

M I N U T E S

of the
14th meeting of the

COMMITTEE ON PATENT LAW

(Munich, 3 to 6 July 2000)

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The Committee on Patent Law held its 14th meeting in Munich from 3 to 6 July 2000, with Mr Laurent (BE) presiding. The list of participants is annexed.

I. ADOPTION OF THE AGENDA (CA/PL 30/00 Rev. 1)

1. The committee adopted the agenda as set out in CA/PL 30/00 Rev. 1.
2. The chairman gave a short report on the Administrative Council's meeting in Limassol from 6 to 8 June 2000. It had discussed three main EPC revision-related topics: the Regulation on a Community Patent, patent protection for biotechnological inventions, and draft Implementing Regulations. The heads of delegation on the Council shared the view, expressed by several delegations on the committee, that protection for biotechnology should be regulated in the EPC itself. They had also agreed that points which could not be finalised for the Diplomatic Conference in November 2000 (eg biotechnology, novelty grace period and Community patent) could be dealt with in a second "basket" at a later conference. So could any points on which the committee failed to reach agreement at the present meeting. The Council had also discussed the possibilities, conditions and consequences of EPC accession by the European Union. It was not insisting that the implementing regulations be revised in time for the Diplomatic Conference.

II. APPROVAL OF THE MINUTES OF THE 13TH MEETING (CA/PL 27/00)

3. The committee approved the minutes of its 13th meeting, subject to various amendments and additions proposed by the Belgian (point 117), Swedish (points 66, 132, 135 and 141), Swiss (points 11, 22 and 26) and United Kingdom delegations (points 30, 57, 66, 67 and 98) and the staff representatives (points 7 and 22). They have since been issued as CA/PL PV/13.

IIla. BASIC PROPOSAL (CA/PL 25/00 + Add. 1 and 2, and Info 2/PL 14 e)

4. The chairman suggested that the committee discuss the outstanding questions on the basis of a "List of Points" broken down into three categories:

Category A: points regarded as approved and requiring no further discussion;

Category "B": points requiring only clarification of detail;

Category "C": points still requiring thorough discussion.

5. Asked by the chairman whether they agreed to this procedure, and to the proposed "List of Points", some delegations (CH, DE, FR, GR, SE and GB) thought certain points should be moved from Category B to C, or from Category A to B or C.
6. The committee then adopted the following revised "List of Points":

Category A: Articles 11, 16, 17, 18, 23, 38, 42, 50, 54(4), 75, 78, 79, 86, 88, 90, 91, 92, 95, 96, 97, 98, 102, 103, 104, 108, 110, 115, 119, 126, 128, 129, 130, 135, 136, 150-158, 159-160, 161, 162, 163, 167 and the Protocol on the Staff Complement;

Category B: Articles 14, 37, 51, 61, 65, 68, 76, 77, 80, 87, 93, 94, 99, 101, 105, 106, 117, 120, 123, 124, 127, 133, 134, 134a, 138(2) and (3) and the Protocol on Centralisation;

Category C: Articles 22, 33, 35, 52, 53, 54, 105a-c, 112a, 121, 122, 149a and 164.

IIIaa. LIST OF CATEGORY A ARTICLES

The committee gave a unanimous favourable opinion on the Category A points (see list above), without discussing any of them any further.

IIIbb. LIST OF CATEGORY B ARTICLES

(i) ARTICLE 14 EPC (CA/PL 25/00, page 3)

7. Several delegations (AT, DE, FR, IE and GB) thought the fundamental principle laid down in Article 14(7) EPC should remain in the Convention; its removal would create an inconsistency with Article 97 EPC.
8. The Hellenic delegation thought existing Article 14(7) EPC might conflict with the protocol on languages. Now that the protocol existed, this matter no longer needed to be regulated in the Convention. It was therefore in favour of the Basic Proposal.

9. The Office said it did not intend to do away with the translations of the claims into the other two EPO official languages. The approach in Article 14 EPC was different from that in Article 97 EPC, the aim being to make the system more flexible. It was quite feasible that there might be a more liberal regime in future, eg with translations being provided consecutively so as to reduce grant times. As things stood, the Council could already decide that applicants did not have to file translations of the claims (see Article 97(5) EPC: "Provision may be made in the Implementing Regulations ..."). For Article 14 EPC to require that patent specifications contained translations of the claims into the other two EPO official languages could lead to a contradiction with Article 97(5) EPC if the Council decided to waive that requirement. In that case, if translations of the claims still had to be published the Office would have to do them itself. So the main point was that producing the requisite translations should remain the applicant's responsibility.
10. The chairman summed up: the committee gave a unanimous favourable opinion on the Office's proposal for Article 14 EPC, provided that the revised text retained paragraph 7 in its present wording.

(ii) ARTICLE 37 EPC (CA/PL 25/00, page 27)

11. Asked by the chairman why it wanted this article moved to Category B, the German delegation said it could not agree to either Article 37 or Article 42 EPC as currently proposed.
12. The chairman said the committee noted that statement, and gave a favourable opinion on the proposal.

(iii) ARTICLE 51 EPC (CA/PL 25/00, page 35)

13. Some delegations (BE, FR, GR, NL) said they agreed to the proposal.
14. The Netherlands delegation suggested a clarification to the effect that the second paragraph related only to time limits not already regulated in the Convention.

15. The Hellenic delegation asked if the Office had considered including a general clause on fee reductions.
16. The Belgian delegation asked about the legal consequences if fees referred to in the Implementing Regulations were not paid in time.
17. The Office said it had opted against laying down in Article 51 EPC who decided on fees. That was in line with the existing system. The circumstances giving rise to fee reductions were described in the Convention, its Implementing Regulations, and the Rules relating to Fees. New Article 51 EPC would not change that. The legal consequences of non-payment (in time) of fees referred to in the Implementing Regulations were also described in those Regulations. Similarly, where a fee was staying in the Convention, that was also where the legal consequences of late payment would be found. Administrative fees would be in the Implementing Regulations. The Netherlands delegation's suggestion on Article 51(2) EPC would be incorporated into the Basic Proposal.
18. The chairman summed up: the committee gave a unanimous favourable opinion on Article 51, with the addition to paragraph 2 of an express reference to time limits other than those fixed by the Convention itself.

(iv) ARTICLE 61 EPC (CA/PL 25/00, page 45)

19. The German delegation thought Article 61 EPC, as it stood, exemplified the system of laying down the core points in the actual Convention and leaving the precise rules to the Implementing Regulations. Article 61(1) EPC should therefore remain unchanged.
20. The chairman said the committee noted the German delegation's statement and gave a favourable opinion on the proposal.

(v) ARTICLE 65 EPC (CA/PL 25/00, page 47)

21. The Netherlands delegation said the amendment to the first paragraph gave new importance to the third one. If a European patent was limited very late in its term the

patentee ran a big risk of its being deemed void retroactively through failure to submit in due time the translation of the patent as limited. That was too harsh.

22. The Office said it was left to each contracting state to decide whether to require a translation. And since Article 65(3) EPC was an optional provision, they were all at liberty to provide for some other legal consequence if they felt the one in Article 65(3) EPC was too harsh. Lastly, given the effect of limitation as laid down in Article 68 EPC, the overall system was balanced.
23. The chairman noted that the committee gave a unanimous favourable opinion on Article 65 EPC.

(vi) ARTICLE 68 EPC (CA/PL 25/00, page 49)

24. The Swedish and Danish delegations expressed reservations about this proposal.
25. Some delegations (BE, FR, MC, GB) and the *epi* representative suggested editorial amendments to the provision itself and to the references in the text of the Convention.
26. The Office said the words "totalement ou partiellement" had been deleted to bring the French text into line with the German and English versions. The remark in the margin about the French text of Article 68 would be corrected. The proposal that the French wording be amended to read " ... dans la mesure dans laquelle ..." would be examined.
27. The chairman summed up: the committee gave a favourable opinion on Article 68 EPC, with the Swedish and Danish delegations expressing reservations. At the suggestion of the Monegasque delegation, it decided that a new French version of Article 68 ("dans la mesure dans laquelle" instead of "dans la mesure où") would be examined.

(vii) ARTICLE 76 EPC (CA/PL 25/00, page 53)

28. The French delegation asked how Article 76(1) EPC fitted with Article 79(2) EPC, and about designations in divisional as opposed to parent applications.
29. The Office replied that here the Convention was not being changed. The geographical cover of a European patent application was confined to the states designated on filing; no designation could be added which did not appear in the

original application or had been validly waived. A designated state forfeited in the parent application could not be revived in a divisional one.

30. The Monegasque delegation suggested that the reference to the Implementing Regulations in Article 76(1) EPC should read " ... selon les dispositions prescrites par le règlement d'exécution ...".
31. The United Kingdom delegation thought the proposed wording was confusing as regards the relationship between Article 76(2) and Article 79(1) EPC. The latter seemed to take precedence.
32. The Office explained that Article 76(2) EPC was *lex specialis* for Article 79 EPC; by definition, a divisional application always presupposed the earlier filing of a parent application. So Article 76(2) EPC governed the exception to the general rule in Article 79(1) EPC, and should not be unduly complicated by adding qualifications such as "notwithstanding" or "subject to". This could be clarified in the explanatory remarks.
33. The *epi* representative pointed out that Article 76 EPC did not clearly state that a divisional application could itself be divided; it merely referred to the "earlier application" ("frühere Anmeldung", "demande initiale"). Clarification would be desirable.
34. The Office conceded that the rules on this point were not clear. But in practice the dividability of divisional applications had never been questioned. To avoid overcomplicating the text, this could be clarified in the Implementing Regulations to Article 76 EPC if the committee thought this necessary. Perhaps the problem was caused by inconsistencies in the different language versions. The Office would try to find a French adjective closer to the English and German ones.
35. The chairman summed up: the explanatory remarks would emphasise that Article 76(2) was *lex specialis* and make it clear that the geographical cover of the divisional application depended on the designation fees paid for the earlier application; a further clarification, in the Implementing Regulations or explanatory remarks, would indicate that divisional applications could themselves be divided;

and the committee gave a unanimous favourable opinion on the proposed text for Article 76 EPC, subject to the above amendments and the Monegasque delegation's more general comment.

(viii) ARTICLE 77 EPC (CA/PL 25/00, page 55)

36. The United Kingdom delegation withdrew its request that the time limits under Article 77(2) and (3) EPC should remain in the Convention, after the Office said they were not being changed but merely shifted to the Implementing Regulations, and the Council could amend them anyway as the law stood.
37. The chairman noted that the committee gave a unanimous favourable opinion on Article 77 EPC as set out in the Basic Proposal.

