Article 99 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Article 96d
Opposition

Working Party text

(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.

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

(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.

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) 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.

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
Weiteres Material zu Artikel 99 EPÜ:
Further material to Article 99 EPC:
Ultérieur matériel pour l'Article 99 CBE:

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

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

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

Closely connected with the substantive requirement of disclosing the invention under Article 81 was the problem of making special provisions for European patent applications covering micro-organisms. It was not contested that the relevant provision, Rule 28, should lay down that micro-organisms which are not available to the public should be deposited with a recognised culture collection no later than at the time of filing the application, that the micro-organism should be 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 or for 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.


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

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

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

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

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

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

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

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

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

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

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

1. The Committee of the Whole, which was established by the Plenary of the Conference and comprised all the Government delegations (see Rule 14 of the Rules of Procedure)*, was, pursuant to paragraph 4 of Rule 14, chaired by Dr. Kurt Haertel (Federal Republic of Germany), President of the German Patent Office and Chairman of Main Committee I, Mr. François Savigon (France), Director of the French Industrial Property Office and Chairman of Main Committee II, was First Vice-Chairman; Mr. Edward Armitage (United Kingdom), Comptroller-General of the United Kingdom Patent Office and Chairman of Main Committee III was Second Vice-Chairman.

2. In accordance with Rule 14 of the Rules of Procedure, the terms of reference of the Committee of the Whole were to take decisions on proposals from the General Drafting Committee on drafts established by Main Committees I, II and III and on proposals submitted to it directly and to forward the drafts approved by it to the Plenary of the Conference for adoption.

3. The Committee of the Whole met under the direction of the Chairman from 1 to 4 October 1973.

4. At the meeting on 1 October 1973, the Committee of the Whole received the reports of Main Committees I and II. Main Committee I's report was approved without debate (see Section I below).

5. At its meeting on 2 October 1973, the Committee of the Whole discussed Main Committee II's report. The discussion and subsequent approval of the report are dealt with below in Section II.

6. At the same meeting, it heard and approved Main Committee III's report (see Section III below); it also discussed the results of the proceedings of the General Drafting Committee (M/146 R/1 to R/15 and M/151 R/16). These discussions are covered in Section IV below.

7. On 3 October 1973, the Committee of the Whole received and approved the report of the Credentials Committee (see Section V below). The problems of a European School and the European Patent Office building in Munich were then dealt with (see Sections VI and VII).

8. At its last meeting on the morning of 4 October 1973, the Committee of the Whole discussed the organisation and work programme of the Interim Committee. These discussions are presented in Section VIII below. It finally considered a proposal from the Yugoslav delegation for a Resolution on technical assistance (Section IX) and a Recommendation regarding the status and remuneration of certain employees (Section X).

I. Report of the discussions and decisions of Main Committee I

8. The rapporteur of this Main Committee, Mr. Paul Braendli, Vice-Director of the Federal Intellectual Property Office (Switzerland), presented the report on the work of Main Committee I to the Committee of the Whole. The text of this report is given in Annex I.

The report was unanimously adopted by the Committee of the Whole.

II. Report on the work of Main Committee II

9. Subject to a few minor amendments, the Committee of the Whole unanimously approved the report presented by the rapporteur of Main Committee II, Mr. R. Bowen (United Kingdom), Assistant Comptroller of the United Kingdom Patent Office. The text of the report as adopted by the Committee of the Whole is given in Annex II. The discussions concerning the proposals for amendments to the report are summarised in the following paragraphs.

10. As regards the section of the report concerning the Protocol on Centralisation, the Netherlands delegation, commenting on the first sentence in point 16, stated that the obligations of the European Patent Office towards the Member States of the International Patent Institute had simply been clarified rather than extended. However, the French and United Kingdom delegations maintained that the obligations had in fact been extended since the original text had only referred to tasks at present incumbent upon the Institute whereas now tasks entrusted to the EIB after the signing of the Protocol were expressly covered. While disagreeing with this view, the Netherlands delegation did not insist on an amendment.

11. The Netherlands delegation proposed, also with regard to point 16, that the last sentence should state that the EPO would also undertake searches for Member States of the EIB which had not submitted any applications for search before the entry into force of the Convention. This would make provision for those States which, up to the time in question, had submitted no applications for search to the EIB although they were entitled to do so.

The Committee of the Whole agreed to amend the part of the report concerned as follows: "...the Office will also assume this responsibility in respect of a Member State of the Institute which prior to the entry into force of the Convention, has agreed to submit national applications to the Institute for search."

12. The Committee of the Whole adopted a proposal from the Swedish delegation that the idea proposed by the Scandinavian countries at the beginning of point 22 be worded as follows: "Consideration was given to the idea, proposed by the Scandinavian countries, that such work might be entrusted to national offices, possessing the minimum documentation, whether or not they possessed the other qualifications, required of an International Searching Authority under the Patent Cooperation Treaty." It also approved an addition at the end of the third sentence in this point to the effect that national offices would have to "fully qualify as Searching Authorities."

13. The Austrian delegation suggested that in the English version of point 22, in the middle of page 14, the words "some search work" be used so as not to prejudge the question of the amount of such search work, which had deliberately been left open. The text would therefore read: "difficulties resulting from a renunciation under Section 12, to entrust some search work to national offices whose language is..."

The Committee of the Whole accepted this suggestion. The German and French texts remained unaltered.

14. With regard to the part of the report dealing with Article 166 (Article 167 of the signed version) of the Convention, the Greek delegation proposed that point 11 be amended at the top of page 7 so as to state, not that Main Committee II had accepted the view as to the effects of a reservation, but that it had considered such a possibility. The rapporteur and the Netherlands delegation stated that this view had been generally accepted in Main Committee II.

The Committee of the Whole accordingly decided not to amend the draft which had been submitted.

III. Report on the results of Main Committee III's proceedings

15. Main Committee III's rapporteur, Mr. Fressinet, Deputy Director of the National Industrial Property Office
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
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420. The EIRMA delegation suggested that Article 104 (105) be completely deleted. Discussion of the length of time to be allowed for filing opposition had shown that nobody wanted to extend this period more than was necessary for legal certainty. There was a danger here in the case of intervention that the opposition-procedure might be held up. At the moment, however, there was no need to provide for intervention since the assumed infringer could both file opposition within the permitted period and/or initiate an action for revocation in national courts.

If Article 104 were to be retained, the time limits set for the grant and opposition procedures would have to be reconsidered in the interests of the research-oriented industries.

