Rule 61 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Regel 61
MPÜ
Rechtsübergang des europäischen Patents

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3. 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 time and the applicant would have to meet 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 adequately described in the application, and that the culture collection should be identified either in the application itself or 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
Article 125 — Reference to general principles

665. In connection with Article 125, it was established at the request of the United Kingdom delegation that there was majority agreement in the Main Committee on the following: that it was a generally recognised principle of procedural law in the Contracting States that a person can be granted only one European patent for the same invention in respect of which there are several applications with the same date of filing.

666. The Norwegian delegation stated that it could not agree to this principle in its present general form since under Scandinavian law it was possible in theory to grant two patents to an applicant for the same invention.

667. The FICPI delegation wondered what was meant in this instance by the same application or the same patent; did it mean that the content was substantially the same or that the patent claims were substantially the same?

668. The United Kingdom delegation interpreted it as meaning that the patent claims were the same.

669. It was furthermore established, at the request of the United Kingdom delegation, that it was the unanimous opinion of the Main Committee that the European Patent Office had the right to correct any inadvertent errors on its part.

Article 126 — Termination of financial obligations

670. At the suggestion of the Belgian delegation, the Main Committee referred Article 126 to the Drafting Committee to see whether a more suitable heading could be found.

Article 127 — Register of European Patents

671. The Austrian delegation proposed that it should be made clear that entries in the Register of Patents could be made, not only on the basis of the Convention, but also on the basis of the Implementing Regulations (M/41, point 5).

672. The German and Netherlands delegations considered such clarification superfluous in view of Article 163 (164).

673. The Austrian delegation accordingly withdrew the proposal.

674. The Austrian delegation further proposed that Article 127 be so worded that legal amendments concerning the European patent made during the opposition proceedings which, in any case, were entered in the relevant national patent registers, should also be entered in the European Register of Patents. Awareness of such entries could be of particular importance for opponents. The Austrian delegation also felt that it should be made clear that no entry could be made in the Register of European Patents once the opposition proceedings had been concluded (M/41, points 6-8).

675. The German delegation maintained that the Austrian delegation's request was already covered since Rule 62 (61) together with Rule 20 laid down that the transfer of the European patent during the opposition period or during opposition proceedings had to be entered in the Register of European Patents at the request of an interested party.

676. It did not consider it worthwhile fixing the final deadline for entries in the Register of European Patents in the Convention: the German delegation felt that it would be preferable to leave the matter as it now stood in Rule 62 (61) which could be more easily amended if the need arose.

677. The Swiss delegation came to the conclusion that the present flexible arrangement governing entries in the Register of European Patents was more expedient than a rigid provision in the Convention.

678. The Austrian delegation pointed out that its reason for proposing that a final deadline for entries in the Register of European Patents be fixed in the first place was that under Austrian law, entries in the register had legal effect and consequently, contradictory entries in the national register on the one hand, and in the European Register on the other, could give rise to problems.

679. The Chairman replied that entries in the Register of European Patents created no rights or obligations towards third parties but only vis-a-vis the European Patent Office. Accordingly, differences between entries in the Register of European Patents and those in national registers should have no adverse consequences.

680. In view of the outcome of the discussion, the Austrian delegation withdrew its proposal even though this might cause it some difficulty.

Article 128 — Inspection of files

680. The Swedish delegation proposed that Article 128 and in particular paragraphs 1 and 4 be amended so that instead of having to wait for the patent application to be published the files would be made available for unrestricted inspection 18 months after either the date of filing or the priority date (M/53/I/II, point 7).

681. The Netherlands delegation wondered whether this would mean that copies of all patent applications would, after 18 months, have to be made available for inspection of the files.

682. The Swedish delegation considered that this would certainly not be necessary for all patent applications but only for those which competitors of the applicant wished to inspect.

683. The United Kingdom delegation pointed out that patent applications would probably be published very shortly after expiry of the 18-month period from the date of filing or priority date. If only a short period — about 1 month — was going to elapse before publication, it would not be worthwhile setting up a special section in the European Patent Office for inspection (with its own staff and a special library). Moreover, it would not be right to allow the files to be inspected before the provisional protection deriving from the application had begun; this would be afforded only on publication.

684. The German delegation also drew attention to this point. It furthermore pointed out that practice of making as yet unpublished applications available to third parties could detract from novelty. For these reasons it had no alternative but to reject the Swedish proposal.

685. The Swiss delegation opposed the Swedish proposal mainly on the grounds that during the period between the date of making available the files for inspection and the publication of the application, the applicant would have no provisional legal protection.

686. The IAPIP delegation agreed with the German delegation's views.

687. Having considered these objections, the Swedish delegation withdrew its proposal.

688. The Main Committee referred to the Drafting Committee a drafting proposal from the German delegation relating to paragraph 4 (M/47/I/II/III, point 42).

689. The Swiss delegation proposed that paragraph 5 (b) be supplemented to the effect that the date of any priority claim concerning third parties could also be given or published since if this date were not given, third parties could draw false conclusions (M/31, point 5, and M/54/I/II/III, page 21).

690. The United Kingdom delegation pointed out that publication of the priority date could, in some cases, conflict with Article 30, paragraph 2, of the Patent Cooperation Treaty. This problem could be overcome by including among the information which could be given, in addition to the priority
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MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Rule 64

Transfer of the European patent

Rule 20 shall apply *mutatis mutandis* to any transfer of the European patent made during the opposition period or during opposition proceedings.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1975
M/146/R 10
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 54 to 82
"Article 127, fourth sentence

... As long as a transfer within the meaning of Articles 69 and 72a has not been entered in the Register of European Patents, the previous applicant for or proprietor of the patent shall have the same rights and obligations as hitherto in proceedings before the European Patent Office."

9. A further question arises in connection with entries in the Register of European Patents, that of the law governing examination by the European Patent Office of a request for transfer and the supporting documents. Transfer documents may fulfill the legal requirements of certain designated States while being inadequate for other Contracting States. In addition, under the Austrian provisions governing derivative acquisition of rights, for example, an entry has to be made in the national register and registration fees have to be paid. A central registration procedure such as that aimed at by the Register of European Patents therefore requires a system governing, on the basis of the Convention, the relationship between the various national procedures and the central procedure.

