

M I N U T E S

of the
19th meeting of the

COMMITTEE ON PATENT LAW

(Munich, 15 and 16 October 2002)

CONTENTS

Subject	Page
I. ADOPTION OF THE AGENDA (CA/PL 13/02)	1
II. APPROVAL OF THE MINUTES OF THE 18th MEETING (CA/PL 9/02)	1
III. DRAFT IMPLEMENTING REGULATIONS TO THE EPC 2000 (CA/PL 5/02 Rev. 1, CA/PL 10/02 and Add. 1 to 13)	1
IV. AMENDMENT OF THE RULES OF PROCEDURE OF THE BOARDS OF APPEAL (RPBA) (CA/PL 11/02)	17
V. AMENDMENT OF THE RULES OF PROCEDURE OF THE ENLARGED BOARD OF APPEAL (RPEBA) (CA/PL 12/02)	17
VI. SUBSTANTIVE PATENT LAW TREATY (SPLT) (CA/PL 15/02)	20
VII. OTHER BUSINESS	23
ANNEX I: LIST OF PARTICIPANTS	24

The 19th meeting of the Committee on Patent Law, chaired by Mr W. van der Eijk (NL), took place in Munich on 15 and 16 October 2002. The list of participants is annexed.

Mr van der Eijk particularly welcomed the representatives of the states which had recently acceded to the EPC, and congratulated Mr Edwards (GB) on his re-election as Deputy Chairman.

I. ADOPTION OF THE AGENDA (CA/PL 13/02)

1. The agenda was adopted as set out in CA/PL 13/02.

II. APPROVAL OF THE MINUTES OF THE 18TH MEETING (CA/PL 9/02)

2. The Committee approved the draft minutes of its 18th meeting, subject to the insertion, at the request of the German delegation, of an amendment to point 10 of the draft. The final version would be issued as CA/PL PV 18.

III. DRAFT IMPLEMENTING REGULATIONS TO THE EPC 2000 (CA/PL 5/02 Rev. 1, CA/PL 10/02 and Add. 1 to 13)

3. The EPO introduced the document, drawing particular attention to the significant changes vis-à-vis CA/PL 5/02 and outlining the further procedure for the revision of the legislation. The Committee unanimously approved the proposal that a further revised version of the draft Implementing Regulations, incorporating the results of the Committee's deliberations, be made available after the meeting for approval by written procedure, so that the draft could be submitted to the Administrative Council in time for its December 2002 meeting. Regarding the process of ratifying the EPC 2000, the Office said that none of the contracting states - apart from those obliged to accept the EPC 2000 as a condition of joining the European Patent Organisation - had so far deposited their instruments of ratification.
4. In an initial "tour de table", the individual contracting states provided information on the current status of national ratification procedures. Some of the delegations said that their countries were waiting for the new Implementing Regulations before instituting national legislative procedures. In the majority of the contracting states, parliamentary discussion was likely to begin in 2003, and ratification could be expected in 2004 (GR, SE, NL, GB, DK, ES, DE, AT, FI, FR, MC). The Swiss delegation expected the EPC 2000 to be put before parliament in 2004. The revised text of the EPC could therefore

be expected to enter into force at the beginning of 2007. The Belgian and Turkish delegations pointed out that the forthcoming parliamentary elections could delay ratification. The Cypriot delegation said that the ratification procedure would probably be completed in the first half of 2003. In some contracting states, the EPC 2000 would be discussed in connection with the implementation of other international agreements and EU Directives, such as the London Agreement on the language issue, the Patent Law Treaty or the EU Biotechnology Directive (NL, DE, FR, CH). The Romanian delegation said that Romania would be depositing its instruments of accession before 10 December 2002.

5. Some delegations expressed misgivings about amendments to the EPC which did not arise directly from the revision of the EPC but had been made for linguistic reasons, since this might create the impression that the substance of the relevant provisions had been changed (SE, DK, DE, BE, UNICE and staff representatives). The Office replied that many drafting points aimed at harmonizing with terminology of the Revision Act and at harmonizing between the three language versions.
6. The Committee then embarked on a substantive examination of Part I of the draft Implementing Regulations, with the Chairman going through the Rules one by one and inviting the delegations to comment.
7. The following provisions in the text proposed in CA/PL 5/02 Rev. 1 were accepted by the Committee without further discussion: Rules 3, 4, 5, 7, 8, 8a, 9, 10, 11, 12, 14, 14a, 16, 18, 19, 21, 22, 23, 23b, 23c, 23d, 23e, 23f, 23g, 23h, 23i, 23j, 25b, 25c, 25d, 26, 27, 27a, 28, 28a, 30, 31, 32, 33, 34, 35, 36, 37, 38b, 39, 41, 41a, 42, 43, 44, 45, 46, 46a, 47, 48, 49, 50, 50a, 51, 52, 53, 54, 55, 55a, 56, 56a, 57, 57a, 58a, 59, 60, 61, 61a, 62, 62a, 63, 63a, 63b, 63f, 63i, 63j, 64, 65, 66, 67, 67b, 67d, 67g, 68, 70, 70a, 71, 71a, 72a, 72b, 72c, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83, 84, 84a, 85, 86, 87, 88, 89, 90, 91, 92, 93, 94, 95, 96, 97, 98, 99, 100, 101, 102, 102a, 103, 104, 106, 107, 108, 109, 110, 111 and 112. The delegations commented on the provisions listed below:

Rule 1 - [...] Language in written proceedings

8. At the suggestion of the Hellenic delegation, supported by the Spanish and UK delegations, Rule 1(3) was left unamended. The Committee unanimously approved the provision.

Rule 2 - [...] Language in oral proceedings

9. The UK delegation pointed out that the deletion of the words "the course of" in the English text of paragraph 2 could create the impression that the application of the

provision had been extended. The delegations favoured retaining the original wording. The Committee approved Rule 2, subject to the reinstatement of the words deleted from the draft English version.

Rule 6 - Filing of translations and reduction of fees

10. The Spanish, Hellenic and Cypriot delegations wanted to retain the three-month period for filing the translation of the application, so that the applicant would have enough time to prepare a translation of sufficient quality. This view was not shared by the majority of the delegations (DE, FR, IT, FI, SE, NL, AT and UNICE), which instead endorsed the Office's position that the new law also allowed the applicant to remedy deficiencies within a period of two months, and that early filing was necessary so that the application could be published together with the search report. The Committee endorsed the text of Rule 6 as set out in the draft.