421. The Chairman replied that no extension proper of these periods was involved since opposition proceedings had to be in progress already. Article 104 was intended to protect third parties, against whom proprietors of patents had not initiated infringement proceedings until after the expiry of the period allowed for filing opposition, from having to initiate revocation proceedings in a number of national courts.

He further noted that the suggestion that Article 104 be deleted had not been taken up by the delegation of any Government.

422. In response to the Swiss delegation's supplementary proposal, the French delegation said that there was no provision in French law for actions intended to produce such negative rulings. It also wondered whether there was not a certain difference between the present provisions of paragraph 1, which the French delegation understood as being in the interest of the proprietor of the patent, and the Swiss delegation's proposal, which might in fact cause the procedure to be more drawn out than before. In the event of a vote on the matter the French delegation would probably abstain.

423. The Chairman concluded by establishing that no Government Delegation opposed the Swiss proposal and that the proposal was therefore adopted.

Article 105 (106) — Decisions adopted by appeal

424. The Main Committee adopted a proposal by the delegation of the Federal Republic of Germany that paragraph 1 be amended to the effect that appeals should also lie from decisions of the Legal Division (M/47/I/II/III, points 6 and 17).

425. The Main Committee noted a proposal by Member States of the European Communities that a new paragraph be included (see M/14, point 6).

426. The Main Committee referred to the Drafting Committee a proposal by the Luxembourg delegation (M/9, point 17) and two proposals by the delegation of the Federal Republic of Germany (M/11, points 28 and 29) concerning the wording of paragraph 2.

427. With the support of the Netherlands and Austrian delegations, the Swedish delegation suggested that in paragraph 4, because of the minimum permitted amount for an appeal against a decision fixing the amount of costs, no reference be made to the implementing Regulations; the minimum amount should be fixed by the Convention itself or — a second possibility — by the Rules relating to Fees (see M/54/I/II/III, page 16).

As regards the figure for this minimum amount, consideration might be given to fixing it at three times the opposition fee, which had been fixed at present at 20 UA (equal to about DM 140.00). If three times the opposition fee were reached or exceeded, then it would no longer be a question of a small amount, and appeals against decisions fixing the amounts of costs would be in order.

428. The United Kingdom delegation reminded the meeting that the appeal fee would also be high and was expected to be 50 UA. If the minimum payment were fixed at three times the opposition fee, i.e. 60 UA, then nobody would, in practice, make use of the possibility of making an appeal. In its view the best solution was not to allow any appeal at all against decisions fixing the amounts of costs since they were purely discretionary.

429. The French delegation opposed the Swiss delegation's proposal on the grounds that it might not be wise to fix an amount in the Convention; it preferred an amount to be laid down in the Implementing Regulations since then it could be more easily changed. If it were done in this way, the French delegation could agree to three times the amount of the opposition fee.

430. The delegation of the Federal Republic of Germany did not think that the minimum permitted amount for an appeal should be linked to the opposition fee. The opposition fee could be fixed in accordance with widely differing criteria and might perhaps in the course of time undergo changes.

Moreover, it would be preferable not to fix a minimum payment in the Convention so that it might be more easily changed. For these reasons the delegation of the Federal Republic of Germany could not support the Swiss delegation's main proposal.

431. After the Swiss delegation had withdrawn its main proposal in a subsequent meeting, the Main Committee accepted its alternative proposal that the minimum permitted amount for appeals be fixed in the Rules relating to Fees; at the same time it deleted Rule 54 (83), paragraph 5.

Article 106 (107) — Persons entitled to appeal and to be parties to appeal proceedings

432. The Main Committee referred drafting proposals by the Luxembourg (M/9, point 18) and Swiss (M/54/I/II/III, page 17) delegations to the Drafting Committee.

433. The Member States of the European Communities proposed that in the second sentence the words "with the exception of those who have abandoned that right" be deleted (M/14, point 7).

434. The delegation of the Federal Republic of Germany thought that the aim of this proposal was for parties to proceedings of the first instance also to be entitled to take part in the appeal proceedings. Most national regulations governing civil proceedings included provisions embodying this principle. The present draft, on the other hand, could lead to difficulties in the allocation of costs in appeal proceedings. If one of the parties to the proceedings of the first instance were able to drop appeal proceedings, it might well be that the other party would have to bear the full costs in the event of a court's ruling in its favour. Such an outcome was naturally not desirable; the power to drop appeal proceedings should therefore be ruled out.

435. The FICPI delegation asked whether a party to proceedings who was convinced of the hopelessness of an appeal could be compelled to take part in appeal proceedings and thereby run the danger of being required, possibly years later, to contribute to costs.

436. The UNION delegation thought that that would be an unjustifiable burden. By way of illustration it gave the following example: proceedings brought by two opponents has led to the limitation of the patent. One of the opponents is content with that result; the other, however, wants the whole patent to be revoked and starts appeal proceedings. If all parties were bound to be party to the appeal proceedings, it could happen that in the event of an unfavourable ruling the first opponent
were not official languages of the European Patent Office wanted translations of specifications and publication of those translations to be required; three months each had been agreed on for translation and publication. The remaining three months had been considered as time for consideration by the patentee’s competitors in that State.

399. The Netherlands and Swiss delegations took up the Observer delegations’ point. The Netherlands delegation stressed that as a result of the Main Committee’s decision the applicant should provide translations of the patent claims into the two other official languages of the European Patent Office (see point 378), the period of time specified in Article 96, paragraph 4, would probably have to be extended by two months, with the result that that extra time would be gained for translation. It thus seemed justified to shorten the time allowed for filing opposition correspondingly.

400. The United Kingdom delegation did not want the period of nine months allowed for filing opposition to be changed immediately. If it were to emerge later that it was too long, the Administrative Council could always shorten it then. It was also worthy of note that the United Kingdom’s experience of shorter time limits had been unfortunate, in that notices of opposition had not been drawn up with sufficient care and had had to be amended later.

401. The delegation of the Federal Republic of Germany thought that competitors should in any case have six months in which to give notice of opposition. Consideration had also to be given, however, to competitors in other countries who would probably require translations of patents in their own languages; in such countries — for example Sweden — the patent would only be available for examination in the national language much later, with the result that even in the event of a nine-month period for filing opposition those competitors would be much worse off than those in countries whose national language was the language of the proceedings. The period should be allowed to stand at least for the present.

402. The Swedish delegation thought that the period of nine months which had been agreed upon hitherto should be used to start with and that it should be left to the Administrative Council to make any reduction in this period on the basis of practical experience.