(ix) ARTICLE 80 EPC (CA/PL 25/00, page 63)

38. The French delegation thought the filing-date requirements should stay in the Convention: Article V PLT, by derogation from Article II PLT, prescribed binding minimum requirements for a filing date. These should therefore at least be laid down in Article 80(1) EPC. If in due course there was a real need to amend them, given new Articles 33 and 35 EPC this could be done quickly.
39. The Spanish delegation too felt that the minimum filing-date requirements should stay in the Convention, and be in line with Article V PLT.
40. The Hellenic delegation referred to its position on this point as stated at earlier meetings, and otherwise supported that of the French delegation. The Netherlands and Belgian delegations too endorsed the French delegation's arguments.
41. The Swedish delegation said it did not mind the filing-date details being moved to the Implementing Regulations, but was not so sure about deleting Article 80 EPC altogether; there would then be nothing in the actual Convention about the date of filing. It therefore suggested that the Convention should stipulate that in order to get a filing date an application had to fulfil certain requirements laid down in the

Implementing Regulations. That should clarify matters, which after all was the point of the revision exercise.

42. The Danish delegation endorsed the Swedish delegation's proposal.
43. The WIPO representative said the PLT discussions had shown that member states could agree to some flexibility on filing-date provisions - not least with a view to future electronic filing, etc. - but not to regulating them in their entirety in the Implementing Regulations.
44. The Swiss delegation said it had previously taken the same line as the Office, but given the views expressed at the present meeting, and the lack of any more time for discussion, could agree as a compromise to the Swedish delegation's proposal. Article 80 EPC should be worded in very general terms, to permit a rapid and appropriate response to possible developments in electronic means of communication. The new procedure under Articles 33 and 35 EPC was not suitable for this.
45. As a compromise between the proposal that Article 80 EPC should at least include the requirements referred to in Article V(1) PLT and the wish that it be retained in the Convention as an introductory general clause, the Office suggested the following wording: "The date of filing of a European patent application shall be the date on which the requirements laid down in the Implementing Regulations are fulfilled".
46. In response to a question from the chairman, the French delegation said it would have preferred to see the substantive filing-date requirements kept in the Convention, but could agree to the compromise proposed. The Spanish delegation said it too agreed to the compromise proposal.
47. The chairman summed up: the committee unanimously decided that a filing-date provision should be retained in the Convention; the new wording would simply state that the requirements for according a date of filing were defined in the Implementing Regulations.

(x) ARTICLE 87 EPC (CA/PL 25/00, page 67)

48. The French delegation expressed concern at the extent to which national courts might be bound by the EPO President's decisions.

49. The Finnish delegation said it was dropping its objections to revised Article 87(5) EPC.
50. The Office said it could understand the French delegation's concern. However, the President's powers were subject to prior ratification by national parliaments, and thereafter there was no reason not to recognise his decisions in this area - which would in any case always require consensus amongst all delegations on the Council.
51. The chairman noted that the committee gave a unanimous favourable opinion on the text proposed for Article 87 EPC.

(xi) ARTICLE 93 EPC (CA/PL 25/00, page 83)

52. The French delegation said the Convention should continue to specify the contents of European patent applications as published under Article 93(2) EPC.
53. The Office said the relevant parts were expressly listed in Article 78(1) EPC.
54. The chairman summed up: the committee gave a favourable opinion on proposed Article 93 EPC.

(xii) ARTICLE 94 EPC (CA/PL 25/00, page 85)

55. The staff representatives saw an inconsistency between Article 94 and Article 101 EPC (governing examination and opposition respectively): Article 94(3) EPC said invitations were issued to applicants "as often as necessary", a formulation dropped from Article 101 EPC. But parties' rights to be heard should be the same in all EPC proceedings.
56. The Office said Article 94 EPC resulted in a loss of rights which did not occur in opposition proceedings. The provisions proposed were therefore appropriate.
57. The chairman summed up: the committee gave a unanimous favourable opinion on proposed new Article 94 EPC.

(xiii) ARTICLE 99 EPC (CA/PL 25/00, page 97)

58. The German delegation said it agreed to the proposed restructuring, except that existing Article 99(3) EPC was of fundamental importance and should therefore stay in the body of the Convention.
59. The Monegasque delegation suggested two editorial amendments: a review of the wording in paragraph 1 ("date on which the mention ...") and the use (in the French text) of "selon les dispositions prescrites par le règlement d'exécution" rather than "conformément au règlement d'exécution". Nor could it see why the first paragraph had been revised when the actual opposition period remained unchanged. The old wording was better. The Office said the revised wording made the paragraph clearer and more consistent with other provisions.
60. The chairman summed up: the committee gave a favourable opinion on the proposal and noted the statement by the German delegation; the editorial suggestions would be considered when the draft Basic Proposal was finalised.

(xiv) ARTICLE 101 EPC (CA/PL 25/00, page 99)

61. The United Kingdom delegation suggested two editorial amendments (to Article 101(1) and 101(2), first sentence, EPC). The Swiss delegation suggested a correction to Article 101(2), final sentence, EPC.
62. The Swedish delegation said Article 101(3)(a) and (b) EPC as worded did not say what legal consequence ensued if the requirements of the Convention were met but not those of the Implementing Regulations; a reference to the latter might be appropriate. Also, Article 102(5) EPC should remain in the Convention.
63. The *epi* representative said the proposed new version of Article 101(1) and (2) EPC posed a serious danger that in practice boards of appeal would send more cases back to opposition divisions if they thought they had not considered a ground for opposition properly.
64. The Office said opposition divisions' normal practice - in accordance with the principle of procedural economy - was to examine all grounds raised or requiring consideration, unless there were special reasons for taking some other course. The

Implementing Regulations made it clear that as a rule the division had to decide on all the grounds for opposition raised. So there was no need for the Convention itself to say how the proceedings should best be conducted; it should merely define the subject-matter to be examined, not the reasons on which the decision was based. Going back to the staff representatives' idea that deleting the second paragraph was at odds with the provisions governing examination proceedings, the Office suggested keeping Article 101(2) EPC, and formulating it in the same way as Article 94(3) EPC.

65. The chairman summed up: the committee gave a unanimous favourable opinion, subject to insertion of "at least" in paragraph 1, as suggested by the United Kingdom delegation ("at least one ground for opposition ..."), and deletion of the words "to be examined" in paragraph 2. In line with the new wording of Article 94 it also decided to retain, in the revised text, the existing wording of Article 101(2) EPC.

(xv) ARTICLE 105 EPC (CA/PL 25/00, page 111)

66. The United Kingdom delegation suggested an editorial amendment: replacing the word "it" in paragraphs 1(a) ("... against it ...") and 1(b) ("... it has ...") by "that third party".
67. The Swedish delegation thought that inserting the word "following" into proposed Article 105(1)(b) EPC created a new problem: the new provision could be understood as a chronological sequence.
68. The United Kingdom delegation said that in today's Europe it could be to a potential infringer's advantage to sue for a favourable decision (ie that he was not infringing the patent) in the national court where that ruling seemed most likely ("forum shopping"). The words "following a request" implied a chronology which in the old text was lacking. A more non-committal wording like that in the earlier text might be an improvement.
69. The Office said a certain chronology - sequence of steps - had always been assumed. The English text had merely been brought into line with the German and French versions, which were both very clear about this. The intention was that third-party intervention should be limited to those cases fulfilling both conditions in the requisite order, thus preventing any circumvention of the opposition period.

70. The chairman summed up: the delegations gave a unanimous favourable opinion on the Basic Proposal for Article 105 EPC, subject to the editorial amendments proposed by the United Kingdom delegation.

(xvi) ARTICLE 106 EPC (CA/PL 25/00, page 119)

71. The German delegation thought existing Article 106(2) EPC should be retained in the proposed new version.
72. The committee noted the German delegation's statement and gave a favourable opinion on the proposed wording of Article 106 EPC.

(xvii) ARTICLE 117 EPC (CA/PL 25/00, page 137)

73. The Netherlands delegation suggested that the Enlarged Board of Appeal be expressly mentioned, in view of the new procedure proposed in Article 112a EPC. The Swiss delegation endorsed this, particularly since it was uncertain whether DG 3 would remain part of the Office in the long term.
74. The chairman summed up: the committee gave a unanimous favourable opinion, provided that paragraph 1 expressly mentioned "the Enlarged Board of Appeal" as a body competent to take evidence or used a more general formulation.

(xviii) ARTICLE 120 EPC (CA/PL 25/00, page 143)

75. The United Kingdom delegation suggested a clarification of Article 120(b) EPC (deletion of "such"); particular categories of time limits were not the issue. In paragraph (a), "EPO" should be written out in full.
76. The chairman summed up: subject to the United Kingdom delegation's proposed minor editorial amendments to the English text (deletion of the word "such"; "EPO" written out in full), the committee gave a unanimous favourable opinion on Article 120 EPC as submitted in the Basic Proposal.

(xix) ARTICLE 123 EPC (CA/PL 25/00, page 151)

77. The Office said it had made a few minor editorial amendments to the previous draft, clarifying the content and wording of Article 123(3) EPC by saying "The European patent may not be amended in such a way ..." (ie deleting the reference to the claims).

78. The committee gave a unanimous favourable opinion on the amended proposal for Article 123 EPC.

(xx) ARTICLE 124 EPC (CA/PL 25/00, page 153)

79. Regarding the legal consequence under paragraph 2, the UNICE representative said that hitherto the question of what reasonable penalty the Office could apply in the event of non-compliance had been left open. It should now rather be specified in the Implementing Regulations; it could then be adjusted more easily if necessary. He then asked if the list under point 3 of the explanatory remarks was exhaustive.
80. The German delegation said the Office clearly had an interest in information from parallel proceedings, but there was a problem: what the words "the proceedings concerning them" covered. These were normally examination proceedings subject to national law and meeting different standards. Submitting every document relating to purely national peculiarities might give rise to a quite different evaluation in EPO proceedings and thus create a false impression. Also, the Office could be overloaded if supplied with too much information which was not always very relevant. US practice showed what could happen. As for penalties, deemed withdrawal was too harsh, particularly for minor errors. A more appropriate solution was needed.
81. The Swiss delegation was in favour of the provision as put forward in the Basic Proposal. As a compromise, a second sentence along the lines of "The Implementing Regulations may provide for exceptions to said penalty" could be added to paragraph 2, with those regulations then listing special circumstances where some other legal consequence applied.
82. The Belgian delegation too agreed with the proposal submitted, and endorsed the Swiss delegation's proposed compromise for Article 124(2) EPC. So did the Swedish delegation.
83. The German delegation was against the Swiss delegation's compromise proposal. It would be better if paragraph 1 made it clear that the obligation to provide information was limited to that needed to determine the closest prior art. In that case the existing penalty would be appropriate and could be retained. The Hellenic and Danish delegations and the *epi* representative endorsed the German delegation's proposal.