Rule 13 - Stay of proceedings

11. The Office explained that, for the sake of terminological consistency, the wording of paragraph 2 was to be brought into line with paragraph 1, referring directly to Article 61. The Committee unanimously approved Rule 13, subject to this amendment.

Rule 14 - Limitation on withdrawals

12. The Office suggested that the reference to "entitlement proceedings" be replaced by the more explicit "proceedings referred to in Rule 13".

Rule 15 - Filing of a new European patent application by the entitled person

13. The UK delegation wondered about the possibility of inserting a reference to Rule 25b in paragraph 2, and of providing in paragraph 3 for some form of sanction in case the designation fees were not paid in due time. The Hellenic delegation doubted whether it was necessary to provide, in paragraph 1, that deemed withdrawal could also be based on decisions which had to be recognised on the basis of the Protocol on Recognition. The Swiss delegation wondered whether the deletion of the previous paragraph 3 was appropriate in every case and whether there were not cases where it would be desirable that a new application could continue to be filed at national level.
14. The EPO explained that Article 78(2) EPC 2000 governed the general legal consequences of non-payment of filing and search fees. The further mention of this in

Rule 15(2) was merely to clarify that the consequence also applied in the case of a new application under Article 61(1)(b) EPC 2000. The legal consequence of non-payment of designation fees, on the other hand, was only dealt with in the Implementing Regulations (Rule 25c(2) and (3)). The inclusion in paragraph 1 of decisions to be recognised on the basis of the Protocol on Recognition served to close a gap in the wording of the existing text. The reason for deleting the possibility under the previous paragraph 3 of filing a new application with a national office was that there was no apparent need in the contracting states to keep such applications secret after the conclusion of entitlement proceedings, since the earlier application had already been published by this date.

15. The Committee unanimously approved Rule 17 in the text proposed.

Rule 17 - Designation of the inventor

16. In response to a question from the UK delegation, the Office explained that Rule 17(3) provided for certain information in the application to be communicated to a third party. This was justified on the basis of the close relationship between applicant and inventor. The interested circles were not seeking to make more information available.
17. The Committee approved Rule 17 in the text proposed.

Rule 20 - Registration of transfers

18. The *epi* representative expressed concern that the deletion of the words "satisfying the EPO" could mean a change in Office practice regarding the scrutiny of documents produced as evidence of a transfer. It was essential to ensure that the EPO continued to register transfers only after careful examination of the evidence. Rule 29 should also include the possibility of central registration of transfers of granted European patents, and of licensing such rights.
19. The Office replied that the purpose of the proposed rewording was merely to harmonise the texts in the three languages; the substantive requirements in respect of evidence would remain unchanged.
20. The Committee unanimously approved Rule 20 in the text proposed.

Rule 23a - Prior application as state of the art

21. The UNICE representative proposed that this provision be deleted forthwith - instead of waiting for the entry into force of the EPC 2000 - as it conflicted with Article 54(3) and (4).
22. The Office said that the possibility of deleting the Rule in advance should be considered. However, such a step appeared premature until it was established that all contracting states were designated in all practically all applications (on payment of seven designation fees).
23. The Committee unanimously approved the proposed deletion of Rule 23a.

Rule 24 - General provisions

24. In response to the proposal from the Swiss delegation that the President could also be explicitly authorised, as in the existing Rule 36(5), to determine the legal consequences of failure to observe the requirements regarding communication, the Office said that this could be left to the decision of the President, particularly since the main case in question - the filing of written confirmation reproducing the contents of a telegram, telex or fax - would scarcely arise in future.
25. The Committee unanimously approved Rule 24 in the text proposed.

Rule 25 - European divisional applications

26. In view of the wording of Rules 24(1) and (2), the EPO proposed that the word “directly” be deleted from the English version of Rule 25 in order to avoid any misinterpretation. It said that specifying the language in which a divisional application was to be filed represented a change in legal terms, but no change to current practice. Art. 14(2) did not exclude a clarification of this nature.
27. The Committee unanimously approved Rule 25 in the text proposed.

Rule 25a - Forwarding of European patent applications

28. The EPO agreed to look into a proposal from UNICE to include a provision covering those cases where national offices did not disclose in time whether a particular invention was liable to secrecy.
29. The Committee unanimously approved Rule 25a in the text proposed, subject to an editorial amendment to paragraph (2) proposed by the United Kingdom delegation to

bring it into line with Art. 77(3) EPC 2000.

Rule 29 - Form and content of claims

30. The UNICE representative said that the proposed text in paragraphs 1(a) and (b) did not sufficiently reflect the case law in the field of computer-related inventions. The possibility of characterising the subject-matter of an invention using non-technical features should be included in paragraphs 1(a) and (b), either as part of the current revision of the Implementing Regulations or in the form of a general amendment to the rule.
31. The chairman replied that deleting the word "technical" or adding the word "non-technical" would represent a fundamental change to the legal text which would have far-reaching consequences. The issue should therefore be discussed separately and that these discussions should not be held until such time as the outcome of work being done by the EU (Guideline) and WIPO (SPLT) was available.
32. The Committee unanimously approved Rule 29 in the text proposed.

Rule 38 - Declaration of priority

33. Having agreed to change the wording in paragraph (2) of the English version to "... may not be ...", the Committee unanimously approved Rule 38 in the text proposed.

Rule 38a - Priority documents

34. The *epi* representative pointed out that priority documents which had not been of particular interest to third parties during the grant procedure could well be extremely important to them in subsequent infringement proceedings. The EPO should therefore also be authorised to require a translation of the priority document at the instigation of a third party. UNICE supported this view.
35. The EPO said that the intention and purpose of Rule 38a was to give the EPO the provisions it needed to implement the patent grant procedure. This meant that priority documents could only be taken into account if they were required for the purposes of assessing the patentability of an invention. This was particularly so in cases where there was relevant prior art from the priority interval. The provision could not affect the post-grant phase, as this was subject to national legislation. Moreover, no check was

made in limitation proceedings as to whether a priority right had been validly claimed. The provision was drafted to conform closely with the corresponding provision in the PLT (Rule 4), which was another reason why it should remain unchanged. The Hellenic delegation agreed with this interpretation.

