

**CA/PL 8/01**

Orig.: English/German

Munich, 3.5.2001

SUBJECT:           Proposals re new text of the European Patent Convention  
                      (CA/PL 6/01)

DRAWN UP BY:     1.   Swiss delegation  
                      2.   United Kingdom delegation

ADDRESSEES:      Committee on Patent Law (for opinion)

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I. **PROPOSAL FROM THE SWISS DELEGATION**

Article 64

Rights conferred by a European patent

(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor, from the date on which ~~the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted,~~ **it is effectively granted in the Contracting State in question**, the same rights as would be conferred by a national patent granted in that State.

Article 86

Renewal fees for a European patent application

(1) ...

(2) The obligation to pay renewal fees shall terminate with the payment of the renewal fee due in respect of the year in which ~~the mention of the grant of the European patent is published in the European Patent Bulletin~~ **takes effect**.

Article 141

Renewal fees for European patents

(1) ...

(2) Any renewal fees falling due within two months of ~~the publication in the European Patent Bulletin of the mention of the~~ **effective** grant of the European patent shall be deemed to have been validly paid if they are paid within that period. Any additional fee provided for under national law shall not be charged.

## **II. COMMENTS BY UNITED KINGDOM**

Our general comment on this document is that some of the changes go beyond the remit established by Article 3 of the Revision Act, whereby the Administrative Council is empowered to draw up a new text in which the wording may be aligned in the three languages. No other type of amendment is envisaged apart from re-numbering. As a point of principle this exercise should not introduce changes (or potential changes) of meaning or scope: see A below for specific instances.

In addition, not all the proposed drafting amendments seem to improve the clarity of the Convention. See B below.

Finally we make some suggestions for further drafting changes: see C below.

### **A. AMENDMENTS INTRODUCING (POTENTIAL) CHANGE**

#### **Article 49:**

These changes extend considerably beyond the remit and hardly seem appropriate at this stage. Nor is the Committee on Patent Law expert to deal with these financial changes. [One drafting improvement may be made in the last sentence of Article 49(2): "The auditors shall draw up a report containing a signed audit opinion after the end of each accounting period."]

#### **Article 54(5):**

Drafting is very sensitive here, and we do not welcome change.

#### **Article 178(2):**

These are new amendments which were presumably overlooked earlier, although they seem not to be sensitive.

#### **Protocol to Article 69:**

Another area where drafting is very sensitive, and we do not welcome changes at this stage since they are not subject to scrutiny by the Revision Conference.

1. "legal certainty" is a new development for the English and French versions. It is a limitation of meaning.

2. "patent proprietor" has a very exact meaning (the person who happens to own the patent at any given time), which does not fit very well in the phrase "what the patent proprietor has contemplated", which tends to imply the original patentee. Possibly the present English version is not quite in line with the French and German here but it gives some flexibility to cover changes in ownership, and the more general wording "patentee", which we are used to, is therefore preferable.

## **B. DRAFTING AMENDMENTS WHICH DO NOT IMPROVE CLARITY**

### **Article 10(2)(c):**

The attempt to save words by deleting "and any proposal" has destroyed the clear two-part structure of the paragraph, whereby the words "which come within the competence of the Administrative Council" clearly related to any proposal for "general regulations" and "decisions". With the new short text they may be judged to relate only to proposals for "decisions".

### **Article 14(4):**

In the new wording it is imprecise to talk of "using" a language "in filing documents". Use how? We should say that the document is in that language. The word "state" should also have a capital. The original wording is clearer in meaning, if not so fluent, and should be retained.

### **Articles 21(3)(b) and 21(4)(b) and 22(2):**

These three have been made consistent in style by saving repeated words, but that style does not look consistent with Articles 21(3)(a) and 21(4)(a), which do not (cannot) save words. We particularly dislike the deletion of the word "qualified" in these three paragraphs and would prefer the paragraphs to be unchanged (in the German also). To achieve consistency Article 22(2) could insert "members" after "legally qualified".

### **Article 105b(3):**

There is a typo: "the" has been repeated before "European Patent Bulletin".

### **Article 134(6):**

Deletion of "public security" loses something particular and does not seem to accord with the French and German versions. We would prefer no change here.

**Article 139(2):**

It is not clear why this should be changed. The English proposal seems to harmonise with the French but not with the German!

**Article 168(2):**

This change should not be made. The word "notification" is needed to accord with "such notification" later in the sentence, and with Article 168(1), and with the French and German versions.

**Article 173(2):**

The reason for the change is not clear. The original text seemed to agree with at least the French version.

**C. FURTHER SUGGESTIONS FOR DRAFTING AMENDMENTS**

**Article 10(2)(g):**

In the present text it is not really appropriate to require the President to promote employees. It would be better (as apparently in German and French versions) to say that he should decide on their promotion.

**Article 21(1):**

We suggest that "of" be deleted in "of the Legal Division".

**Article 122:**

We suggest that after "the refusal of the European patent application" the comma be deleted. This may better distinguish all the many alternatives in the paragraph.

UK Patent Office  
1 May 2001

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