Basically, this can be done in two ways:

1. by laying down formal minimum requirements for the request for transfer, to be examined by the European Patent Office and subsequently by the national authorities which may then reject the transfer (central registration procedure similar to the system adopted in Article 14 of the Treaty on the international registration of trade marks – TRT), or

2. by having the request for transfer examined first by the national authorities of the Contracting States, which then transmit the approved request to the European Patent Office for registration in the Register of European Patents.

Without additional provisions of this nature, the Register of European Patents would be able to function only to a very limited degree as a central reference source.

.../...
7. In the context of the period to be covered by the Register of European Patents, a particular problem is presented by the entry of transfers. Chapter IV of Part II of the Convention covers the transfer and constitution of rights in respect of European patent applications only, the registration of which in the Register of European Patents is provided for in Chapter III of Part II of the Implementing Regulations. A change of proprietor after grant is dealt with solely by Rule 13. Yet it would hardly seem reasonable not to enter in the Register of European Patents a transfer of a patent in respect of which proceedings were still continuing before the European Patent Office. Otherwise, for example, the proprietor in opposition proceedings could be different from the person entered in the Register of European Patents. In the case of this type of information as in any other, the principle should apply that up to the end of the "European phase" relevant changes to the particulars entered in the Register of European Patents should also be entered in the Register. The proprietorship of the patent could be dealt with by inserting a new Article after Article 72 and by amending Rule 20 accordingly:

"Article 72a

The provisions of Articles 69 to 72 shall apply mutatis mutandis to European patents."

"Rule 20

(1) Any transfer of a European patent application or of a European patent during the period laid down in Article 127 shall be recorded in the Register of European Patents at the request of an interested party ...".

8. Article 127 does not cover the legal effects of entries or amendments to entries in the Register of European Patents. Nor does Rule 20, paragraph 3, provide a satisfactory solution, as it only covers effects between the applicant and the European Patent Office. It is therefore proposed that the following be added to Article 127:
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 22 August 1973
M/ 41
Original: German

PREPARATORY DOCUMENT

Drawn up by: Austrian Government

Subject: Proposals for amendments to the Drafts of the Convention, the Implementing Regulations, the Protocol on the Recognition of Decisions, the Protocol on Privileges and Immunities and the Protocol on Centralisation
(6) In der Mitteilung der Einspruchsabteilung nach Absatz 5 werden die benannten Vertragsstaaten angegeben, die eine Übersetzung nach Artikel 63 Absatz 1 verlangen.

(7) In der Entscheidung, durch die das europäische Patent in geändertem Umfang aufrechterhalten wird, ist die der Aufrechterhaltung zugrundeliegende Fassung des europäischen Patents anzugeben.

Vgl. Artikel 63 (Übersetzung der Patentschrift), 100 (Prüfung des Einspruchs), 101 (Widerruf oder Aufrechterhaltung) und 104 (Beitritt des vermeintlichen Patentverletzers)

Regel 60
Anforderung von Unterlagen

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

Vgl. Artikel 100 (Prüfung des Einspruchs)

Regel 61
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.

Vgl. Artikel 98 (Einspruch)

Regel 62
Rechtsübergang des europäischen Patents

Regel 20 ist auf einen Rechtsübergang des europäischen Patents während der Einspruchsfrist oder der Dauer des Einspruchsverfahrens entsprechend anzuwenden.

Vgl. Artikel 98 (Einspruch)

Cf. Articles 63 (Translation of the European patent specification), 100 (Examination of the opposition), 101 (Revocation or maintenance of the patent) and 104 (Intervention of the assumed infringer)

Rule 60
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 filed within such period as it may specify. If such documents are not filed in good time, the European Patent Office may decide not to take into account any evidence based on them.

Cf. Article 100 (Examination of the opposition)

Rule 61
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.

Cf. Article 98 (Opposition)

Rule 62
Transfer of the European patent

Rule 20 shall apply mutatis mutandis to any transfer of the European patent made during the opposition period or during opposition proceedings.

Cf. Article 98 (Opposition)
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
Gouvernement de la République fédérale d'Allemagne

1972
107. UNEPA also considered that in paragraph 3, last sentence - and in Article 102 as well - the discretionary powers of the Opposition Division ("if it considers it expedient") should be replaced by the right of the third parties involved to submit their observations.

Article 105a (Effect of the decision)

108. EIRMA and TFIA proposed that it be left to national law to regulate the consequences - for rights attached to a patent - of the ex tunc effect of the revocation of the patent.

Moreover, IAPTP observed that it would be useful to introduce a provision laying down that, in the event of revocation of the patent following opposition, licences should continue to have effect until the date of the revocation, provided that they were issued prior to the decision revoking the patent.

Article 106a (Intervention of the presumed infringer in opposition proceedings pending before the European Patent Office)

109. The introduction of this provision in the Convention met with opposition from EIRMA, FICPI and ICC, owing to the complication and delays which would result in the opposition proceedings. FICPI also observed that any third party would be free to submit observations on a patent which was the subject of opposition proceedings and that if such observations seemed well founded, the European Patent Office could examine them ex officio.

BR/169 e/72 cyd/AV/prk
Article 97 (Grant of the European patent)

103. CEIF proposed that the period provided for in paragraph 1 be transferred to the Implementing Regulations, and that it be extended to two months. With regard to paragraph 3, it proposed the replacement of the explicit decision to grant the patent by an automatic entry into force of the latter as soon as the fees due were paid. Furthermore, it expressed doubts about the usefulness of the minimum period provided for in paragraph 4.

Article 101 (Opposition)

104. ICC, backed up by EIRMA, IFIA and FICPI argued in favour of shortening the period provided for in paragraph 1 to six months to align it with the period in operation under several national laws. On the other hand, IAPIIP was opposed to this period being shortened, either by amendment of the text of Article 101 or by a decision of the Administrative Council taken under Article 35a, paragraph 1(b).

