Rule 104 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 104
MPÜ
Weiterleitung der intern. Anmeldung an das EPA

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<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>
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<tr>
<td>BR/81/71</td>
<td>120, Nr. 1</td>
<td>BR/84/71</td>
<td>Rdn. 30</td>
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Dokumente der MDK

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<tr>
<th>E 1972</th>
<th>R 105</th>
<th>M/52/I/II/III</th>
<th>S. 27</th>
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<td>M/146/R 11</td>
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<td>M/PR/G</td>
<td>S. 205/188/189</td>
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provision was also adopted to authorise the national authorities of the host country to withdraw the right to a place of business for reasons of "ordre public".

(d) Deletion from the list of professional representatives

The Main Committee examined the grounds for deletion of professional representatives from the list and re-arranged them in Rules 103 (permanent solution) and 107 (transitional period). No difficulties were presented by the three grounds for deletion which apply both in the transitional period and in the permanent solution, namely, death or legal incapacity of the representative, his ceasing to be a national of one of the Contracting States, where the President does not grant or is not required to grant exemption from this requirement, or his ceasing to have a place of business or employment in any of the Contracting States. There was unanimous agreement that, in respect of representatives during a transitional period, the national central industrial property office in question must, in these three cases, withdraw the certificate which it has issued and the representative must be deleted from the list. There was, however, disagreement as to whether the mere surrender of the place of business in the State in which the certificate was granted should result in the withdrawal of the certificate, if the representative establishes another place of business in another Contracting State. The Committee's answer was in the negative. The majority adopted the viewpoint that it would be unfair and unjustifiable to make representation before the European Patent Office during a transitional period dependent on a merely national requirement of any State that the place of business should be within its territory. This restriction on the national central industrial property offices was incorporated in Rule 107 relating to the transitional period, while at the same time it was laid down that the national offices could withdraw the certificate, apart from one of the three above-mentioned grounds, pursuant to other conditions of national law and, in particular, on disciplinary grounds.

Subject to these limitations, representatives entered on the list during the transitional period will, throughout this period, be required to have a certificate issued by the national central industrial property office of a Contracting State. This requirement will, however, cease to apply on the expiry of the transitional period after which the certificate will be devoid of all effect. Thus, representatives during the transitional period and representatives newly authorised after having taken the European qualifying examination will have equal status under the permanent solution. Both kinds of representative will therefore be subject to the disciplinary power decided upon by the Administrative Council pursuant to Article 134, paragraph 7(c); in order to avoid a situation where there would be no disciplinary supervision, the disciplinary power should begin to apply not later than on the expiry of the transitional period.

The Main Committee also remedied other defects in Rules 103 and 107 by including in them provisions laying down that, when the ground for deletion no longer obtains, a representative deleted from the list may be re-entered on it.

13. Conversion procedure (Articles 135-137/Rule 104)

Article 135, paragraph 1, sets out the grounds for the conversion of a forfeited European patent application into a national application. It was proposed to delete the possibilities for conversion under the national laws of the Contracting States in paragraph 1(b). It was maintained that, firstly, Articles 120 and 121 protected the applicant sufficiently against the consequences of omissions and, secondly, that there were no grounds to justify pursuit at national level of European patent applications refused or European patents revoked on material grounds. The principal objection raised against this proposal for deletion was that it was a matter for the national laws whether conversion should be permissible in cases other than those compulsorily prescribed, i.e. in cases where national law provided for forms of protection such as utility models, the grant of which was conditional on less exacting requirements than those applicable to the grant of patents for invention. The great majority of the Committee subsequently rejected the proposal, so that the existing solution was retained.

14. Revocation and prior rights (Articles 138-139)

With regard to the grounds on which, pursuant to Article 138, a European patent may be revoked, the Main Committee made it clear that extension of the protection conferred can be a ground for revocation, irrespective of whether the extension occurs during opposition proceedings or national proceedings. This clarification takes account of the fact that a change in the claims of a European patent during national revocation proceedings or during national proceedings for partial surrender may result in an inadmissible extension of protection. Moreover, the Committee refused to impose, in paragraph 2 of the same Article, any restrictions on national laws in respect of the form in which limitations of European patent claims can be made in cases of partial revocation.

A further proposal, in connection with the rules laid down in Article 139 governing the relationship between European and national patents, to provide that, in cases of collision, the European patent should always take precedence was also unsuccessful. The Committee, by a great majority, rejected this solution which would have been a further step towards adopting a maximum solution, principally in the belief that, in the interests of flexibility, the national laws of the Contracting States should be left to adopt such collision rules as they considered justified.

