA/6/00 was approved by the delegations, subject to modification of the English and French wordings.

IV. REVISION OF THE EPC: ARTICLES 33 AND 35 (CA/PL 3/00 + Add. 1 + Add. 2)

10. The Office tabled the proposal, which was the fruit of discussions at the committee's 12th meeting and in particular took into consideration the four issues raised at that meeting.
11. The Swiss delegation tabled the new proposal it had submitted, which featured an extra clause designed to preserve national legislators' rights of verification (three variants, the Swiss delegation preferring the principal variant on grounds of legal certainty). In terms of the separation of powers, the proposal in particular made allowance for the interests of states which were EPC contracting states but not members of the EU or parties to the international treaty to which the EPC was to be adapted. However, it also took into account the problems faced by a contracting state which had not yet had parliamentary approval for such an international agreement.

12. The Office welcomed the Swiss delegation's proposal and developed an approach, based on the idea underlying its principal variant, whereby under Article 33 EPC an Administrative Council decision initially did not actually enter into force, but for a defined period was subject to the suspensive condition that no contracting state declared that it was unwilling to be bound by its delegation's vote. The Office emphasised that a provision with such extensive safeguards for parliamentary rights would represent a considerable improvement.
13. In the ensuing debate it was evident that most of the delegations could offer only provisional opinions, as internal consultations were still pending (ES, IE, BE, FR, SE, PT, LU and GR). While some delegations indicated approval in principle of the formulation now being proposed by the Office and CH (IE, FR, AT, NL, MC, IT, GB, DK, LU and GR), others expressed considerable constitutional objections to the proposed provision (ES, DE, FI, SE).
14. Another controversial issue was the delegations' position on the scope of Article 33 EPC. The Belgian delegation said it could not agree to the current restrictive wording because provision also had to be made for adaptation to other agreements such as the Convention on Biological Diversity, the ECHR or the Treaties of Rome. On the other hand the French and Monegasque delegations favoured retaining the words "on patents", provided it was ensured that all agreements which at least included elements relevant to patent law (eg TRIPs) were covered. The Irish and Italian delegations were also in favour of retaining the restriction.
15. As to the Parts of the EPC to be covered by Article 33(1)(c) EPC, the French delegation advocated a clear exclusion of Part IX. The UK delegation said it supported the restrictions under Article 33(1)(c) EPC.
16. Regarding the search for a suitable term for the notion of "required" in Article 33(1)(c) EPC, the Belgian, French and Monegasque delegations said there were no objections to using the word "nécessaire" in the French version. The Italian delegation wanted to stay with "required", whereas the Irish and UK delegations took the view that it made more sense to delete the entire phrase "when amendment is required".
17. A number of delegations made suggestions regarding the voting rules. The Italian and Danish delegations suggested moving the clause "die eine Stimme abgeben" in Article 35(3) EPC to the end of the paragraph. Lastly, the Monegasque delegation proposed an editorial revision of Article 33(1) EPC to avoid the frequent repetition of the word "dispositions" in the French version.

18. The Office pointed out that a decision of general principle needed to be taken on whether the unanimity criterion was still met if a contracting state abstained or whether an abstention invalidated the vote. Second, it said that in its view the proposed wording covered all agreements which included provisions specifically relating to patent law, which among other things included TRIPs.
19. Summing up, the chairman said the delegations did not question the need in principle for rules on bringing the EPC into line with international agreements, though some had reservations about transferring national sovereignty to the Administrative Council. The Swiss delegation's proposal (especially the principal variant) appeared however to reduce the strength of these reservations. He therefore requested the Office to draw up a new proposal on the basis of the day's discussions. This draft should indicate that agreements containing, inter alia, provisions relating to patent law were also covered. It should also consider whether the notion of "required" could be deleted, and it should formulate the voting rules more clearly to ensure that an abstention did not defeat the requirement for unanimity. The chairman also asked the Office to arrange for the Basic Proposal to include a variant based on Article 23 in the light of the Netherlands proposal (see CA/16/98, point I).

V. REVISION OF THE EPC: ARTICLES 37, 38, 42 AND 50 (CA/F 3/00)

20. The committee noted the Office's proposal for reformulating the financial provisions.
21. The auditors' representative said the proposal was in line with the auditors' recommendations and was a practicable, flexible solution.
22. The delegations which spoke on this matter responded positively to the proposal (CH, DE, EPO staff representatives) because an overhaul of the Organisation's budgetary practice was overdue. The Swiss delegation considered the term "retained earnings" in Article 38(a) EPC insufficiently precise as it was not clear whether these were appropriated provisions or reserves. In Article 42(1) EPC, the notion of "generally accepted accounting principles" should be made more specific by the insertion of a few core principles (such as the accruals concept, the going-concern concept or the consistency concept).

The staff representatives said that, in addition to the Budget and Finance Committee, the Supervisory Board of the Pension Reserve Fund should also be asked for its opinion on these proposals.

23. The committee's unanimous opinion was that the Budget and Finance Committee, as the body with primary responsibility, should give its view of the substantive issues before a position could be taken up on the legal aspects.

24. The chairman concluded that the committee would return to the proposal at its next meeting - without engaging in substantive debate - if a Budget and Finance Committee opinion was available to it by then.

VI. REVISION OF THE EPC: ARTICLES 51 AND 126 (CA/PL 8/00)

25. The Office tabled the proposal.
26. Commenting on the proposed amendment of Article 51 EPC, most delegations took the opportunity to discuss the issue of transferring provisions from the EPC to the Implementing Regulations. The delegations advocated increased flexibility for the Convention and deregulation, but agreed, by a large majority, that core provisions, such as those relating to the major procedural fees and the legal consequences of late payment, had to stay in the EPC itself (AT, CH, SE, DE, BE, FR, NL, DK, ES, IT, PT, FI and GR). The Swiss delegation suggested transferring Article 126 EPC to the Implementing Regulations rather than to the Rules relating to Fees. Some delegations cited constitutional objections (SE, BE, DK, ES, IT and PT); others said the proposed arrangement went beyond the defined aim of the revision process because it entailed transferring core EPC provisions to the Implementing Regulations. This vote was endorsed by the EPO staff representatives and the UNICE representative.
27. Some delegations also gave their views on editorial aspects of the proposed text (AT, CH, IE).
28. The chairman summarised the delegations' contributions as follows.

The editorial amendments involved:

- formulating Article 51(1) EPC as an optional provision
- harmonising the terms "procedural and administrative fees", "Zahlung" and "Entrichtung" (German version)

Most of the delegations objected in principle to the transfer of central provisions governing fees and the legal consequences of failure to pay in due time.

29. In reply the Office said it was aware how far-reaching the proposal was, and it took the delegations' objections seriously; but it asked them to bear in mind that the Implementing Regulations, as secondary legislation, themselves formed an integral part of the Convention and were likewise legally binding. It referred to other modern treaties such as the PCT, where most fees were dealt with in the implementing regulations. It was not always easy to foresee how legislation would

develop, so the Organisation needed to be able to respond flexibly to changes. The same applied to provisions governing legal consequences. The Office nevertheless intended leaving a basic stock of fee-related rules in the EPC, that being a matter for discussion when individual provisions were debated. It announced that Article 14 EPC would have to be amended because in future every language was to be allowed on the date of filing.

30. Summing up, the chairman noted that the Office would incorporate the suggested changes to the wording (see point 28 above) into the Basic Proposal, and that the major fees, and the legal consequences of late payment, would be retained in the EPC itself.