403. The Netherlands delegation pointed out that the time allowed for providing translations of specifications under Article 63 (65), paragraph 1, started from the moment when an applicant was informed by the European Patent Office of the form which it was intended the grant of a patent would take. Only after these three months, which were to be extended to five, could mention of the grant be made in the European Patent Bulletin. The period allowed for filing opposition only began with the publication of that mention. In all, that amounted to fourteen months and it would therefore be quite justifiable to reduce the period allowed for filing opposition to, for instance, seven months.

404. The Norwegian delegation, taking into account the views of interest circles in Norway, was in favour of retaining the present period.

405. The Irish delegation did not think that the period for filing opposition should be changed for the time being.

406. In the ensuing vote, three delegations were in favour of reducing the period for filing opposition to six months, ten were in favour of retaining the nine-month period, and three delegations abstained.

407. The Member States of the European Communities proposed that a new paragraph provide that opposition might still be filed even where the patent had been surrendered or had lapsed for all designated States (see M/14, point 4).

408. The United Kingdom delegation explained this proposal by pointing out that the effect of a patent’s being surrendered or lapsing was immediate, but that there might be residual legal effects which could appropriately be removed subsequently by means of the opposition procedure.

409. The Main Committee adopted this proposal.

410. The Netherlands delegation said that paragraph 4 constituted an exception to the principle of the uniform treatment of proprietors laid down in Article 117 (118) in that a previous proprietor and the person who replaced him in respect of a designated Contracting State were not treated as joint proprietors. It followed therefore that two separate patents would be involved, which might turn out quite differently as regards claims, descriptions and so on. Because of this fact textual drafting changes would probably have to be made in the Implementing Regulations.

411. The Chairman noted that this was also the view of the Main Committee.

Article 99 (100) — Grounds for opposition

412. The Main Committee referred to the Drafting Committee a proposal for the rewording of sub-paragraph (b) of this Article by the delegation of the Federal Republic of Germany (M/11, point 26).

Article 100 (101) — Examination of the opposition

413. The Norwegian delegation withdrew its proposal concerning Article 100 (M/28, point 10).

Article 101 (102) — Revocation or maintenance

414. A proposal by Member States of the European Communities concerning the wording of paragraph 2 (M/14, point 5) was referred to the Drafting Committee.

415. As regards paragraph 3, the Main Committee decided that, in the same way as it had been laid down that the applicant would be required to have the patent claims translated into the two other official languages of the European Patent Office (see point 378 above), the proprietor of the patent would have to supply a translation of any claims changed as a result of opposition proceedings.

Article 103 (104) — Costs*

Article 104 (105) — Intervention of the assumed infringer

416. A proposal by the delegation of the Federal Republic of Germany concerning the wording of paragraphs 1 and 2 (M/47/I/II/III, point 41) was referred to the Drafting Committee.

417. In connection with paragraph 1, the Swiss delegation proposed that a third party should also be allowed to intervene in opposition proceedings if he showed that, after being warned of infringement by the proprietor of the patent, he had instituted proceedings against the proprietor of the patent in order to have a ruling that he was not infringing the patent (see M/54/I/II/III, page 15). This remedy was available under the law of a number of countries and had proved to be of value.

418. The UNICE delegation supported this proposal. It stressed, however, that warning by the proprietor of the patent could not be considered sufficient grounds for intervention, but that a party wanting to intervene would have to have started proceedings for a ruling.

419. The CEIF and UNION delegations, the latter making reference to its own proposal in M/28, point 8, also supported this proposal.

* For an explanation of these Articles, see points 2012, 2015 and 2016.
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
PART V
OPPOSITION PROCEDURE

Article 98

Opposition

(1) Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid.

(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.

(3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.

(4) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.

(5) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. By derogation from Article 118, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/F 4
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 84 to 111
PART V

OPPOSITION PROCEDURE

Article 98

Opposition

(1) Unchanged from 1972 published text
(2) Unchanged from 1972 published text

(2a) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.

(3) Unchanged from 1972 published text

(4) Only concerns French text
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973
M/143/I/R 14
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 27 SEPTEMBER 1973

Articles of the Convention:

Articles 58
98
133

Rules of the Implementing Regulations:

Rules 13
14
16
28
PART V

OPPOSITION PROCEDURE

Article 98

Opposition

(1) 

(2) Unchanged from 1972 published text

(2a) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.

(3) Unchanged from 1972 published text

(4) 

(5) 

(6)
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 14 September 1973
M/80/I/R 2
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 13 SEPTEMBER 1973

Articles of the Convention:

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Rules of the Implementing Regulations:

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PROPOSAL ON ARTICLE 98

Paragraph 1: Omit last sentence.

Comments:
In the Norwegian view notice of opposition should not be made conditional upon payment of an opposition fee. The opposition procedure ought to be regarded as a valuable supplement to the examination performed by the EPO, and in the long run also a service to the proprietor of patent himself.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973
M/60/1
Original: English

CONSEQUENT DOCUMENT

Drawn up by: Norwegian delegation

Subject: Proposals for Articles 68, 98 and 109 of the Convention
and for Rules 2 and 41 of the Implementing Regulations.
this paragraph 2 in such a way that the abstract shall be published in the same way and at the same time as the search report.

18. **Article 96, par. 2:**

See our observations nr. 3 on Article 14, par. 7.

19. **Article 98, par. 4:**

According to this paragraph the previous proprietor of the patent and the person replacing him as proprietor in some contracting state following a courts' decision, shall not be deemed to be joint proprietors within the meaning of Article 117. The question arises what effect such a situation would have on the prosecution of the application. Should not Rule 16, par. 2 be rendered applicable also on this case?

20. **Article 123, par. 2:**

We are afraid that the German and French texts are not wholly identical with the English text. In our opinion an incomplete reply cannot be deemed to be a withdrawal of the European patent application.

21. **Article 135, par. 1:**

The German text should be made conform to the English and French text by placing the word "nur" before "Auf Antrag" in the third line of this paragraph and by replacing the word "nur" in the fifth line by "und".

22. **Article 149, par. 2:**

In order to make clear that not only the first sentence but also the second sentence of this paragraph deals exclusively with PCT-applications we propose to read this paragraph as follows:

"Where the European Patent Office acts as a designated Office under Article 153, par. 1, paragraph 1 shall apply if the applicant -
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 1 June 1973
M/32
Original: English

PREPARATORY DOCUMENT

Drawn up by: Netherlands Government

Subject: Observations and proposed amendments concerning the Draft Convention and the Draft Implementing Regulations
4 Zum Übereinkommensentwurf selbst möchte die norwegische Regierung folgendes bemerken:


6 Kann dieser Vorschlag nicht angenommen werden, so schlägt die norwegische Regierung als Alternative eine Lösung vor, die dem Erfordernis der Erfinderennung (Artikel 79 und Artikel 90 Absatz 5) entspricht. Das würde bedeuten, daß in einem Fall, in dem der Anmelder sein Recht auf die Erfindung nicht nachgewiesen hat, die Anmeldung für die benannten Staaten, in denen ein solches Erfordernis für nationale Patentanmeldungen besteht, als zurückgenommen gelten würde.