15. Relationship between the Convention and the PCT (Articles 150-157/Rules 105-106)

The Main Committee re-examined the provisions of Articles 150-157, linking the Convention and the Patent Cooperation Treaty/PCT, i.e., the provisions governing the procedure for international applications which are the subject of proceedings before the European Patent Office. In the course of this examination, it remedied the remaining defects and, where necessary, removed discrepancies between the provisions of the Convention and those of the PCT.

With regard to material content, the amendment made by the Main Committee to Article 157 concerning the effects of the publication of the international application on proceedings before the European Patent Office should be noted. A consequence of the previous text of paragraph 1, according to which publication of the international application by the International Bureau of WIPO takes the place of the publication of a European patent application, would have been that, in each case, the published international application would have formed part of the state of the art, pursuant to Article 52, paragraph 1. This legal consequence was regarded as unjustified where an application, which has not been published in an official language of the European Patent Office, is withdrawn before its communication to the European Patent Office. Therefore, the Committee, after a thorough examination of the relevant provisions of the PCT, decided by a large majority to take account of this case by providing that an international application published pursuant to Article 21 of 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
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Münch, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Rule 10.4

Transmittal of the international application to the European Patent Office

If an international application is filed with an authority of a Contracting State for transmittal to the European Patent Office as the receiving Office, the Contracting State must ensure that the application reaches the European Patent Office not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, the date of priority.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/146/R 11
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 83 to 106
27. **Proposal of the Netherlands Delegation for a new Rule in the Implementing Regulations.**

In the Implementing Regulations should be inserted at an appropriate place, for instance after Rule 105, a new Rule to read as follows: "The mention of the publication of an international application pursuant to Article 157, paragraph 1, shall be effected by publishing the name and the address of the applicant, the number under which the publication took place and the Contracting State or States designated in the international application."

To be seen in connection with the Netherlands proposal to Article 157, paragraph 1.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/52/I/II/III

Original: English

CONFERENCE DOCUMENT

Drawn up by: Netherlands delegation

Subject: Proposals for amendments to the draft texts
ACHTER TEIL
AUSFÜHRUNGSVORSCHRIFTEN ZUM ACHTEN, ZEHNTEN UND ELFENTEN TEIL DES ÜBEREINKOMMENS

Regel 104
Unterrichtung der Öffentlichkeit bei Umwandlungen

(1) Die Unterlagen, die dem Umwandlungsantrag nach Artikel 136 beizufügen sind, sind der Öffentlichkeit von der Zentralbehörde für den gewerblichen Rechtsschutz unter den gleichen Voraussetzungen und im gleichen Umfang wie die Unterlagen eines nationalen Verfahrens zugänglich zu machen.

(2) Auf den Patentschriften der nationalen Patente, die aus der Umwandlung einer europäischen Patentanmeldung hervorgehen, ist diese Anmeldung anzugeben.

Vgl. Artikel 136 (Einreichung und Übermittlung des Antrags)

Regel 105
Weiterleitung der internationalen Anmeldung an das Europäische Patentamt

Wird eine internationale Anmeldung bei einer Behörde eines Vertragsstaats zur Weiterleitung an das Europäische Patentamt als Anmeldeamt eingereicht, so hat der Vertragsstaat dafür zu sorgen, daß die Anmeldung beim Europäischen Patentamt spätestens zwei Wochen vor Ablauf des dreizehnten Monats nach ihrer Einreichung oder, wenn eine Priorität in Anspruch genommen wird, nach dem Prioritätstag eingeht.

Vgl. Artikel 152 (Einreichung und Weiterleitung der internationalen Anmeldung)

Regel 106
Beschränkungen der Prüfung

(1) Die Beschränkungen der Prüfung der europäischen Patentanmeldungen nach Artikel 161 und die Aufhebung dieser Beschränkungen werden im Europäischen Patentblatt veröffentlicht.

(2) Die Gebiete der Technik, auf denen europäische Patentanmeldungen behandelt werden, werden in Anwendung der Internationalen Klassifikation festgelegt.