VII. REVISION OF THE EPC: ARTICLES 61, 71, 72, 75 TO 78 AND 86 (CA/PL 12/00)

31. The Office tabled the proposal.
32. The delegations declared their support in principle for the legislation proposed in the document. Some rejected the deletion of certain EPC provisions which they felt contained fundamental regulations. Thus a broad majority was in favour of retaining Articles 71 and 72 EPC in the Convention (LU, CH, BE, NL, AT, MC, DE, DK, FI, SE and PT plus *epi* and the EPO staff representatives). For the same reason, some delegations advocated leaving Article 61 EPC (ES and SE), Article 78(2) EPC (BE, DE, FR, IE, FI and SE), Article 76(3) EPC (SE), Article 77(5) EPC (BE and the EPO staff representatives), Article 77 EPC (SE) and the main elements of Article 86 EPC (ES, IE, FI, FR, SE) in the Convention.
33. In response the Office proposed that Articles 71 and 72 EPC be left in their present form. If need be, the Implementing Regulations could clarify what was meant by the terms "in writing" and "signature". Regarding Article 78(2) EPC, the French delegation's proposal would be taken up: the principle of mandatory fee payment would be mentioned in the Convention, while details of the fees to be paid would be moved to the Implementing Regulations. A compromise solution for Article 86 EPC might be to keep paragraphs (1) and (4) in the Convention and shift the other details to the Implementing Regulations. The German delegation having asked when draft Implementing Regulations were likely to be ready, the Office pointed out that the tight schedule for preparing the Conference made it impossible to submit revised Regulations in advance, especially as the final shape of the revised Convention would not be known until after the Conference. The Office promised that the Basic Proposal would specify in great detail what would be in the Implementing Regulations.
34. Summing up, the chairman said the proposals set out in CA/PL 12/00 were approved, subject to the retention in the Convention of Articles 71 and 72 EPC,

the principle enshrined in Article 78(2) EPC, and at least paragraphs (1) and (4) of Article 86 EPC.

VIII. REVISION OF THE EPC: ARTICLE 79 (CA/PL 13/00)

- 35. The Office tabled the proposal.
- 36. The UK, Spanish and Finnish delegations having advocated leaving Article 79(2), first sentence, EPC in the Convention, the Office suggested amending Article 79(2) EPC to the effect that the Implementing Regulations may provide for payment of a designation fee.
- 37. The chairman noted that none of the delegations objected to formulating Article 79(2), first sentence, as an optional provision. Summing up he said that the Office's proposal was approved as submitted in CA/PL 13/00, on condition that at least the first sentence of Article 79(2) EPC remained in the Convention, but in the form of an optional provision.

IX. REVISION OF THE EPC: ARTICLE 87(5) EPC (CA/PL 9/99 Rev. 1)

- 38. The Office tabled the proposal.
- 39. Apart from the Finnish delegation, which was against national law being bound by priority agreements reached within the Organisation, the delegations were in principle in favour of the proposal (FR, AT, MC, GB, NL, DE, SE, IT, IE and the *epi* and UNICE representatives), though mostly with the proviso that the internal consultation process had not yet been completed, so their opinions had to be considered provisional (FR, GB, IE, SE and IT). The Netherlands, Monegasque and Swedish delegations favoured assigning authority under Article 87(5) EPC to the President of the EPO. The other delegations were not yet prepared to commit themselves on the issue. The *epi* representative said the formulation "... at an industrial property authority which ..." in Article 87(5), first sentence, EPC was incorrect and misleading, because the Paris Convention concerned itself not with patent authorities but with the nationality of a person. He therefore proposed changing the wording to "... by a person who ...".
- 40. The Office answered that the existing legal situation (Article 66 EPC) already provided for a binding effect on national authorities or courts, and the proposed formulation of Article 87(5), first sentence, EPC did not conflict with the Paris Convention.

41. Summing up, the chairman said the proposal was approved by almost all the delegations, with the Finnish delegation objecting not to the procedure as such but to the binding effect of its result at national level. The French delegation could not yet commit itself on the issue of recognition in national legal proceedings. There had not yet been a decision on the matter of authority for issuing the communication.

X. REVISION OF THE EPC: ARTICLES 92, 93 AND 98 (CA/PL 14/00)

42. The Office tabled the proposal.
43. The delegations welcomed the proposal in principle, though some (FR, NL, SE and UNICE) wanted the reference to the basis for the search report (the claims) to be left in the EPC. The Italian delegation proposed looking for a more precise formulation for Article 93, first half-sentence, EPC because it found "as soon as possible" too vague. The Swedish delegation said it would prefer seeing the provision governing the content of the publication retained in its entirety. The Austrian delegation felt there was a major substantive difference between the existing and proposed wordings of Article 98 EPC, and it thought "when/wenn" was not an appropriate word to use.
44. The Office said that the requests that had been made with regard to Article 92(1) EPC would be taken into consideration.
45. The chairman summed up by saying that the proposal was approved, subject to the qualification that the reference to the patent claims in Article 92(1) EPC should remain in the Convention and that the Office should again consider whether a different formulation could be found for the word "when" in Article 98 EPC.

XI. REVISION OF THE EPC: ARTICLES 99 TO 105 (CA/PL 15/00)

46. The Office tabled the document.
47. With regard to the transfer of provisions relating to the opposition procedure, too, a number of delegations thought that some provisions should remain in the EPC because they were fundamental to that procedure.
48. The French, Belgian, Monegasque, German and Swedish delegations and the *epi* representative were in favour of defining the opposition period in the EPC, though the German delegation said it understood the arguments for defining it in the Implementing Regulations. It referred to the competence of the Administrative

Council under Article 33(1)(a) EPC, which meant that the change would not make any substantive difference in the legal situation.

49. The French delegation proposed retaining in Article 101(2) EPC a provision governing the right to comment in opposition proceedings, in which it was supported by the Belgian and Monegasque delegations and the EPO staff representatives. The German delegation observed that the substance of this provision was probably covered by the principle of the right to be heard.
50. The Austrian delegation objected to the proposed wording of Article 101 EPC on the grounds that the attempt to codify board of appeal practice in Article 101(2)(b) EPC was unsuccessful because it did not clearly indicate what the opposition division was authorised to examine.
51. The UK and Swedish delegations took the view that Article 102(5) EPC should not be transferred to the Implementing Regulations.
52. Editorial amendments were submitted for Article 103 EPC. The *epi* representative suggested a formulation equivalent to that in Article 98 EPC for the timing of publication. The French delegation submitted a revised version of the French text, worded as follows: "Lorsque le brevet européen a été maintenu suite aux modifications opérées en vertu de l'article 101(3)(a), l'Office européen des brevets publie un nouveau fascicule du brevet européen après la publication de la mention de la décision concernant l'opposition dans le Bulletin européen des brevets."
53. Several delegations (FR, BE, MC and the EPO staff representatives) felt it was appropriate to mention the principle of equity in Article 104 EPC.
54. The Swedish delegation said it had reservations about the new wording of Article 105(1) EPC. The formulation "any third party" might give the impression that the Convention postulated the right of any third party to intervene, unrestricted by requirements indicated only in the Implementing Regulations. The Austrian delegation requested the drafters of the Basic Proposal to consider the fact that the procedure envisaged in Article 105(1)(b) EPC did not necessarily have to be a matter for the courts in every contracting state (Austria being one example).
55. The Office commented on the delegations' contributions and confirmed that the provisions governing the opposition period would be left in the EPC. It promised to take The delegations' suggestions, especially those on Articles 103, 104 and 105(1)(b) EPC and for editorial improvements, would be taken into account.

