Rule 56 E

Travaux Préparatoires
(EPC 1973)

Comment:
The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness. The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.
Regel 56  
MPÜ  
Verwerfung des Einspruchs als unzulässig

<table>
<thead>
<tr>
<th>Entwurf, der dem nebenstehenden Dokument zugrunde liegt</th>
<th>Art. Nr. im Entwurf/Dokument</th>
<th>Dokument, in dem der Art. behandelt wird</th>
<th>Fundstelle im Dokument</th>
</tr>
</thead>
<tbody>
<tr>
<td>BR/59/70</td>
<td>101 Nr. 3</td>
<td>BR/60/70</td>
<td>Rdn. 27</td>
</tr>
<tr>
<td>VE 1971 (AO)</td>
<td>101 Nr. 3</td>
<td>BR/135/71</td>
<td>Rdn. 134</td>
</tr>
</tbody>
</table>

Dokumente der MDK

<table>
<thead>
<tr>
<th>E 1972</th>
<th>R 57</th>
<th>M/146/R 10</th>
<th>R 56</th>
</tr>
</thead>
<tbody>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/155/G</td>
<td>S. 1</td>
</tr>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/PR/G</td>
<td>S. 207/208</td>
</tr>
</tbody>
</table>

5. Filing and requirements of the European patent application (Articles 73-84 and Rules 24-37)

During its discussion of Article 73, the Main Committee was faced with the question of which office of the European Patent Office the European patent application should be filed at. In the interests of the applicant, it gave him the choice of Munich or The Hague and amended Article 73, paragraph 1(a) and Article 74, paragraph 1, accordingly.

In connection with the requirements of the application under Article 76, the Main Committee examined the need to file the abstract. It considered that if this were not done, there would be a loss of information and therefore maintained this requirement. It also decided to prescribe the compulsory publication of the abstract with the search report under Article 92.

Closely connected with the substantive requirement of disclosing the invention under Article 81 was the problem of making special provisions for European patent applications covering micro-organisms. It was not contested that the relevant provision, Rule 28, should lay down that micro-organisms which are not available to the public should be deposited with a recognised culture collection no later than at the time of filing the application, that the micro-organism should be described in the application, and that the culture collection should be identified either in the application itself or for within a short time thereafter. It was also agreed that the disclosure of the micro-organism should be subject to certain measures to protect the applicant. Views differed, however, on the latest time at which the micro-organism should be made available to the public. Contrary to the draft of Rule 28, which provided for this to be not later than the date of publication of the application, it was proposed that the applicant should not be obliged to make the micro-organism available to the public until the time of the grant of the patent, at which point the provisional protection would be lost. The main arguments put forward in defence of this standpoint were that the approach contained in the draft laid an unfair burden on such applicants in comparison to inventors in other fields of technology by requiring the subject-matter of the invention to be deposited, and that the applicant was forced to reveal know-how, thus making it easier for his invention to be copied at a time when it was not yet definite whether or not the application would lead to the grant of a patent.

Those who advocated the approach set out in the draft argued that the public could be considered to be sufficiently informed about the subject-matter of the invention only if the micro-organism were made available to the public at the time of the publication of the application; furthermore, it was only by such a disclosure that the micro-organism could be comprised in the state of the art under Article 52, paragraph 3, with the result that this was the only means whereby duplication of patents could be avoided and legal uncertainty in relation to national patent applications could be removed.