36. The Committee unanimously approved Rule 38a in the text proposed.

Rule 39a - Missing parts of the description or missing drawings

37. The United Kingdom delegation was of the opinion that the provision in paragraph 1 under which the applicant could not invoke the omission of a communication from the Office inviting the applicant to file missing parts was unreasonable. The *epi* representative also considered the provision to be disadvantageous to the applicant. The Austrian delegation asked why, with regard to the time frame within which missing parts could be submitted, it had not been possible to follow the example of the PLT. In response to this question, the chairman proposed adding the words " ..., but as soon as possible and at least within two months ..." to paragraph (2).
38. On the question of the potential liability of the Office, the EPO said that the Office checked applications for the completeness of the documents making up the application, as prescribed in the PLT. This did not however mean that the Office could be liable for checking individual applications for missing parts of the description as part of the examination on filing. This was part of the substantive examination. Even in those cases in which the Office was obliged by provisions of the EPC to inform the applicant, it was accepted that it was excluded from liability. The proposal would not limit the other means of redress available to applicants.

39. The Committee unanimously approved Rule 39a in the text proposed

Rule 40 - Examination as to formal requirements

40. The Committee unanimously approved Rule 40 subject to the inclusion in (d) of a reference to Rule 15(2).

Rule 55 - Surrender or lapse of the patent

41. The Austrian delegation pointed out an error in the numbering (no Rule 55).

Rule 55b - Form and content of the opposition

42. The German delegation referred to its written proposal to allow oppositions to be filed electronically. The EPO stated that the requirement for the written form did not exclude electronic filing. What it did exclude was the filing of oppositions orally.
43. The Committee unanimously approved Rule 55b in the text proposed.

Rule 58 - Examination of opposition

44. UNICE said that the word "only" in paragraph 1, first sentence, was misleading and should be replaced by the word "all". The EPO replied that the provision in paragraph 1, second sentence, should not restrict the discretion of the Opposition Division to decide on which of the grounds for opposition it wished to base its decision. The obligation of the Opposition Division to examine the grounds for opposition submitted by the opponent was set out in paragraph 1, first sentence, although for reasons of procedural economy it was not obliged to examine each of these individual grounds. The German and United Kingdom delegations proposed that the word "only" be deleted. As a logical consequence, the word "all" in paragraph 3 would also have to be deleted.
45. The Committee unanimously approved Rule 58, subject to the above-mentioned amendments.

Rules 63a and b - Intervention of the assumed infringer; subject of limitation proceedings

46. The Rumanian delegation suggested that, for reasons of legislative consistency, Rules 63a and 63b should be combined.
47. The Committee unanimously approved Rules 63a and 63b in the text proposed.

Rule 63c - Competence of the Examining Division

48. On the subject of efficiency the staff representative asked whether, in the case of patents which had already been the subject of opposition proceedings, limitation proceedings should be dealt with by the Opposition Division that had originally dealt with the opposition. The EPO said that this idea had been rejected because limitation

proceedings were *ex parte* proceedings which could take place at a considerably later date.

49. The Committee unanimously approved Rule 63c in the text proposed.

Rule 63d - Requirements of the request

50. At the suggestion of the chairman, the term "where appropriate" in paragraph 2(d) was replaced by "as the case may be". The staff representative said that, in the event of a limitation, the proprietor was obliged in view of Art. 84 to submit a correspondingly adapted description. The Committee, citing Art. 105a-c, did not agree with this point of view.
51. The Committee unanimously approved Rule 63d, subject to the amendment proposed by the chairman.

Rule 63e - Precedence of opposition proceedings

52. The United Kingdom delegation proposed that paragraph 2 be edited to bring it into line with the wording of paragraph 1 ("pending"), in order to make it clear that limitation proceedings were pending at the time of filing of the opposition. Furthermore, paragraph 2 should also cover situations in which opposition proceedings were pending at the time of filing of a request for revocation.

The EPO agreed with the editorial amendment and pointed out that Rule 63e(2) did not apply if revocation of the patent had been requested. Opposition proceedings only took precedence when the proprietor was seeking to limit the patent. Should the patent proprietor wish to abandon the patent completely, precedence should be given to the limitation proceedings as the simpler proceedings.

53. The Committee unanimously approved Rule 63e in the text proposed, subject to the proposed editorial amendment.

Rule 63g - Decision on the request

54. The Swiss delegation proposed that paragraph 4 should include a period of grace along the lines of the opposition procedure. UNICE supported this proposal. The *epi* representative asked whether it was possible in limitation proceedings to submit different requests for limitation for different countries, and whether licensees entered in

the European Patent Register were informed as a matter of course when limitation proceedings were initiated. The Irish delegation asked about the general opportunities for third parties to find out about pending limitation proceedings, particularly the possible publication of the request for limitation. Similar comments were made by the Danish and Luxembourg delegations. The United Kingdom delegation said it was important to ensure that information about limitation proceedings was transmitted to the national patent offices of the designated contracting states. The chairman asked whether it would be possible for proprietors to have a further opportunity to amend requests for limitation which were too restrictive.

55. Following a proposal from the Swiss delegation, the EPO agreed to include in paragraph 4 a period such as the one provided for the opposition proceedings in Rule 58a(3). Furthermore, the EPO confirmed that according to Rule 87 different sets of claims were allowed for different states (see p. 21, paragraph 2, of the Explanatory Remarks). Limitation proceedings were announced in the European Patent Register but not in the Patent Gazette, since it was considered that entry in the Register was sufficient to inform the public. Third parties could find out about the contents of a request by inspecting the files. It was planned send the national offices information about pending limitation proceedings within the framework of the general exchange of data. The EPO did not inform licensees either about pending limitation proceedings or any other proceedings initiated in respect of a European patent.

The Committee unanimously approved Rule 63g in the text proposed, subject to the amendment proposed by the Swiss delegation.

Rule 63h - Content and form of the amended European patent specification

56. At the request of the Austrian delegation, the EPO confirmed that a deliberate decision had been taken to list the documents forming the amended patent specification differently to Rules 53 and 62, as it was the amendment to the claims which was most important in this case. The change in sequence should not result in any change in the normal appearance of a patent specification. The Office announced that it would be submitting this provision to further examination.
57. The Committee unanimously approved Rule 63h in the text proposed.