84. Replying to the delegations, the Office said the list was exhaustive, but not every point on it had to be met. The words "namely " and "notamment" in the English and French texts were incorrect and would be deleted. It was also prepared to delete point 3(iii) of the explanatory remarks. The legal consequence under Article 124(2) EPC could be specified in the Implementing Regulations, but had to stay as such in the Convention. Further processing was available as a remedy against any legal consequence. The German delegation's proposal was acceptable. Confining the information to the relevant prior art was a good idea which would be taken up in the revised Basic Proposal.
85. The committee gave a unanimous favourable opinion on the proposed text for Article 124 EPC, subject to three amendments:
- making it clear that "such information as shall be specified in the Implementing Regulations" was confined to the prior art.
 - replacing the word "notamment" in point 3 of the French text of the explanatory remarks with "à savoir"
 - deleting point 3(iii) of the explanatory remarks.

(xxi) ARTICLE 127 EPC (CA/PL 25/00, page 157)

86. The United Kingdom delegation thought the word "useful" was unnecessary; these "particulars" could be specified in the Implementing Regulations.
87. The Austrian delegation said the word "all" should be deleted as well.
88. The chairman noted that the committee gave a unanimous favourable opinion on proposed Article 127 EPC, subject to the above two deletions.

(xxii) ARTICLES 133 and 134 EPC (CA/PL 25/00, pages 169 and 173)

89. The United Kingdom delegation thought deleting "within the territory" and "sur le territoire" from the English and French versions of Article 133(2) and (3) might create legal uncertainty. The same reservation applied to all versions of Article 134(2)(b) EPC.
90. On Article 134 EPC, the German delegation suggested an addition to the "grandfather clause" taken over from Article 163 EPC, to specify that the necessary

five years' professional experience must not have been acquired in an existing contracting state.

91. The Monegasque delegation agreed to the new wording "in a Contracting State" and suggested replacing "conformément" with "conforme" in the French text proposed for Article 133(3) EPC.
92. The Belgian delegation wondered whether deleting the reference to "territory" was really only formal. After all, the provision as it stood had served its purpose since 1973.
93. The Office replied that every contracting state determined its own territory; given international law, the present wording merely stated the obvious. Article 168 EPC already defined the EPC's territorial field of application perfectly well, rendering the references to "territory" superfluous. The simplifications proposed would harmonise Articles 133 and 134 EPC, which at the moment were inconsistent. It could agree to the Monegasque delegation's suggestion.
94. The committee gave a unanimous favourable opinion on Articles 133 and 134 EPC, but suggested that the explanatory remarks should indicate that removal of the reference to "territory" in Article 133(2) EPC was not intended to alter the scope of the provision. Also, following an intervention by the German delegation, the committee noted that the wording of the second sentence of Article 134(3)(c) EPC needed to be brought into line with the first sentence of existing Article 163(3) EPC. It also noted the Monegasque delegation's suggestion that "conformément" be replaced by "conforme" in the proposed French version of Article 133(3) EPC.

(xxiii) ARTICLE 134a EPC (CA/PL 25/00, page 179)

95. The chairman said the above outcome on Article 134 EPC applied equally to Article 134a EPC, the United Kingdom delegation having expressed the same misgivings as those just discussed in connection with Articles 133 and 134 EPC.
96. The *epi* representative explained his organisation's proposal that provision be made for representative-client privilege. Under US case law on "discovery" proceedings, a counterparty could be ordered to disclose documents in his possession. At present, there was no provision for European professional representative-client

privilege. The Convention should mention it, so that the Administrative Council could adopt the necessary provisions in the code of professional conduct. The proposal would also harmonise national laws governing European patent agents, and provide confidentiality protection for attorneys employed in industry.

97. The German delegation said the arrangements proposed would also apply to employees in industry.
98. The Office said the proposal's sole purpose was to create the basis for the Administrative Council to adopt appropriate rules. Such rules would be confined to professional representatives. Also, the absence of any binding rules on attorney-client privilege in EPO proceedings sometimes put European attorneys at a disadvantage to their US counterparts. The proposal should therefore be included in revised form in the Basic Proposal; it could then be looked at again. To that end, the *epi* should submit written arguments in support of its proposal.
99. The Swiss delegation said it was in favour of attorney-client privilege, but was not sure that this was the right approach: the *epi* proposal, if it had understood correctly, was directed towards US discovery procedures and harmonisation of national law in the contracting states. If that was indeed the intention, the Swiss delegation endorsed the German delegation's position. But it was well disposed towards a provision confined to EPC proceedings.
100. The French delegation, the representative of UNICE and the staff representatives endorsed the *epi* proposal, the latter pointing out that it was a useful extension of the confidentiality obligations of EPO examiners.
101. The *epi* representative stressed that the proposal was confined to patent attorneys' activities as professional representatives and thus to proceedings before the EPO.
102. The chairman summed up: the *epi* proposal would be included in the revised Basic Proposal as a new paragraph 1(d), and the *epi* would provide the committee with the arguments backing it up.

(xxiv) ARTICLE 138 EPC (CA/PL 25/00, page 187)

103. The Office pointed out some additional changes to the wording of the present Basic Proposal. In paragraph 3, the word “corresponding” was to be deleted and the words “in revocation proceedings” replaced by the formulation “in proceedings relating to the validity of the European patent”.
104. The United Kingdom delegation expressed its support for the revised version. It requested that note be taken that the title of the provision no longer reflected its content.
105. The French delegation explained that consultations on this matter were still ongoing and that for this reason it could not yet adopt a definitive position. It considered that the proposal was going in the right direction, but stressed that the wording of Article 138 EPC should be consistent with the newly introduced procedure under Articles 105A-C EPC.
106. The Austrian delegation felt that the proposal was satisfactory. However, in the “Explanatory remarks” (point 3), the words “... und stellt klar ...” in the German version (“... designed to make it clear ...”) should be replaced by “... und bestimmt ...” to indicate that this is a normative provision that has an impact on national legislation.
107. The Netherlands delegation backed the proposal. In response to its query, the Office clarified with regard to point 5 that it was not the limited part but rather the part that the patent proprietor had chosen to forfeit by limitation that could be revoked by the court without further substantive examination. The final sentence would be revised. Point 3 could be adapted in line with the suggestions made by the Austrian delegation.
108. The Swedish delegation said that it accepted the proposed wording of paragraphs 2 and 3. It would, however, have to express a reservation as this rule could cause controversy in the circles concerned in Sweden.
109. The committee gave a favourable opinion, subject to a number of editorial changes to paragraph 3 (deletion of the word “corresponding”; replacing “in revocation proceedings” by “in proceedings relating to the validity of the European patent”; adapting the article title) and to clarifications and additions to points 3 and 5 of the “Explanatory remarks”. The committee noted the reservations of the Swedish and French delegations.

(xxv) PROTOCOL ON CENTRALISATION

110. The German delegation said with regard to Section I(3)(a) and (b) of the Protocol on Centralisation that as a result of the deletion of the allocation of duties to the Berlin sub-office, the Administrative Council could redefine the Berlin sub-office's tasks. This could impact on Germany's obligation to bear the additional cost of the Berlin sub-office. The German delegation announced that it would give the Administrative Council a written statement in September to the effect that this issue should be left open at the Diplomatic Conference and a solution sought at a later stage that could not be interpreted as impinging on Germany.
111. The chairman noted that the committee had given a positive opinion on the proposal. The reservations of the German delegation were recorded.

IIIcc. LIST OF CATEGORY "C" ARTICLES

(i) ARTICLES 22 and 112a EPC

112. The Swedish delegation said that the provisions governing the composition of the Enlarged Board should remain in the EPC as the composition of a deciding body should not be decided on by the Administrative Council. Therefore, Article 22 EPC should at least contain a provision regarding the minimum number of members.
113. The German delegation stressed that it still approved of the idea of a review procedure. As all the substantively important key provisions should be contained in the Convention, so too should all important procedural issues (eg ruling out oral proceedings and admissibility of the petition for review).
114. The Belgian delegation suggested that Article 112a(1)(b) EPC should refer to the existence of a final court decision rather than to the Implementing Regulations. The most important procedural provisions should be dealt with in the Convention.
115. The Swiss delegation called for a more precise definition of the term "criminal act" in Article 112a(1)(b) EPC: "... if a criminal act established as final by a competent court may have had an impact on the decision". The separate rule in the Implementing Regulations could then perhaps be dropped.

116. In response to the delegations' comments, and particularly the questions raised, the Office said the Swedish delegation's suggestion to specify a minimum number of members in the Convention was a possible compromise. If oral proceedings were not excluded from the "acceptance procedure", the desired aim (rapid processing) would be frustrated. The exact form of the procedure should however be set out in the Implementing Regulations. The Belgian proposal to replace "criminal behaviour" by "sentence which is res judicata" was problematic as a res judicata sentence need not necessarily have been passed (eg circumstances preventing the passing of sentence). The principle that not everything could be laid down in the Convention also applied to this question.
117. The committee gave a favourable opinion on the proposal, subject to an amendment to Article 22(2) EPC specifying the minimum number of Enlarged Board of Appeal members. The Swedish and German delegations added the proviso of an examination.

(ii) ARTICLES 33 and 35 EPC (CA/PL 25/00, pages 21 and 25)

118. The Irish delegation supported the proposed changes to Articles 33 and 35 EPC. Regarding the committee's mandate to deal with this matter, it quoted Article V of the Paris intergovernmental conference mandate ("bring into line..."). It referred to the Council of Europe provisions in connection with the constitutional problems that some delegations had with the simplified procedure. As most of the delegations were members of this body, it was possible that the selected approach was nothing more than that already in place at Council of Europe level. The words in square brackets in Article 33(1)(b) should be deleted. In the English version of Article 33(1)(b), final sentence, "on patents" should read "relating to patents" .
119. The Swiss delegation also supported the Basic Proposal concerning Article 33 und 35 EPC. In Article 35(3) EPC, last half-sentence, the word "ihn" should be deleted in the German version to make it perfectly clear that the decision would not enter into force not just in that state but anywhere.
120. The Austrian delegation accepted the Basic Proposal, subject to the Swiss delegation's changes. The text in square brackets in Article 33(1)(b) EPC should be deleted. As Austrian agreement to the Basic Proposal would entail an amendment of constitutional provisions, it had to add a political proviso.
121. The Danish delegation stated that the constitutional situation in Denmark vis-à-vis the proposed change was unclear and that it could not yet adopt a definitive position. In principle, it considered the proposal to be sound as it provided flexibility

and at the same time afforded national interests sufficient protection. The text in square brackets in Article 33(1)(b) EPC should be deleted.