56. Summing up, the chairman said that the document was approved in principle. Suggestions for amendment had been made regarding individual provisions, as follows. The opposition period was to continue to be defined in the EPC. There was no need for any special reference to the right to comment in Article 101(1) EPC, that being sufficiently provided for in Article 113 EPC. Also, Article 101 EPC did not necessarily have to indicate the grounds that the opposition division had to examine; that could be specified in more detail in the Implementing Regulations instead. The information content of Article 102(5) was in principle to be left in the Convention. The wording of Article 103 EPC was to be clarified. Article 104 EPC was to retain the principle of cost apportionment based on considerations of equity. Regarding Article 105 EPC, possible legal uncertainty about the right to intervene could be avoided by revising the wording; the word "court" was to be deleted from (b).
57. The Office further stated that the provisions governing the opposition procedure (see Article 101(3)(a) EPC) were being reformulated along the same lines as those governing the examination procedure, the same or similar issues being dealt with in the EPC and in the Implementing Regulations according to the same principle. It stressed that the proposed wording of Article 101 EPC exactly matched what was currently provided for in Article 102(5) EPC, ie the option of making provision in the Implementing Regulations for a translation to be filed.
58. The chairman concluded that in the light of the Office's remarks its proposal on Article 102 EPC could be adopted.

XII. REVISION OF THE EPC: ARTICLES 106 TO 111 (CA/PL 16/00)

59. The Office tabled the document.
60. The delegations essentially agreed to the proposal (MC, FR, DE, SE, BE, IT and the *epi* and UNICE representatives).
61. Apart from a few proposals for technical amendments, in particular regarding Articles 109 and 110(1) EPC where the existing formulation was seen as preferable to the proposed wording (MC, FR, SE and IT), debate centred on provisions which some thought it best to leave in the EPC. This applied to those governing the opposition period (SE, BE and the *epi* and UNICE representatives), the principle of mandatory fee payment (SE and BE) and the reference to legal consequences in Article 110(3) EPC (SE and BE).
62. The Office promised to subject the proposed version to editorial revision on the basis of the delegations' remarks. On the issue of time limits it again pointed out

that the best way to go about making the Convention more flexible depended on the status that was to be assigned to the Implementing Regulations. It stressed that the Implementing Regulations were an integral part of the EPC and promised to examine the extent to which the Basic Proposal could make appeal proceedings consistent with opposition proceedings.

63. The chairman noted that the proposal was approved subject to the following amendments: the time limit for appeal (Article 108 EPC) was to be defined in the EPC; the wording of Article 109 EPC was to be revised; Article 110(3) EPC should be made consistent with equivalent provisions in other procedures; and the same should be taken into account with regard to the fees system.

XIII. REVISION OF THE EPC: ARTICLES 22 AND 112a (CA/PL 17/00)

64. The Office gave an explanatory introduction to the proposal.
65. The delegations expressed a very positive attitude towards the proposal. The majority (FR, DE, NL, GB, CH, SE, BE, DK, ES, GR, the *epi* and UNICE representatives and the EPO staff representatives) stressed that they had not yet been able to complete their internal consultations and could therefore give only a provisional opinion.
66. It was the unanimous view of the committee that essential procedural provisions relating to matters of principle should be incorporated in the EPC. Some delegations (DE, ES, NL, BE, *epi*, UNICE and the EPO staff representatives) considered an (exhaustive) enumeration of the conditions for filing a petition for review to be a matter for the EPC. A more liberal attitude was taken by the Danish, Italian, Swedish and Swiss delegations, which could conceive of enumerating them in the Implementing Regulations. The Swedish delegation stressed the importance of case law and advocated a non-exhaustive enumeration of what could be regarded as fundamental procedural defects and thus constitute grounds for review.
67. Some delegations further considered the time limit for filing the petition (SE and the EPO staff representatives), fees (SE, BE and the UNICE representative), the composition of the deciding bodies (SE) and the nature and effect of the Enlarged Board decision (BE and NL) to be matters of such fundamental importance that they should be dealt with in the EPC. A number of proposals for editorial amendments were submitted with regard to Article 112a(1) EPC ["if a criminal act as defined in the Implementing Regulations may ..."] (BE) and Article 112a(4) EPC ["The period starts from the decision of the board of appeal that is under review.

The period of time closes at the publication of the mention ..."] (GB). The staff representatives asked about the financial and staff-related implications of introducing the proposed procedure. The *epi* and UNICE representatives referred to potential risks arising from continuing legal uncertainty for third parties while the review proceedings were in progress.

68. During the discussion on extending the jurisdiction of the Enlarged Board of Appeal, the Swiss delegation referred to an aspect likely to lead to a political debate in view of a possible follow-up revision conference. It asked the other delegations for their opinion on the need to restructure the European Patent Organisation, dividing it into Administrative Council, EPO as administrative authority, and judicial bodies.
69. The Office responded in detail to the delegations' interventions. Evolving case law should be retained as a possible ground for reopening proceedings. The composition of the Board should be defined in the Implementing Regulations, as it made sense to have an opportunity to adapt it quickly in the light of initial experience with the new procedure. The effects of the extraordinary legal remedy were sufficiently regulated in Article 112a(2) EPC because it was in the legal nature of the remedy that the only effect it could have was to reverse the ruling of the challenged decision. The Office countered a concern expressed by many delegations by saying that legal uncertainty was a risk inherent in any extraordinary appeal proceedings, and had to be accepted with a view to a balance of interests. The formulations proposed for Article 112a EPC would be taken into account when drawing up the Basic Proposal.
70. Summing up, the chairman said the proposal was approved on condition that the time limit for filing for the extraordinary legal remedy (two months) was set in the EPC, its starting point being left to the Implementing Regulations. The Office would examine whether the effects of Enlarged Board decisions should be mentioned explicitly rather than being regulated implicitly. The exact nature of the two grounds for review mentioned in the EPC should be defined in the Implementing Regulations. In drafting the Basic Proposal the Office should take the proposed editorial amendments into account. At the suggestion of the German delegation the chairman made it clear that no final decision on the grounds for review had yet been taken.

XIV. REVISION OF THE EPC: ARTICLES 115, 117, 119, 120, 123, 124, 127, 128 AND 130 (CA/PL 18/00)

71. The Office tabled the proposal.
72. The delegations approved the proposal in principle but suggested numerous amendments, most of them designed to leave particular provisions or their substance in the EPC or to provide clarification.
73. Regarding Article 115 EPC it was stated that the substance of paragraph 2 should be retained.
74. Regarding Article 117 EPC the Monegasque delegation suggested the following formulation: "Le règlement ... , et fixe les règles relatives à l'instruction." The Spanish, Swedish and German delegations and the EPO staff representatives held Article 117(1) EPC to be a central provision which there was no reason to remove from the Convention.
75. Regarding Article 119 EPC the Belgian delegation objected to removal of the indication that notification was a matter of course. The Swedish delegation asked the committee to consider whether the last sentence was to be viewed as an obligation on the contracting states and should therefore stay in the EPC.
76. Regarding Article 120 EPC it was remarked that the new wording went well beyond the present provision. There were also objections to the fact that there was no longer any reference to the possibility of extending time limits and specifying maxima and minima (GB, BE). The French delegation repeated its fundamental view that it preferred the EPC to include at least the principle of fee payment and the legal consequences of non-compliance in each individual case. Other delegations shared this view in full (IT) or at least with regard to legal consequences (DE, SE, ES)
77. Regarding Article 123 EPC it was stated that the provision in paragraph 1 was a key element of patent procedure guaranteeing the applicant's right to make amendments and should therefore be retained in the EPC (BE, DE, SE, ES and the *epi* representative).
78. Expanding the scope of Article 124 EPC by using the words "useful information" was considered a significant change which gave the provision a different character (GB, DE) and created uncertainty for applicants (AT). The UNICE

representative warned against over-burdening the applicant and made a comparison with US law; there had to be a clear definition of what the Office can demand of the applicant. Some delegations (BE, MC, FR) did not approve of using "require" instead of "invite". The Belgian, Swedish and French delegations felt that the second paragraph should be retained. The Netherlands delegation in contrast advocated transferring the provision governing legal consequences to the Implementing Regulations; if that were done, a less severe sanction might possibly be considered. The *epi* representative was in principle not against transferring this provision to the Implementing Regulations, but it did call for a clear indication of the documents that had to be submitted to the Office. The Monegasque delegation proposed the following wording: " ... pour l'invention ... et à des procédures ...".