After detailed consideration of the various arguments for and against the two approaches, the Main Committee decided by a majority to retain the solution proposed in the draft and to lay down that the micro-organism should be made available to the public at the latest at the date of publication of the European patent application. At the same time, it added provisions to Rule 28 which gave the applicant far-reaching guarantees against misuse of the disclosed micro-organism during the existence of the provisional protection conferred by the application and the definitive protection of the European patent. These guarantees consisted in requiring that any third party who had access to a sample of the culture would have to make certain undertakings vis-à-vis the culture collection or the applicant for or proprietor of the patent in respect of the ways in which he used the culture. On the other hand, the Main Committee decided, in the same way as in respect of Article 67, not to adopt a procedural rule which would have obliged a third party who used a micro-organism disclosed by the applicant to prove that the culture concerned was not that described in the application, even though the reversal of the burden of proof would have reinforced the legal position of the applicant even further. It was also made clear in Rule 28 that the built-in safety clauses in favour of the applicant did not prejudice any national provisions concerning compulsory licences or uses in the interest of the State. The details governing the deposit, storage and availability of cultures were left to agreements to be concluded between the President of the European Patent Office and the recognised culture collections.

6. Questions of priority (Articles 85-87/Rule 38)

Apart from the amendment to Article 85, paragraph 5, already dealt with above in the chapter on "language questions", the provisions of Articles 85-87 concerning priority led to few amendments. It may be mentioned that the extension of the priority right to States which are not members of the Paris Convention, in accordance with an amendment decided upon by the Committee in the interests of the Contracting States, will apply only if international reciprocity is granted not only in relation to European but also in relation to national applications by Contracting States.

7. Procedure up to grant (Articles 88-97/Rules 39-55)

In so far as individual provisions of Articles 88-97 and the corresponding Rules 39-55 concerning the procedure up to grant have already been discussed in connection with language questions, identification of the inventor and the abstract, reference should be made to the appropriate Chapters 1, 3 and 5.

During the discussion of Articles 93/94 the Committee confirmed the specified period within which requests for examination may be filed and also the possibilities for extending the time limits, both of which are the result of well thought out compromises. The Committee refused in particular to lay down in Article 94 an absolute right for third parties to request examination in the event of the Administrative Council extending a time limit. The need for such a right for third parties depends largely on the length of time by which the period is extended.

8. Opposition procedure (Articles 98-104/Rules 56-64)

The provisions concerning opposition procedure gave rise to very little discussion. A proposal to delete the opposition fee in Article 98, paragraph 1, on the ground that the opponent was to be considered as a person helping to establish the legal facts of the matter, was rejected by the majority. If the fee were to be dispensed with, dilatory opposition would be encouraged. Furthermore, the interests of the opponent are his main incentive and lastly, pursuant to Article 114, any person who wishes to help to establish the legal facts of the matter may present, free of charge, observations concerning the patentability of an invention in respect of which an application has been filed. By a vast majority the Committee also refused to shorten to six months the nine-month opposition period laid down in Article 98, paragraph 1, which had been adopted as a compromise solution at an earlier stage in the negotiations.

In Article 98 and in Rule 61 the Committee added new provisions which also make possible the filing of notice of opposition and consequently the continuation of opposition proceedings when the proprietor has completely surrendered the European patent or when it has lapsed for all the
ANNEX I

REPORT

by Mr. Paul Braendli, Lic. iur.
Vice-Director of the Federal Intellectual Property Office (Switzerland)

on the results of Main Committee I’s proceedings

ANNEX II

REPORT

by Mr. R. Bowen
Assistant Comptroller, British Patent Office

on the results of Main Committee II’s proceedings

ANNEX III

REPORT

by Mr. Fressonnet
Deputy Director of the Institut National de la Propriété Industrielle (France)

on the results of Main Committee III’s proceedings

ANNEX IV

REPORT

by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office

on the results of the Credentials Committee’s proceedings

with regard to full powers for signing the Convention
## Contents

<table>
<thead>
<tr>
<th>Section</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Introduction</td>
<td>7</td>
</tr>
<tr>
<td>Report on the meeting of the Plenary Opening Meeting</td>
<td>9</td>
</tr>
<tr>
<td>(M/PR/K/1)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of the Credentials Committee</td>
<td>25</td>
</tr>
<tr>
<td>(M/PR/V)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee I</td>
<td>27</td>
</tr>
<tr>
<td>(M/PR/I)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee II</td>
<td>109</td>
</tr>
<tr>
<td>(M/PR/II)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee III</td>
<td>155</td>
</tr>
<tr>
<td>(M/PR/III)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of the Committee of the Whole</td>
<td>163</td>
</tr>
<tr>
<td>(M/PR/G)</td>
<td></td>
</tr>
<tr>
<td>Report on the meeting of the Plenary Final Meeting</td>
<td>199</td>
</tr>
<tr>
<td>(M/PR/K/2)</td>
<td></td>
</tr>
<tr>
<td>List of participants</td>
<td>211</td>
</tr>
</tbody>
</table>
Rule 56, paragraph 2:

(2) If the Board of Appeal notes that the appeal does not comply with the provisions of Rule 64, sub-paragraph (a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

In paragraph 1 (present Rule 65) insert "sub-paragraph (b)" after "Rule 64".
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 2 October 1973
M/155/G
Original: English

CONFERENCE DOCUMENT

Drawn up by: Norwegian delegation

Subject: Rule 56, paragraph 2, of the Implementing Regulations
Rule 55b
Rejection of the notice of opposition as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and Rule 55, sub-paragraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Rule 55 other than those mentioned in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not corrected in good time, the Opposition Division shall reject it as inadmissible.

(3) Any decision to reject a notice of opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/146/R 10
Original: English/French/German

CONFERECE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 54 to 82
FÜNFTER TEIL

AUSFÜHRUNGsvORSCHRIFTEN ZUM FÜNFTEN TEIL DES ÜBEREINKOMMENS

Regel 56
Form des Einspruchs

Der Einspruch muß enthalten:

a) den Namen, die Anschrift und den Staat des Wohnsitzes oder Sitzes des Einsprechenden nach Maßgabe der Regel 26 Absatz 2 Buchstabe c;

b) die Nummer des europäischen Patents, gegen das der Einspruch eingelegt wird, sowie die Bezeichnung des Inhabers dieses Patents und der Erfindung;

c) eine Erklärung darüber, in welchem Umfang gegen das europäische Patent Einspruch eingelegt und auf welche Einspruchsgründe der Einspruch gestützt wird, sowie die Angabe der zur Begründung vorgebrachten Tatsachen und Beweismittel;

d) falls ein Vertreter des Einsprechenden bestellt ist, seinen Namen und seine Geschäftanschrift nach Maßgabe der Regel 26 Absatz 2 Buchstabe c.

Vgl. Artikel 98 (Einspruch) und 104 (Beitritt des vermeintlichen Patentverletzers)

Regel 57
Verwerfung des Einspruchs als unzulässig

(1) Stellt die Einspruchsabteilung fest, daß der Einspruch Artikel 98 Absatz 1 sowie Regel 1 Absatz 1 und Regel 56 Buchstabe c nicht entspricht oder daß das europäische Patent, gegen das der Einspruch eingelegt wird, nicht hinreichend bezeichnet ist, so verwirft sie den Einspruch als unzulässig, sofern die Mängel nicht bis zum Ablauf der Einspruchsfrist beseitigt worden sind.

(2) Stellt die Einspruchsabteilung fest, daß der Einspruch anderen als den in Absatz 1 bezeichneten Vorschriften der Regel 56 nicht entspricht, so teilt sie dies dem Antragsteller mit und fordert ihn auf, innerhalb einer von ihr zu bestimmenden Frist die festgestellten Mängel zu beseitigen. Werden die Mängel nicht rechtzeitig beseitigt, so verwirft die Einspruchsabteilung den Einspruch als unzulässig.

(3) Jede Entscheidung, durch die ein Einspruch als unzulässig verworfen wird, wird dem Patentinhaber mit einer Abschrift des Einspruchs mitgeteilt.

Vgl. Artikel 100 (Prüfung des Einspruchs) und 104 (Beitritt des vermeintlichen Patentverletzers)

PART V

IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

Rule 56
Form of the notice of opposition

The notice of opposition shall contain:

(a) the name and address of the opponent and the State in which his residence or registered place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) the number of the European patent against which opposition is filed, and the name of the proprietor and title of the invention;

(c) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;

(d) if the opponent has appointed a representative, his name and the address of his place of business, in accordance with the provisions of Rule 26, paragraph 2(c).