105. UNICE requested an additional period of one month for payment of the opposition fee.

106. During the discussion on the latter point, ICC and UNEPA emphasised that the general problem of the observation of time limits with regard to payment of fees would be largely resolved in practice if interested parties were given the right to have a current account at the European Patent Office. They therefore proposed that Article 5, paragraph 2, of the Rules relating to Fees be amended to this effect (cf. BR/160/72, point 166).
MINUTES

of the

5th Meeting of the Inter-Governmental Conference
for the Setting up of a European System
for the Grant of Patents

Part II.

Hearing of the non-governmental international organisations
on the Second Preliminary Draft of a Convention
establishing a European System for the
Grant of Patents

(Luxembourg, 26 January to 1 February 1972)
of the question that this period might be adapted. In conclusion, the Conference decided to adopt a period of nine months.

125. The Conference agreed with the idea that, in so far as it concerned the opposition, the problem of a change of proprietor by virtue of a legal decision arose in different terms than for the procedure for the grant of a patent. In fact, granted patents will be entered in the national patent registers and those listed as proprietors in these registers will be recognised as such by the European Patent Office.

Article 101a (Grounds for opposition)

126. In reply to a question raised by the delegation, it was stated that the fact that the ground for revocation referred to in Article 133, paragraph 1(e), was not adopted as a ground for opposition under Article 101a was explained by the consideration that matters concerning the right to a European patent according to the terms of Article 15 must come within the scope of national legal systems alone.
123. Furthermore, the Conference noted that paragraphs 2, 3 and 4 raised the following problems, which were given to Working Party I for examination:

(a) Connection between paragraph 4 and Article 18 (cf. point 53 above);

(b) Connection between paragraph 3 and Article 56, paragraph 2, second sub-paragraph, (c);

(c) The legal consequences of a refusal on the part of the applicant to pay the fees laid down in paragraph 1 if he makes it known that he is not in agreement with the European patent being granted in the envisaged text: both with regard to the continuation of the procedure before the Examining Division and with regard to the beginning of the period laid down in Article 107a, paragraph 1.

**Article 101 (Opposition)**

124. In the light of the comments made by the non-governmental organisations, the Conference first of all reconsidered the period laid down in this Article. Some delegations proposed that the opposition period should be shortened to meet the wishes of the organisations which are particularly concerned with this question, and to come more into line with the national rules. In reply, it was stressed that the present period was already a compromise and that it was advisable to allow the opponent to prepare his case properly as this would save time in the later stages of the proceedings. In addition, in the light of the Administrative Council's experience it is not out
MINUTES

of the

5th Meeting of the Inter-Governmental Conference
for the Setting up of a European System
for the Grant of Patents

Parts 1 and 3

(Luxembourg, 24-25 January and 2-4 February 1972)
Article 101
Opposition

(1) Within a period of nine months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement. It shall not be deemed to have been given until the fee prescribed by the Rules relating to Fees adopted pursuant to this Convention has been paid.

(1a) +

(1b) Article 23, paragraphs 2, 3 and 4 shall apply mutatis mutandis to any transfer of the European patent made during the period mentioned in paragraph 1 or during opposition proceedings.

(2) +

(2a) Where a person provides evidence that in one or more Contracting States, following a final decision, he has been entered in the patent register or registers of such State or States instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State or States. By derogation from paragraph 1a, the previous proprietor and the person making the request shall not be considered as joint proprietors unless both so request.

(3) The Opposition Division shall examine whether the notice of opposition complies with the provisions of this Convention and the Implementing Regulations. If the opposition is admissible it shall notify the proprietor of the patent of the opposition lodged and shall invite him to reply to the opposition, by presenting his observations and submitting amendments to the description, claims and drawings within a period to be fixed by the Division. These amendments may not go beyond what is necessary to meet the opposition. The observations and amendments shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division.

BR/139 e/71 prk
SECOND PRELIMINARY DRAFT OF THE CONVENTION

ESTABLISHING

A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS
DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -
their patent as they see fit, independently from each other, the Working Party finally decided by a majority that the two proprietors should not be forced to join into the same opposition procedure, but would on the other hand be able to request so (Article 101, paragraph 1a).

(c) The stage of revocation proceedings (Article 133)

49. In this regard it was proposed by the United Kingdom delegation (BR/GT I/133/71) to establish non-entitlement to the patent under Article 15 as a ground for revocation under Article 133. As a matter of fact under the prior text the victim of misappropriation of the right to the patent could not obtain a declaration revoking the patent with effect ex tunc. By a majority decision this proposal was accepted by the Working Party.

50. In the course of these discussions the Working Party examined two other proposals by the United Kingdom delegation (BR/GT I/113/71) the aim of which was to provide for two additional grounds for revocation under Article 133:

(i) abuse of the right of monopoly which could not be precluded by the machinery for compulsory licences;

(ii) the case of a patent being fraudulently obtained.

The Working Party adopted neither of these proposals.
In the second place, the assignant could file a new application in place of the original application. As far as no new subject matter would be included the new application would receive the same filing and priority date as the original one. At the same time the original application would be deemed to be withdrawn with respect to the designated countries where the judgment is either directly applicable or recognised.

Finally it should be open to the assignant to simply demand refusal of the original application without filing a new application himself.

(b) The stage of opposition proceedings (Article 107)

48. Considering that at the stage of opposition proceedings the European patents already have the character of a bundle of national patents, which each are entered into the respective national patent registers, the Working Party agreed that the EPO should at this stage recognise as proprietor of the patent the person who is entered as such in these national patent registers. This means however that following a national judgment which recognises the right to the patent to another person than the original applicant which judgment might not be recognised in all designated countries, the EPO would once more have to face the problem of two proprietors of the same patent. Weighting the conflicting interests of, on the one hand, the opponent to have one, unitary, opposition procedure, and, on the other hand, of the two proprietors to be able to defend
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Secretariat

Brussels, 16 December 1971
BR/144/71

MINUTES

of the 10th meeting of Working Party I,
held in Luxembourg from 22 to 26 November 1971

1. Working Party I held its 10th meeting in Luxembourg from 22 to 26 November 1971, with Dr. HAERTEL, President of the Deutsches Patentamt, in the Chair.

