

**MR/11/00**

Orig.: English

Munich, 20.11.2000

SUBJECT: Basic Proposal: Articles 121 and 122 EPC

DRAWN UP BY: Swedish delegation

ADDRESSEES: Revision Conference (for consideration)

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SUMMARY

This document contains drafting proposals for the revised EPC Articles 121 and 122

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## I. INTRODUCTION

1. In the preparatory discussions of the Committee on Patent Law the Swedish delegation has expressed concerns with regard to the proposed amendments of Articles 121 and 122. The delegation has, in particular, questioned whether further processing under Article 121 should be offered as the standard remedy for failures to observe time limits, irrespective of whether these are fixed by the EPO, on a discretionary basis, or established once for all in the convention or in the Implementing Regulations. The delegation has argued that a widely broadened scope of further processing might unjustly prolong the administrative procedure and even jeopardise third party interests.

At the same time the delegation has recognised that a simple, generally applicable procedure for obtaining further processing could be of benefit for applicants. Moreover it has been obvious to the delegation that such a procedure could reduce the need for the European Patent Office to examine whether the conditions for re-establishment of rights are met in accordance with Article 122.

In view of this, the Swedish delegation, having also noted the favourable opinions of other delegations, has finally chosen not to speak against an extension of the scope of Article 121. The purpose of this submission is mainly to provide for increased transparency of the legal framework. To this end the Revision Conference should seek to identify time limits that should be exempted from further processing and also make direct references to such time limits in the basic Article. The delegation further believes that Article 122 should contain an explicit proviso, excluding re-establishment of rights in situations where the applicant would have had recourse to further processing under Article 121. This means that the Swedish delegation does not regard it appropriate that such important provisions are referred to the Implementing Regulations only.

## II. EXPLANATORY NOTES TO THE PROPOSED DRAFTING OF ARTICLES 121 AND 122

2. When explaining the effect of a grant for further processing the Basic Proposal introduces, in draft **Article 121(3)**, a simplified wording compared to that of present Article 121(1). The Swedish draft retains the current language, which is considered to better cover the situations that may occur (cf. also proposal for **Article 122(3)**).
3. The Swedish draft for **Article 121(4)** contains an extended - although not exhaustive - list of exemptions. As already stated the Swedish delegation believes that as many as possible of those time limits that obviously should be exempted be highlighted in the Convention Article.

### Article 121

Further processing of the European patent application

- (1) If an applicant fails to observe a time limit vis-à-vis the European Patent Office, he may request further processing of the European patent application.
- (2) The European Patent Office shall grant the request, provided that the requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.
- (3) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.
- (4) Further processing shall be ruled out in respect of the time limits in Article 87, paragraph 1, Article 108 and Article 112a, paragraph 3, as well as the time limits for requesting further processing or re-establishment of rights. The Implementing Regulations may rule out further processing for other time limits.

(2) **Deleted** – to be incorporated into the Implementing Regulations.

(3) **Deleted** – to be incorporated into the Implementing Regulations.

### Article 121

Further processing of the European patent application

- (1) If an applicant fails to observe a time limit vis-à-vis the European Patent Office, he may request further processing of the European patent application.
- (2) The European Patent Office shall grant the request, provided that the requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.
- (3) If the request is granted, the legal consequences of the failure to observe the time limit shall not ensue or, if it has already ensued, shall be retracted.
- (4) Further processing shall be ruled out in respect of the time limits established in, or prescribed by virtue of, Article 61, paragraph 1, Article 86, paragraphs 1 and 2, Article 87, paragraph 1, Article 108 and Article 112a, paragraph 3. Further processing shall also be ruled out in respect of time limits for requesting further processing as prescribed by virtue of paragraph 2 of this Article and time limits for requesting re-establishment of rights as prescribed by virtue of Article 122, paragraph 2. The Implementing Regulations may rule out further processing in respect of other time limits.

(2) **Deleted** – to be incorporated into the Implementing Regulations.

(3) **Deleted** – to be incorporated into the Implementing Regulations.