Rule 64a - Examination of appeals

58. UNICE said that the legal consequence set out in paragraph 3 should not be the deemed withdrawal of the application but rather the withdrawal of the appeal. The EPO

did not agree, as this provision was mostly used in proceedings before the technical boards of appeal in which the appeal was against the refusal of an application. If a fictional withdrawal of the appeal were created, applicants would be deprived of the legal remedy of further processing. The unfortunate consequence of this for the applicant would be that the decision of the first instance to refuse the application would become final. For this reason, the proposed provision was more favourable to the applicant, with the exception of those few cases in which an appeal was based on the clarification of a point of detail.

59. The Committee unanimously approved Rule 64a in the text proposed.

Rules 67a, 67c and 67f - Further fundamental procedural defects; Obligation to raise objections; Procedure in dealing with petitions for review

60. The German delegation expressed a general reservation about Rule 67a because it did not see any sense in extending the circumstances justifying a review under Article 112a EPC 2000. It also had misgivings about restricting the scope for reviews by introducing an obligation to raise objections under Rule 67c and having all petitions for review examined by a three-member body under Rule 67f(2)(a). These provisions should be aligned more to Article 112a EPC 2000.

UNICE was in favour of a more restrictive wording in Rule 67a(b) (" ... on a clearly stated request ...") in the interests of legal certainty.

61. The *epi* representative shared the reservations of the German delegation and UNICE.
62. The staff representatives criticised the lack of a provision for boards of appeal to rectify contested decisions that they themselves had taken.
63. The Hellenic delegation shared the reservations of the German delegation.
64. The Office responded that the new means of redress was designed to prevent the system from being abused by the endless dragging out of proceedings. This was why certain provisions, eg the obligation to raise objections, had been written into the proposed draft. Article 112a(2)(d) EPC 2000 covered the provision of additional grounds for review in the Implementing Regulations. It should be left to case law to interpret the term "relevant request" in Rule 67a(b). Proceedings would not be

streamlined by introducing means of rectification as the need to reconvene the relevant boards of appeal would prolong proceedings. In any case, the EPC only provided for rectification in *ex parte* proceedings. Introducing an obligation to raise objections was a more effective way of achieving this aim.

65. The Belgian delegation expressed its support for the Office's proposal. It too was conscious of the danger that, in the absence of clear provisions, the procedure for reviewing board of appeal decisions could be misused to deliberately stall proceedings. The proposed provisions lay within the mandate given by the Diplomatic Conference and left case law enough scope for further development.
66. The Swiss delegation objected to the term "concisely" in Rule 67f(4), whereupon the Committee thought it best to delete the entire paragraph as general procedural principles apply even where a petition for review is rejected on the grounds of being clearly inadmissible or non-allowable. The question of the form the decision should take could be dealt with in the Rules of Procedure of the Enlarged Board of Appeal.
67. The German delegation did not think it was appropriate to restrict the proceedings to a purely written form under Rule 67f(3). This was not in the interests of transparency, particularly in the case of proceedings to establish fundamental procedural defects. It also argued that there was no means of legal redress against decisions taken by the board assessing the petition.
68. The Swedish delegation also objected on the grounds that the proposed provision contradicted Article 116 to a certain extent. The Swiss and UK delegations likewise fundamentally opposed deviating from the principle laid down in Article 116 and called for the deletion of at least this part of the provision ("in written proceedings"). The staff representatives supported this position: no provision had been made for such an exception in Article 116(2) and there was thus no legal basis for purely written proceedings. They believed, however, that the appropriateness of oral proceedings in this context needed to be discussed.
69. The Austrian delegation was in favour of the draft wording of the provisions. It was clear looking at Article 9(1) RPEBA that Article 116 was not an absolutely mandatory provision; indeed, the former provision would be superfluous if a universally applicable principle were postulated in Article 116.

70. The Office again stressed that establishing this extraordinary means of redress should not be allowed to bring about procedural delays. This was why the procedure had to be concluded quickly by means of a decision. The proposed two-pronged approach met this requirement. The case made in relation to Article 116 did not hold up as hearings could also be granted in the form of written proceedings. In any case, Article 116 referred to the patent grant procedure, as opposed to part of the special procedure concerned here. The proposed procedural form did not lack legal legitimacy: Article 112a(5) EPC 2000 referred to the procedure being laid down in detail in the Implementing Regulations. The proposed model had already been described in the legal texts relating to Article 112a EPC 2000 (see CA/100/00). In an effort to find a compromise between ensuring that proceedings are conducted efficiently and taking account of the reservations expressed by certain delegations, the Office proposed deleting the wording "in written proceedings" in Rule 67f(3). In practice, this would mean that if the Enlarged Board of Appeal was of the view at the assessment stage that a petition for review was clearly inadmissible or unfounded, it would give petitioners the opportunity to respond and summons them to oral proceedings, where such proceedings had been requested. A proposal was also made to add in Rule 67f(1), final sentence, that not only Rule 84(2) but also Rule 71(1), second sentence, would not apply.
71. The Chairman summed up by saying that the majority of delegations approved the proposed wording of Rules 67a, 67c and 67f, subject to the amendments referred to above; the German and Hellenic delegations had, however, expressed reservations about introducing an obligation to raise objections and authorising a wider range of grounds for review.

Rule 69 - Noting of loss of rights

72. Responding to a question put by the Hellenic delegation about why the reference to Article 119 had been deleted, the Office explained that Article 119 EPC 2000 applied to the notification of all the Office's communications and decisions, making this separate reference unnecessary (see end of point 4, Explanatory Remarks to the draft).
73. The Committee unanimously approved Rule 69 in the text proposed.

Rule 72 - Decision on taking of evidence

74. At the *epi*'s suggestion, the Office agreed to give separate consideration to the length of minutes taken at oral proceedings, in particular the transcripts of witness and expert testimonies.