79. In Article 127 EPC the wording "all useful particulars" was seen as a far-reaching change in the scope of the article's application, not as merely editorial (GB, FR). Regardless of whether or not they were listed exhaustively, the particulars should at least be specified in more detail in the Implementing Regulations (BE, FR). The Monegasque delegation proposed the following wording: "L'Office européen des brevets tient un Registre ... qui les concernent, et prévu notamment par la présente convention".
80. Regarding Article 128 EPC the Swedish delegation remarked that paragraph 5, as a provision of fundamental importance, should stay in the EPC.
81. Regarding Article 130 EPC it was asked why the proposal did not include a reference to Article 75(2) EPC. The Monegasque delegation proposed the following wording for paragraph 1: " ... du droit national de l'état concerné ne s'y opposent pas".
82. The German delegation again pointed out that it was hard for it to decide on far-reaching amendments to the law without having a draft of the future Implementing Regulations to hand. Some delegations agreed (ES, DK), but others said they were happy with the procedure envisaged by the Office, namely that detailed information about the content of the future implementing provisions would be given in the Basic Proposal (SE, NL, BE).
83. The Office responded to the delegations' remarks as follows: Article 115(2) EPC would be transferred "as is" to the Implementing Regulations, possibly with an indication that paragraph 1 was applicable in all stages of proceedings before the EPO. Article 117(1) EPC would stay in the EPC, and only the details relating to the taking of evidence would be specified in the Implementing Regulations. In Article 119 EPC, the phrase "as a matter of course" would be retained, and the best position for the last sentence would be reviewed. In Article 120 EPC, a rider concerning the possibility of extending time limits should be added, with an

indication that it did not apply to time limits governed by the Convention itself. The Office characterised the compromise being sought as a balancing act between time limits set in the EPC and time limits defined in the Implementing Regulations together with the legal consequences of failure to observe them. The guarantee provided for in Article 123(1), second sentence, EPC would stay in the EPC. Article 124 EPC would be revised so as to limit the applicant's information obligations. The legal consequences provided for in Article 124(2) EPC would be reviewed to see if they were justified and might possibly be toned down on transfer to the Implementing Regulations. Even after Article 127 EPC had been amended, its terms of reference would still be Rule 92 EPC in its current scope. If however the two existing registers were combined, information from the post-grant phase could also be included. This would not place the contracting states under any additional obligations. The editorial suggestions would be taken into consideration. As discussions with the interest groups involved had shown that there was no need for the provision in Article 128(5) EPC, it could be deleted in its entirety. The reference to Article 75(2) EPC in Article 130(1) EPC had become obsolete with the addition of the proviso at the end of the paragraph, so the formulation now matched that of Article 131 EPC.

84. The chairman in his summary endorsed the Office's remarks and noted that the delegations agreed in principle to the proposed amendments.

XV. REVISION OF THE EPC: ARTICLES 133 AND 134 (CA/PL 22/00)

85. The Office tabled the document.
86. The *epi* representative said he had no problems with the proposal.
87. The UNICE representative agreed with the *epi* representative, particularly on Article 134 EPC. Regarding Article 133 EPC he added that from the users' viewpoint he would welcome allowance being made for the way things now worked in the business world, in the form of a provision governing the representation of one company by employees of another company with which it had economic connections. A suitable reformulation of Article 133(3), second sentence, EPC was suggested: "The Implementing Regulations shall provide [...] under what conditions ... which have their residence or principal place of business in a Contracting State and which ...". A definition of "economic connections" should be added to the Implementing Regulations to clarify that employees of a parent company may also represent affiliated companies ("affiliate means an entity that directly or indirectly controls, is controlled by or is under the control of such employer"). The proposal was supported by the Netherlands delegation.

88. In response to the chairman's enquiry the observer states said they had no problems with the proposed wording.
89. A number of delegations (FR, AT, MC, IE, NL, DK and CH) approved the proposal, but suggested editorial amendments:
- in Article 134(3)(b) EPC (French version) the passage "... sur le territoire de l'Etat ..." should be brought into line with the wording of Article 134(2)(b) EPC, "... dans l'Etat contractant" (FR);
 - in Article 133(3), first sentence, EPC the original wording should be used instead of "duly" (AT and DK);
 - in Article 134(2)(a)-(c) EPC (German version) nouns could be used instead of verbs, eg "Besitz der Staatsangehörigkeit .." or "Bestehen der europ. ..." (AT and DK);
 - in Article 134(7)(a) the expression "... in special circumstances ..." should be replaced or at least made more precise (MC);
 - in Article 134a(1)(a) EPC the phrase "..., established under this Convention, ..." should be deleted because once the revised version came into force the EPC would no longer include a provision governing the establishing of the Institute (AT, DK and NL).
90. On Article 134a(1)(a), the Swiss delegation commented that it agreed with the logic of the Austrian delegation's proposal (deletion of "..., established under this Convention, ..."), as long as there was one Institute of Professional Representatives before the European Patent Office. That was the case today, but it need not always be so. The proposed provision, by enshrining in the Convention the situation which existed and was desired at present, ran contrary to the legislator's intention of using the revision process to make the EPC more flexible. Existing Article 134(8)(b) EPC was more loosely formulated in that respect, so future changes were at least possible. It therefore suggested formulating Article 134a EPC more loosely in that respect, and including more specific information in the Implementing Regulations. The Danish delegation endorsed this.
91. The *epi* representative replied that express mention of the *epi* in the EPC itself was necessary to promote understanding of the *epi*'s role within the European patent system. The present proposal best reflected this importance because it also confirmed that the *epi* was established under the Convention.
92. The Office responded to the delegations' interventions. The present provision in Article 133(3) EPC governing the employee authorisations would be retained. Formulating Article 133(3), second sentence, EPC as a mandatory provision would require detailed consultation because there were major differences of

opinion on that issue among the interest groups involved. The Office would take up the matter again once agreement had been reached on it between industry and the independent patent agents. In Article 134a(1)(a) EPC the phrase "..., established under this Convention, ..." would be deleted. In view of the *epi*'s position, there was no chance of seeking a more flexible wording for Article 134a EPC which would keep open the possibility of establishing further professional institutes. The proposed editorial amendments would be taken into account.

93. Summing up, the chairman said the delegations approved the proposal, and editorial amendments would be incorporated into the draft Basic Proposal.

XVI. REVISION OF THE EPC: ARTICLES 135 TO 137, 140 AND 141 (CA/PL 23/00)

94. The Office tabled the proposed amendments.

95. The proposal was approved in principle. Some delegations, citing the importance of the provisions and their implications for national legislation, advocated retaining Article 141(1) EPC (SE, IE, BE and DE), Article 141(2) EPC (GB, SE, IE, ES, BE and DE), Article 136(1) EPC (BE) and Article 137 EPC (BE, ES and SE) in the EPC.

96. The Office said it was prepared to leave Articles 137 and 141 EPC in their present form and to examine whether it was possible, as suggested by the Belgian delegation, to refer to the principle of fee payment in Article 136(1) EPC and to retain in the EPC the substance of Article 136(1), first half-sentence, EPC and of Article 136(2), first sentence, EPC.