Representatives from the Commission of the European Communities, the IIB and WIPO attended the meeting as observers. The Council of Europe representatives sent their apologies for being unable to attend. For the list of those present at the 10th meeting see Annex I to these minutes.

2. Working Party I adopted the provisional agenda as contained in BR/GT I/133/71 on the understanding that item 3 would also cover the examination of a number of problems including those referred to in BR/GT I/138/71. The provisional agenda is given in Annex II to these minutes.

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

BR/144 e/71 ley/prk
Unrevised translation
Article 101

Opposition

(1) Within a period of nine months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement. It shall not be deemed to have been given until the fee prescribed by the Rules relating to Fees adopted pursuant to this Convention has been paid.

(1a) +

(1b) Article 23, paragraphs 2, 3 and 4 shall apply mutatis mutandis to any transfer of the European patent made during the period mentioned in paragraph 1 or during opposition proceedings.

(2) +

(3) The Opposition Division shall examine whether the notice of opposition complies with the provisions of this Convention and the Implementing Regulations. If the opposition is admissible it shall notify the proprietor of the patent of the opposition lodged and shall invite him to reply to the opposition, by presenting his observations and submitting amendments to the description, claims and drawings within a period to be fixed by the Division. Those amendments may not go beyond what is necessary to meet the opposition. The observations and amendments shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division.
SECOND PRELIMINARY DRAFT OF THE CONVENTION

ESTABLISHING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 22 October 1971 -
For Article 101, paragraph 1(c), see point 156, which covers Article 83a.

140. For Article 101, new paragraph 1b, see point 105, which covers Article 23.

Article 105a (Effect of the decision)

141. In accordance with its mandate from the Conference (cf. BR/125/71, page 67), the Working Party looked into the feasibility of improving the wording of this Article so as to make it clear that, in conformity with the principle of the ex tunc effect of revocation decisions, it would be left to national law to lay down the details of the effects of these decisions as regarded derived rights, and in particular licence contracts.

The Working Party found that it was unnecessary to amend the wording of Article 105a, as Article 18 of the Convention stated which rights this provision referred to, these being the rights conferred on the proprietor of the patent. The absence of provisions governing the derived rights of third parties meant that they fell within the jurisdiction of national laws.

142. The Working Party agreed to re-examine at a later stage the question raised by the United Kingdom delegation of whether the ex tunc effect of the revocation of a patent commenced as from the date of grant of the patent or whether it also extended to the provisional protection conferred by the patent application on which the revoked patent was granted.

BR/135 e/71 ley/prk
Some delegations were worried in case such a communication might prejudice the equality of the parties in the proceedings. Others considered that there was no foundation for this anxiety, since this was only the preliminary stage of the proceedings.

In conclusion, and to avoid excessive extensions of time limits, the Working Party decided that the right of opponents to reply in every case should not be recognised, and that this right should be limited to cases in which the Opposition Division considered that it would be useful; in such cases the opponent would have at his disposal the period allotted to him by the Opposition Division itself.

137. The Working Party did not adopt the United Kingdom delegation's proposal that Article 101 should also contain a new paragraph 4, which would lay down a provision similar to that of Article 92, paragraph 2, i.e. that in the event of the patentee failing to indicate within the period fixed by the Opposition Division that he wished to maintain his patent, the patent would be deemed to be revoked.

138. In view of the decisions taken by the Working Party on Article 101, paragraph 3, a number of amendments had to be made to the wording of Articles 102 and 103 of the Convention.

139. In Article 102 it was, moreover, specified that the application mutatis mutandis of the provisions of Article 95 during opposition proceedings was to be limited to paragraphs 1 and 2 of this Article, paragraphs 1a and 1b being inapplicable, as the proceedings would otherwise be overburdened.
135. The Working Party then discussed whether, as proposed by the United Kingdom delegation, the possibility should be provided for the proprietor to file amendments to the description, claims and drawings of his patent during this first phase of the opposition proceedings, i.e. when the Opposition Division notified him of the opposition lodged and invited him to reply to it. The Working Party considered that it would be advisable to provide such a possibility in Article 101, paragraph 3, stipulating at the same time that the amendments filed were not to go beyond what was necessary to meet the opposition. This provision is thus in harmony with the principle set out in Article 104, which deals generally with the limits for amendments which may be made to the patent during opposition proceedings.

136. In addition the Working Party examined the United Kingdom delegation's proposal that Article 101, paragraph 3, should also contain a provision to the effect that replies to the opposition and, where appropriate, amendments to the patent submitted by the patentee should be communicated to the opponent together with a notification of the opponent's right to reply. The Working Party considered that it would certainly be advantageous to communicate such information to the opponent, especially when this would enable him to form an idea, even at this preliminary stage of the opposition proceedings, of the extent to which the patentee might be prepared to take account of the opposition.

BR/135 e/71 ley/prk .../...
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)

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.

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 lor/prk .../...
Since any change of ownership of the European patent would in any event be subject to the formalities laid down in national law, which usually involved the change of ownership being entered in the national patent register, the following alternatives were submitted: either the European Patent Office should be made dependent on the forwarding of information from the national registers, or the patentee should be obliged to ensure that the change of ownership is also recorded in the Register of European Patents. Bearing in mind the possibility for a patent to change hands in some countries without the transaction being recorded in the national register, the Working Party discarded the first option. On the other hand it considered that obtaining the desired entry in the Register of European Patents would not necessitate an explicit obligation, and that it would be sufficient to provide that for the purposes of the opposition proceedings the European Patent Office would consider that the proprietor of the European patent was the person entered as such in the Register of European Patents; this would normally give the new patentee sufficient incentive to have the change of ownership recorded.

The Working Party therefore decided to insert a new paragraph 1(b) into Article 101, to the effect that the provisions of Article 23, paragraph 2, 3 and 4 are to apply to the transfer of a European patent made during the opposition period or during opposition proceedings.
In the light of these arguments, the German delegation withdrew its proposal.