75. The Committee unanimously approved Rule 72 in the text proposed.

Rule 85a (new) - Further processing

76. The *epi* made the case for lifting the exclusion in respect of Rules 41 and 41a given that the interests of third parties in such instances would not be affected to an unreasonable degree by further processing.
77. The Office explained the new form of legal redress under EPC 2000 whereby further processing would be the standard legal remedy in the grant procedure. This meant that there would be no choice between legal remedies and no cumulation of legal remedies, ie further processing and re-establishment of rights. In practice, further processing would be a procedural means of getting a retrospective extension by paying a fee. This had to be taken into account when considering ruling out further processing in respect of a certain time limit. The new approach was based on the idea that in the case of non-observance of time limits, there should always be one opportunity for rectification. As means of legal redress already existed for dealing with the non-observance of time limits set for examination on filing and formalities examination, allowing further processing in the case of non-observance of time limits under Rules 39, 39a, 41 and 41a would create a two-tier system for rectifying errors at the first-instance stage. This would go against the efforts to streamline the patent grant procedure.
78. At the suggestion of the Austrian delegation, the phrase in the German version "durch Einrichtung der vorgeschriebenen Gebühr" was moved to appear after the word "ist" rather than after the word "Rechtsverlust".
79. The Committee unanimously approved Rule 85a in the text proposed, subject to the editorial change referred to above.

Rule 85b (new) - Re-establishment of rights

80. At the request of the UNICE representative, the Office explained that re-establishment of rights was not generally possible where, in the case of non-observance of a time limit, further processing was available under Rule 85a. It was irrelevant whether the time limit under Rule 85a(1) had expired or not. In accordance with the wishes of the Swedish delegation, the wording of paragraph 1 of the English and French versions was brought into line with the German version ("spätestens jedoch / but at the latest / mais au plus tard").

81. The Committee unanimously approved Rule 85b in the text proposed, subject to the editorial change referred to above.

Rule 89a - Information on prior art

82. The *epi* representative considered the formulation "to which the European patent application relates" to be too vague and proposed replacing it with "concerning applications having one priority in common". UNICE seconded this motion because applicants should know exactly what type of document the Office expected of them.
83. The staff representatives pointed out that the documents cited in the search report were not necessarily taken into account in the substantive examination and, conversely, new documents not included in the search report were sometimes introduced at the substantive examination stage. To make it perfectly clear that documents of both categories came under Rule 89a, the second part of the provision should read:
" ...: documents cited in the search report or taken into consideration in the examination of national
84. The Office made the point that the wording chosen appeared in the Convention already (see Article 124). To rule out any confusion in practice, special consideration would be given to this question when drafting the Guidelines for Examination.
85. The Committee unanimously approved Rule 89a in the text proposed.

Rule 95a - Constitution, maintenance and preservation of files

86. The Office went along with the Swiss delegation's suggestion regarding paragraph 4 that files should also be preserved where patents were revoked or claims limited in a limitation procedure.
87. The UK delegation pointed out that the provision only concerned the preservation of files on patents that had already expired. There did not appear to be any need for a provision for limited or amended patents.
88. The Committee unanimously approved Rule 95a in the text proposed, subject to the Swiss delegation's amendment that the provision would only apply to revocation cases.

Rule 101a - Attorney evidentiary privilege

89. The French delegation suggested changing the term "client" in the French text to "mandant" as this had a wider meaning and thus better reflected the diverse nature of the contractual relations between professional representatives and their clients.
90. The UK delegation wondered whether the wording of the provision should be more general to ensure that it could be applied to any type of communication, regardless of the author and the context in which the specific information was being given.
91. The Swedish, Danish and Netherlands delegations reported that the parties concerned were pushing for the rapid adoption of this provision in national law. The Swedish delegation expressed concerns that the new EPC provisions might not be fully efficient as long as a representative would run the risk of having to disclose confidential information in national court proceedings, regardless of whether this information was obtained in a case before the EPO. For this reason it might be appropriate to include corresponding legislation for patent attorney privilege in national law.
92. The Office emphasised that the provision had been drafted with US case law in mind to cover as many cases as possible in which attorney evidentiary privilege was recognised. The *epi* and UNICE were happy with the new provision and supported the moves to have it adopted in national law.
93. The Committee unanimously approved Rule 101a in the text proposed, subject to the editorial amendment to the French version.

Rule 105 - The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

94. The Office opposed the suggestion made by the German delegation that boards of appeal be given the task of ruling at least on the legitimacy of an additional fee under paragraph 3, and dismissed the doubts expressed by the *epi* concerning the independence of the review board. The revision of the EPC had done away with any legal basis for board of appeal involvement. Board of appeal members were legally prohibited from taking part in the work of other legal tribunals. The proposed single-step review procedure was in keeping with the PCT. There were no legal grounds for objecting to the provision as applicants did not face loss of rights in the protest procedure and further examination of the unity of invention could take place in the national phase of the application procedure. The staff representatives expressly supported the Office's position, ie that the efforts of certain - especially US - applicants to make non-unitary inventions part of the subject-matter of applications in what were referred to as "complex applications" should be resisted.

95. The Committee unanimously approved Rule 105 in the text proposed.

Part II (Draft decision of the Administrative Council)

96. The Committee unanimously approved the draft decision of the Administrative Council in the text proposed in Part II of the document.
97. The Office explained the next steps with regard to the Implementing Regulations. After a further reworking in the light of the Committee's deliberations, the latest draft would be put on the Micado database. The delegations would then have a week to make comments in writing. The preparatory work should be completed in time for the draft to be put to the Administrative Council for decision at its December 2002 meeting.

IV. AMENDMENT OF THE RULES OF PROCEDURE OF THE BOARDS OF APPEAL (RPBA) (CA/PL 11/02)

and

V. AMENDMENT OF THE RULES OF PROCEDURE OF THE ENLARGED BOARD OF APPEAL (RPEBA) (CA/PL 12/02)

98. The Office tabled the two documents.
99. Welcoming the proposals, the United Kingdom delegation said the documents were important generally in giving detailed insight into the boards' structure and procedures. In the overwhelming majority of cases, the boards did an excellent job. But it was always the exceptions which parties used to voice their doubts about procedures. The discussions leading up to the proposed changes had also shown that some users were suspicious of them, expressing concern for example that boards might unexpectedly confront parties with new arguments or change their opinion of a citation's relevance. And sometimes there were doubts as to whether board members fully understood the technology in certain fields. Misconceptions were identified only at an advanced stage of the proceedings - if at all - when it was sometimes too late to clear them up. Also,

one board had departed from the established case law on disclaimer admissibility without giving the parties any prior warning. Similarly, the boards' handling of auxiliary requests had given rise to criticism. The present initiative should therefore be used to initiate a broad discussion of procedures before the boards. The United Kingdom delegation offered to draft a document describing British users' main concerns. The proposed amendments were significant because the new rules would place obligations on parties rather than merely regulating the boards' internal procedures.