Vgl. Section 98 (Opposition) and 104 (Intervention of the assumed infringer)

Rule 57
Rejection of the notice of opposition as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 98, Rule 1, paragraph 1, and Rule 56, sub-paragraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Rule 56 other than those mentioned in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not corrected in good time, the Opposition Division shall reject it as inadmissible.

(3) Any decision to reject a notice of opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice.

Vgl. Artikel 100 (Prüfung des Einspruchs) und 104 (Beitritt des vermeintlichen Patentverletzers)

Cf. Articles 100 (Examination of the opposition) and 104 (Intervention of the assumed infringer)
ENTWURF EINER AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN
ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN

DRAFT IMPLEMENTING REGULATIONS
TO THE CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

PROJET DE RÈGLEMENT D'EXÉCUTION
DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTERTeilungsverfahrens 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Munich, 10 September to 6 October 1973)

CONFERENCE DIPLOMATIQUE DE MUNICH
POUR L'INSTITUTION D'UN SYSTÈME EUROPÉEN
DE DÉLIVRANCE DE BREVETS
(1973)
(Munich, 10 septembre - 6 octobre 1973)

VORBEREITENDE DOKUMENTE
ausgearbeitet von der
Regierungskonferenz über die Einführung eines europäischen Patenterteilungsverfahrens
herausgegeben von der
Regierung der Bundesrepublik Deutschland

PREPARATORY DOCUMENTS
drawn up by the
Inter-Governmental Conference for the setting up of a European System for the Grant of Patents
and published by the
Government of the Federal Republic of Germany

DOCUMENTS PRÉPARATOIRES
élaborés par la
Conférence intergouvernementale pour l'institution d'un système européen de délivrance de brevets
et publiés par le
Gouvernment de la République fédérale d'Allemagne

1972
**Article 101** (Opposition)

**Article 102** (Notification of the result of the examination in opposition proceedings)

**Article 103** (Reply of the parties concerned)

Re. **Article 101. No. 3** (Rejection of the notice of opposition as inadmissible)

133. The Working Party examined proposals by the United Kingdom delegation (BR/GT I/113/71) on clarifying the order of operations in opposition proceedings and on filling certain gaps left by the Second Preliminary Draft.

134. The Working Party first examined a proposal to provide in **Article 101, paragraph 3**, that before informing the proprietor of a patent that opposition has been lodged, the Opposition Division should examine the admissibility of the notice of opposition.

Certain delegations stated that the patentee had a certain interest in being informed of the existence of an opposition notice, even where it was not admissible, as he would probably then expect to see revocation proceedings instituted before the national courts of the States in respect of which his patent had been granted.

While agreeing with the United Kingdom's proposal, the Working Party decided, in view of the patentee's interest in being informed, to amend **Re. Article 101, No. 3**, of the Implementing Regulations by adding a new paragraph 3 providing that any decision to reject a notice of opposition should be communicated to the proprietor of the European patent together with a copy of the notice.

BR/135 e/71 lcr/prk.../...
MINUTES

of the 9th meeting of Working Party I

held from 12 to 22 October 1971, in Luxembourg

1. Working Party I held its 9th meeting in Luxembourg from 12 to 22 October 1971, with Dr. Haertel, President of the German Patent Office, in the Chair.

Representatives from the IIB and WIPO took part in the meeting as observers. The representatives of the Commission of the European Communities and the Council of Europe sent their apologies for being unable to attend. See Annex I to these minutes for the list of those present at the 9th meeting.

2. Working Party I adopted the provisional agenda as contained in BR/GT I/120/71 and attached to this document as Annex II.

3. The Drafting Committee of Working Party I met first under the chairmanship of Mr. van BENTHEM, President of the Octrooiraad; and after his departure, that of Mr. LABRY, Embassy Counsellor at the Ministry of Foreign Affairs (France).