Vgl. Artikel 129 (Regelmäßig erscheinende Veröffentlichungen) und 161 (Stufenweise Ausdehnung des Tätigkeitsbereichs des Europäischen Patentamts)

PART VIII
IMPLEMENTING REGULATIONS TO PARTS VIII, X AND XI OF THE CONVENTION

Rule 104
Information to the public in the event of conversion

(1) The documents which, in accordance with Article 136, accompany the request for conversion shall be communicated to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specifications of the national patent resulting from the conversion of a European patent application must mention that application.

Cf. Article 136 (Submission and transmission of the request)

Rule 105
Transmittal of the international application to the European Patent Office

If an international application is filed with an authority of a Contracting State for transmittal to the European Patent Office as the receiving Office, the Contracting State must ensure that the application reaches the European Patent Office not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, the date of priority.

Cf. Article 152 (Filing and transmittal of the international application)

Rule 106
Restrictions affecting examination

(1) Restrictions affecting the examination of European patent applications, applied pursuant to Article 161, and the removal of such restrictions shall be entered in the European Patent Bulletin.

(2) The areas of technology in respect of which European patent applications are to be processed shall be determined by reference to the international classification.

Cf. Articles 129 (Periodical publications) and 161 (Progressive expansion of the field of activity of the European Patent Office)
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-DIPLOMATICHE 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
débors 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
in the First Preliminary Draft Convention in addition to the cases provided for here.

Article 111 of the First Preliminary Draft Convention

29. The Sub-Committee wondered whether it would be useful to specify the relationship existing between Articles 111 and 145 of the Convention (BR/88/71) by means of a provision in the Implementing Regulations. This provision would stipulate that an appeal could be considered as being made even without payment of the fee provided for under Article 111 where the decision being contested is obviously the result of a substantial procedural violation. The majority of the Sub-Committee was not in favour of laying down such a measure. It considered in fact, that this text would contradict the principle contained in Article 145 and that moreover such a provision would involve considerable uncertainty since the person making the appeal would have to evaluate whether or not the decision being questioned is obviously the result of a substantial procedural violation.

Re. Article 120, No. 1 - Transmittal of the international application to the European Patent Office

30. This Article specifies the period of time within which a national office must transmit any international PCT application which has been filed with it to the European Patent Office so that the latter may complete its duties as regards transmittal within the required time, in accordance with the provisions of the Regulations under the PCT (Rule 22.1(a)).

BR/34 e/71 nan/KM/prk .../...
MINUTES

of the 5th meeting of the "Implementing Regulations" Sub-Commitee of Working Party I

(Luxembourg, 12 - 14 January 1971)

1. The fifth meeting of the "Implementing Regulations" Sub-Committee was held in Luxembourg from 12 to 14 January 1971, 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 representatives of WIPO/OMPI and the International Patent Institute.(1)

2. The Drafting Committee met each day, under the Chairmanship of Mr NEERVOORT, Secretary of the Octrooi-raad, following the Sub-Committee's meetings.

(1) See the list of participants in Annex I.
Re: Article 120
No. 1

Test drawn up by the Sub-Committee

transmittal of the international application to the European Patent Office

- station is filed with an authority of a Contracting State with
- rice, the Contracting State must ensure that the application
- a later than two weeks before the end of the thirteenth
- claimed, the priority date, or, if more than one priority
- ity, shall be taken as the beginning of the period.

INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Outcome of the work of the "Implementing Regulations" sub-Committee
of Working Party I
(12 to 18 January 1971)

PRELIMINARY DRAFT IMPLEMENTING REGULATIONS

-ies 16, 17, 28, 34, 53, 59, 66, 79, 85, 97, 101, 120, 128, 139, 159, 172 and 186

Brussels, 20th January
BR/81/71

of the first preliminary draft Convention
PCT, for which the European Patent Office is a designated Office, shall be deemed to form part of the state of the art only if it is confirmed, i.e. if it is communicated to the European Patent Office in one of its official languages and the national fee prescribed is paid. In order to create better information facilities for third parties, the Committee provided for a mention to be made in the European Patent Bulletin of the publication by the International Bureau of WIPO of the international application, and, where the publication by the International Bureau is not in one of the official languages of the European Patent Office, for the compulsory publication of the international application communicated to the European Patent Office.

The Committee then inserted a new Article 153a, which empowers the European Patent Office to act as an International Searching Authority within the meaning of the PCT, pursuant to an agreement to be concluded with WIPO at the appropriate time.