10 Artikel 100 betreffend die Prüfung des Einspruchs sollte durch einen dritten Absatz ergänzt werden, der Artikel 109 Absatz 3 entspricht, wonach der Artikel 95 Absatz 3 Anwendung findet. Auch während der Prüfung des Einspruchs sollte das

4 With regard to the Draft Convention itself the Norwegian Government would like to make the following observations:

5 The first observation concerns the interests of the inventor. According to Art. 58 the right to a European patent shall belong to the inventor or his successor in title. However, for the purposes of the proceedings before the European Patent Office the applicant shall be deemed to be entitled to exercise this right. In the Norwegian view the applicant, not being the inventor himself, ought to have an obligation to establish his right to the invention.

6 If this proposal cannot be adopted, the Norwegian Government alternatively proposes a solution along the same lines as those governing the requirement to identify the inventor (Art. 79 and Art. 90(5)). This would imply that in a case where the applicant has not established his right to the invention, the application would be deemed to be withdrawn in respect of designated states having such a requirement for national patent applications.

7 Art. 68(4)(a) of the Draft Convention allows the applicant for or proprietor of the patent to supply a corrected translation. This corrected translation shall, however, have no legal effect until the conditions specified in Art. 65(3) have been met. It is assumed that when the translation refers to the patent specification, the applicant may also be required to pay the costs of a publication of the new translation. This ought to be stated expressly in Art. 68(4)(a) by a reference to Art. 63(2).

8 The continuation of use which is made provision for in Art. 68(4)(b) should in the Norwegian opinion be permitted without payment of compensation. Such a rule can be based upon essentially the same considerations as those underlying Art. 121(6) of the Draft Convention as well as similar provisions in many national laws concerning prior users right.

9 Art. 98(1) makes opposition dependent upon payment of an opposition fee, a rule which is virtually unknown in the patent laws in force today. In the Norwegian view, notice of opposition ought to be allowed without payment of a fee, since the opposition procedure should be regarded as a valuable supplement to the examination performed by the European Patent Office.

10 Art. 100 on examination of the opposition should be completed by adding a third paragraph, similar to that of Art. 109, providing for the application of Art. 95(3). Even during the examination of the opposition the European Patent Office should be
STELLUNGNAHME
DER NORWEGISCHEN REGIERUNG

COMMENTS
BY THE NORWEGIAN GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT NORVÉGIEN
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)

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

STELLUNGNAHMEN
zu den vorbereitenden Dokumenten
herausgegeben von der
Regierung der Bundesrepublik Deutschland

COMMENTS
on the preparatory documents
published by the
Government of the Federal Republic of Germany

PRISES DE POSITION
sur les documents préparatoires
publiées par le
Gouvernement de la République fédérale d'Allemagne

1973
Begründung:

Die Korrektur ist erforderlich, um den deutschen Text an den englischen und französischen Text anzupassen, die den richtigen Sinn wiedergeben.

Artikel 96, Absatz (2) b

5 Vorschlag:

Die Worte „und die Druckkostengebühr“ werden gestrichen.

Begründung:

Im Interesse einer Vereinfachung des Verfahrens ist es besser, eine Erteilungsgebühr solcher Höhe vorzusehen, daß sie die durchschnittlichen Druckkosten deckt.

6 Anmerkung: In Art. 101(3)b sollen die Druckkosten beibehalten werden.

Artikel 98, Absatz (1)

7 Vorschlag:

In Zeile 1 wird das Wort „neun“ durch „sechs“ ersetzt.

Begründung:


Artikel 104

8 Vorschlag:

In Zeile 4 ist nach den Worten „worden ist“ einzufügen „oder daß er aufgrund einer Verwarnung eine Klage auf Feststellung, daß er das Patent nicht verletzt hat, erhoben hat“.

Begründung:

Ein wegen Verletzung des Patentes Verwarnten sollte die gleiche Möglichkeit haben wie ein Beklagter; jedoch nur dann, wenn er dagegen Klage erhoben hat.

Grounds:

The correction is necessary in order to adapt the German text to the English and French texts which provide the correct sense.

Article 96, paragraph 2(b)

5 Proposal:

The words “and printing” to be deleted.

Grounds:

In the interest of simplifying the procedure it is better to provide a granting fee of an amount which covers the average printing costs.

6 Note: The printing costs are to be retained in Article 101, paragraph 3(b).

Article 98, paragraph 1

7 Proposal:

The word “nine” to be replaced by “six” in line 1.

Grounds:

With a term of 9 months, the patentee and public would only learn at a very late date whether the patent has been opposed or has remained unopposed. The patentee and the public have however a justified interest in this information not being unnecessarily delayed. Since in countries which provide for an opposition, the opposition term generally amounts to 3 months, a term of 6 months would certainly be sufficient for filing an opposition against a European patent, particularly as the public had already known of the patent application through the publication thereof according to Article 92.

Article 104

8 Proposal:

In line 4, after the word “him”, insert the words: “or that as a result of a warning he has instituted proceedings to establish that he has not infringed the patent”.

Grounds:

A person cautioned for infringing the patent should have the same possibility as a defendant; however only when he has lodged a complaint.
STELLUNGNAHME DER
UNEPA
Union Europäischer Patentanwälte

COMMENTS BY
UNEPA
Union of European Patent Agents

PRISE DE POSITION DE
L'UNEPA
Union des Conseils en brevets européens

(1) English translation submitted by UNEPA
(2) La traduction française a été fournie par l'UNEPA
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)

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(1973)

(Munich, 10 septembre - 6 octobre 1973)

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PRISES DE POSITION
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Gouvernement de la République fédérale d'Allemagne

_______________________________

1973
im Rahmen des Artikels 94 nicht als eine im Ermessen des Verwaltungsrats liegende Gunst, sondern als ein Recht zuerkannt werden, das ihnen aufgrund der vom Verwaltungs rat beschlossenen Verlängerung der Fristen automatisch zusteht.