122. The Belgian delegation was in favour of deleting the text in square brackets in Article 33(1)(b) EPC. It was happy with the formulation "relating to patents" provided that it did not rule out international agreements which did not relate exclusively to patent law but nonetheless affected the EPC (eg TRIPs, Convention on Biological Diversity). A definition of the term could be provided in a separate explanation. Article 35(3) EPC of the Basic Proposal was acceptable. The last sentence of this paragraph was very awkward, at least in the French version. The proposed provision would not encounter any constitutional opposition in Belgium. The Swiss delegation's proposal was also supported.
123. The Portuguese and Italian delegations expressed their overall support for the proposed text, subject to the suggestions made by the Irish delegation.
124. The French delegation backed the proposal in principle and agreed with the comments made by the other delegations; it supported in particular the amendments proposed by the Swiss and Irish delegations.
125. The United Kingdom delegation expressed its support for the proposal, subject to the amendment to Article 33(1)(b) EPC proposed by the Irish delegation.
126. The Hellenic delegation agreed with the text of the Basic Proposal but favoured retaining the text in square brackets. It also suggested several editorial improvements to Article 33(1)(a) EPC (see earlier proposal) and Article 35(3) EPC. Instead of the unanimity requirement, a revision clause adapted from other international agreements in the area of industrial property could provide for a three-quarters majority, as two requirements had to be met in any case according to the proposed version (unanimity and no objection raised within 12 months). These measures were too harsh.
127. In reply to this, the French delegation suggested that in the French version of Article 33(1)(a) EPC the word "dispositions" was more appropriate than the word "articles", although "les dispositions énumérées" could be dropped from the first paragraph.
128. The Monegasque delegation backed up the French proposal concerning Article 33(1) EPC. In addition, it felt that the text in square brackets should be

deleted. It supported the Swiss delegation's proposal concerning Article 35(3) and also supported the Basic Proposal.

129. The Spanish delegation stated that while it could not yet adopt a definitive position, as the internal clarification procedure was still going on, it took an initially positive view of the Basic Proposal.
130. The Netherlands delegation was in favour of the proposed changes. In Article 33(1)(b) EPC, the text in square brackets should be deleted. It endorsed the proposal of the Irish delegation ("relating to patents") and that of the Swiss delegation concerning Article 35(3) (delete "ihn").
131. The Luxembourg delegation expressed its support for the Basic Proposal. The text in square brackets in Article 33(1)(b) EPC should be deleted along with the superfluous wording at the end of the first sentence of Article 33(1) EPC. It must be ensured, possibly by adding a separate comment, that the reference to international treaties and EU provisions be loosely interpreted. Editorial amendments were necessary in Article 35(3), final sentence, EPC, at least in the French version.
132. The Swedish delegation said that it could not yet adopt a definitive position as there were constitutional issues that required further consultation in Sweden. Regarding the wording of the article, it favoured deleting the text in square brackets Article 33(1)(b) EPC; it supported the Swiss delegation's proposal re Article 35(3). The Hellenic delegation's proposal to qualify the safety clause was completely unacceptable.
133. The Finnish delegation expressed its support for the Basic Proposal, subject to the changes proposed by the Irish and Swiss delegations.
134. The German delegation also referred to constitutional problems. It was, in principle, in favour of greater flexibility but was bound by constitutional provisions relating to preserving sovereignty. However, it signalled its basic approval of the legal mechanism with the current legal provisions. The text in Article 33 EPC in square brackets should be deleted. Article 35(3), first and second sentences, EPC should be retained; the third sentence was superfluous. The suspensive effect provision was not relevant to Germany in any case as Administrative Council decisions of this type could only be approved if a prior decision had been taken by the German legislative bodies. It therefore approved the Hellenic delegation's proposal and

suggested placing the text regarding the suspensive effect in square brackets. It regarded the principle of unanimity as being of central importance.

135. The Hellenic delegation stated that the proposals of both delegations would have the same net effect. The final sentence in Article 35(3) EPC could be placed in square brackets.
136. The Cypriot delegation supported the Basic Proposal, subject to the changes to Article 35(3) EPC put forward by the Swiss delegation and to Article 33(1)(b) EPC put forward by the other delegations.
137. In response to the comments made by the German and Hellenic delegations, the Swiss delegation said that the provision indeed had the potential to cause various constitutional problems but that these had been fully taken into account in the proposal. In some states, parliament had to be consulted prior to an Administrative Council decision and afterwards in other states. That was why it opposed putting the third sentence of Article 35(3) EPC in square brackets.
138. In view of the above, the German delegation stated that it would now abandon its earlier proposal to put the passage in square brackets.
139. The Irish delegation made another suggestion relating to Article 35(3) EPC to the effect that a rule would be written into the Convention allowing the proposed change to be announced six or nine months before a decision was to be made by the Administrative Council in order to permit consultations with national legislative bodies.
140. The chairman concluded that all delegations had seen the Basic Proposal in a very positive light. The following editorial changes would be made:
 - the deletion of the text in square brackets in Article 33(1)(b) EPC (AT, BE, DE, DK, FI, FR, IE, IT, LU, MC, NL, PT, SE and GB);
 - the reformulation of the phrase "on patents" in Article 33(1)(b) EPC (IE, FR, PT) to "relating to patents";
 - the deletion of the word "ihn" from the German version of Article 35(3) (AT, CH, CY, FI, FR, LU, MC, NL and SE);
 - the deletion of the last part of the first sentence in Article 33(1) EPC and replacement with "les dispositions énumérées ci-après" (FR, LU, MC);
 - the Hellenic delegation's proposal to replace the term "les dispositions" with "les articles" in the French version would not be adopted;

- the term "relating to patents" in the "Explanatory remarks" is to be clarified to the effect that it applies not just to international treaties and European Union legislation relating solely to patents (BE and LU);
- the proposal to delete the last sentence in Article 35(3) or to put it in square brackets (DE and GR) was no longer backed by the German delegation;
- as the Irish delegation's proposal for an alternative provision to Article 35(3) was only made at the present meeting and given that there was no time to discuss it, preference was given to the formulation in the Basic Proposal.

141. The French delegation expressed the desire that the changes that could be made to the Implementing Regulations due to amendments to Article 80 EPC be mentioned in Article 35(2) EPC. The Office stated in response that no new decision would be taken on Article 80. The chairman stressed that Article 80 EPC came under the scope of Article 33(1)(c) EPC and not Article 35(2) EPC.

142. The chairman noted that the committee gave a unanimous favourable opinion on Article 35(1) and (2) EPC in the proposed form.

(iii) ARTICLE 52 EPC (CA/PL 25/00, page 37)

143. The United Kingdom delegation advised against approving the proposed amendment to Article 52(2)-(4) EPC. It was unacceptable for the United Kingdom delegation, at least for the time being. In view of the key importance of the regulation and the EU work on a directive on the subject, it would be best to wait and have a more in-depth debate on the matter. If an EU directive were adopted, revised Articles 33 and 35 EPC could serve as a "fallback" by making it possible to amend the regulation without necessitating a diplomatic conference. Deleting the provision on computer programs from the EPC might send out the wrong signal about a deregulation of the system. The UK delegation's reservation also related to the fact that this key provision of the EPC should remain in the Convention. It therefore felt that Article 52(2)-(4) EPC should remain unchanged for the time being. It supported the proposed amendment of Article 52(1) EPC provided that it was brought into line with the TRIPs provisions. The Spanish and Swedish delegations agreed with the UK delegation regarding the revision of Article 52(2) and (3).

144. The Swiss delegation was of the different opinion that Article 52(2) and (3) EPC should be deleted entirely. Once Article 52(1) EPC was amended, a step it approved of, exclusion provisions would no longer be necessary as the criterion "technical character" of the invention was enough to differentiate it from non-patentable creations. In Switzerland Article 52(2) and (3) EPC would never have been implemented in national law without diverging from EPO practice. No new input was to be expected from the EU provision as it would simply codify the *status quo*. The Swiss delegation supported the *epi* proposal in Info 2/PL 14, which envisaged the complete deletion of Article 52(2) and (3) EPC.
145. The *epi* representative referred to Info 2/PL 14 and said it was in favour of deleting paragraph 2 because it was outdated and a formulation of paragraph 1 that was in line with TRIPs would be sufficient. It should be left to the EPO boards of appeal and the national courts to develop their own case law on issues relating to non-patentable inventions.
146. The French delegation said there was a discrepancy between the French version of Article 52(1) and TRIPs. Article 27(1) TRIPs should be reflected in Article 52(1) EPC. It supported deleting the reference to computer programs from Article 52(2) EPC. The list of non-patentable inventions should inter alia concur with public opinion and remain in the Convention. Adding a definition of the term "invention" to the Implementing Regulations would not be the preferred alternative of the French delegation. While the rationale behind the intended transfer of the provision in Article 52(4) EPC to Article 53 EPC was clear, it should nevertheless remain in Article 52 EPC. The Monegasque delegation concurred.
147. The Irish delegation agreed to the proposal to bring Article 52(1) EPC into line with the TRIPs provisions. It could not yet adopt a definitive position on Article 52(2) and (3). It might be acceptable to transfer it to the Implementing Regulations but complete deletion was out of the question. The provision governing computer programs could be deleted from the Convention. A definition of the term "invention" was perfectly acceptable as a provision in the Convention as conflicts under Article 164(2) EPC might otherwise arise. There were considerable objections, also in relation to the appeal boards' case law (see T 465/92), against including what is known as the "problem-solution approach" in such a definition. The incorporation of Article 52(4) EPC into Article 53 EPC was supported.
148. The Danish delegation favoured the UK delegation approach. It agreed to the proposed amendment of Article 52(1) EPC. The provision governing computer programs in the second paragraph should be deleted. The "Explanatory remarks"

should state how far-reaching the consequences of removing computer programs from the list of non-inventions were expected to be. A study was currently being carried out in Denmark on whether the grounds for exclusion should be deleted entirely from the Patent Law. As this study had not yet been concluded, it could not yet adopt a definitive position on the matter. Paragraph 4 should not now be transferred to another article.