100. In a general statement, the German delegation said the main objective was a more streamlined procedure. Fair and expeditious judicial proceedings were indispensable for the proper functioning of the system and for its acceptance by the users. That meant balancing the tasks of the boards and the obligations of the parties. The proposals should be reviewed accordingly.
101. The EPO said the points raised by the German and United Kingdom delegations had often been discussed before. They were basically self-evident procedural rules which the boards were required to observe. One or two isolated exceptions did not mean the whole system was defective. Regarding technical expertise, it would not be a good idea to make the boards always give their provisional opinion, to avoid any possible misunderstandings. The current proposals contained a balanced set of changes designed to increase the speed and efficiency of the proceedings, as the first step in a wide-ranging project.
102. Delegations had no comments on the amendments proposed to Articles 1, 5, 10c and 12 RPBA and to Articles 1, 5 and 9 RPEBA.
103. The United Kingdom delegation asked about the relationship between registrars (Article 5(3) RPBA) and the board member designated under Article 3a RPBA; both could be asked to consider the admissibility of appeals. Parties should always be notified of the member designated under Article 3a. There could be a "case manager

conference", along UK lines, to clarify preliminary (procedural) issues. The Swedish and German delegations thought Article 3a RPBA should be reworded to make it clear that the rapporteur could not rule on admissibility on his own.

104. The United Kingdom delegation said the procedure described in Article 10a(2), first sentence, RPBA was at odds with UK practice, which gave appellants an opportunity to reply to the opposing party's case, provided their response was confined to the other party's submissions and did not present new arguments. The final sentence of the second paragraph was hard to understand; it was not clear what exceptions the board might authorise. The *epi* representative too was in favour of giving appellants an opportunity to respond. The EPO countered that experience of second-instance proceedings showed there was no need for new aspects to be introduced at that stage. The proposed rules fairly balanced the twin requirements that all relevant arguments were fully aired and the proceedings concluded within reasonable time.
105. Replying to a query from the German delegation, the EPO confirmed that Article 10b(1) RPBA precluded new substantive submissions, but not a change in their legal appraisal. The wording chosen was designed to give the case law room to evolve.
106. On Article 11(1) RPBA, the German delegation took up the United Kingdom delegation's suggestion that boards should keep parties informed generally during the proceedings, and in particular notify them of their provisional opinion in preparation for any oral proceedings. Article 11(1) RPBA should be worded to reflect that more strongly. The EPO said it was against any general obligation for boards to issue provisional opinions; this would mean undue extra work in the many cases where the substantive and legal position was clear.
107. Nor did the EPO share the United Kingdom delegation's reservations that the list of circumstances in which costs might be reapportioned (Article 11a(1)(a) to (e) RPBA) went beyond Article 104(1) EPC. The reference to the latter provision in Article 11a(1) RPBA was a sufficient safeguard against that.

108. The *epi* representative thought there should be explicit "burden-of-proof" rules in case of claims for award of costs. The EPO said such claims were governed by general procedural rules, so the burden of proof was on the claimant. The legal basis for this was Article 125 EPC.

VI. SUBSTANTIVE PATENT LAW TREATY (SPLT) (CA/PL 15/02)

109. The WIPO representative began with a status report on preparations for the draft SPLT. The relevant documents would be issued to delegations on WIPO's Standing Committee on Patents in the 43rd calendar week. One document contained the proposed provisions, together with brief explanations; another, separate paper gave more detailed reasons. The WIPO representative then made a few general remarks about the draft SPLT, and commented on the points raised in CA/PL 15/02.
110. Many of the draft's provisions had met with general approval from all concerned. Those on which agreement had still to be reached included difficult issues such as how patentable subject-matter was to be defined, the meaning of "technical character", and the attempt by several developing countries to include wide-ranging exceptions (eg to protect biological diversity, public health, traditional knowledge or genetic resources). The US delegation had said however that it would no longer be party to patent-law harmonisation if the SPLT contained such provisions.
111. Turning to the points in CA/PL 15/02, the WIPO representative said the draft contained no provision on patentable subject-matter, in view of currently irreconcilable differences. The USA had indicated informally that it could understand the rest of the world's unwillingness to abandon established standards on "technical character", but since this had clearly not been an official statement WIPO preferred to continue these negotiations for the time being. On novelty, WIPO would support neither the doctrine of "loss of rights" nor that of "experimental use", as most delegations were against these

concepts. The draft therefore contained no such provisions. On the "grace period", there had been no substantive amendments to the previous draft, but a number of alternative solutions (eg for the length of the period) had been included. As for the abstract, the draft provided, in line with the views of the large majority of delegations, that it should not form part of the disclosure. On the deposit of biological materials, there were still differences between the USA (whose position was that the deposit could be validly made after the filing date) and other delegations (who were against such a rule). Here too further discussion was necessary, so the draft only presented various alternatives for consideration. The "anti-self-collision" provisions had not been significantly changed.

WIPO was also thinking about including in the SPLT a provision governing amendment of granted patents. In line with the clear majority view, international applications should have the effect of an earlier application only as from entry into the national phase. That effect was confined to novelty, and did not extend to inventive step. New approaches to industrial applicability (or "usefulness") would be proposed, and on "equivalents" too the draft would contain several options.

112. The WIPO representative added that the working party on "complex applications" and "multiple invention disclosures" would be holding a consultation meeting in Geneva on 26.10.2002, during the PCT conference. WIPO would be producing a discussion paper based on the survey of delegations it had conducted.
113. The EPO expanded on the positions set out in CA/PL 15/02. With the revised draft SPLT not yet ready, some were only of a general nature. In view of a possibly controversial debate about including a provision on genetic resources, the EPO raised the whole issue of discussing strategic aspects in the committee before WIPO meetings. Past experience had shown that it was useful if the EPC contracting state delegations and the EPO concerted their positions beforehand.