Artikel 98 – Einspruch


Artikel 104 – Beitritt des Patentverletzers zum Einspruchsverfahren


Artikel 124 – Ergänzender europäischer Recherchenbericht


Artikel 166 – Vorbehalte

16 Die STÄNDIGE KONFERENZ bedauert, daß den Staaten die Möglichkeit belassen bleibt, während eines Zeitraums von 10 Jahren sowohl hinsichtlich der Patentierbarkeit der Nahrungs- und Arzneimittel und der Agrar- oder Gartenbauernzeugnisse als auch in bezug auf die Laufzeit des europäischen Patents Vorbehalte geltend zu machen. Falls durch eine solche Möglichkeit die Ratifizierung des Übereinkommens erleichtert werden kann, so würde sie sich damit einverstanden erklären, daß diese Vorbehalte für eine Höchstdauer von fünf Jahren eingelegt werden können.

them under Article 94, not as a favour left to the discretion of the Administrative Council, but as a right which is automatically granted where the Council decides to extend the period in question.

Article 98 – Opposition

13 The STANDING CONFERENCE is in favour of there being opposition proceedings particularly since they constitute the only proceedings which may be brought before a European body involving a dispute as to the validity and extent of a European patent. These proceedings are likely to encourage the development of common jurisprudence on these two major problems which have basically been left to the interpretation of national courts.

Article 104 – Intervention of the infringer in the opposition proceedings

14 The STANDING CONFERENCE supports the possibility accorded to the assumed infringer against whom proceedings for infringement have been instituted to intervene in opposition proceedings. It considers that, in order to take account of the concern expressed with regard to Article 67, the possibility of extending this provision should be examined so that an assumed infringer against whom proceedings for infringement have been instituted may request the opinion of the European Patent Office as to the validity and scope of the patent in question by means of direct action.

Article 124 – Supplementary European search report

15 The STANDING CONFERENCE supports the possibility accorded to the European Patent Office to obtain at any time a supplementary search report on the state of the art from the International Patent Institute, particularly in the case provided for under Article 156 of the Convention. The European Patent Office, which is responsible for the grant of the patent, must be the sole judge of the desirability of obtaining a supplementary report having regard to the information at its disposal for taking its decision on the application.

Article 166 – Reservations

16 The STANDING CONFERENCE deplores the option granted to the Contracting States to make reservations, which will be valid for a period of ten years, both as concerns the patentability of food and pharmaceutical products and agricultural or horticultural processes and as concerns the period of validity of European patents. If it is felt that such an option would encourage States to ratify the Convention, it could accept these reservations being limited to a maximum period of five years.
STELLUNGSNAHME DER

StKIHK
Ständige Konferenz der Industrie- und Handelskammern
der Europäischen Wirtschaftsgemeinschaft

COMMENTS BY

CPCCI
Standing Conference of the Chambers of Commerce and Industry
of the European Economic Community

PRISE DE POSITION DE LA

CPCCI
Conférence Permanente des Chambres de Commerce et d’Industrie
de la Communauté Économique Européenne
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTVERTEILUNGSVORFAHRENS 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)

CONFÉRENCE DIPLOMATIQUE DE MUNICH
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(1973)

(Munich, 10 septembre - 6 octobre 1973)

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__________________________

1973

Bei Annahme des von COPRICE vorgezogenen Vorschlags erhielt Artikel 67 Absatz 1 Satz 1 folgende Fassung: Der Schutzbereich des europäischen Patents und der europäischen Patentanmeldung wird durch die Patentansprüche bestimmt."

10 Artikel 93 – Prüfungsantrag – und 94 – Verlängerung der Frist zur Stellung des Prüfungsantrags

Hinsichtlich dieses wichtigen Artikels sollten nach Ansicht von COPRICE zwei Zeiträume unterschieden werden:

1. Während der Übergangszeit muß der Verwaltungsrat über eine große Ernennungsfreheit verfügen, um die Frist für die Stellung des Prüfungsantrags zu verlängern und auf diese Weise zu vermeiden, daß die europäischen Patentanmeldungen nicht fristgerecht oder nicht zufriedenstellend bearbeitet werden können. Zu diesem Zweck könnte in Artikel 94 Absatz 1 den Gründen, die den Verwaltungsrat zur Verlängerung der Frist ermächtigen, der Begriff des allgemeinen Interesses hinzugefügt werden.

2. Für die Zeit nach der Übergangszeit könnte eine rasche Prüfung – die wohl vorzuziehen ist – eingeführt werden; COPRICE unterschätzt jedoch nicht gewisse Vorteile einer aufgeschobenen Prüfung.

Auf alle Fälle hält es COPRICE überleinwilligend für wünschenswert, daß die Prüfung der Patentierbarkeit, wenn sie erst einmal aufgenommen worden ist, rasch vonstatten geht.

Schließlich sei darauf hingewiesen, daß das Europäische Patentamt den Artikel 161 Absatz 1 betreffend die stufenweise Ausdehnung des Tätigkeitsbereichs des Europäischen Patentamts zur Anwendung bringen kann.

11 Artikel 98 – Einspruch


12 Artikel 107 – Frist und Form

Es wird vorgeschlagen, die in diesem Artikel vorgesehene Frist in folgende zwei Zeitabschnitte aufzuteilen:

– zwei Monate für das Beschwerdeverfahren,
– zwei zusätzliche Monate für die Begründung und die Entrichtung der Gebühren.

“teneur“, “terms“ and “Inhalt“ or at least by replacing the word “teneur“ by “contenu“ in the French text.

If the former proposal were adopted, the 1st part of Article 67, paragraph 1, would read as follows: “The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims.”

10 Article 93 – Request for examination – and Article 94 – Extension of the period within which requests for examination may be filed

COPRICE considers that a distinction should be made between two periods in this important Article:

1. During the transitional period the Administrative Council must have broad discretionary powers to extend the period within which requests for examination may be filed. This is in order to avoid a situation where European patent applications cannot be examined in due time or in a satisfactory manner. To this end in Article 94, paragraph 1, the concept of public interest could be added to the grounds on the basis of which the Administrative Council may extend the period.

2. During the definitive period a system of rapid examination could be established, and this would appear preferable; however, COPRICE does not underestimate the fact that there may be certain advantages in deferred examination. In any event it is the unanimous wish of COPRICE that, once an examination as to patentability has been started, it should be carried out quickly.

Finally, it is pointed out that the European Patent Office will be able to avail itself of the provisions of Article 161, paragraph 1, relating to the progressive expansion of its field of activity.