149. The proposed new version of Article 52(1) EPC to harmonise it with the TRIPs provision met with the broad approval of the other delegations. Some delegations (AT, CY, ES, FI, GR, LU, NL, SE) and the UNICE representative favoured the formulation in the Basic Proposal while other delegations (BE, IT, MC, PT) sided with the French delegation in its preference for a formulation that was closer to the wording of the relevant TRIPs provision.
150. With regard to the list of non-inventions in paragraphs 3 and 4, it became apparent as the discussion continued that the delegations' opinions differed greatly from one another. Some delegations (AT, GR, IT) and the UNICE representative favoured the complete deletion of the provisions from the Convention. Other delegations, however, remained committed to a legislative provision. Certain delegations (CY, DE, DK, ES, FI, FR, LU, MC, PT) said the provision should remain in the Convention because of its fundamental importance; other delegations (BE, GR, IT and NL) considered the proposed ruling in the Implementing Regulations to be adequate.
151. There was broad support from the delegations for the deletion of the computer program provision in paragraph 2(c). The Netherlands delegation made the point that the problems concerning the protection of computer programs could not simply be solved by deleting the provision in Article 52(2) EPC as other regulations, eg the EU directive, could affect the issue. The deletion should be explained in greater detail in the "Explanatory remarks". The Luxembourg delegation, however, was against deleting the computer program provision from the list of non-inventions, saying in support that a new version should not create the impression that a change in existing practice was being sought. The German delegation suggested that a decision on whether or not to delete the provision concerning the non-patentability of computer programs should be taken by the Administrative Council rather than the committee, given that it was a political issue.
152. The majority of delegations (AT, BE, CY, DE, ES, GR, IT, LU, PT, SE) agreed to the transfer of the current provision in Article 52(4) EPC to the revised Article 53

EPC as this step was a logical legal amendment. The UNICE representative informed the committee that EFPIA wished to go a step further and delete the fourth paragraph entirely.

153. A definition of the term "invention" above and beyond the proposed formulation in Article 52(1) EPC was considered by the delegations to be neither necessary nor useful. Should a definition be incorporated, some delegations (BE, LU, PT and SE) felt that it should appear in the Convention.
154. The Belgian delegation stated that it could not yet adopt a definitive position.
155. The Office responded to the delegations' comments and stressed that all proposals made by the committee were subject to political scrutiny. Although the deletion of the computer program provision would not pose any problem, there were questions about how to deal with the rest of the provision. Paragraphs 2 and 3 should therefore be put in square brackets except for the computer program provision, which should definitely be deleted. The revised Basic Proposal could then form the basis for discussions at the next Administrative Council meeting at the intergovernmental conference in London. There was unqualified support for the amendment of the first paragraph apart from a difference of opinion concerning the terms "domaine de la technique" and "domaine technologique". The proposal to provide a separate definition of the term "invention" would be dropped. Article 52(4) EPC would be retained as it appeared in the Basic Proposal. In a comment directed at the French delegation, the Office stated that if the provision were to remain in place as Article 52(4) EPC, the old wording would have to be retained as it would have to be formulated there as a quasi-definition through a fiction, whereas, if it were transferred to Article 53 EPC, it could be formulated as an exception. This was also in line with the TRIPs approach.
156. The Chairman summarised the outcome of the debate. The delegations took the following positions on the various questions:
 - 15 delegations were in favour of deleting the words "programs for computers" from the list of non-patentable inventions in Article 52(2) EPC: BE, DK, FI, FR, IE, IT, ES, MC, AT, PT, NL, CH, SE, GR, CY.
 - With regard to a fundamental revision of Article 52(2) EPC, opinion within the committee was divided as follows:
 - 9 delegations were in favour of retaining Article 52(2) EPC in the Convention: CY, DK, DE, ES, FI, FR, LU, MC, PT.
 - 7 delegations were in favour of transferring the list of exceptions (non-inventions) in Article 52(2) to the Implementing Regulations: BE, IE, NL, AT, CH, GR, IT.

- 4 delegations wanted to delete the list of exceptions entirely (no mention in either the European Patent Convention or the Implementing Regulations): GR, CH, AT, IT.
- 8 delegations were against the principle of defining an "invention": IE, ES, DE, GB, SE, AT, MC, FR.
- 3 delegations were in favour of a legally binding definition of an "invention", provided that such a definition was necessary: PT, BE, LU.
- 3 delegations were against transferring Article 52(4) EPC to Article 53 EPC: DK, FR, MC.

On a proposal from the chairman, it was agreed that:

- Article 52 EPC in the wording appearing in the Basic Proposal was to be retained, subject to editorial adaptation of the French version to match Article 27(1), first sentence, of the TRIPs Agreement.
- the words "programs for computers" were to be deleted.
- opinions were divided over retaining exceptions within the Convention or transferring them to the Implementing Regulations.
- the wording of the present Article 52(4) EPC was to be transferred to Article 53 EPC.

(iv) ARTICLE 53 EPC (CA/PL 25/00, page 41)

157. The Swedish delegation withdrew its comment regarding this provision given that Article 53 EPC had been amply discussed in connection with Article 52 EPC.
158. The Chairman therefore noted that the committee had given a favourable opinion on Article 53 EPC in the proposed version.

(v) ARTICLES 105a-c EPC (CA/PL 25/00, page 113)

159. The *epi* representative said that he supported the Basic Proposal in principle. The regulation should ensure that the protection provided should not go beyond that conferred by the patent as granted. In view of this, the wording could be clarified to the effect that it had to be a genuine limitation and not an extension of the scope of protection.
160. The Office responded that the limitation check meant that the question of Article 123(3) EPC did not arise. This problem was implicitly covered by the term "limitation". The "Explanatory remarks" could make clear that that was the intention of the procedure.

161. The Irish delegation suggested that third parties should be given the possibility of making infringements of Article 123 EPC known. The term "limitation" should be clarified in the "Explanatory remarks". The Office said that consideration should be given to including an additional indication in Article 115 EPC that third parties had the right to supply information in limitation procedures.
162. The Swedish delegation favoured deferring discussion of this provision until a follow-up conference. It could not yet adopt a definitive position and would therefore have to express reservations about the proposed provision. It could, however, make general comments about the proposal: Article 105A was too broadly worded. The article should lay down whether the limitation applied to claims only or also extended to the description. Article 105B should contain a provision regarding the Office's scope of examination, as a reference to the Implementing Regulations was not sufficient. Article 105B(3) did not state clearly that limitation would not take retroactive effect. The revised Article 68 EPC would have exactly the opposite effect however. The text should be reformulated to eliminate these possible inaccuracies.
163. The French delegation stated that the proposal had already been approved in principle. The provision should clearly express that the limitation procedure could not lead to an extension of protection. Limiting the procedure to the patent claims could solve the problem. It was therefore also important that Articles 84 and 123(2) EPC remain in the Convention. The relationship between Articles 105A-C and Article 138(2) EPC was still unclear. National proceedings should not be unduly delayed.
164. The Danish delegation expressed an opinion, but said that the constitutional consequences needed to be examined. The parties concerned had indicated that there was no great need for a procedure of this kind in Denmark as it would only hold up the proceedings. Any provision should therefore stipulate that a limitation procedure be completed within one to two months. Suspending national proceedings for the duration of the limitation procedure was not acceptable for political and other reasons.
165. The German delegation pointed out that it would be most unfortunate if freshly raised questions of detail or reservations were to result in the limitation procedure provisions not being adopted in November.
166. The United Kingdom delegation reported that the interested circles in the United Kingdom supported the proposal on the understanding that it put in place a simple, effective procedure to limit patents before the EPO. The only reservation expressed was that no time limit had been imposed on the procedure and that national procedures could thus be held up. The *ex parte* proceedings outlined in

the Basic Proposal largely did away with this objection. To rule out possible procedural abuses on the part of the patent proprietor, Article 105B(2) EPC should grant the Office a degree of discretion. The proposal should be adopted without fail at the present meeting.

167. In response to the delegations' comments, the Office explained that under the limitation procedure it was only possible to limit the claims (see point 2, "Explanatory remarks"). This was stated explicitly in the Implementing Regulations in keeping with the provision applicable to revocation or opposition proceedings. The "Explanatory remarks" also made clear that a limitation implied a reduction in the scope of protection. The provisions of Article 105B EPC stipulated that the requirements of Articles 123(2) and 84 EPC have to be checked. There was no need to refer to Article 123(3) EPC as limitation necessarily ruled out extension of the scope of protection. Clarification could be provided in the "Explanatory remarks". With regard to the relationship between the limitation procedure before the European Patent Office and national revocation proceedings, the Office said that the patent proprietor could institute limitation proceedings even though revocation proceedings were pending. It was at the discretion of the national court to suspend pending proceedings if European limitation proceedings were under way. In this respect, there was no difference to the European opposition procedure already in place. In addition, a national court could revoke a patent extending beyond the content of the limited version. The assumption was that following revocation proceedings a request for corresponding limitation would normally be made to the European Patent Office. There was deliberately no time limit on the limitation procedure. It should be applicable at any time during the entire term of the patent to ensure that all parties concerned were on a level playing field. The introduction of a degree of discretion would mark a whole new approach not provided for previously in the EPC. The procedure would be hindered by the fact that the Office would have to carry out investigations into the patent proprietor's actions. However, this issue had not been considered further in the discussions on Article 138 EPC.
168. The Austrian delegation said that "limitation" affected not just the extension of the scope of protection but also the question of inadmissible limitation by means of features not originally disclosed. This should be addressed in the "Explanatory remarks". It was not logical to include a provision in the Implementing Regulations to the effect that limitation took the form of a limitation of the claims as the Convention already contained a corresponding provision in Article 138(2) EPC.

169. The Office endorsed the Austrian delegation's proposal, which was similar to that of the Swedish delegation. It would be made clear in the Convention that limitation took the form of an amendment of the claims.
170. The United Kingdom and French delegations said that they had been swayed by the Office's explanations and arguments. The Office's explanations should be incorporated to the extent possible into the Convention or the Implementing Regulations in order to dispel any doubts among the interested circles.
171. Regarding Articles 105A-C, the committee gave a favourable opinion on the proposal, subject to the following clarifications/amendments:
- precise indication in point 2 of the "Explanatory remarks" that the limitation procedure is designed to limit only the protection conferred by the patent
 - indication in point 5 of the "Explanatory remarks" of the requirements of Article 123(3) (extension)
 - indication in a new point in the "Explanatory remarks" of the relations that may exist between national revocation proceedings and the European limitation procedure, particularly in terms of the suspension of proceedings
 - a new point in the "Explanatory remarks" defining the concept of "limitation"
 - express indication in the wording of Article 105A that limitation is restricted to the claims (see the related Article 138(3)).