BR/135 e/71 prk
(Unrevised translation)
Zu Artikel 101
Nummer 2

Anforderung von Unterlagen

Werden im Einspruchsverfahren von einem Beteiligten Unterlagen genannt, die im Europäischen Patentamt nicht vorhanden sind, so kann das Europäische Patentamt die Nachrechnung der Unterlagen innerhalb einer von ihm zu bestimmenden Frist verlangen. Werden die Unterlagen nicht rechtzeitig vorgelegt, so braucht das Europäische Patentamt das darauf gestützte Vorbringen nicht zu berücksichtigen.

Zu Artikel 101
Nummer 3

Verwerfung des Einspruchs als unzulässig

(1) Stellt die Einspruchsabteilung fest, daß der Einspruch dem Artikel 101 des Übereinkommens und dem Artikel ... (Nummer 1 zu Artikel 101) Absatz 2 Buchstabe c nicht entspricht oder daß das Patent, gegen das der Einspruch eingelegt wird, nicht hinreichend bezeichnet ist, so verwirft sie den Einspruch als unzulässig, sofern die Mängel nicht bis zum Ablauf der Einspruchsfrist beseitigt worden sind.

(2) Stellt die Einspruchsabteilung fest, daß der Einspruch anderen als den in Absatz 1 bezeichneten Vorschriften des Artikels ... (Nummer 1 zu Artikel 101) nicht entspricht, so teilt sie dies dem Antragsteller mit und fordert ihn auf, innerhalb einer von ihr zu bestimmenden Frist die festgestellten Mängel zu beseitigen. Werden diese Mängel nicht rechtzeitig beseitigt, so verwirft die Einspruchsabteilung den Einspruch als unzulässig.

Zu Artikel 101
Nummer 4

Fortsetzung des Einspruchsverfahrens von Amts wegen

Stirbt ein Einsprechender oder verliert er seine Handlungsfähigkeit, so kann das Einspruchsverfahren auch ohne die Beteiligung seiner Erben oder gesetzlichen Vertreter von Amts wegen fortgesetzt werden. Das Verfahren kann auch fortgesetzt werden, wenn der Einspruch zurückgenommen wird.

Zu Artikel 101
Nummer 5

Mitteilungen an die übrigen Einsprechenden

(1) Sind mehrere Einsprüche eingelegt worden, so teilt die Einspruchsabteilung gleichzeitig mit der Mitteilung gemäß Artikel 101 Absatz 3 des Übereinkommens die Einsprüche den übrigen Einsprechenden mit.

(2) Die weiteren Schriftsätze der Einsprechenden werden den übrigen Beteiligten mitgeteilt. Enthalten diese Schriftsätze Tatsachen und Beweismittel, die nicht in der Einspruchs begründung enthalten sind, und beabsichtigt die Einspruchsabteilung, diese Tatsachen und

Re. Article 101
No. 2

Requests for documents

If during opposition proceedings a party refers to documents which are not available in the European Patent Office, the European Patent Office may require that those documents be produced within such period as it may specify. If such documents are not produced in good time, the European Patent Office may decide not to take into account any evidence based on them.

Re. Article 101
No. 3

Rejection of the notice of opposition as inadmissible

(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 101 of the Convention and of Article ... (Re. Article 101, No. 1), paragraph 2 (c), or does not provide sufficient identification of the patent against which (opposition has been lodged, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

(2) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article ... (Re. Article 101, No. 1) other than those mentioned in paragraph 1, it shall so notify the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not rectified in good time, the Opposition Division shall reject it as inadmissible.

Re. Article 101
No. 4

Continuation ex officio of the opposition proceedings

In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued ex officio, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

Re. Article 101
No. 5

Communications to the other opponents

(1) If several notices of opposition have been lodged, the Opposition Division shall communicate them to the other opponents at the same time as the notification provided for under Article 101, paragraph 3, of the Convention.