11 Article 98 – Opposition

The period of nine months laid down in this Article would seem to be excessive. In order to shorten as much as possible the procedure which, as pointed out at the beginning of this note, is very long and complicated, COPRICE proposes that the period in question should be reduced from nine to six months.

12 Article 107 – Time limit and form of appeal

It is proposed that the period laid down in this Article should be sub-divided into two parts:

– two months for instituting appeal proceedings
– two additional months for the submission of the grounds on which the appeal is based and for the payment of the fees.
STELLUNGNAHME DES COPRICE
Comité pour la Protection de la propriété industrielle dans la Communauté économique européenne

COMMENTS BY COPRICE
Comité pour la Protection de la propriété industrielle dans la Communauté économique européenne

PRISE DE POSITION DU COPRICE
Comité pour la Protection de la propriété industrielle dans la Communauté économique européenne
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTeilungsVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
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(1973)
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1973

**A. ÜBEREINKOMMEN**

1 **Titel des Übereinkommens**

Hinter dem Titel des Übereinkommens sollte als Kurztitel in Klammern „Europäisches Patentübereinkommen“ hinzugefügt werden; der Kurztitel sollte für Bezugsnahmen auf dieses Übereinkommen und insbesondere im Übereinkommen über das Gemeinschafts­patent verwendet werden können.

2 **Artikel 22 Absatz 3**

Im englischen Text sollte das letzte Wort dieses Absatzes „appellant” in „party making the objection” berichtigt werden.

3 **Artikel 59 Absatz 1**

Im englischen Text sollten die Worte „following the final decision” in „after the decision has become final” berichtigt werden.

4 **Artikel 98**

Es sollte ein neuer Absatz 2a folgenden Wortlauts eingefügt werden:

“(2a) Der Einspruch kann auch eingelegt werden, wenn für alle benannten Vertragsstaaten auf das europäische Patent verzichtet worden ist oder wenn das europäische Patent für alle benannten Vertragsstaaten erloschen ist."

**Begründung:**

Mit dieser Änderung soll dem auf nationaler Ebene entstandenen Bedürfnis Rechnung getragen werden, den Widerruf eines europäischen Patents auch dann betreiben zu können, wenn der Patentinhaber auf das Patent ausdrücklich verzichtet hat oder das Patent (beispielsweise infolge der Nichteintrichtung einer nationalen Gebühr) erloschen ist und infolgedessen nicht mehr besteht. Wird eine solche Möglichkeit nämlich nicht vorgesehen, so würde der

In connection with the work carried out in the Council of the European Communities for the drawing up of a Draft Convention for the European Patent for the Common Market, hereinafter referred to as the “Second Convention”, the Member States of the European Communities have set forth in this document proposals for amendments to the drafts of the Convention establishing a European System for the Grant of Patents, and of the Implementing Regulations.

**A. THE CONVENTION**

1 **Title of the Convention**

It is proposed that the following abbreviated title be added in brackets after the title of the Convention so that the abbreviated title can be used to refer to this Convention, in particular in the Community Patent Convention:

“European Patent Convention”

2 **Article 22, paragraph 3**

It is proposed that in the English text the last word in this paragraph, “appellant” be corrected to read “party making the objection”.

3 **Article 59, paragraph 1**

It is proposed that in the English text the words “following the final decision” be corrected to read “after the decision has become final”.

4 **Article 98**

It is proposed that a new paragraph 2a, worded as follows, be inserted:

“(2a) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.”

**Reason:**

This amendment takes account of the need, as demonstrated on the national level, for proceedings to be initiated for the revocation of a European patent even where that patent has ceased to exist after the proprietor has expressly surrendered it or after it has lapsed (e.g. as a result of non-payment of a national fee). In the absence of such a possibility, a presumed infringer of a revocable patent might be held liable for the period preceding the surrender or the lapse of the patent which normally only have "ex nunc" effect. It has, of course, been left to
STELLUNGNAHME

DER MITGLIEDSTAATEN DER EUROPÄISCHEN GEMEINSCHAFTEN

COMMENTS

BY THE MEMBER STATES OF THE EUROPEAN COMMUNITIES

PRISE DE POSITION

DES ÉTATS MEMBRES DES COMMUNAUTÉS EUROPÉENNES
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)

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

STELLUNGNAHMEN
zu den vorbereitenden Dokumenten
herausgegeben von der
Regierung der Bundesrepublik Deutschland

COMMENTS
on the preparatory documents
published by the
Government of the Federal Republic of Germany

PRISES DE POSITION
sur les documents préparatoires
publiées par le
Gouvernement de la République fédérale d'Allemagne

1973
FÜNFTER TEIL
EINSPRUCHSVERFAHREN

Artikel 98
Einspruch


(2) Der Einspruch erfaßt das europäische Patent für alle Vertragsstaaten, in denen es Wirkung hat.

(3) Am Einspruchsverfahren sind neben dem Patentinhaber die Einsprechenden beteiligt.


Vgl. Regeln 13 (Aussetzung des Verfahrens), 56 (Form des Einspruchs), 61 (Fortsetzung des Einspruchsverfahrens von Amts wegen), 62 (Rechtsübergang des europäischen Patents), 70 (Feststellung eines Rechtsverlustes) und 91 (Unterbrechung des Verfahrens)

Artikel 99
Einspruchsgründe

Der Einspruch kann nur darauf gestützt werden, daß

a) der Gegenstand des europäischen Patents nach den Artikeln 50 bis 55 nicht patentfähig ist;

b) das europäische Patent die Erfindung nicht so deutlich und vollständig offenbart, daß ein Fachmann sie danach ausführen kann;

c) der Gegenstand des europäischen Patents über den Inhalt der Anmeldung in der eingereichten Fassung oder, wenn das Patent auf einer europäischen Teilanmeldung oder einer nach Artikel 59 eingereichten neuen europäischen Patentanmeldung beruht, über den Inhalt der früheren Anmeldung in der ursprünglich eingereichten Fassung hinausgeht.

PART V
OPPOSITION PROCEDURE

Article 98
Opposition

(1) Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid.

(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.

(3) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.

(4) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. By derogation from Article 117, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request.

Cf. Rules 13 (Suspension of proceedings), 56 (Form of the notice of opposition), 61 (Continuation ex officio of the opposition proceedings), 62 (Transfer of the European patent), 70 (Noting of loss of rights) and 91 (Interruption of proceedings)

Article 99
Grounds for opposition

Opposition may only be filed on the grounds that:

(a) the subject-matter of the European patent is not patentable within the terms of Articles 50 to 55;

(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, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 59, beyond the content of the earlier application as filed.