The committee also noted the reservations voiced by the Swedish and Danish delegations about the appropriateness of dealing with these articles at the Diplomatic Conference in November.

(vi) ARTICLES 121 and 122 EPC (CA/PL 25/00, pages 145 and 147)

172. The Swedish delegation justified its request for a renewed discussion of this provision with the same argument that it used with regard to Articles 105A-C EPC. It had reservations about agreeing to such a wide-reaching provision on further processing as was contained in the Basic Proposal. There had been a balance between Articles 121 and 122 EPC to date. It could not yet adopt a definitive position. It would be a great help in this particular case to obtain at least a first draft of the relevant Implementing Regulations prior to the Diplomatic Conference.
173. The Office responded that it would not be possible to draft the Implementing Regulations by the start of the Diplomatic Conference. At best an indication of what it had in mind for inclusion in the Implementing Regulations could be given.

174. The German delegation said that it shared most of the Swedish delegation's reservations. It suggested that at least the time limits in respect of which further processing was ruled out should be specified in the Convention.
175. The Netherlands delegation said that while it had certain reservations about an extension of the further processing provisions, it would not go against the majority opinion. It would support the German delegation's proposal regarding the inclusion of the exceptions in Article 121 EPC. The level of the further processing fee should be reconsidered. The reference to Article 15 PLT in the "Explanatory remarks" (point 1) did not seem to constitute appropriate grounds for the proposed amendment as Article 15 PLT was more or less the same as the current Article 121 EPC.
176. The Irish delegation proposed introducing a provision that would correspond to Article 122(6) EPC.
177. The French delegation welcomed an extension of the further processing provisions. A balance needed to be struck between Article 122 and Article 121 EPC. The Convention should lay down the time limits in respect of which further processing did and did not apply. It was not clear whether Article 121 EPC covered the time limit for paying renewal fees.
178. The *epi* representative suggested not just limiting the scope of application of Article 121 EPC to the patent grant procedure but extending it to all procedures before the EPO. Although this did not involve many time limits, it would still be a considerable improvement.
179. The Office responded that an extension of the scope application of Article 121 EPC to the opposition procedure was not intended. Article 121 EPC did not apply to the payment of renewal fees. In future, not only would it be possible to pay an additional fee in respect of late payment but re-establishment of rights in respect of the time limit for payment of the renewal fee would also be possible. This would be made clear in the "Explanatory remarks". The Implementing Regulations was the appropriate place to deal with time limits in respect of which further processing and re-establishment of rights was possible. As the main time limits involved were those for further processing and re-establishment as well as the priority time limit, all of which were excluded from further processing, they could be included in the Convention with the addition of an indication that other exclusions could be provided for in the Implementing Regulations. The results achieved with the PLT, which corresponded with current EPO practice, could be looked on as a source of inspiration for further development of the EPC. The EPC had served as a model that had been adopted internationally. The PLT also provided for exclusions in the Implementing Regulations. Provisions governing intervening rights were inappropriate given the short time frame in which further processing usually took place.

180. The German delegation said that it maintained its demand that the time limits excluded from further processing be dealt with in the Convention.
181. The chairman noted that the committee gave a unanimous favourable opinion on the proposals, subject to an amendment to Article 121(1), last sentence, to the effect that at least the exclusions mentioned in point 3 of the "Explanatory remarks" should be expressly included in said paragraph, with the addition of an indication that other exclusions could be specified in the Implementing Regulations.

(vii) ARTICLE 149a EPC (CA/PL 25/00, page 191)

182. The French delegation advocated incorporating the protocols in the Convention. One of the options in the Protocol on cost reduction (translation in a non-official language) was missing from Article 149a(1)(c) EPC. Given the possibility of central filing of translations and the need for a legal basis for financing of the common entity and the common patent court by the European Patent Organisation, this option should be provided for in the Convention. The drafting of the article should be postponed until further information on the likely wording of the protocols was available.
183. The Office replied that Article 65 EPC simply defined the maximum translation requirements that a state could demand. Every state was at liberty to pitch its requirements below the maximum provided for in Article 65 EPC and to dispense with a translation into its official language or to implement an arrangement in keeping with the Protocol on languages. This solution was fully compatible with Article 65 EPC. Article 149a(1)(c) EPC implicitly regulated the financial side of central filing and publication of translations by the EPO. Clarification could be provided in the "Explanatory remarks".
184. The German delegation said it agreed in principle to Article 149a EPC. The formulation of sub-paragraph 1(b) was incomplete, since the Working Party on Litigation at its meeting in Luxembourg had extended the scope of referrals to include national patent law issues. The Office replied that the extended jurisdiction of the common entity would be taken into account in the Basic Proposal.
185. The Austrian delegation supported the German delegation and suggested a modification to sub-paragraph 1(b) to allow Austrian revocation divisions to refer issues to the common entity.
186. The UK delegation was in principle in favour of the proposed arrangement, but pointed out that sub-paragraphs 1(a) and (b) already referred to deciding bodies

whose existence and powers were not yet certain. It therefore thought it best to formulate the provision as broadly as possible. It suggested dividing sub-paragraph 1(c) into two separate provisions, one dealing with the agreement on translations, the other with centralised filing and publication.

187. The head of the Netherlands delegation in his capacity as chairman of the sub-group of the Working Party on Litigation reported on the status of its deliberations. He felt the proposed wording of paragraph 1 risked leaving insufficient latitude to respond to possible developments. Too narrow or precise a formulation restricted this freedom, so the UK delegation's suggestion was preferable.
188. The Hellenic delegation shared the UK delegation's reservations. Sub-paragraph 1(c) should be split into two separate provisions, and the issue of central filing should be regulated independently.
189. The Italian delegation said it was not convinced of the need to incorporate the substance of Article 149a EPC in the Convention, as there was nothing in the Convention to prevent contracting states from concluding such agreements. It did not support the Office's proposal.
190. The Luxembourg delegation on the other hand held that the substance of Article 149a EPC should be enshrined in the Convention. The highly detailed formulation of the present proposal was not entirely satisfactory.
191. The Swiss delegation reaffirmed its support for a clear and precise definition of a basis for the agreement on creating a European patent court, which it had fully substantiated at the committee's previous meeting. It agreed in principle to the wording of Article 149a(1) EPC. The new EU Regulation created no problems with regard to sub-paragraph 1(b), so a more general formulation could be chosen for it. In allowing for the common entity's wider advisory powers, it should be borne in mind that this extended only to issues of harmonised national law. Otherwise Article 149a(2)(b) EPC would have to state that expenses incurred by the common entity in relation to national law issues would not be borne by the European Patent Organisation. For sub-paragraph 2(b) the delegation suggested adding a reference to the limited duration of support for the common entity (" ... its duties. Such support shall continue until a common court of appeal has been set up. The expenses ...").

192. Commenting on the Swiss delegation's proposed amendment to Article 149a(2)(b) EPC, the Office said there would be a clear indication in the "Explanatory remarks" that financial support from the European Patent Organisation was of limited duration, ceasing once the common patent court took over the common entity's duties. The wording of the existing proposal already implied that the Administrative Council could discontinue support for the common entity at any time, not just if a common patent court were to be set up.
193. The Danish delegation shared the Italian delegation's view of paragraph 1. Regardless of financing by the European Patent Organisation, paragraph 2 had to make a clear distinction between the EPO boards of appeal and the common court.
194. The UK delegation proposed an editorial amendment to sub-paragraphs 1(a) and 1(b) with a view to a more flexible formulation. It was supported by the Hellenic and Netherlands delegations but opposed by the French delegation.
195. The *epi* representative further stressed how important it was for the common entity to be independent of the European Patent Organisation. He supported the delegations which had voiced similar sentiments.
196. The chairman noted that the committee gave a favourable opinion on the proposal, subject to the following reservations:
- the proposed wording should be amended to include a reference to "harmonised national law"
 - the words "or quasi-judicial authority" should be inserted in the new Article 149a(1)(b) EPC (compare with Article 11 EPC)
 - regarding Article 149a(1)(c) EPC, the option of filing translations with the European Patent Office should be dealt with in a separate provision (new sub-paragraph (d)), it being left to the Office to verify whether any such provision needed to be expressly included in Article 149a EPC
 - the "Explanatory remarks" should indicate that the Administrative Council may discontinue financing of the common entity, for instance once the common European patent court goes into operation
 - regarding the provisions relating to the optional Protocol on litigation, greater generalisation in the wording of Article 149a EPC was sought.

(viii) ARTICLE 164 EPC (CA/PL 25/00, page 237)

197. The French delegation was in favour of retaining the present wording of Article 164 EPC, with the addition of a reference to the Protocol on Staff Complement.

198. The chairman established that none of the other delegations supported the French delegation's proposal and therefore noted that the committee gave a favourable opinion on the proposal for Article 164 EPC as set out in the Basic Proposal.

(ix) ARTICLE 54 EPC (CA/PL 25/00, page 43)

199. The *epi* representative tabled the proposal set out in Info 2/PL 14 e. Unlike the first medical use, further medical uses of a known substance were only inadequately protected. Although Enlarged Board of Appeal decision G 6/83 confirmed that such inventions are eligible for protection, the present situation was unsatisfactory because national courts did not consistently recognise European patents in this field. The delegation therefore proposed that a new paragraph (6) be added to Article 54 to guarantee the patentability of a substance for further therapeutic applications. The important thing was to maintain the existing protection for the first indication as it was while putting protection for the second and further indications on a sound legal footing. Unlike the Office's proposal, the *epi* proposal envisaged dealing with the first and second indications separately.
200. The Swiss delegation supported the *epi* proposal. It referred to decision G 1/83, which had provided for effective legal protection of the second medical indication. Legal certainty could be enhanced by enshrinement in law. It stressed the difference in terms of the content of the inventions between the first and any subsequent indications. These should not be merged in a single paragraph, as the practical implication of that might be more restrictive treatment of the first medical indication or more liberal treatment of the second and any further medical indication.
201. In view of the prevailing lack of legal certainty, the UK delegation welcomed the opportunity of improving the legal position. It was prepared to support the *epi* proposal, subject to a number of editorial amendments (eg clarification of the expression "its use").
202. The French delegation said it was up to the Administrative Council to incorporate a suitable proposal in the Basic Proposal. It found the *epi* proposal interesting primarily in terms of its separate provisions for the first and any further indications, but stressed that its remarks were of a provisional nature because further internal consultations were required.