**Article 21 (Patents of addition)**

103. The Working Party had been given a mandate by the Conference to examine the advisability of retaining the system of patents of addition in view of the fact that it would have no bearing on fees in the system set out in Articles 11 and 13. It was agreed that patents of addition should not be included. It was consequently decided to delete Article 21 and the provisions of the Convention and Implementing Regulations which dealt with patents of addition (Article 88, paragraph 4, Article 129, paragraph 3, Re. Article 21, Nos. 1, 2 and 3, Re. Article 34, No. 7, Re. Article 59, No. 1, paragraph 1(k), (n) and (o), Re. Article 130, No. 1, and Re. Article 145, No. 11, paragraph 1(c). In the light of this decision, two other provisions of the Implementing Regulations had to be amended: Re. Article 34, No. 8 and Re. Article 66, No. 1, paragraph 2.

**Article 22 (Unitary character of the European patent application in proceedings before the European Patent Office)**

104. As the problems concerning this provision were closely bound up with those raised by Articles 15 and 16, the Working Party decided to defer discussion of them until such time as a final text for these Articles has been adopted.

**Article 23 (Transfer of a European patent application)**

105. As a note to Article 23 stated that provisions would have to be made to inform the European Patent Office of any change of ownership of the European patent during the opposition period or during opposition proceedings, the Working Party discussed the drafting of such provisions.
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)

Artikel 101a

Einspruchsgründe
Der Einspruch kann nur darauf gestützt werden,
a) daß der Gegenstand des europäischen Patents nach den Artikeln 9 bis 14 nicht patentfähig ist;
b) daß das europäische Patent die Erfindung nicht so deutlich und vollständig offenbart, daß ein Fachmann sie danach ausführen kann;
c) daß der Gegenstand des europäischen Patents weiter ist als der Inhalt der eingereichten Patentanmeldung.

Article 101a

Grounds for opposition
Opposition may only be lodged on the grounds that:
(a) the subject-matter of the European patent is not patentable within the terms of Articles 9 to 14;
(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
(c) the subject-matter of the European patent extends beyond the content of the application as filed.

Artikel 101b

Prüfung des Einspruchs
(1) Ist der Einspruch zulässig, so erforscht die Einspruchsabteilung den Sachverhalt im Rahmen der in Artikel 101a vorgesehenen Einspruchsgründe von Amts wegen; diese Prüfung ist weder auf das Vorbringen noch auf die Anträge der Beteiligten beschränkt.
(2) Die Einspruchsabteilung braucht neue von den Beteiligten vorgebrachte Tatsachen und Beweismittel nicht zu berücksichtigen, die nicht in der Einspruchs begründung oder in der Erwiderung auf den Einspruch enthalten sind.

Article 101b

Examination of opposition
(1) If the opposition is admissible, the Opposition Division shall examine the facts, in so far as they lie within the grounds for opposition laid down in Article 101a; this examination shall not be restricted to the facts, evidence and arguments provided by the parties and the relief sought.
(2) The Opposition Division may disregard fresh facts or evidence submitted by the parties concerned, which were not included in the statement of grounds for opposition or in the reply to the opposition.

Artikel 102

Prüfungsbescheid im Einspruchsverfahren
Ist die Einspruchsabteilung nach Prüfung des Einspruchs der Auffassung, daß das europäische Patent nicht hätte erteilt werden dürfen, so ist Artikel 95 entsprechend anzuwenden. Der Prüfungsbescheid und die Stellungnahme des Patentinhabers werden den übrigen Beteiligten mitgeteilt.

Article 102

Notification of the result of the examination in opposition proceedings
If, after having examined the opposition, the Opposition Division considers that the European patent should not have been granted, Article 95 shall apply mutatis mutandis. The result of the examination and the observations of the proprietor of the patent shall be communicated to the other parties concerned.

Artikel 103

Stellungnahme der Beteiligten
Die Einspruchsabteilung fordert die übrigen Beteiligten auf, sich innerhalb einer von ihr zu bestimmenden Frist zu Stellungnahmen des Patentinhabers zu äußern, sofern diese wesentliches neues Vorbringen enthalten oder die Einspruchsabteilung dies aus anderen Gründen für sachdienlich hält.

Article 103

Reply of the parties concerned
The Opposition Division shall invite the other parties concerned to comment, within a period to be fixed by the Division, on the observations of the proprietor of the patent in so far as these contain substantial new elements or in so far as the Opposition Division considers this expedient for other reasons.
Artikel 99
Urkunde über das europäische Patent
(1) Sobald die Patentschrift herausgegeben worden ist, stellt das Europäische Patentamt dem Patentinhaber die Urkunde über das europäische Patent aus, der als Anlage die Patentschrift beigefügt ist.
(2) In der Patenturkunde wird bescheinigt, daß das europäische Patent für die in der Patentschrift beschriebene Erfindung der in der Urkunde benannten Person für die in der Patentschrift bezeichneten Vertragsstaaten erteilt worden ist.

Artikel 100
Kosten für die Veröffentlichung der Übersetzung — Sanktion
(1) Jeder Vertragsstaat, der eine Vorschrift gemäß Artikel 97a Absatz 1 erlassen hat, kann vorschreiben, daß der Patentinhaber innerhalb einer von diesem Staat bestimmten Frist die Kosten für eine Veröffentlichung der Übersetzung des europäischen Patents ganz oder teilweise zu entrichten hat.
(2) Jeder Vertragsstaat kann vorschreiben, daß im Fall der Nichtbeachtung einer auf Grund von Artikel 97a Absatz 1 oder auf Grund des vorstehenden Absatzes erlassenen Vorschrift die Wirkungen des europäischen Patents in dem Vertragsstaat als von Anfang an nicht eingetreten gelten.