97. The chairman endorsed the Office's remarks and noted that the committee in principle accepted the proposal.

XVII. REVISION OF THE EPC: ARTICLE 138 (CA/PL 19/00)

98. The Office tabled the document, highlighting the necessity for the proposed provision in Article 138(2) EPC by referring to UK case law, where the court had discretion to refuse amendments made by the patent proprietor.
99. The UK delegation felt that the proposed wording was not in keeping with the objective of harmonising laws at a minimum common level, as it did not establish the proprietor's right to self-limitation as a principle. It put forward the following wording for discussion: "... revoked unless the patent is correspondingly limited. The proprietor of the patent shall have opportunity in revocation proceedings to

amend the patent to effect such a limitation". Regarding Article 138(1) EPC it said it could not see why the reference to the law of a contracting state had been deleted, and asked the Office to give more information.

100. The Office replied that Article 138(1) EPC had been amended partly in anticipation of a common patent court and partly because the present wording was potentially misleading as it might give the impression that national law had either to reproduce or to incorporate the provisions of Article 138 EPC in order to be applicable. That was not the case, since the EPC was directly applicable where national law lacked a provision equivalent to Article 138 EPC.
101. The Office having asked if the aim of the UK delegation's proposal was that the patent should be revoked *in toto* if the proprietor did not, or did not adequately, respond by limiting his patent, the UK delegation explained that that did not necessarily have to be the logical consequence; it depended on the particular powers of the national courts. Its proposal was designed merely to formalise the proprietor's right to self-limitation. Regarding the remark that the EPC was "self-executing", the UK delegation pointed out this was not a view that had ever been held in the United Kingdom.
102. To clarify the substance of Article 138(2) EPC the German delegation proposed a three-part formulation: 1. The patent proprietor's right to limitation in revocation proceedings; 2. Revocation of the limited part; and 3. Substantive examination of the residual part by the court.
103. In view of any future Community patent court the *epi* representative advocated deleting the restriction on the territorial effect of a court ruling and instead finding a loose formulation for Article 138(1) in that respect. Regarding Article 138(2) EPC it found the UK delegation's alternative preferable. Finally, thought should be given to restricting the right to limitation to amendment of the claims, as this would make the procedure less complicated and make it easier for the courts to effect a limitation.
104. The French delegation said it approved Article 138(1) EPC, but reserved its position on Article 138(2) EPC, as there had not yet been time for internal consultation.
105. The Irish delegation supported the UK delegation's proposal, in turn proposing that the effect of limitation in revocation proceedings be regulated in the EPC.

106. In the light of the Irish delegation's objection the Office felt clarification of Article 68 EPC would be appropriate.
107. The chairman summed up by saying that the proposal was approved without reservation as to Article 138(1) EPC, that Article 138(2) EPC would be revised in the light of the UK delegation's proposed formulation, and that a suitable reference to the effects of in revocation proceedings would be added to Article 68 EPC.

XVIII. REVISION OF THE EPC: ARTICLES 142 TO 149 (CA/PL 7/00 + Add. 1)

108. The Danish delegation gave an explanatory introduction to the document it had submitted. It said its proposal was designed to make it possible for national patent offices to take part in the work concerning any future Community patent. The plan to put the EPO in charge of search, substantive examination and grant for Community patents meant an enormous increase in the EPO's workload and at least temporarily a processing backlog. The proposed solution aimed to counteract that by allowing national patent offices to play a greater part in Community patent work if they wished to do so. The proposal was based in particular on the principle of subsidiarity. The document was being submitted to the committee because the delegation thought that proposals were to be drafted on how the national offices could support the EPO.
109. The chairman announced that he had received a written declaration from the Portuguese delegation expressing agreement with the Danish delegation's proposal.
110. The Austrian delegation found the proposal interesting and supported its objective. It considered its motives justified.
111. The French delegation stressed that the committee was not the right forum for discussing the Danish delegation's proposal as it had no mandate for such matters. It pointed out that the proposal conflicted with the Protocol on Centralisation, which took precedence over the provisions of the EPC in cases of inconsistency.
112. The German delegation said it was at present not clear what a Community patent would look like; in particular, interaction between the complementary patent systems (national patent, European bundled patent and Community patent) was still totally undefined. The idea of national offices taking over some Community patent work was interesting and was open to discussion within a competent body. The present committee had no mandate to discuss it.

113. In the Finnish delegation's view the proposal was likely to foster intensive co-operation between the EPO and the national offices and to further the improvement of the patent system throughout Europe and should therefore be pursued further.
114. The Swedish delegation emphasised the purely political nature of the issue. It referred to the positive attitude Sweden had taken towards it at various conferences. It was essentially sympathetic to the idea of outsourcing EPO work to national offices on condition that this helped the EPO out of processing bottlenecks and contributed to the preservation of competence in patent law at national level. For the Swedish delegation, the essential condition for agreeing to Community patent work being taken over by national offices was that existing standards of quality had to be maintained.
115. The Monegasque delegation endorsed the French delegation's position. The Belgian delegation said it did not think the Committee on Patent Law had a mandate to discuss the issue, so it was not prepared to comment on it at that time.
116. The UK delegation agreed with the Swedish delegation.
117. A number of delegations (IT, GR, LU, NL, ES, IE) found the proposal to be an interesting basis for further discussion; but they shared the view that the committee was not the right forum to consider the matter at that time. The delegations would therefore refrain from any further comment on the proposal.
118. The Swiss delegation stressed that nothing had changed about the guarded attitude it was known to have towards general decentralisation of core patent office work such as search and substantive examination. Its scepticism in that respect was essentially based on concern for the maintenance and monitoring of quality standards. It shared the view that the topic was not a matter for debate in the committee.
119. The UNICE representative said the committee was not the appropriate forum for debating so political an issue. From the users' viewpoint he had to make it quite clear that he was totally against taking substantive work out of the Office's hands. Particularly in view of the territorial legal effect of a Community patent, UNICE had to insist on the maintenance of uniform high standards of quality. That could not be guaranteed if the central patent grant procedure were made less strict, so no such opportunity should be created.

120. The EPO staff representatives said they had no mandate on the present committee to comment on the Danish delegation's proposal; they suggested that the committee should restrict itself to dealing with technical amendments.
121. The chairman said that whilst he did not wish to cut off debate on the Danish delegation's proposal, the majority of the delegations had indicated that the committee had no mandate for such matters, so he would refrain from summing up what had been said. The Danish delegation said it did not agree; many of the delegations had in principle responded positively to the proposal and were interested in having the issue discussed in the Administrative Council at the present time. Therefore the summary had to reflect many delegations' wish to debate the matter in the Council. The chairman did not share the Danish delegation's view. It was not his job to summarise opinions on topics not covered by the committee's mandate. The Danish delegation was at liberty to submit its proposal to the Administrative Council. In response the Danish delegation said it did not share the view that the committee had no mandate for the matter, as the mandate issued by the Paris intergovernmental conference included Part IX of the EPC. The chairman replied that the mandate from the IGC did indeed relate to the Community patent, but that did not alter the fact that the committee was a forum for discussing legal issues only. The committee would deal with the topic if the Administrative Council asked it to do so.

XIX. REVISION OF THE EPC: ARTICLES 150 TO 158 (CA/PL 21/00)

122. The Office tabled the document, indicating that the proposal had been submitted to WIPO for perusal, and barring a few linguistic suggestions WIPO had not proposed any amendments.
123. The German delegation welcomed the proposal and requested some editorial amendments. Thus the note in Article 151(1), second half-sentence, EPC (German version) should perhaps be retained for the sake of clarity. In Article 153(3), second sentence, EPC the phrase "... als einer Amtssprache des Europäischen Patentamts ..." could be omitted because the provision was clear enough without it. In Article 153(4) EPC the reference to Article 17(2)(a) PCT should be retained. The substance of Article 157(2)(a) should remain in the EPC in view of the severity of the sanction. Regarding the new Article 152(a) EPC it was suggested that "... in respect of which the PCT is in force" should be added after the word "State". On the other hand, transfer of the provision governing the transmittal fee (Article 152(3) EPC) to the Implementing Regulations was approved.