203. The Austrian delegation thought it was not yet clear whether use-bound substance protection extended the legal position of the right holder in comparison with therapeutic practice. It referred to debate on the Office's earlier proposal, which had produced a suggestion to examine the likely impact of such an arrangement on medical and therapeutic practice. Without detailed information on this issue, the Austrian delegation could not approve the proposal.
204. The German delegation remarked that courts had to remain free to continue developing their position on the scope of protection for the first medical indication and to restrict the extent of protection where appropriate. This latitude would be lost if the new paragraph proposed by the *epi* were added.
205. The UNICE representative read out an EFPIA statement advocating far-reaching protection for the first medical indication. This precluded only the Office's earlier proposal, in which the two indications were given equal standing.
206. The Office put forward an editorially revised draft text purely as a basis for discussion. It contained no substantive changes vis-à-vis the proposal set out in CA/PL 4/00 and did not constitute a new Office proposal for Article 54(4) EPC. It was worded as follows: "Where the subject-matter of the invention is the use of a substance or composition in a method referred to in Article 53(c), the substance or the composition shall, [without prejudice to paragraphs 2 and 3], be deemed, for the purpose of that use, as not being comprised in the state of the art".
207. The UK delegation said the new text submitted by the Office seemed a helpful approach to solving the problem.
208. The German delegation stated its preference for the proposal in CA/PL 4/00, that version already forming the basis for case law on such issues.
209. The Austrian delegation said its opinion remained unchanged even after submission of the new text for the revised Article 54(4) EPC and referred in that respect to its earlier position. Moreover, the proposed formulation raised an as yet undiscussed matter of principle: the extent to which the first medical indication should be afforded the same protection as the second and further medical indications.
210. In reply to these questions, the Office said that comparing its two substantively identical proposals with the existing legal situation showed that protection of the first medical indication was clearly an enshrined principle. Case law in practice allowed claims for which support could not necessarily be inferred from the present

version of Article 54(5) EPC. Maintenance of broad claims for a first medical indication extending beyond a single specific application was also conceivable under the new formulation, but could not be guaranteed any more than it could under Article 54(5) EPC in its present form. Instead of a process claim for the second medical indication the proposal envisaged a use-bound substance claim, ie a use claim in the form of a substance claim. This claim formulation probably offered no greater extent of protection than the Swiss-type claim.

211. The French delegation declared its provisional support for the new draft text prepared by the Office.
212. The Swiss delegation continued to favour retention of the existing protection for the first medical indication and addition of a new paragraph governing the second and each further medical indication. The procedure it suggested entailed incorporating Article 54 EPC in the Basic Proposal, with the Office's wording for Article 54(4) EPC and the *epi* proposal for Article 54(4) and (5) EPC in square brackets. This would give the delegations time until the next Administrative Council meeting to form a complete opinion and come to a decision on the Administrative Council.
213. The Swedish delegation in a provisional opinion said it would like the Basic Proposal to include a provision equivalent to Article 54(5) EPC. The draft text submitted by the Office might be a suitable proposal.
214. The German delegation pressed for preparation of a final decision on the issue at the present meeting of the committee. The *epi* proposal was to be rejected because it would codify past case law and thereby deprive case law of any chance of evolving flexibly in the future. The same risk attached to the new formulation submitted by the Office. The delegation therefore advocated simply adopting the clarificatory amendments set out in CA/PL 4/00 and excluding other proposals from the Basic Proposal.
215. The Italian delegation supported the German delegation's position.
216. The Netherlands, Monegasque and Hellenic delegations in provisional opinions supported the Office's new draft text.
217. The Office considered the provisions for Article 54(4) and (5) EPC proposed by the *epi* to be contradictory and for that reason alone could not support the proposal. Maintaining the *status quo* meant overestimating the strength of the legal position that had evolved in practice from case law. Even if broad claims have been

allowed, a patent formulated so broadly could not be enforced before any national court if another undisclosed use were at stake.

218. The chairman having asked which delegations preferred the *epi* proposal to the other alternatives, the Swiss delegation said the *epi* proposal codified the existing legal situation and therefore had the advantage of legal certainty.
219. The French delegation stressed that the Enlarged Board of Appeal's interpretation of the law with regard to broad claim formulations was not shared by all national courts. The Cour de Cassation, for example, had declared in an *obiter dictum* that it did not agree with this interpretation. Thus the *epi* proposal was not a true reflection of the *status quo*.
220. The UNICE representative objected that in German legal practice the court was not authorised to delve beneath the wording of a patent claim in order to interpret it unless there had been at least a partial revocation; to which the Office replied that this would not apply if one court had jurisdiction for both infringement and revocation issues.
221. The Belgian delegation in a provisional opinion said it favoured the arrangement currently specified in the Basic Proposal. The Austrian delegation agreed.
222. The Irish delegation advocated adding the Office's new text to the Basic Proposal within square brackets, an idea supported by the Spanish and Cypriot delegations.
223. The Danish delegation said it as yet had no specific statement to make on this issue. It suggested initially retaining all the proposals and making a selection once the interest groups involved had been consulted.
224. The Portuguese delegation was happy with the *status quo* and supported the Irish delegation's proposal.
225. The UK delegation questioned the point of submitting multiple proposals to the Administrative Council. The issue was very complex, and the Administrative Council expected the committee to provide it with a clear opinion and advice to help it make a decision. In terms of the wording, the last half-sentence of the Office's text seemed incorrect ("such").
226. The chairman concluded that the committee had not given a clear opinion. The following four proposals had been discussed:
 - retention of the existing provision
 - the version proposed by the Office in CA/PL 4/00

- an *epi* proposal for Article 54(5) worded as follows: "The fact that its use for any method referred to in Article 53(c) is comprised in the state of the art shall not exclude the patentability of any substance or composition for another such use."
- a new version of Article 54(4), put forward by the Office in the course of the debate and worded as follows: "Where the subject-matter of the invention is the use of a substance or composition in a method referred to in Article 53(c), the substance or the composition shall, [without prejudice to paragraphs 2 and 3], be deemed, for the purpose of that use, as not being comprised in the state of the art."

It was agreed that the Basic Proposal should retain the Office's last proposal in square brackets; it would be left to the Administrative Council to decide whether that proposal should be retained.

IIId. ARTICLE 69 EPC (CA/PL 25/00 Add. 2)

227. The German delegation said the proposal was sound and should be implemented as quickly as possible to close a legal loophole.
228. The UK delegation said it was an interesting proposal which constituted a radical change to the legal position in the United Kingdom and still required in-depth examination and consultation of the interest groups involved. Hence it was too early to place the proposal on the agenda for the Diplomatic Conference.
229. In reply, the Office compared the legal position in the United Kingdom with the proposed arrangement. UK law did not apply the classical doctrine of equivalents, instead dealing with the issue of equivalence by applying the principle of "purposive construction" developed in the House of Lords "Catnic" decision. The "Catnic" test consisted of three steps, the first two constituting the equivalence test. The third step had yet to meet with worldwide recognition, but was widely felt to be a useful addition to the doctrine of equivalents; in the proposal it was provided for under "Prior statements". Referring to the divergent ruling in the "Epilady" case, the Office said the proposal was a suitable means of harmonising legal practice in Europe.
230. The Swiss delegation likewise referred to the "Epilady" case, calling it a striking demonstration of how equivalents were treated differently in individual contracting states. It saw an urgent need for legislation and therefore supported the proposal. If the committee could not immediately agree to the proposal, it should at least be incorporated in the Basic Proposal in square brackets.

231. The Austrian, Belgian, Netherlands and Swedish delegations and the UNICE representative found the proposal an interesting approach which should be pursued further because legislation was needed. They supported the Swiss delegation's request to incorporate the proposal in the Basic Proposal in square brackets.
232. The *epi* representative preferred having the legislation in the Implementing Regulations rather than the Convention or the Protocol on Article 69 EPC, as that would make for greater flexibility.
233. The chairman concluded that the committee gave a favourable opinion on the proposal set out in CA/PL 25/00 Add. 2. The proposal would be incorporated in the Basic Proposal in square brackets; it would be up to the Administrative Council to decide whether to retain it.

IIlee. REVISION ACT (CA/PL 25/00, page 247)

234. A number of delegations (AT, FR and GB) had questions about the renumbering of the Convention as provided for in Article 4(1), second sentence. Changes arising from a follow-up conference might necessitate a further renumbering. The Office promised to look into the matter again.
235. The chairman concluded that the committee gave a unanimous favourable opinion on the proposed EPC Revision Act.

IIIb. CONFERENCE OF MINISTERS OF THE CONTRACTING STATES (CA/83/00)

236. The Office tabled the document.
237. The Hellenic delegation said it was too early to begin debating the proposal or to give an opinion on it, as there would have to be in-depth consultation with national authorities, especially because the issue was not of a purely legal nature. The Spanish delegation agreed.
238. The Swiss delegation favoured implementation in the Convention because then there would be no need for an additional instrument of international law. If the committee was looking for an arrangement under which the agreement of all contracting states was always required to convene a conference, it would be better for this arrangement to be in a separate protocol. It was important to make a three-quarters majority sufficient for the conference to be convened. As for the name of the instrument, it was in favour of "Protocol" and "intergovernmental conference".

239. The French delegation supported the proposal, referring to similar arrangements within the WTO and the EU. It considered a resolution preferable to a protocol. It suggested reformulating the second half-sentence of paragraph (1) as follows: "or establish **extended** co-operation between contracting states **within the framework** of the European **patent system**". The invitation mechanism seemed excessively formalised and counterproductive and should therefore be dispensed with.
240. The UK delegation also warned against excessive formality, preferring a succinct and general formulation. On the basis of the alternative proposed for Article 4(4) EPC it drafted the following wording: "A conference of the ministers of the contracting states responsible for intellectual property shall meet at least every five years to discuss issues pertaining to the European patent system". It did not agree to the draft protocol as submitted.
241. The Belgian delegation said it had no objections in principle to the proposed arrangement. It agreed with the UK delegation's proposed formulation.
242. The Austrian delegation was not sure how useful such an arrangement would be, referring to earlier successful conferences which had taken place without any such mechanism. If found necessary, it should be formulated as broadly as possible.
243. The Netherlands delegation in a provisional opinion supported the UK delegation's proposal.
244. The Office pointed out that the submitted document had not been designed as a proposal but as a basis for discussion. It had been clear from the debate that many delegations favoured the approach formulated by the UK delegation, involving a broad and general provision in the Convention. For the present there was no basis for submission of a revised Office wording. The Administrative Council would in any case be able to gain some idea of the way things were moving from the committee chairman's report. If no actual text were submitted to the Administrative Council, the Council would be able to hold a general debate on the topic. As host of the London intergovernmental conference the UK delegation could put forward a suitable proposal.
245. The chairman concluded that the committee had not formulated a definite opinion on the issue. There had been a trend in favour of a succinct provision in the Convention. The proposal would be further discussed on the Administrative Council, which would be informed of the delegations' viewpoints.