(2) Any written statement subsequently made by an opponent shall be communicated to the other parties. If such a statement refers to facts and evidence not indicated in the notice of opposition, and if the Oppo-
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES
PATENTERTeilungsverfahren

FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS
TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION
DE LA CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN
DE DÉLIVRANCE DE BREVETS
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN

sowie
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN

und
ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

SECOND PRELIMINARY DRAFT OF A CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

with
FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION DE LA CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

— 1971 —
Swiss and German delegations emphasised in this respect that this rule could not be interpreted in such a way that the oral decision would constitute an exception. The Drafting Committee, furthermore, thought it desirable to lay down a general provision relating to the form of the decisions taken by all the departments of the European Patent Office (See footnote to the text)."

7. In the last paragraph of point 55 for "from the point of view of international law" read "as an international convention was concerned".

8. Delete the text of point 57 and substitute "Following this decision, the German delegation reserved its position on paragraph 2. It stated that in its opinion it was illogical to lay down a binding rule under which decisions subject to appeal should be accompanied by a notification stating the conditions of appeal, and yet, in paragraph 2, to debar any legal consequences in the event of an infringement of that rule."

BR/68 e/70 (ANNEX III) oyd/KM/fm
ANNEX III

Amendments to the minutes of the meeting from 20 to 23 October 1970

1. Delete the text of point 17, and substitute:
"The Sub-Committee made provision for the reimbursement of the appeal fee in the event of an interlocutory revision, or when the Board of Appeal allows the appeal, on condition that the reimbursement is equitable by reason of a substantial procedural violation."

2. This amendment does not concern the English text.

3. Under point 22 add: "See the footnote to the text."

4. Under point 23 delete the text and substitute "No comments."

5. Under point 27 delete the last paragraph and substitute:
"Paragraph 2 states the deficiencies which may be rectified even after expiry of the opposition period. Nevertheless if no rectification has taken place within a certain period to be laid down by the Opposition Division, the latter will reject the opposition as inadmissible."

6. Delete the texts of points 52, 53 and 20 and substitute:
"This provision lays down that in the event of a hearing or oral proceedings the decisions of the European Patent Office may be given orally at the hearing. They should then be put in writing and notified to the parties. The
MINUTES

of the 4th meeting of Working Party I Sub-Committee
on "Implementing Regulations"
(Luxembourg, 23-27 November 1970)

I.

1. The fourth meeting of the Sub-Committee instructed by
Working Party I to draw up draft Implementing Regulations to
the Convention was held at Luxembourg, from Monday 23 to
Friday 27 November 1970, with Mr. PRESSONNET, Deputy Director,
French Industrial Property Institute, in the Chair.

In addition to the national delegations represented in
the Sub-Committee, the meeting was attended by WIPO and the
International Patent Institute (1).

(1) See the list of participants in Annex I.
This does not alter the fact that as soon as the European Patent Office finds a deficiency of this nature, it will be morally obliged to bring it to the attention of the opponent so that the latter may rectify it in due time. This is the meaning that the Sub-Committee intended to give to the words: "unless these deficiencies have been remedied before expiry of the opposition period."

Paragraph 2 states the deficiencies which do not affect the validity of the notice of opposition and which may be rectified even after the opposition period has expired. Nevertheless, if no rectification has taken place within a certain period to be laid down by the Opposing Division, the latter Office is obliged to inform the opponent of the deficiencies and the liability of the European Patent Office is not involved in this case.

Re. Article 101, No. 4 - Continuation ex officio of the opposition proceedings

28. The majority of the Sub-Committee considered it necessary to lay down that the European Patent Office has the right to continue the opposition proceedings in the event of death, legal incapacity or even withdrawal. It may in fact be necessary to withdraw or amend a patent in the public interest. The right - and not the obligation - provided will enable the European Patent Office to assess whether or not the public interest is concerned.