114. The chairman having asked whether delegations wanted such a co-ordination meeting, and whether it should be held immediately before the WIPO discussions in Geneva or as a separate meeting of the Committee on Patent Law, the German and Hellenic delegations said they expressly supported such efforts by the EPC contracting states and the EPO to achieve common positions. The other delegations endorsed this.
115. The European Commission representative said a paper from the EPO could be useful in achieving consensus on specific technical questions beforehand, thereby strengthening Europe's negotiating position. This however could not contradict positions on policy issues already agreed by the Commission. On such issues the Commission would continue to consult the member states *in situ* at WIPO conferences. The proposed co-ordination initiative amongst EPC contracting states could be a useful adjunct to those discussions.
116. The Danish delegation said that Denmark, the current holder of the EU presidency, would work towards greater concertation of the EU member states' positions. It would however also participate unreservedly in any co-ordination of views amongst the EPC contracting states.
117. The committee agreed to meet in Munich on 21.11.2002, to co-ordinate positions for the SPLT negotiations. The sole topic for discussion would be WIPO's new draft SPLT. The EPO would produce a discussion paper, which by general agreement would be only in English and - if there was time - French.
118. The UNICE representative said that the basic problem underlying all efforts to harmonise patent law worldwide was the distinction between "first to invent" and "first to file". Large parts of industry - American as well as European - were convinced that these efforts had little prospect of success until a unitary system - namely "first to file" - was in use worldwide. The European Patent Organisation and the EU should make it

clear to WIPO and especially the USA that they were against incorporating, into Europe's traditional patent system, alien elements which would call into question its workability and the resulting legal certainty.

119. The German delegation said the US had signalled a willingness to negotiate on this key issue. The US Bar Association's decision in favour of "first to file" was a clear indication of possible radical change in the US patent system.

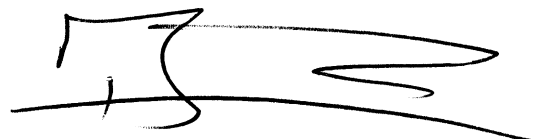
VII. OTHER BUSINESS

120. With no contributions from the floor to this agenda item, the chairman duly closed the meeting.

The Committee on Patent Law approved the minutes contained in this document on 29 April 2003.

Munich, 29 April 2003

For the Committee on Patent Law
The Chairman

A handwritten signature in black ink, consisting of a stylized 'W' followed by a long horizontal line that ends in a small hook.

Wim Van der EIJK

CA/PL 14/02 Rev. 1

Orig.: d,e,f

München/Munich, 25.10.2002

BETRIFFT: Teilnehmerliste der 19. Sitzung des Ausschusses "Patentrecht"
(München, 15. bis 16. Oktober 2002)

SUBJECT: List of participants of the 19th meeting of the Committee on Patent
Law (Munich, 15 to 16 October 2002)

OBJET : Liste des participants de la 19^e réunion du comité "Droit des brevets"
(Munich, du 15 au 16 octobre 2002)

VERFASSTER: Ratssekretariat
DRAWN UP BY: Council Secretariat
ORIGINE : Le secrétariat du Conseil

EMPFÄNGER: Ausschuß "Patentrecht" (zur Unterrichtung)
ADDRESSEES: Committee on Patent Law (for information)
DESTINATAIRES : Le comité "Droit des brevets" (pour information)

VORSITZENDER - CHAIRMAN - PRESIDENT

Mr Wim VAN DER EIJK
Legal Advisor
Netherlands Industrial Property Office
(Nederland)

STELLVERTRETENDER VORSITZENDER - DEPUTY CHAIRMAN - VICE-PRESIDENT

Mr Hugh J. EDWARDS
Deputy Director
Patents and Design Directorate
The Patent Office
(United Kingdom)

MITGLIEDSTAATEN - MEMBER STATES - ETATS MEMBRES

BELGIQUE

M. Geoffrey BAILLEUX	Conseiller adjoint Office de la Propriété Industrielle
Mme Stéphanie MISSOTTEN	Conseillère adjointe Office de la Propriété Industrielle

BULGARIA

Ms Margarita NEDYALKOVA-MECHEVA	Vice-President Bulgarian Patent Office
Ms Svetla YORDANOVA	State Examiner Bulgarian Patent Office

CESKÁ REPUBLIKA

Ms Svetlana KOPECKÁ

Director of the International and European
Integration Department
Industrial Property Office

Mr Jaroslav KOZÁK

Director of the Patent Department
Industrial Property Office

CYPRUS

Ms Vicky CHRISTOFOROU

Law Officer on European Law
Ministry of Commerce, Industry and
Tourism

DANMARK

Ms Lisbet DYERBERG

Principal Legal Adviser
Danish Patent Office

DEUTSCHLAND

Herr Dietrich WELP

Ministerialrat
Bundesministerium der Justiz

Frau Susanne FEHLHAMMER

Oberregierungsrätin
Deutsches Patent- und Markenamt

Frau Verena WOLF

Regierungsrätin z.A.
Deutsches Patent- und Markenamt

EESTI

Mr Raul KARTUS

Counsellor - EPC Coordinator
Estonian Patent Office

Ms Viive KÜBAR

Head of Legal Department
Estonian Patent Office

Ms Evelyn HALLIKA

Executive Officer
Ministry of Economic Affairs

ΕΛΛΑΣ

Ms Catherine MARGELLOU

Director
International Affairs and Legal Matters
Industrial Property Organisation (OBI)

Mr Costas ABATZIS

Director
Industrial Property Titles
Industrial Property Organisation (OBI)

ESPAÑA

Mr Miguel HIDALGO LLAMAS

Head of Legal Division
Patent and Technological Information
Department
Spanish Patent and Trademark Office

Mr David GARCÍA LÓPEZ

Technical Advisor
Spanish Patent and Trademark Office

FINLAND

Ms Maarit LÖYTÖMÄKI

Deputy Director
National Board of Patents and
Registration

Ms Marjo AALTO-SETÄLÄ

Coordinator of International Affairs
National Board of Patents and
Registration

FRANCE

M. Jean-François LEBESNERAIS

Chargé de mission
Département des Brevets
Institut National de la Propriété Industrielle

M. Pascal DUMAS DE RAULY

Chef du service des affaires
internationales et du droit communautaire
Institut National de la Propriété Industrielle