KAPITEL III
Einspruchsverfahren
Artikel 101
Einspruch
(1a) Der Einspruch erfaßt das europäische Patent für alle Vertragsstaaten, in denen es Wirkung hat. Sind in diesen Staaten verschiedene Personen Inhaber des europäischen Patents, so gelten diese für das Einspruchsverfahren als gemeinsame Inhaber.
(2) Diejenigen Dritten, die Einspruch gemäß Absatz 1 eingelegt haben, sind neben dem Patentinhaber am Einspruchsverfahren beteiligt.

CHAPTER III
Opposition procedure
Article 101
Opposition
(1) Within a period of nine months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement. It shall not be deemed to have been given until the fee prescribed by the Rules relating to Fees adopted pursuant to this Convention has been paid. No fee shall be payable for opposition if the notice of opposition is given by the third party who made the request for examination.
(1a) The opposition shall apply to the European patent in all the Contracting States in which it has effect. If the European patent belongs to different proprietors in different States, such proprietors shall be considered as joint proprietors for the purposes of opposition proceedings.
(2) Third parties who have given notice of opposition as provided for in paragraph 1 shall take part in the opposition proceedings with the proprietor of the patent.
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS
ÜBER EIN EUROPÄISCHES PATENTERTeilungsverfahren

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

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME
EUROPÉEN DE DÉLIVRANCE DE BREVETS
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN
EUROPÄISCHES PATENTERTeilungsVERFAHREN

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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 —
Item 2 on the agenda: Continuation of work on the amendment of the First Preliminary Draft on the basis of decisions taken at the Inter-governmental Conference, beginning with Article 101 (Opposition proceedings).

4. The Working Party discussed the questions remaining open which relate to opposition proceedings (cf. BR/49/70, point 123) on the basis of BR/GT I/49/70.

The most important results of this discussion are given below.

Article 101 (96d): Opposition

5. After examining the "notes concerning opposition procedure" contained in the printed First Preliminary Draft (page 87), the Working Party decided to add a paragraph 1a to cover a situation where different persons are the proprietors of the European patent in several Contracting States. It also agreed that there was no need for special provisions in respect of surrender and lapse of the patent.
71. **Article 101**: Opposition

The Working Party decided to delete the notes to this Article in view of the new provisions it adopted for opposition proceedings (Article 101a dealing with grounds for opposition and Article 55a dealing with Opposition Divisions). Note 3 is covered by a provision of the Implementing Regulations.

72. **Article 105**: Decision in opposition proceedings

(a) The note to this Article was deleted (cf. Article 101a).
(b) Paragraph 4 was deleted, its contents having been transferred to Article 138.

(c) Paragraph 5 was deleted, its contents having been transferred to the Implementing Regulations.

73. **Article 106**: Hearings before the Examining Division

This Article was deleted, its contents having been transferred to Article 139. The Working Party also decided to delete the two notes relating to Articles 101 to 106, in view of the provisions adopted for opposition proceedings.

74. **Article 108**: Decisions subject to appeal

The Working Party retained paragraph 1 in its present form (subject to the addition of the mention of Opposition Divisions). Paragraph 2 was not amended at this stage, to allow the interested circles time to submit their observations.
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Brussels, 28 February 1971

BR/87/71

MINUTES of the meeting of Working Party I

held at Luxembourg from 30 November to 2 December 1970

and of the meeting held on 3 December 1970 by that Working Party, acting in its capacity as Co-ordinating Committee

Item 1 on the agenda (1) : Opening of the meeting and adoption of the provisional agenda

1. The Working Party held its sixth meeting at Luxembourg from Monday, 30 November to Wednesday, 2 December 1970, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

Representatives of the Commission of the European Communities, WIPO-BIRPI and the International Patent Institute took part in the meeting (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

2. The Drafting Committee, under the chairmanship of the President of the Netherlands Octrooiraad (Patent Office), Mr. J. B. van BENTHEM, held its meetings directly after the deliberations of the Working Party.

(1) For the provisional agenda (BR/GT I/62/70), see Annex I.
(2) For the list of participants, see Annex II.
Text drawn up by the Working Party

Opposition

Article 101 (former Article 96)

OPPOSITION PROCEDURE

CHAPTER III
oppositions of the proprietor or the patent shall be communicated to the other parties concerned.

3) The examining division shall notify the proprietor of the patent of any opposition lodged.

The examining division shall, if any opposition is lodged, notify the parties concerned of the lodging of the opposition. The opposition proceedings shall proceed if no opposition has been lodged within three months from the date of the publication of the patent.

(2) Third parties who have given notice of opposition as provided for in Paragraph 1 shall take part in the opposition proceedings with the proprietor of the patent.

Any third party or any person may give notice of opposition to the European Patent Office of opposition to the European Patent Grant. Notice of opposition shall be given in reasoned statement in writing. It shall not be given by the third party who made the request for examination.

(1) Notice of opposition shall be given in reasoned statement in writing. It shall not be given by the third party who made the request for examination.

Opposition

Article 101 (former Article 96d)

Opposition proceedings

Chapter III
to those under (a) and (b) are set out in numerical order.

Reasons of convenience, the Articles contained in this document which bear reference to this document sets out the results of the work of Working Party I, for

meeting

this second part of the work could not be completed at the above-mentioned

organisations on 21 and 22 April 1970. For the same reason of lack of time,

on 22 April 1970 after hearing the views of the non-governmental information

in accordance with the decisions taken by the Inter-governmental Conference,

(b) it then re-examined a number of Articles of the First Preliminary Draft Convention,

coming to lack of time,

of the proposition, pointing out the study of certain Articles to a later meeting,

European system for the Grant of Patents, published in 1970, as regards most

spectra of patents on the basis of proposals put forward by the Chairman.

t to the meeting From 7 to 11 September 1970, Working Party I completed a

Introductory Remarks
(7 to 11 September 1970)

Preparatory Draft Convention

FOR A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Preliminary Draft Convention

Secretariat

BR/48/70

Brussels, 22 September 1970

FOR THE GRANT OF PATENTS FOR THE SETTING UP OF A EUROPEAN SYSTEM INTER-GOVERNMENTAL CONFERENCE
121. Given the new provisions of Article 97, Article 97a (new) and Article 100, and taking into account the shorter period as compared with that previously provided for in Article 100, the Working Party studied, whether it was possible to shorten the twelve-month period provided for in Article 101, paragraph 1, as the Conference had instructed.