Article 100
Prüfung des Einspruchs

(1) Ist der Einspruch zulässig, so prüft die Einspruchsabteilung, ob die in Artikel 99 genannten Einspruchsgründe der Aufrechterhaltung des europäischen Patents entgegenstehen.

Article 100
Examination of the opposition

(1) If the opposition is admissible, the Opposition Division shall examine whether the grounds for opposition laid down in Article 99 prejudice the maintenance of the European patent.
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. UNIPA also considered that in paragraph 3, last sentence - and in Article 103 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 IFIA 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, IAPIP 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 **EIRWA**, **IFIA** and **FIPOPI** 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, **IAPIP** 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).

BR/169 e/72 oyd/AV/prk
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.
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-govern-mental 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)

BR/168 e/72 eld/KM/gc
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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -

BR/139 e/71
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).

49. The stage of revocation proceedings (Article 133)

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 101)

48. Considering that at the stage of opposition proceedings the European patents already 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
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 Octrooiraad, and, following his departure, under that of Mr. LABRY, Embassy Counsellor at the Ministry of Foreign Affairs (France).
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. 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.
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.

BR/135 e/71 ley/prk
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 2, 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 2, 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.
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 2, 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.**
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 17 November 1971
BR/135/71

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 Octrooiread, 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.

**Artikel 101b**

**Prüfung des Einspruchs**

1. Ist der Einspruch zulässig, so erforscht die Einspruchsaufteilung 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 Einspruchsaufteilung braucht neue von den Beteiligten vorgebrachte Tatsachen und Beweismittel nicht zu berücksichtigen, die nicht in der Einspruchsbegründung oder in der Erwiderung auf den Einspruch enthalten sind.

**Artikel 102**

**Prüfungsbescheid im Einspruchsverfahren**

Ist die Einspruchsaufteilung 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.

**Artikel 103**

**Stellungnahme der Beteiligten**

Die Einspruchsaufteilung 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 Einspruchsaufteilung dies aus anderen Gründen für scheidlich hält.

(3) The Opposition 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.

**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.

**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.

**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.

**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 Dritte, die Einspruch gemäß Absatz 1 eingelegt haben, sind neben dem Patentinhaber am Einspruchsverfahren beteiligt.

ARTICLE 99
Certificate for a European patent
(1) As soon as the patent specification has been published, the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent, to which the specification shall be annexed.
(2) The certificate shall certify that the European patent has been granted, in respect of the invention described in the patent specification, to the person named in the certificate, for the Contracting States designated in the specification.

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.
REGIERUNGSKONFERENZ ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTERTeilungsVERFAHREN
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS
CONFERENCE INTERGOUVERNEMENTALE POUR L'INSTITUTION D'UN SYSTÈME EUROPEEN DE DELIVRANCE DE BREVETS

ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN
sowie
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES PATENTERTeilungsVERFAHREN
und
ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

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

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

and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN
SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

— 1971 —
Re. Article 130, No. 1 - Renewal fees in respect of applications for patents of addition which have become independent

Re. Article 130, No. 2 - Renewal fees in respect of applications for divisional European patents

23. See the note addressed to Working Party I below the text of the provision. This concerns the payment of renewal fees which must be made in advance.

No comments.

24. Having concluded their examination of the Chairman's proposals contained in BR/GT I/52/70, the Sub-Committee turned to the proposals contained in BR/GT I/65/70, beginning with the Implementing Regulations to the Articles relating to opposition procedure.

Re. Article 101, No. 1 - Form of the Notice of opposition

25. It was stressed that the opponent must base his opposition on at least one of the grounds listed in Article 101a (new) of the Preliminary Draft. See also the note under the provision as to whether a certain rule should appear in the Convention or in the Implementing Regulations.

BR/60 e/70 ley/EM/prk

.../...
MINUTES

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

I

1. The third working meeting of the Sub-Committee instructed by Working Party I to draw up draft Implementing Regulations to the Convention was held at Luxembourg, from Tuesday 20 to Friday 23 October 1970, with Mr. PRESSCHET, 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 BIRPI and the International Patents Institute (IIB) (1).

(1) See the list of participants in Annex I.
as having been completed. A footnote to the text draws the attention of Working Party I to the fact that it might be opportune to amend the text of Article 85, paragraph 3, so that the publication cannot include amendments unless they were communicated before the completion of the technical preparations.

Re. Article 97, No. 1 - Grant of a European patent to joint applicants

26. No comments.

Re. Article 101, No. 1 - Form of the notice of opposition

27. The Sub-Committee decided to add to the text of sub-paragraph (c) that the notice of opposition shall indicate besides the grounds for opposition, the facts, evidence and arguments presented in support of these grounds. This addition is intended to implement a decision taken by Working Party I at its meeting in December, 1970. It must be pointed out that the documents which have to be produced to support these facts, evidence and arguments may be communicated later, within a period of time which is specified in the Implementing Regulations, Re. Article 101 No. 2.

Finally, the Sub-Committee considered that it would be superfluous to provide for a special entry in the Bulletin to mention the absence of opposition.

Re. Article 101, No. 5 - Communications to the other opponents

28. When adopting this article, the Sub-Committee wondered whether it would be opportune to combine in a single provision the various cases of notification mentioned

BR/84 e/71 nan/Ki/prk

.../...
INTEGOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

MINUTES

of the 5th meeting of the "Implementing Regulations" Sub-Committee 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 FRESSONNET, 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 Octrooiiraad, following the Sub-Committee's meetings.

(1) See the list of participants in Annex I.
Re. Article 101  
(former Article 96d)  
No. 1 (new)  

Form of the notice of opposition

Text drawn up by the sub-Committee

The notice of opposition shall contain:

(a) the name and address of the opponent and the State in which his residence or registered place of business is located, in accordance with the provisions of Article ... (Re. Article 66, No. 1), paragraph 2 (c);

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

(c) a statement of the extent to which the European patent is opposed and of those grounds, prescribed by Article 101 (a) (new) of the Convention, on which opposition is based.

(d) if the opponent has appointed an agent, his name and the address of his place of business, in accordance with the provisions of Article ... (Re. Article 66, No. 1), paragraph 2 (c).

Note:
Article 101 (1), second sentence, of the First Preliminary Draft Convention lays down that notice of opposition must be given in writing. It will be appropriate to examine whether this provision should be transferred to the Implementing Regulations, by analogy with Re. Article 88, No. 1, on the Form of the Request for Examination.
Outcome of the work of the "Implementing Regulations" sub-Committee of Working Party I
(20 to 23 October 1970)

PRELIMINARY DRAFT IMPLEMENTING REGULATIONS

Re. Articles 85, 88, 97, 99, 101, 106, 111, 112, 113, 114, 115, 130
154, 155, 156, 157 and 159

of the first preliminary draft Convention
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.