124. The *epi* representative criticised the formulation of the new Article 152 EPC because there was no clause specifying that the EPO could take on additional work only if it was guaranteed that its primary work would not be adversely affected.
125. The staff representatives asked whether it might not be better for the provision governing the responsibilities of the boards of appeal with regard to PCT protests to be kept in the EPC.
126. On this issue, the Office pointed out that the committee had already approved the deletion of Articles 154(3) and 155(3) EPC. Regarding the EPO taking on additional work, there was a difference between the EPO's duties as a patent granting authority for contracting and non-contracting states respectively. Towards the contracting states it had a legal obligation which it did not have towards other states, so its own work took precedence on legal grounds alone. It was up to the Organisation to decide whether to take on additional work and how much. A priority list could be drawn up, but it had to be borne in mind that the Administrative Council's decision-making autonomy had to be preserved. It was promised that the proviso regarding entry into force would be retained in the new Article 152(a) EPC.
127. The chairman noted that the delegations approved the proposal.

XX. REVISION OF THE EPC: LIMITATION PROCEDURE (CA/PL 29/99 Rev. 1)

128. The Office tabled the document. The chairman supplemented this introduction by summarising aspects which had been brought up in earlier discussions of the issue (violation of the principle of restricting the centralised procedure to patent granting, scope and effect of decisions in limitation proceedings, publication of an amended patent specification, effect on pending national proceedings and the relationship with future Community patents; see minutes of 11th meeting in CA/PL PV 11).
129. The delegations stated their positions on the points at issue. It became clear that they were in favour of introducing a central limitation procedure for European patents (GB, FR, BE, AT, MC, ES, DE, NL, SE, *epi* and UNICE). Two delegations (SE, ES) stressed the provisional nature of their opinions. There were however a number of different ideas regarding the form of the procedure. Only the German, Netherlands and Monegasque delegations and the UNICE representative were unrestrictedly in favour of the proposed format.

130. The UK delegation found the new procedure problematical in terms of legal certainty if no maximum time for completing the limitation procedure were defined. The French delegation also referred to conflicts that might arise if European and national limitation proceedings were pending in parallel. Thus it too was in favour of a provision requiring rapid completion of the procedure. The Belgian delegation, citing the possible impact of the limitation procedure on ongoing national proceedings, thought it appropriate to regulate the duration of the procedure. The Austrian delegation announced that it might withdraw its reservations about a limitation procedure with no time restrictions. It considered the implications that the procedure might have for pending proceedings to be less of a problem than the impact it might have on final and absolute national decisions, because a number of decisions might have to be considered in parallel in order to establish the exact status of a European patent. The Spanish delegation had no reservations about allowing limitation throughout the term of the patent. The German delegation said it did not expect the relationship between the European limitation procedure and national proceedings to cause any problems.
131. The French and Monegasque delegations expressly accepted restricting limitation to the claims. The Spanish delegation advocated extending it to the description and the drawings to match the arrangement for Community patents. The Swedish delegation wanted the matter regulated in the EPC.
132. The French delegation expressly approved dispensing with examination of the patentability of the residual patent; but the Swedish delegation thought it preferable to include this examination in view of a draft proposal to introduce a limitation procedure in Sweden. Two delegations (BE, *epi*) suggested that Article 105b EPC should include a reference to Articles 84 and 123 EPC, as they had to be considered in limitation proceedings.
133. The *ab initio* effect now proposed for decisions in limitation proceedings met with the approval of the delegations (FR, BE, AT, MC, ES, DE, NL, *epi* and UNICE), except for the Swedish delegation.
134. The Belgian delegation proposed extending the right to request limitation under Article 105a(1) EPC to licensees, subject to the proprietor's consent.

135. The Austrian delegation suggested considering whether the applicability of Article 65 EPC could be regulated by means of an explicit reference. The Spanish delegation thought Article 65(1) EPC should provide a legal basis for allowing contracting states to file a new translation of the patent specification when a patent was limited. The Swedish delegation urged that the legal basis for levying fees for the limitation procedure be established in the EPC. This was endorsed by the Belgian delegation.
136. The delegations suggested various editorial amendments:
- in the title of Article 105b(1) EPC the words "Examination of the request" should be omitted and the order should be changed to "Limitation or revocation" (AT);
 - in Article 105b(2), last sentence, EPC (French version) the words "Faute de quoi, ..." should be replaced with "A défaut de quoi, ..." (BE);
 - in Article 105b(3) EPC the time when the decision takes effect should be clarified by reformulating the wording (AT);
 - in Article 105c the wording should be brought into line with the formulation of Article 65 EPC (AT);
 - in Article 68 EPC (French version) the words "... en tout ou en partie ..." should be deleted (MC).
137. The Office responded as follows to the delegations' views and questions:

If a patent had different proprietors in different contracting states, the request would have to be accompanied by authorisations from the other proprietors; this requirement would be defined in the Implementing Regulations. The request could be for limitation or for revocation, as the purpose of the provision was to give proprietors the same legal options as in opposition proceedings, where they could also request revocation. The duration of the limitation procedure should be kept short not by setting a strict period in which to complete it but by structuring the procedure along the proposed lines (dispensing with examination of the patentability of the residual patent). As a central procedure, limitation was effective in all contracting states. Staying of national proceedings was governed by the law of the given contracting state. To ensure that the contracting states were quickly informed of pending limitation proceedings, the filing of the request itself would be recorded in the Register of European Patents. The decision on the limitation request would not undermine pending national decisions. The EPC would not make express provision for translation of the claims of a limited patent; this would be handled in the Implementing Regulations, by analogy with the examination and opposition procedures. In the Basic Proposal, the proposed formulation regarding fees would be brought into line with general discussions on

the fees issue. Application of Articles 84 and 123 EPC would in any event be provided for in the Implementing Regulations.

138. The chairman summed up by saying that the document was approved subject to the following points. The principle of the limitation procedure being subject to payment of a fee was to be enshrined in the EPC. The principles underlying translation of the claims were to be the same as for the examination and opposition procedures, with Article 65 EPC being adapted accordingly. Positions differed as regards express mention of Article 84 and Article 123(2) EPC in Article 105b EPC. The Office continued to hold that a reference in the Implementing Regulations was preferable to a provision in the EPC itself. The committee reserved the right to return to the matter at its next meeting.

XXI. REVISION OF THE EPC: ARTICLE 164 (CA/PL 20/00)

139. The Office tabled the document.
140. Some delegations took up fundamental positions. The Belgian delegation pointed out that the idea of deregulation should not be used as a uniform principle underlying every transfer of a provision to the Implementing Regulations. It had to be decided on a case-by-case basis which provision could be transferred to the Implementing Regulations and which had to stay in the EPC. The French delegation wished to know the extent to which deregulation had to distinguish among requirements which had to be observed in proceedings before the EPO and those which, together with the legal consequences of failure to comply, had to be regulated in the EPC itself.
141. A number of delegations said they approved in principle of the proposed text (FR, NL, AT, GB, SE, CH, BE, DE, MC, LU and ES), but most had reservations about the wording of Article 164(1)(b) EPC. Some objected to the inclusion of rules of interpretation, as this would give the Administrative Council over-extensive powers which were the preserve of the judiciary. Others criticised the last half-sentence, "including the legal consequences ... or procedure", on the grounds that rules governing legal consequences were a fundamental part of the EPC which could not be transferred to the Implementing Regulations by means of a catch-all provision. The Austrian delegation did not share this view. As a compromise the Monegasque delegation proposed that the passage relating to legal consequences be moved to Article 164(1)(a) EPC. The German delegation favoured drawing up a list of specific individual powers.

Finally, doubts were raised regarding the term "useful". The Belgian delegation asked about the criteria by which usefulness was defined within the meaning of the provision.