16. Activities of the European Patent Office during a transitional period (Article 161/Rule 106)

The principle, laid down in Article 161, that the European Patent Office will, after opening, only be able to assume its activities progressively was not questioned. The Main Committee was also of the unanimous opinion that, during the transitional period, searches should be carried out in all areas of technology, a task which the European Patent Office should easily be in a position to perform after taking over the capacity of the IB and the Berlin sub-office. This unequivocal declaration of intent was, like other general opinions expressed by the Main Committee, included in the Minutes. Nevertheless, in order to be able to meet difficulties, at present unforeseeable, which might subsequently arise, the Committee decided not to incorporate this principle in any binding form in Article 161. On the other hand, it was considered a firm principle that the Administrative Council should not be able to rescind decisions on the extension of the system once they had been adopted. Article 161 was re-worded accordingly.

17. Adjustment of the Convention to take account of the decisions of Main Committees II and III

The textual amendments adopted by Main Committee III did not affect the provisions dealt with by Main Committee I. Adjustments were, however, necessary in respect of two decisions of Main Committee II, relating to the inclusion of Search Divisions as departments in the proceedings (Article 15), a measure by which the Convention was adjusted to take account of the integration of the IB provided for in the Protocol on Centralisation, and to the setting up of a Legal Division as a further department in the proceedings (Article 15) competent for certain decisions. These adjustments entailed purely drafting amendments (Articles 91, 105, paragraph 1, 109, paragraph 3, Rules 44-47), deletion of provisions which had become superfluous (Article 124, Rules 48, 67, paragraph 2) and new provisions such as the Article 153a referred to under point 15 above.

III Protocol on Recognition

The Protocol on Recognition, which lays down rules governing jurisdiction and the recognition of decisions of courts and other authorities of the Contracting States in respect of the right to the grant of a European patent required an amendment as to substance only in one point. With respect to the provision on jurisdiction in the Draft Protocol (Article 5), it was pointed out that a plaintiff residing in a Contracting State claiming the right to the grant of a European patent vis-à-vis an applicant not residing within the territory of a Contracting State would always have to bring proceedings before the German courts and not, as would be desirable, before the courts of his place of residence. The Main Committee agreed that this was a valid point and supplemented Article 5 to the effect that the courts of the plaintiff's place of residence shall also have jurisdiction in such cases, with, however, the subsidiary jurisdiction of the courts of the Federal Republic of Germany being retained.

IV Recommendation on Preparations for the Opening of the European Patent Office

The Main Committee approved the Recommendation which provides for the setting up of an Interim Committee responsible for preparatory work for the opening of the European Patent Office. In addition, in the interests of a clear delimitation of responsibilities the preparation both of the five-year plan mentioned in the Protocol on Centralisation and of the study on the extension of searches to the documentation of the Contracting States, introduced into that Protocol by Main Committee II, was assigned to the Interim Committee. With regard to the point that the Working Parties of the Interim Committee should, as a general rule, each be composed of six signatory States, the Committee decided that the Federal Republic of Germany and the Netherlands, as the countries in which the European Patent Office was based, should always be admitted as observers at meetings of Working Parties of which they were not members, and that other States should be admitted as observers at meetings where problems of special interest to them were dealt with. Furthermore, it was made clear that not only inter-governmental but also private international organisations could be invited as observers.

V Resolution on training staff for the European Patent Office

Finally, as the last item of the negotiations the Main Committee approved without discussion the draft Resolution on training staff for the European Patent Office contained in M/37 which essentially provides for the formation of an Interim Committee responsible for the training and recruiting of examiners.

D Final remarks

Here a report closes which has, perhaps, been too detailed, but which has attempted to summarise in the space of scarcely one hour the results of three weeks of extensive negotiations. The report may also have succeeded in showing that, in spite of the multitude of individual problems, which were usually resolved, those parts of the Draft Convention and the Draft Implementing Regulations which were the subject of the Main Committee's deliberations have been retained without any substantial changes. This is a happy state of affairs and demonstrates how thoroughly the Drafts were prepared.

The rapporteur feels he should not finish without paying tribute to the Chairman of the Main Committee, Dr. Kurt Haertel, for the efficient but gentle manner in which he has guided the negotiations, thus enabling the Main Committee to deal with such a multitude of problems. Main Committee I is also indebted to Mr. van Benthem, the indefatigable Chairman of Drafting Committee I, and his colleagues on that Committee, to the Secretariat staff, the interpreters and all the silent helpers whose selfless work has enabled the newly completed Drafts to be submitted today to the Committee of the Whole.