The United Kingdom delegation expressed a provisional reservation on the actual principle of the continuation ex officio of the opposition proceedings.
Re. Article 101, No. 2 - Requests for documents

26. This Article lays down firstly that the person lodging the opposition must supply the European Patent Office with the documents that he is citing in support of his case, if the Office is not in possession of them and asks him for them. In opposition proceedings the European Patent Office is obliged to examine all relevant documents. Working Party I has not in fact ruled against the opponent producing, during the course of opposition proceedings, any document which might cast doubts on the novelty of the invention.

After an observation on the part of the United Kingdom delegation, the Sub-Committee subsequently decided that the provision should not be limited to the opponent alone, but should be extended to apply to all the parties involved in opposition proceedings. The European Patent Office may also find it very useful to obtain from the proprietor of the patent supplementary documents regarding the novelty of the invention.

Re. Article 101, No. 3 - Rejection of the Notice of Opposition as inadmissible

27. During its discussion on this Article, the Sub-Committee decided in connection with the requirements for the admissibility of the notice of opposition (paragraph 1), that in spite of the importance of the matter, it was not necessary to oblige the European Patent Office to ask the opponent to rectify within the time-limit laid down deficiencies in the notice of opposition. The consequences of such an obligation would put the European Patent Office in too difficult a position in the event of a delay on its part. The term of nine months laid down in the Preliminary Draft for lodging opposition will be fully binding, and the European Patent Office will not be able to grant periods of grace.

BR/60 e/70 ley/KM/prk
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 16 November 1970
BR/60/70.

- Secretariat -

MINUTES
of the 3rd meeting of Working Party I Sub-Committee
on "Implementing Regulations"
(Luxembourg, 20-23 October 1970)

I

1. The third working meeting of the Sub-Committee
instructed by Working Party I to draw up draft
Implementing Regulations to the Convention was held at
Luxembourg, from Tuesday 20 to Friday 23 October 1970,
with Mr. FRESSONET, Deputy Director, French Industrial
Property Institute, in the Chair.

In addition to the national delegations represen-
ted in the sub-Committee, the meeting was attended by
BIRPI and the International Patents Institute (IIB) (1).

(1) See the list of participants in Annex I.

BR/60 e/70 oyd/EM/prk
Preliminary draft implementing regulations

(20 to 23 October 1970)

of Working Party I

outcome of the work of the "Inter-Departmental Regulation" sub-committee

Secretary

BR/59/70

9 November 1970
designated Contracting States. The valid interests of an assumed infringer in the retroactive revocation of the patent may thus be upheld. In this connection it may be noted that this amendment has raised the opposition proceedings another step towards the level of actual revocation proceedings.

A further procedural amendment was made to Article 104 whereby any person who has been given notice by the proprietor as a result of a claimed patent infringement may also intervene in the opposition proceedings, if he proves that he has instituted proceedings to establish that the act in question did not infringe the patent. This text takes into account the fact that national laws of Contracting States allow such actions for negative declaratory judgments.

9. Appeals procedure (Articles 105-111/Rules 65-68)

Corresponding to the amendment to Article 98 with reference to the possibility of continuing the opposition proceedings despite the lapse of the patent, the Committee decided also to allow an appeal against a decision of the Opposition Division in such cases and to amend Article 105 accordingly. It was consequently made clear in Article 106 that all parties to proceedings of the first instance are also parties to appeal proceedings, even if they do not actively participate in the proceedings, so that for example a decision concerning costs by the Boards of Appeal which differs from the decision of the lower department will be binding for all parties.

The discussions during the earlier stages of the negotiations concerning the length of the time limit for filing an appeal were — as was to be expected — resumed in the Main Committee. An exchange of opinions showed that the division of the time limit for filing an appeal, as provided for in Article 107, into a time limit for filing the appeal and a time limit for filing the grounds for appeal, was generally welcomed. In the interests of the applicants and especially of their representatives who have such a multiplicity of time limits to observe, the Main Committee divided the time limits into one of two months for the notice of appeal, which also applies to the payment of the fee for appeal, and one of four months for filing the grounds for appeal; both time limits are to commence from the time when notification is given of the contested decision. This amendment made it necessary to adjust the one-month time limit for interlocutory revision, which now begins from the receipt of the grounds for appeal (Article 108). If the potential appellant waits until the end of each time limit — which experience leads us to expect — an appeal which is not immediately allowed will not reach the Board of Appeal earlier than five months after the contested decision has been taken! Whether this is compatible with the previously defended principle of streamlining the proceedings, remains to be seen.