IRELAND

Mr Michael LYDON

Head of Patent Examination
Patents Office

Ms Helen CURLEY

Assistant Principal - Patents Section
Intellectual Property Unit

ITALIA

M. Giovanni DE SANCTIS

Coordonnateur technique
Office italien des brevets et des marques

Mme Rosanna LANZARA

Chef du Bureau G4 "Affaires juridiques et
législatives"
Office italien des brevets et des marques

LUXEMBOURG

M. Claude SAHL

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

MONACO

M. Yann STRIDDE

Chef de section
Division de la propriété intellectuelle

NEDERLAND

Mr Albert SNETHLAGE

Legal Advisor on Industrial Property
Ministry of Economic Affairs

ÖSTERREICH

Frau Erika BAUMANN-BRATL

Vorstand der Rechtsabteilung A
Österreichisches Patentamt

Herr Wilhelm UNGLER

Mitglied der Rechtsabteilung A
Österreichisches Patentamt

SCHWEIZ

Herr Stefan LUGINBÜHL

Jurist
Rechtsdienst Patente und Design
Abteilung Recht & Internationales
Eidgenössisches Institut für Geistiges
Eigentum

SLOVENSKA REPUBLIKA

Ms Jolana HANCÍKOVÁ

Director
Patent Department
Industrial Property Office

Mr Martin CIBULA

Legal Officer
Legislation Department
Industrial Property Office

SVERIGE

Mr Jonas PONTÉN

Legal Adviser - Associate Judge of Appeal
Ministry of Justice

Mr Per HOLMSTRAND

Chief Legal Counsel
Swedish Patent and Registration Office

Ms Marie ERIKSSON

Head of Legal Affairs
Patents
Swedish Patent and Registration Office

Ms Karin MÅRTENSSON TELDE

Associate Judge of Appeal

TÜRKIYE

Mr Mustafa BARAN

Head of Patent Department
Turkish Patent Institute

Mr Huseyin ULUDAG

Patent Examiner
Turkish Patent Institute

UNITED KINGDOM

Mr Hugh J. EDWARDS

Deputy Director
Patents and Design Directorate
The Patent Office

BEOBACHTER - OBSERVERS - OBSERVATEURS

1. Staaten - States - Etats

LATVIJA

Mr Guntis RAMANS

Deputy Director
Latvian Patent Office

LIETUVA

Mr Žilvinas DANYŠ

Head of Legal Division
State Patent Bureau

Mr Zenonas VALASEVIČIUS

Head of Invention Division
State Patent Bureau

MAGYARORSZÁG

Ms Judit HAJDÚ

Head of the Patent Department
Hungarian Patent Office

Ms Anna LÖRINCZ-FEJES

Deputy Head
Legal and International Department
Hungarian Patent Office

NORGE

Ms Randi M. WAHL

Head of Legal Section
Norwegian Patent Office

POLSKA

Mr Andrzej PYRZA

Vice-President
Polish Patent Office

Ms Ewa NIZINSKA MATYSIAK

Principal Expert
Cabinet of the President
Polish Patent Office

ROMÂNIA

Mr Alexandru Cristian STRENC

Deputy Director General
State Office for Inventions and
Trademarks

Mr Liviu BULGAR

Director
Legal and International Affairs
State Office for Inventions and
Trademarks

SLOVENIJA

Ms Mojca PECAR

Head of Legal Department
Slovenian Intellectual Property Office

Mr Janez KUKEC MEZEK

Head of Patent Department
Slovenian Intellectual Property Office

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

**World Intellectual Property Organization
Organisation Mondiale de la Propriété
Intellectuelle (WIPO/OMPI)**

Mr Philippe BAECHTOLD

Head of Patent Law Section
Patent Policy Department

Europäische Kommission - European Commission
Commission européenne

Mr Jean-Luc GAL

Administrator
Industrial Property Unit

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

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

Mr Axel CASALONGA

President
European Patent Practice Committee

Mr Wim HOOGSTRATEN

Vice-President
European Patent Practice Committee

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

Mr Jan E.M. GALAMA

Vice-Chairman of UNICE's working group
on "Patents"

EUROPÄISCHES PATENTAMT - EUROPEAN PATENT OFFICE
OFFICE EUROPEEN DES BREVETS

Herr Wolfgang STAAB
Mr Jan STEENBAKKER
Herr Rolf SPIEGEL

Direktor (1.1.4.2)
Principal Director (1.2.4)
Direktor (1.2.6.2)

Herr Gerhard WEIDMANN
Mr Steef POLDERDIJK

Direktor (2.2.0.5)
Director (2.3.1.4)

Herr Peter MESSERLI
Mr Franco BENUSSI
Ms Alessandra PIGNATELLI
Mr Vincenzo DI CERBO

Vize-Präsident GD 3
Director (3.0)
Lawyer (3.0.3.0)
Member of the Board of Appeal (3.1.1)

Mr Christoph RENNIE-SMITH	Member of the Board of Appeal (3.1.1)
Mr Johannes WILLEMS	Member of the Board of Appeal (3.1.1)
Frau Ursula KINKELDEY	Vorsitzende einer Beschwerdekammer (3.3.4)
Herr Stefan STEINBRENER	Vorsitzender einer Beschwerdekammer (3.5.1)
Mr Manuel DESANTES	Vice-President DG 5
Ms Lise DYBDAHL	Director (5.1.1)
Herr Robert CRAMER	Jurist (5.2.1)
Frau Theodora KARAMANLI	Juristin (5.2.1)
Herr Ingwer KOCH	Direktor (5.2.1)
Herr Gert KOLLE	Direktor (5.2.2)
Herr Ulrich JOOS	Jurist (5.2.2)
Herr Eugen STOHR	Jurist (5.2.2)
Mme Sylvie STROBEL	Juriste (5.2.2)
M. Eskil WAAGE	Juriste (5.2.2)
Mme Fabienne GAUYE WOLHAENDLER	Administratrice (5.2.2)

PERSONALAUSSCHUSS - STAFF COMMITTEE - COMITE DU PERSONNEL

Herr Serge MUNNIX	Personalvertreter, Berlin
Herr Luis RODRIGUEZ	Personalvertreter, Den Haag

SEKRETARIAT - SECRETARIAT

M. Yves GRANDJEAN	Chef du secrétariat du Conseil
Herr Hans-Christian HAUGG	Jurist
Ms Nuala QUINLAN	Assistant
Frau Monika BAUER	Assistentin
Frau Susanne LICHTENVORT	Assistentin