It appeared advisable to make provision for a period for the printing of translations in the Contracting States (even for those in which the official language is one of the official languages of the Convention) and to allow time for consideration, from the time when the translations become available, of possible opposition, so as to avoid the increase of oppositions filed as a precautionary measure.

In these circumstances, the Working Party considered that a period of nine months seemed appropriate.

122. Furthermore, the Working Party noted that it might be advisable to make the provision within the Convention as in Article 47, paragraph 2, of the PCT Treaty, for the possibility of amending certain periods, fixed by the Convention, by a simpler procedure than that of revision, i.e. by a decision of the Administrative Council.

The Working Party will re-examine this matter at a later date.

Article 101a (new): Grounds for Opposition
(BR/40/70, page 8, No. 21, first paragraph)

123. The Working Party was unable to complete the discussion of this Article, which will be re-examined during the next meeting.

At the present stage of the discussion, the Working Party noted that the grounds on which an opposition may be entered should be comparable to those for revocation. An additional ground to be borne in mind would be: poorly defined claims.
MINUTES

of the meeting of Working Party I
Luxembourg, 7 - 11 September 1970

Agenda item 1 (1): Opening of the meeting and adoption of the provisional agenda

1. The fifth working meeting of Working Party I was held at Luxembourg from Monday 7 to Friday 11 September 1970, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

Representatives of the Commission of the European Communities, WIPO-BIRPI and the International Patent Institute took part in the meeting (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

2. The Drafting Committee, under the Chairmanship of the President of the Netherlands "Octrooiraad", Mr. J.B. van BENTHEM, held its meetings directly after the meetings of the Working Party.

(1) See Annex I for provisional agenda (BR/GT 1/51/70)
(2) See Annex II for list of those attending the meeting of the Working Party.

BR/49 e/70 eld/PA/bcc
Article 100 (ancien article 96c)

Traduction du fascicule du brevet

(1) Si le fascicule du brevet européen n’est pas rédigé dans une des langues officielles d’un État contractant pour lequel le brevet européen a été délivré, celui-ci peut exiger que, dans un délai minimum de trois mois à compter du jour de la publication de la délivrance du brevet au Bulletin européen des brevets, le titulaire du brevet européen:

a) remette au service central national de la propriété industrielle une traduction du fascicule du brevet dans l’une des langues officielles de cet État, ou

b) verse à ce même service une taxe pour l’établissement d’une traduction officielle du fascicule du brevet dans une des langues officielles de cet État.

(2) Tout État contractant ayant adopté des dispositions conformément au paragraphe 1 peut, en outre, exiger que le titulaire du brevet acquitte tout ou partie des frais de publication de la traduction dans le délai prévu au paragraphe 1.

(3) Tout État contractant peut prescrire qu’en cas de non-observation d’une disposition prise en vertu des paragraphes 1 ou 2, le brevet européen est réputé sans effet dans cet État, dès l’origine.

CHAPITRE III

Procédure d’opposition

Article 101 (ancien article 96d)

Opposition

(1) Dans un délai de 12 mois à compter de la date de publication visée à l’article 97, paragraphe 4, toute personne peut faire opposition auprès de l’Office européen des brevets au brevet européen délivré. L’opposition doit être formée par écrit et motivée. Elle n’est réputée formée qu’après versement de la taxe prévue par le règlement relatif aux taxes pris en exécution de la présente Convention. La taxe n’est pas due lorsque l’opposition est faite par le tiers qui a formulé la requête en examen.

(2) Les tiers qui ont fait opposition conformément au paragraphe 1 participent, avec le titulaire du brevet, à la procédure d’opposition.

(3) La division d’examen commune au titulaire du brevet les oppositions formées et l’invite à prendre position sur celles-ci dans un délai à déterminer par elle. La prise de position du titulaire du brevet est communiquée aux tiers participants.

Bemerkungen zu Artikel 101:
1. Die Gründe, auf die ein Einspruch gestützt werden kann, sind noch festzulegen; es kommen insbesondere die in den Artikeln 9 bis 14 ausgeführten Voraussetzungen in Betracht.
2. Es wird ebenfalls die Frage geprüft werden, ob die Prüfungsabteilung im Einspruchsverfahren anders besetzt sein soll als im Prüfungsverfahren vor Erteilung des europäischen Patents.
3. Falls Einspruch eingeleget worden ist oder die Einspruchsfrist ohne Einlegung eines Einspruchs abgelaufen ist, sollte im Patentblatt darauf hingewiesen werden. Eine entsprechende Bestimmung ist in die Ausführungsordnung aufzunehmen.

Notes to Article 101
1. The grounds on which an opposition may be lodged, mainly those based on Articles 9 to 14, will need to be specified later.
2. The question will also be studied whether the composition of the Examining Division which deals with the opposition proceedings should be different from that of the Division which dealt with the grant of the patent.
3. If any opposition is lodged, or if the time limit for lodging opposition has expired without any notice of opposition being given, a reference to this should be made in the European Patent Bulletin. A corresponding provision will have to be included in the Implementing Regulations.

Remarques concernant l’article 101:
1. Les motifs pour lesquels les oppositions peuvent être faites (notamment ceux qui se fondent sur les articles 9 à 14) devront encore être précisés.
2. La question sera également examinée de savoir si la division d’examens qui statue sur l’opposition devrait avoir une composition différente de celle qui a statué sur la délivrance du brevet.
3. Au cas où une opposition a été formée ou au cas où le délai d’opposition s’est écoulé sans qu’une opposition ait été formée, il conviendrait d’en faire mention au Bulletin européen des brevets. Une disposition en ce sens est à insérer dans le règlement d’exécution.