4. One of the proposed additional exemptions relate to the time limit referred to in Article 61(1). The exemption seems to be justified already in order to eliminate any ambiguity as to the applicability of further processing to such *potential* applicants as Article 61 deals with.
5. According to note 6 to Article 121 (page 159 of the Basic Proposal) it is envisaged that time limits for payment of renewal fees under Article 86(2) would be excluded from further processing, and that a provision to that effect would be later introduced in the Implementing Regulations. The Swedish delegation now proposes that the exemption be inscribed in the Article itself. Moreover, since the second paragraph of Article 86 in fact provides for further processing in a specific situation (*i.e.* when the first payment term has expired), there is reason to exempt also that first payment term, referred to in Article 86(1), from the application of Article 121.
6. In the Basic Proposal the sole reference in **Article 122** to “Restitutio in integrum” (paragraph 7) has been replaced by “re-establishment of rights”. It would seem appropriate to provide for a corresponding updating of the **headline** to the Article.
7. According to note 4 to Article 122 (page 163 of the Basic Proposal) Re-establishment of rights under that Article should be ruled out “above all for those time limits in respect of which further processing can be requested”. The Swedish delegation finds this approach reasonable enough. However, since it in reality imposes a considerable restriction of the scope for granting *restitutio in integrum*, the Swedish delegation believes that a provision to that effect should not appear in the Implementing Regulations only but rather be included in **Article 122(4)**.
8. The Swedish delegation finds it necessary that the list of exemptions in the present Article 122(5) be reconsidered later on. Consequently the delegation can accept that remaining exemptions generally are referred to the Implementing Regulations. However, with regard to one particular time limit, namely the 12 month term for enjoying priority under Article 78(1), an explicit reference should be made in **Article 122(4)**.
9. Likewise it should be made clear in **Article 122(4)** that re-establishment of rights be excluded with respect to time limits for requesting further processing and re-establishment.

## Article 122

### Restitutio in integrum

(1) **An** Applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis European Patent Office shall, upon **request**, have his rights re-established if the non-observance **of this time limit** has the direct consequence [...] of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) **The European Patent Office shall grant the request, provided that the conditions of paragraph 1 and any other requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.**

(3) **If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.**

(2) **Deleted** – *to be incorporated into the Implementing Regulations.*

(3) **Deleted** – *to be incorporated into the Implementing Regulations.*

(4) **Deleted** – *to be incorporated into the Implementing Regulations.*

## Article 122

### Re-establishment of rights (restitutio in integrum)

(1) **An** Applicant for or proprietor of a European patent who, in spite of [...] due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis European Patent Office shall, upon **request**, have his rights re-established if the non-observance **of this time limit** has the direct consequence [...] of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress.

(2) **The European Patent Office shall grant the request, provided that the conditions of paragraph 1 and any other requirements laid down in the Implementing Regulations are met. Otherwise, it shall reject the request.**

(3) **If the request is granted, the legal consequences of the failure to observe the time limit shall not ensue or, if it has already ensued, shall be retracted.**

(2) **Deleted** – *to be incorporated into the Implementing Regulations.*

(3) **Deleted** – *to be incorporated into the Implementing Regulations.*

(4) **Deleted** – *to be incorporated into the Implementing Regulations.*

10. The Swedish delegation proposes that the word “all” be removed from “all due care” in **Article 122(1)**, thus bringing the language in full conformity with Article 12(1)(iv) of the Patent Law Treaty (PLT). The amendment would not have to imply any substantial change in legal practice or case law.
11. The Swedish delegation would like to bring the attention to an editorial error in Note 5 to Article 122 (page 163 of the Basic Proposal): The commencing words “Further processing” should correctly read “Re-establishment [of rights]”.

(4) Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights. The Implementing Regulations may rule out re-establishment for other time limits.

(5) Any person who, in a designated Contracting State, **has in good faith** used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in [...] the period between the loss of rights referred to in paragraph 1 and publication of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(6) Nothing in this Article shall limit the right of a Contracting State to grant **re-establishment of rights** in respect of time limits provided for in this Convention and to be observed vis-à-vis the authorities of such State.

(4) Re-establishment of rights shall, unless otherwise prescribed in the Implementing Regulations, be ruled out in respect of time limits for which further processing may be requested under Article 121. Re-establishment of rights shall also be ruled out in respect of:

a) the time limit referred to in Article 87, paragraph 1;

b) time limits for requesting further processing as prescribed by virtue of Article 121, paragraph 2;

c) time limits for requesting re-establishment of rights as prescribed by virtue of paragraph 2 of this Article.

The Implementing Regulations may rule out re-establishment of rights in respect of other time limits.

(5) Any person who, in a designated Contracting State, **has in good faith** used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in [...] the period between the loss of rights referred to in paragraph 1 and publication of the mention of re-establishment of those rights, may without payment continue such use in the course of his business or for the needs thereof.

(6) Nothing in this Article shall limit the right of a Contracting State to grant **re-establishment of rights** in respect of time limits provided for in this Convention and to be observed vis-à-vis the authorities of such State.