IIIc. PREPARATIONS FOR THE REVISION CONFERENCE - DRAFT RULES OF PROCEDURE OF THE CONFERENCE (CA/26/00)

246. The Office tabled the document.

247. The chairman noted that CA/26/00 had been noted by the committee.

IV. LEGAL FRAMEWORK FOR ONLINE FILING (CA/PL 28/00)

248. The Office tabled the document.

249. The French delegation asked why the basic standards of electronic records management were only mentioned in the Introduction and not included as a separate article in the President's draft decision. The French formulation of Article 1 was inaccurate. A formulation such as " ... sous forme électronique selon les moyens indiqués ci-après ... " would eliminate the problem. The provision governing standards in Article 2 could include a reference to the WIPO standards to provide for compliance with the PCT standards. The definition of an electronic signature in Article 11(1)(b) to some extent conflicted with the definition in Section 701 of the PCT Instructions, which was far more simply formulated. In Article 11(1)(c) the term "enhanced" (see Section 407 of the Annex to the PCT) was better than the term "advanced" borrowed from the EU Directive. Article 12 differed significantly from Instruction 705, which described the content of an acknowledgment of receipt in detail, eg date and time of receipt, content of document, and was therefore preferable to the proposed provision.

250. The Belgian delegation suggested a number of clarifications, filing requirements not being clear from Article 4, second sentence. Regarding Article 10 it pointed out that users might not be able to comply with the Office's preferred procedure. It asked the Office to give a typical example of Article 11(4).

251. The Luxembourg delegation also suggested a clarification of Article 4, second sentence. It enquired whether the Office would be issuing technical instructions in addition to the proposed provisions and whether the software referred to in Article 3 was publicly accessible to users.

252. The Swiss delegation welcomed the fact that the electronic filing of applications was initially to be regulated by a decision of the President, but ultimately, for reasons of legal certainty, the issue would have to be governed by a provision in the Implementing Regulations. Recital (2) of the preamble had less to do with basic

requirements than with security features; and recital (3) was too restrictive, allowing archive copies to be retained only in the format in which they were submitted. There was no need for encryption of archived data. In recital (9) it suggested inserting " ... and other forms of malicious logic ... " (see Article 6(3)). Recital (10) should also apply to the networks of other offices and organisations linked to the EPO. In technical terms, Article 6(3) was based on an unrealistic assumption, since if the EPO tried to make a virus-infected application readable and perhaps eliminated the virus, it was already to some extent interfering with the document and could then no longer guarantee that the file was identical to the submitted file. If an application appeared to be infected in the current state of the art, by virtue of a legal fiction it should be considered unreadable. The first two options in Article 11 did not fulfill the relevant security requirements, so only the third was acceptable. Generally speaking, the President's decision should be in keeping with WIPO's plans for the PCT.

253. The UK delegation primarily examined some of the fifteen recitals in more detail. In principle it would like the recitals to be reflected in the President's decision in the form of articles as well. Recital (3) should be more broadly formulated, allowing files to be converted to other formats or to paper form. The word "official" as used in recital (4), second sentence, was misleading and should be deleted; the last part of the sentence in English should read: " ... any Office-assigned reference or application number, ...". Recital (6) was inconsistent with Article 11, as the simple electronic signature under Article 11(1)(a) and (b) arguably failed to meet the requirements postulated in recital (6). As a rule, first filers lacking the necessary equipment should be allowed to use simple signatures. The notion of "long-term" in recital (8) was very flexible and should be clarified. The statement in recital (15) raised problems of security and confidentiality. Article 1(a) should mention the national offices (requirement for an epoline address). Article 6(3) said on the one hand that the Office was obliged to read the application, but on the other hand that it did not have to open it. That was a contradiction in terms which could be eliminated by deleting "and need not open or process it". It pointed out that, under Article 6(4), minor technical deficiencies in an application would not result in the loss of the filing date. This could also be included in the recitals. As Article 11 applied only to electronically filed applications, this restriction should be expressed in Article 11 ("... European patents filed in accordance with Article 1 ..."), as was already the case in other provisions. The formulation "In all other cases" in Article 11(4) should be made more specific, since only electronically filed applications could be involved.

254. The Office stated its position on the delegations' interventions, with particular emphasis on the following points:

- The preamble comprised features of general significance to the issue as a whole which therefore did not need to be covered by specific articles.
- The Trilateral Standards had been chosen as yardstick instead of the WIPO standards for historical reasons.
- The second sentence of Article 6(3) was based on the idea that every attempt should be made to accord a filing date to the application.
- Article 11(1) provided for three different forms of signature in order to keep the requirements for obtaining a filing date as low as possible in the interests of applicants. The obstacles that electronic filers had to surmount as a result of signature requirements should be no higher than those currently faced by paper filers.
- Article 11(4) dealt with special cases in which one document had to have multiple signatures or in which the signatures of various people were required for multiple documents (eg authorisation to represent multiple applicants).
- No additional data carrier was required to file sequence listings because they were filed either online or on CD-R anyway (see Rule 27a EPC).
- The software was initially being developed by the Office and made available to users. Programs from private suppliers might be added later. Users would not need to modify their IT systems.
- The Office would issue users with instructions for the procedure and would continue to inform them about all developments in relation to electronic filing.
- The proposed editorial amendments and additions would be examined and where appropriate incorporated in the proposal (recitals 3, 4, 8, 9, 10 and 15, Article 1 ("electronic means"), Article 11(1)(c) ("advanced") and Article 6(3) and (4).

255. The Swiss delegation rejoined that it continued to find Article 11(1)(a) and (b) pointless. Signature requirements for applications should be dropped altogether, only the substance of Article 11(1)(c) being retained. It also proposed amending the wording at the end of recital (10) as follows: "... other networks and applications of the Office and of offices and organisations connected with the EPO;". Debate on Article 6(3) should be conducted in this light.

256. The Office replied that dispensing with signature requirements for applications was desirable in principle, but these requirements were imposed by a statutory provision (Rule 26 EPC), and amendment of this provision was not up for debate at present.

257. The committee noted CA/PL 28/00.

V. AMENDMENT OF RULE 94 EPC (CA/PL 29/00)

258. The Office tabled the document.

259. The French delegation expressed its approval of the proposed new wording of Rule 94 EPC, but asked the Office for further clarification of the submitted document. Given the potential overlap between the reformulated Rule 94 EPC and the second sentence of the present Rule 95, it might make sense to combine the two provisions. In Article 1(3) of the draft decision it was not entirely clear which of the two preceding paragraphs was referred to. The delegation asked how certified copies of applications filed electronically would be issued by the Office pursuant to Article 3 of the draft decision. The same question applied to the draft decision on the issuing of priority documents (Article 2). With regard to Article 4 the delegation asked whether the Office planned to charge for downloading and whether it would register every access to the file for file inspection purposes.

260. The Swiss delegation expressed its approval of the submitted document. The waiving of the file-inspection fee should be announced in appropriate form outside the Office. The delegation was not sure how much legislative substance was to be found in the new version of Rule 94(2). Regarding point 4 of the Introduction it suggested establishing special rules for "mega-applications" and mapping out the boundaries for abuse of rights.

261. The Belgian delegation failed to understand why Rule 94(4) EPC was being deleted and asked to have the reasoning explained.

262. The UK delegation enquired as to the schedule for implementing the President's decisions.

263. The Office answered these questions as follows:

- The date of 1 January 1998 had been chosen because that was when the Office had started creating electronic files and storing them in the PHOENIX system, which meant that such applications could be made available for electronic file inspection.
- Article 1(3) of the President's decision meant that it would continue to be possible to inspect files in paper form, regardless of whether the files were maintained electronically.
- Rule 94 essentially related to telephone enquiries for information from the Register. If a query involved so much data that information could not efficiently be provided by telephone, the enquirer could be referred to the possibility of a file inspection. Certified copies of files maintained electronically could be

issued by virtue of a legal fiction which viewed the file as the original (Rule 95a(3) EPC), of which a certified copy could be made at any time in paper form. In special cases (over 400 pages) the copy could also be made on special data carriers. Then certification would as a rule be performed electronically on the data carrier or, on request, could take the form of a separate certification document enclosed with the data carrier. No record would be kept of who inspected a file; only the fact that the file had been accessed would be registered. Regarding "mega-applications" the Office hoped that the problem might to some extent be solved by the option of online file inspection.

- The Office further stated that it had been unable to identify any applications which might constitute an abuse of rights, so at present it saw no reason to examine extremely large applications for abuse simply because they were extremely large. It would however be closely monitoring subsequent developments. Rule 94(2) EPC covered all the cases which had any connection with file inspection, ie all the cases which were now dealt with in paragraphs (2) and (3); paragraph (4) was covered by a separate decision of the President. The reason for deleting Rule 94(4) EPC was simply that it dealt with an aspect of file inspection. The schedule for enactment of the decisions depended on how quickly the proposed amendment was approved by the present committee and then by the Administrative Council. Once the new wording of Rule 94 EPC had entered into force, the President's decisions could be implemented. In the meantime technical testing would continue. The Office hoped to be able to accept the first online applications in December 2000. Starting in 2001 the intention was to launch new epoline products every three months, thereby progressively extending the product range over a period of about two years.

264. The chairman noted that the committee gave a unanimous favourable opinion on the proposed amendments to Rule 94 EPC.

VI. OTHER BUSINESS - PROPOSAL FOR A REGULATION ON THE COMMUNITY PATENT

265. The EU representative delivered a statement on the European Commission's proposal for a Regulation on the Community Patent. The statement was circulated as Info 3/PL 14.

266. The committee noted the statement.

The Committee on Patent Law approved the minutes contained in this document on 27. October 2000.

Munich, 27 October 2000

For the Committee on Patent Law
The Chairman

A handwritten signature in black ink, consisting of a stylized 'P' and 'L' with a horizontal line extending to the left.

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

14. Sitzung / 14th meeting / 14ème session (München/Munich, 3.-6.7.2000)

München/Munich, 06.07.2000

Orig.: d,e,f

BETRIFFT:	Teilnehmerliste
SUBJECT:	List of participants
OBJET:	Liste des participants
VERFASSEN:	Ratssekretariat
DRAWN UP BY:	Council Secretariat
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