142. The Office replied that the Implementing Regulations already contained a plethora of interpretation rules. The proposal would not detract from the powers of the boards of appeal to interpret the EPC. It was also conceivable that Article 164 EPC could be left as is, apart from the addition of the Protocol on the Staff Complement, as the Office would not insist on change at any price if there were a negative attitude towards extensive regulatory powers for the Administrative Council.
143. The UK delegation returned once more to the reservations many delegations had expressed in particular about the highly generalised formulation of Article 164(1)(b) EPC. It proposed a more restrictive formulation which assumed that there would be references to legal consequences in individual articles ("(b) necessary to the implementation of the provisions of this Convention").
144. The Office proposed that the entire concept of Article 164 EPC be revised on the basis of the meeting's findings; the committee could return to the matter in the course of discussions on the Basic Proposal. It was against reverting below the existing level of Article 164 EPC, which the EPC's founding fathers had framed very broadly anyway; otherwise new Article 164 EPC might find itself at odds with other matters already regulated in the Implementing Regulations. If the committee failed to achieve consensus on a new version, Article 164 EPC would be left in its present form.
145. The German delegation thought the proposed wording went too far. The idea of "interpretation" should be removed, as interpretation was the preserve of the courts; a vaguer formulation should be used instead of "useful" (eg "(b) implementing the provisions of this Convention"), and the clause relating to legal consequences deleted in its entirety. The EPC could in individual cases provide that legal consequences could be defined in the Implementing Regulation.
146. The Office disagreed that there should be no rules of interpretation in the Implementing Regulations. The debate about transferring provisions from the EPC to the Implementing Regulations should not become over-burdened with purely political aspects on which recent events might have bestowed undue significance.

147. The German delegation replied that its proposal was not designed to banish every rule of interpretation from the Implementing Regulations or to accept the lack of legal force of existing rules. What it meant was that there was no need for Article 164 EPC explicitly to grant the Administrative Council the power to regulate the interpretation of every single eventuality.
148. The Swedish delegation supported the UK delegation's proposal; the term "useful" could be retained and that the whole of the last half-sentence of (b) could be deleted if a rider to the same effect were added to individual articles.
149. The Belgian delegation said that simply leaving Article 164 EPC in its present form would be a retrograde step.
150. The UNICE representative affirmed that he supported the principle of transferring provisions to the Implementing Regulations where it could be done without impairing the stability of the system.
151. The chairman summed up by saying that the proposal was not accepted in its present form by the majority of the delegations. CA/PL 20/00 was therefore to be used as the basis for revising the proposal. In the Basic Proposal, the last half-sentence under (b) to which the delegations had objected could if necessary be accommodated in (a), the Monegasque delegation's suggestion being one possible solution. The term "useful" should be re-examined. The chairman gave a general summary of the discussion on the transfer of provisions from the EPC to the Implementing Regulations, noting that the debate's provisional conclusion was that the revised draft should take the technical aspects into account and could be based on a number of considerations of principle. Thus, major fees should be enshrined in the EPC, along with the legal consequences of non-compliance. On the other hand, it made no sense to provide for a fee in the EPC if it derived from some other treaty (such as the PCT). In the case of legal consequences currently covered by the EPC, however, it was indeed necessary to consider transferring provisions governing them to the Implementing Regulations so as to make it easier to tone them down if they proved unduly harsh. The committee further agreed that provisions having a direct impact on national legislation had to remain in the EPC.

XXII. REVISION OF THE EPC: NEW PROVISION IN PART IX (CA/PL 24/00)

152. The Office tabled the document.

153. Most delegations responded positively to the proposal and gave their provisional approval (MC, FR, SE, BE, NL, CH, AT, GB and the *epi* representative). Some offered proposals for editorial amendments, relating inter alia to:

- Article XX(1), for replacing "... right of the Contracting States ..." with "... right of all [some] / [a part of] Contracting States ..." (NL and GB) or a formulation similar to "any group of" as in Article 142 (CH);
- Article XX(1), regarding clarification of its relationship with Article 31 of the Vienna Convention on the Law of Treaties (FR);
- Article XX(2), for adding a paragraph (c) allowing the Administrative Council to decide on the absorption of costs arising from central filing and publication of translations. In principle it was worth considering whether Article XX(2) could be formulated in more abstract terms, reflecting its underlying purpose, to avoid the converse conclusion that no other activities were eligible for financial or logistical support on the basis of an Administrative Council decision; doing so might render superfluous the provision in paragraph 1, which in turn risked the unintended converse conclusion that certain agreements between contracting states were not allowed (DE). The Swiss delegation was expressly against restricting Article XX to the substance of Article XX(2)(b), basing its position on the Brussels Convention on Recognition and Enforcement of Judgments in Civil and Commercial Matters (or the Lugano Convention for non-EU states), due to be enacted as an EU Regulation (see COM19/99, p. 348). Article 63 of the Regulation contained a list of exceptions to the principle that the recognition and enforcement of judgments in civil and commercial matters in the EU area were to be based purely on the new Regulation. One of these exceptions was the EPC. That meant that a protocol - especially one relating to judicial proceedings - on grounds of legal certainty alone would have to be referred to in the EPC itself in order to be considered an exception.
- Article XX(2)(b), where not only the common entity but the common patent court should be mentioned (NL). It also needed to indicate that it applied only until the common entity and a future common patent court were merged (CH); and the reference to "premises" should be removed (*epi*).

154. The Office gave its opinion on the points raised. It had deliberately made no provision for EPO financial involvement in the common patent court, because financing was to be the sole responsibility of the states which were party to the protocol. The need for the provision was being reviewed in the light of the Vienna Convention. The wording of paragraph 1 would be reviewed. Generalising paragraph 2 would result in a highly abstract formulation; but the German delegation's proposal would be examined, as would the French delegation's proposal for creating a central provision (eg in Article 33 EPC) governing all the powers of the Administrative Council. The issue of costs for central filing and publication of translations was dealt with implicitly in Article XX(1)(c), and this would be referred to in the explanatory remarks on the proposal. The time factor and the provisional nature of the common entity would also be emphasised in the explanatory remarks.
155. The chairman noted the delegations' positive attitude towards the proposal, but refrained from drawing any conclusion on this agenda item in view of the provisional nature of the proposed rules and the Office's promise to take the delegations' suggestions into consideration in drawing up the Basic Proposal.


XXIII. OTHER BUSINESS

156. On the basis of Info 2/PL 13 the Office described the progress of preparations for EPC revision. The Basic Proposal should be ready by mid-June.
157. The committee scheduled its next meeting for 3 to 7 July 2000 in Munich. It was pointed out that final voting at this meeting would be restricted to fully formulated proposals.

The Committee on Patent Law approved the minutes contained in this document on 3 July 2000.