In Article 109, paragraph 3, it was specified in respect of the appeals procedure that the deemed withdrawal of a European patent application in the event of failure to reply to an invitation from the Board of Appeal is not valid in proceedings against decisions of the Legal Division. In Article 111 the Committee expressly maintained in the interests of clear legal relationships that the parties to appeal proceedings should also be parties to any proceedings before the Enlarged Board of Appeal. Such a principle could easily be derived from Articles 112/115.

10. General principles governing procedure (Articles 112-126/Rules 69-92)

Some points of the general rules governing procedure were discussed in the Main Committee. In order to avoid improper delays in proceedings an assurance was given in Article 115 that repeated requests for oral proceedings could be refused by the European Patent Office under certain conditions. In Article 116 and in Rule 73 the peculiarities of the national laws of Contracting States were taken into account in respect of the taking of evidence, on the basis of letters rogatory, by authorities in the Contracting States and, in addition to the giving of evidence under oath by a party, witness or expert, provisions were made for other binding forms of evidence which enable the truth to be established. With reference to the communication of the possibility of appeal in accordance with Rule 69, paragraph 2, the principle that parties may invoke errors in the communication was abandoned; errors are however almost entirely excluded because reference must always be made in the communication to the relevant provisions of Articles 105-107, the text of which must be attached.

The rules governing time limits and the arrangements for dealing with unobserved time limits were adopted by the Committee with the following amendments. In Article 120 the time limit concerning the request for further processing of the European patent application was adapted to the new time limit for filing appeals and was therefore quite rightly reduced from three to two months. There was a detailed discussion on the concept of “force majeure” required in accordance with Article 121 for the re-establishment of rights. This condition was generally felt to be too strict because it would justify re-establishment only in the rarest of cases. The Committee also considered the conditions such as those of the “unavoidable event” or of the “legitimate excuse” which are based on national laws of Contracting States. After comparing the laws of various States, the Committee finally agreed, in accordance with the conclusions of the Working Party which it had set up, that the justification for the re-establishment of rights was an impediment which, in spite of all due care required by the circumstances having been taken, had led to the non-observance of the time limit. The Committee also endorsed the general opinion that in reality justice is done to this obligation to take all due care only if the applicant or proprietor and his assistants, especially his representatives, have complied with it. In addition, the Committee considered that Article 121 was to be interpreted in a restrictive manner.

The Main Committee extended the maximum duration of time limits to be set by the European Patent Office under Rule 85 from four to six months for certain special circumstances. However, a proposal was not accepted which aimed to make provision for a one-month extension, on request, of any time limit for representatives who in the proceedings had to draw up documents to the European Patent Office in a language other than the official language of their State or residence. The Committee recognised unanimously that during a transitional period such translation difficulties should be deemed to be “certain special circumstances” within the meaning of paragraph 1 of Rule 85, in so far as the parties complied with their obligation to take due care in obtaining translations.

The provision in Article 124 concerning the procedure for drawing up supplementary search reports provided a large amount of material for discussion. This Article was deleted. The Committee considered it unnecessary to impose search costs on the applicant in the event of his making necessary an additional search due to an amendment to the claims. This financial problem could be settled by slightly increasing the standard amount of the main search fee. After lengthy discussions the Committee reached the majority decision that additional fees for additional searches which were drawn up outside the procedure for international search reports under Article 156, could be dispensed with, especially since such an additional cost would have an unfavourable visual effect in the Convention. At the same time the Committee stated expressly