

DIPLOMATIC CONFERENCE  
TO REVISE THE EUROPEAN PATENT CONVENTION

---

(Munich, 20 - 29.11.2000)

**Info 10**

Munich, 21.11.2000

Orig.: English

SUBJECT: Position paper on the Revision of the European Patent Convention  
DRAWN UP BY: Union of European Practitioners in Industrial Property  
ADDRESSEES: Revision Conference (for information)

---

This document has been distributed **in English only**.

---



- 1 -

OF EUROPEAN PRACTITIONERS IN INDUSTRIAL PROPERTY  
EUROPÄISCHER BERATER FÜR DEN GEWERBLICHEN RECHTSSCHUTZ  
DES PRATICIENS EUROPÉENS EN PROPRIÉTÉ INDUSTRIELLE

**POSITION PAPER**  
**ON THE REVISION OF THE EUROPEAN PATENT CONVENTION**  
**PRESENTED BY THE UNION OF EUROPEAN PRACTITIONERS IN**  
**INTELLECTUAL PROPERTY**

**General Comments**

First of all, UNION congratulates the Administrative Council of the European Patent Organisation to its initiative to convene an EPC Revision conference of the contracting states for the first revision of the European Patent Convention.

UNION agrees with the position taken by the Administrative Council that it is necessary to undertake a comprehensive review of the 1973 European Patent Convention in the light of technical and legal developments over the many years of practical experience and also in the light of the TRIPS Agreement, the future Community patent and the provisions of the forthcoming Patent Law Treaty.

Many of the needs and suggestions put forward by users have been satisfied by the proposed amendments, which should result in a smooth, efficient and transparent conduct of all proceedings before the EPO. However, it is necessary not to put existing quality standards at risk.

UNION also agrees with the guiding principle behind the revision, i.e. to transfer many procedural details from the Convention to the Implementing Regulations in order to prepare for a quick and effective adaptation of the European patent law to new requirements in the future.

However, UNION wishes to propose some amendments and additions to the Basic Proposal in order to enhance the practicality of the EPC and in order to avoid a risk of conflict which may arise in view of New Article 149a EPC.

./..

---

*Residence of the UNION: Cabinet Bede, Place de l'Alma, 3, B-1200 Bruxelles, Belgium*  
*Phone: 32(0)2-779 0339; Fax: 32 (0)2-772 4780; E-mail: mail@bede.be*

## Comments on specific and important Articles

**Article 52(2)**, enumerating inventions which in particular shall not be regarded as inventions within the meaning of Article 52(1), should be transferred to the Implementing Regulations so that this list of non-patentable inventions can be adapted to new requirements in the future without the need for a new intergovernmental conference.

UNION supports the deletion of the old **Article 54(4)**, the adaptations of **Article 54(3)** and **Article 69(2)** to accord with this deletion, and the adaptation of Article 67(1) to accord with the amended Article 69(2), as proposed in document MR/6/00.

The proposed addition of a new **Article 54(5)** is acceptable since it makes it possible to obtain product protection in case of a first medical indication limited to a specific use. However, UNION is of the opinion that a further clarification of this Article is necessary in order to make it possible to obtain product protection also for a second and further medical indication, limited in each case, by the specific uses disclosed in the application. Alternatively, this Article should be supplemented so as to clarify how it is possible to obtain such protection.

UNION is also supporting the proposed transfer of a major part of **Article 77** to the Implementing Regulations. However, in the Implementing Regulations it should be clearly indicated what is meant by “**in due time**” in the new **Article 77(3)**. The penalty – the loss of rights – hits the applicant should the central industrial property office or any other competent authority in a Contracting State not forward the application or forward it too late to the European Patent Office. Thus, the applicant should be entitled to Restitutio in Integrum should such a mistake by the office or the authority arise.

UNION is strongly against the proposed new **Article 149a(2)** and the idea of appointing members of the Boards of Appeal or the Enlarged Board of Appeal to serve on a European patent court or a common entity and to take part in the proceedings before that court or entity. Such a scheme would imply that such members could serve both in a first instance (i.e. the Boards of Appeal) and a superior instance (i.e. a European Patent Court or similar entity). Such a system is against the traditions in most of the Contracting States. The parties of a litigation concerning a granted patent shall have the right to an independent judgement by judges who are unbiased by the traditions within the Boards of Appeal or the Enlarged Board of Appeal and, thus, who have not been and could not have been involved in the granting procedure.

Brussels, 16 November 2000