Munich, 3 July 2000

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

13. Sitzung / 13th meeting / 13ème session (München/Munich, 03. - 07.04.2000)

München/Munich, 31.03.2000

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)

VORSITZENDER - CHAIRMAN - PRESIDENT

M. Paul LAURENT
Conseiller adjoint
Office de la Propriété Industrielle
(Belgique)

VIZEPRÄSIDENT - DEPUTY CHAIRMAN - VICE-PRESIDENT

Mr Hugh J. EDWARDS
Deputy Director,
Legal Division
Patent Office
(United Kingdom)

MITGLIEDSTAATEN - MEMBER STATES - ETATS MEMBRES

BELGIQUE

Mme Monique PETIT	Conseiller adjoint Office de la Propriété Industrielle
M. Geoffrey BAILLEUX	Conseiller adjoint Office de la Propriété Industrielle

CYPRUS

Mr Christoforos CONSTANTINOU	Principal Examiner Ministry of Commerce, Industry and Tourism
------------------------------	--

DENMARK

Ms Anne Rejnhold JÖRGENSEN	Director Industrial Property Law Division Danish Patent Office
Mr Sören HEIN-MAGNUSSEN	Head of Section Danish Patent Office

DEUTSCHLAND

Herr Raimund LUTZ	Ministerialrat Bundesministerium der Justiz
Herr Johannes KARCHER	Richter am Amtsgericht Referent des Referats AIII B4 Bundesministerium der Justiz
Frau Carolin HÜBENETT	Regierungsdirektorin Deutsches Patent und Markenamt
Herr Heinz BARDEHLE	Patentanwalt

ELLAS

Mr Costas ABATZIS	Director Industrial Property Titles Industrial Property Organisation (OBI)
-------------------	--

ESPAGNE

Mr Jesús CONGREGADO LOSCERTALES	Director International Relations and Legal Coordination Department Spanish Patent and Trademark Office
Mr Miguel HIDALGO LLAMAS	Head of Legal Division Patent and Information Technology Department Spanish Patent and Trademark Office

FINLAND

Ms Maarit LÖYTÖMÄKI	Deputy Director National Board of Patents and Registration
Ms Marjo AALTO-SETÄLÄ	Coordinator of International Affairs National Board of Patents and Registration
Mr Markku JÄNKÄLÄ	Government Secretary Ministry of Trade and Industry

FRANCE

M. Jean-Luc GAL

Chargé de mission au Service du droit
international et communautaire
Institut National de la Propriété Industrielle

M. Jean-François LEBESNERAIS

Chargé de mission au Service Département
Brevets
Institut National de la Propriété Industrielle

IRELAND

Mr Jacob RAJAN

Head of Patents Section
Intellectual Property Unit
Department of Enterprise, Trade and
Employment

Ms Hillery SAUNDERS

Administrative Officer
Intellectual Property Unit
Department of Enterprise, Trade and
Employment

ITALIE

Mme Donatella PALMA

Conseiller Ministeriel Adjoint
Office italien des brevets et des marques

M. Angelo CAPONE

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

LUXEMBOURG

M. Claude SAHL

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

MONACO

Mme Marie-Pierre GRAMAGLIA

Chef de Division de la Propriété
Intellectuelle

THE NETHERLANDS

Mr Wim VAN DER EIJK

Legal Advisor
Netherlands Industrial Property Office

Mr Albert SNETHLAGE

Legal Advisor
Ministry of Economic Affairs

ÖSTERREICH

Herr Herbert KNITTEL

Vizepräsident
Österreichisches Patentamt

Frau Erika BAUMANN-BRATL

Vorstand der Rechtsabteilung A
Österreichisches Patentamt

PORTUGAL

Mme Isabel AFONSO

Directeur de Services des Brevets
Institut National de la Propriété Industrielle

Mme Maria JOÃO RAMOS

Juriste
Institut National de la Propriété Industrielle

SCHWEIZ

Herr Felix ADDOR

Stellvertretender Direktor
Eidgenössisches Institut für Geistiges
Eigentum

Herr Stefan LUGINBÜHL

Rechtsanwalt
Rechtsdienst Patente und Design
Eidgenössisches Institut für Geistiges
Eigentum

SWEDEN

Mr Per HOLMSTRAND

Chief Legal Counsel
Swedish Patent and Registration Office

Ms Malin BONTHRON

Legal Adviser
Ministry of Justice

Mr Lennart SUNDIN

Legal Officer
Patent Department
Swedish Patent and Registration Office

UNITED KINGDOM

Mr Hugh J. EDWARDS

Deputy Director
Legal Division
Patents & Designs Directorate

BEOBACHTER - OBSERVERS - OBSERVATEURS

1. Staaten - States - Etats

CZECH REPUBLIC

Ms Světlana KOPECKÁ

Director of the International and European
Integration Department
Industrial Property Office

Mr Jaroslav KOZÁK

Director of the Patent Department
Industrial Property Office

ESTONIA

Mr Laur LEETJÕE

Deputy Director General
Estonian Patent Office

Mr Raul KARTUS

Head of Patent Department
Estonian Patent Office

HUNGARY

Ms Judit HAJDÚ

Head of the Patent Department
Hungarian Patent Office

Ms Margit SÜMEGHY

Senior IP adviser
Hungarian Patent Office

LATVIA

Mr Georgij POLIAKOV

Deputy Director
Patent Office

Ms Jelena KOLOBKOVA

Expert of the Legal Department
Patent Office

**FORMER YUGOSLAV REPUBLIC
OF MACEDONIA**

Ms Marija KOSTOVSKA

Adviser
Industrial Property Protection Office

NORWAY

Mr Eirik RØDSAND

Senior Executive Officer
Legal Section
Norwegian Patent Office

POLAND

Ms Ewa NIZIŃSKA-MATYSIAK

Principal Expert
Cabinet of the President
Patent Office

ROMANIA

M. Alexandru STRENC

Directeur général adjoint
Office d'Etat pour les inventions et les
marques

M. Liviu BULGAR

Directeur
Département "Juridique, Coopération
internationale, Marques et Dessins et
modèles industriels"

SLOVAKIA

Ms Jolana HANČIKOVÁ

Engineer
Industrial Property Office

Ms Katarina BRUOTHOVÁ

Legal Expert
Legal Department
Industrial Property Office

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

Europäische Union - European Union - Union européenne

Herr Carl-Erik NORDH

Hauptverwaltungsrat

3. **Nichtstaatliche Organisationen - Non-Governmental Organisations - Organisations non-gouvernementales**

Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the EPO
Institut des mandataires agréés près l'Office européen des brevets

Mr Axel CASALONGA

President of the European Patent
Practice Committee

Mr Wim HOOGSTRATEN

Vice-President of the European Patent
Practice Committee

Union of Industrial and Employers' Confederations of Europe
Union des Confédérations de l'Industrie et des Employeurs d'Europe

Herr Arno KÖRBER

Siemens AG

Mr Jan GALAMA

Corporate Patents and Trademarks
Philips International BV

EUROPÄISCHES PATENTAMT - EUROPEAN PATENT OFFICE
OFFICE EUROPEEN DES BREVETS

Herr Wolfgang STAAB
Mr Helge RASMUSSEN
Mr Rolf SPIEGEL

Verwaltungsrat (1.1.4.1)
Principal Director (1.2.3)
Director (1.2.6.2)

M. André RÉMOND
Herr Gerhard WEIDMANN

Directeur principal (2,1)
Direktor (2.2.05)

Herr Peter MESSERLI
Mr Franco BENUSSI
Herr Ulrich JOOS
Frau Alexandra PIGNATELLI

Vizepräsident (GD 3)
Director (3.0)
Referatsleiter (3.0.3)
Juristin (3.0.3)

Mr Jonathan PRICE	Principal Director (4.2)
Herr Ingwer KOCH	Direktor (5.1.2)
Frau Theodora KARAMANLI	Juristin (5.1.2)
Herr Robert CRAMER	Jurist (5.1.2)
Herr Ulrich SCHATZ	Hauptdirektor (5.2)
Herr Gert KOLLE	Direktor (5.2.2)
Herr Eugen STOHR	Jurist (5.2.2)
Ms Sylvie STROBEL	Lawyer (5.2.2)
M. Eskil WAAGE	Juriste (5.2.2)
Herr York BUSSE	Hauptverwaltungsrat (5.2.2)

PERSONALAUSSCHUSS - STAFF COMMITTEE - COMITE DU PERSONNEL

Herr Serge MUNNIX	Personalvertreter
Mr Paul LUCKETT	Staff representative

SEKRETARIAT - SECRETARIAT

M. Gérard WEISS	Directeur (0.2)
Herr Christian HAUGG	Jurist (5.1.2)
Frau Helga ECKART	Verwaltungshauptinspektorin
Mme Martine VOSGIN-WIMMER	Assistante