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Artikel 100 (früher Artikel 96c)
Übersetzung der Patentschrift

(1) Ist die Patentschrift des europäischen Patents nicht in einer der Amtssprachen eines Vertragsstaats, abgefaßt, für den das europäische Patent erteilt worden ist, so kann dieser Vertragsstaat vorschreiben, daß der Inhaber des europäischen Patents innerhalb einer Frist von mindestens drei Monaten nach dem Tag der Bekanntmachung der Patenterteilung im Europäischen Patentblatt bei der nationalen Zentralbehörde für den gewerblichen Rechtsschutz
a) eine Übersetzung der Patentschrift in eine seiner Amtssprachen einzureichen oder
b) eine Gebühr für die Herstellung einer amtlichen Übersetzung der Patentschrift in eine seiner Amtssprachen zu entrichten hat.

(2) Jeder Vertragsstaat, der eine Vorschrift gemäß Absatz 1 erlassen hat, kann außerdem vorschreiben, daß der Patentinhaber innerhalb der in Absatz 1 genannten Frist die Kosten für eine Veröffentlichung der Übersetzung ganz oder teilweise zu entrichten hat.

(3) Jeder Vertragsstaat kann vorschreiben, daß im Falle der Nichtbeachtung einer aufgrund der Absätze 1 oder 2 erlassenen Vorschrift die Wirkungen des europäischen Patents in dem Vertragsstaat als von Anfang an nicht eingetreten gelten.

KAPITEL III
Einspruchsverfahren
Artikel 101 (früher Artikel 96d)
Einspruch


(2) Diejenigen Dritten, die Einspruch gemäß Absatz 1 eingelegt haben, sind neben dem Patentinhaber am Einspruchsverfahren beteiligt.


Article 100 (former Article 96c)
Translation of specifications

(1) If the specification of a European patent has not been drawn up in one of the official languages of a Contracting State for which the European patent has been granted, that State may prescribe that the proprietor of the European patent must send to the national central industrial property office, within a period of not less than three months after the date of publication of the grant of the patent in the European Patent Bulletin:

(a) a translation of the specification into an official language of that State, or
(b) a fee for the preparation of an official translation of the specification into an official language of that State.

(2) Any Contracting State which has adopted provisions pursuant to paragraph 1 may further prescribe that the proprietor of the patent must pay all or part of the costs of publication of such translation within the period referred to in paragraph 1.

(3) Any Contracting State may prescribe that, in the event of failure to observe a provision adopted in accordance with paragraph 1 or 2, the European patent shall be deemed to have been void in that State ab initio.

CHAPTER III
Opposition procedure
Artikel 101 (former Article 96d)
Opposition

(1) Within a period of twelve months from the date of the publication pursuant to Article 97, paragraph 4, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement in writing. It shall not be deemed to have been given until the fee prescribed in the Rules relating to fees adopted pursuant to this Convention has been paid. No fee shall be payable for opposition if the notice of opposition is given by the third party who made the request for examination.

(2) Third parties who have given notice of opposition as provided for in paragraph 1 shall take part in the opposition proceedings with the proprietor of the patent.

(3) The Examining Division shall notify the proprietor of the patent of any opposition lodged and shall invite him to present his observations within a period to be fixed by the Division. The observations of the proprietor of the patent shall be communicated to the other parties concerned.
ERSTER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTeilungsverfahren

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

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

— 1970 —
27. The Working Party posed the question whether the grounds for opposition should be restricted. It was in particular urged that mere failure to comply with formal requirements and even the lack of unity of the invention should be excluded as grounds of opposition. Some delegations were against restricting the grounds of opposition excessively, but stated their agreement that lack of unity should not be permitted as a ground for raising opposition. The Working Party reserved the possibility of re-examining this question later and restricted itself for the time being to noting that the requirements set out in Articles 9 to 14 were particularly likely for consideration as grounds of opposition.

28. There was some discussion of whether the opposition fee prescribed in paragraph 1 appears to be justified. The Working Party decided to maintain this fee.

29. See also the other notes including under Article 96d in BR/11/69.

Artikel 97 - Notification of the result of the examination in opposition proceedings

30. No comment.
MINUTES
of the meeting of Working Party I
(Luxembourg, 24 to 28 November 1969)

I.

1. The third working meeting of Working Party I was held at Luxembourg from Monday 24 to Friday 28 November 1969, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

   The Commission of the European Communities, BIRPI, the General Secretariat of the Council of Europe and the International Patent Institute took part in the meeting (1).

2. The Working Party agreed to appoint the following as rapporteurs:

   - a member of the German delegation for Articles 88 to 96 c (Examination procedure) (2),

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(1) See Annex for list of those attending the meeting of the Working Party.
(2) It was originally agreed at the October meeting that the German delegation should produce a report for Articles 88 to 104.
(1) Within a period of twelve months from the date of the publication pursuant to Article 96, paragraph 2, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be given in a reasoned statement in writing. It shall not be deemed to have been given until the fee prescribed in the Rules relating to fees adopted pursuant to this Convention has been paid. No fee shall be payable for opposition if the notice of opposition is given by the third party who made the request for examination.

(2) Third parties who have given notice of opposition as provided for in paragraph 1 shall take part in the opposition proceedings with the proprietor of the patent.

(3) The Examining Division shall notify the proprietor of the patent of any opposition lodged and shall invite him to present his observations within a period to be fixed by the Division. The observations of the proprietor of the patent shall be communicated to the other parties concerned.

The grounds on which an opposition may be lodged, mainly those based on Articles 9 to 14, will need to be specified later.

The question will also be studied whether the composition of the Examining Division which deals with the opposition proceedings should be different from that of the Division which dealt with the grant of the patent.

If any opposition is lodged, or if the time limit for lodging opposition has expired without any notice of opposition being given, a reference to this should be made in the European Patent Bulletin. A corresponding provision will have to be included in the Implementing Regulations.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

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

Articles 88 to 152
prepared by Working Party I
(24 to 28 November 1969)

compared synoptically with
- the 1962 and 1965 versions of the Draft Convention as established by the EEC "Patents" Working Party and
- the Draft of an open European Patent Convention drawn up by the Member States of the European Free Trade Association

BR/11 e/69 mk
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 instigated 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). The potential appealant 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 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 put forward aimed at making 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 83, 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

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