BR/87 e/71 nan/BS/prk
INTER-GOVERNMENTAL CONFERENCE Brussels, 28 February 1971
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS 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.
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 107a (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.
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
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(1) For the provisional agenda (BR/GT I/62/70), see Annex I.
(2) For the list of participants, see Annex II.
CHAPTER III

OPPOSITION PROCEDURE

Article 101 (former Article 96d)

Opposition

Text drawn up by the Working Party

(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 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) *

(3) *
CHAPTER III
OPPOSITION PROCEDURE

Article 101 (former Article 96d)

Opposition

1970 Draft

(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 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.
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 prepared by Working Party I

(7 to 11 September 1970)
Article 101 (former Article 96d) : Opposition

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/49/70, page 3, 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.

BR/49 e/70 oyd/24/cat

.../...
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
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.

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.


Artikel 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.
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.

30. No comment.

BR/12 e/69 ern/PA/mk
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 18 December 1969
BR/12/69

SECRETARIAT

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. HAEFTEL, 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 (Examination procedure) (2),

(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.

BR/12 e/69 kel/PA/mk
Article 96d
Opposition

(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.

Notes:
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
Le Président constate que le groupe de travail est d'accord avec le principe contenu dans le texte de la proposition élaboré par la délégation allemande à la suite des décisions prises par le groupe de travail à Munich.

Il passe ensuite à l'examen des textes des articles modifiés contenus dans cette proposition.

Sous le chiffre I, au point 1, est proposé un nouveau paragraphe 7 à l'article 34. Cette modification est adoptée. Il s'agit d'un texte qui vise les langues dans lesquelles seront publiées les revendications (trois langues de travail de l'Office).

Au point 2, est proposé un nouveau paragraphe 3 à l'article 88. Le nouveau texte a pour but de forcer le titulaire à prendre position dès qu'il formule sa requête en examen. Cela a pour effet de diminuer la longueur de la procédure. Dans la plupart des cas on donne un délai de trois mois puisque selon l'ancien texte, le titulaire ne devait prendre position qu'après l'opposition des tiers. Le texte proposé est adopté. Le Comité de rédaction est chargé de le revoir pour le mettre en conformité avec le dernier état du texte des articles 1 à 103 (doc. 1155 du 2/10/1964).

En outre, le Comité de rédaction veillera à modifier l'article 88 en tenant compte que l'article 90 a) énumère non seulement la description mais encore les revendications et les dessins.

Au point 3, il est proposé de prévoir un nouvel article 90 a) concernant la prise de position du titulaire du brevet européen provisoire lorsqu'il n'a pas présenté la requête en examen. Ce texte est adopté sans observation ainsi que les propositions de modification faites aux points 4, 5 et 6.

Au point 7, une nouvelle rédaction est proposée pour l'article 96 relatif à la publication des revendications. Il s'agit de la publication à intervenir à la suite de la décision transitoire qui sera prise à la fin de la première phase de la procédure d'examen.

Le premier paragraphe de cette disposition prévoit que la division d'examen fait connaître la rédaction qu'elle envisage de donner au brevet européen provisoire confirmé non seulement au titulaire du brevet ou au tiers qui a présenté la requête en examen, mais encore à tout tiers qui a formulé des observations conformément à l'article 92.
Lors de la session de Munich en juin 1964, ce problème de la participation des tiers a, à nouveau, été discuté. À l'époque, la délégation allemande avait fait une proposition pour rencontrer ses objections ainsi que celles de certaines délégations. Il a été décidé que sur la base des discussions de Munich la délégation allemande se chargerait de rédiger un texte à ce sujet. C'est cette rédaction qui fait l'objet du document en discussion.

M. Pfanner signale que ce texte vise principalement à diviser en deux phases la procédure d'examen. Dans la première phase, cette procédure se déroulerait entre l'Office et le titulaire du brevet européen provisoire sans aucune intervention des tiers.

A la suite de ce premier examen, le brevet européen peut être soit supprimé, soit confirmé totalement ou partiellement mais cette confirmation n'est pas encore définitive. Elle ne le sera qu'à la suite de la deuxième phase. Toutefois, à la fin de la première phase, interviendra une décision transitoire qui fera l'objet d'une publication disant que le brevet peut être confirmé sous telle forme avec telle revendication. À partir de cette publication, un délai de 3 mois sera prévu pour permettre les oppositions. Au cas où les tiers forment opposition, on entre dans la deuxième phase de la procédure et l'examen est repris avec tous les tiers opposants. La décision qui interviendra à la fin de la deuxième phase pourra soit annuler le brevet soit le confirmer totalement ou partiellement. Le droit d'appel sera prévu en faveur du titulaire du brevet et également en faveur des tiers. Telle est la caractéristique essentielle du texte proposé.

Toutefois, il y entre encore un autre élément d'importance. Dans le cas où la chambre de recours infirme la décision transitoire de la section d'examen, décision intervenue à la fin de la première phase, celle-ci devra renvoyer la procédure devant la première instance.

La proposition ne prévoit pas, en effet, que la chambre de recours pourrait elle-même prendre cette décision transitoire parce qu'une telle disposition priverait les tiers d'une instance.

Le Président ajoute encore que la publication de la décision transitoire se fera dans les trois langues de travail de l'Office. Il souligne que la proposition actuelle, comme l'a dit M. Pfanner, comporte l'avantage de ne pas alléger la procédure et qu'elle n'oblige pas les tiers à participer à la procédure d'examen à un moment où ils ne sauraient pas encore si le brevet ne sera pas supprimé.
Le Président ouvre la séance à 9h30.

Pour terminer l'examen du point 5 de l'ordre du jour, il soumet à l'attention du groupe deux propositions en relation avec la communication des dossiers.

1° Si une demande est retirée avant la délivrance du brevet provisoire, l'objet de cette demande est considéré comme faisant partie de l'état de la technique mais ne sera pas publié.

Le Président propose pour pallier cet inconvénient de donner au Président de l'Office l'autorisation de procéder à cette impression.

2° Dans de tels cas, il faudrait également permettre au Président d'envoyer une photocopie de la demande à l'I.I.B. afin que cette institution en tienne compte dans l'état de la technique.

Après un échange de vues, le groupe adopte les deux propositions. Le Comité de rédaction est chargé d'en établir le texte. Ce texte dira notamment: "le Président peut...".

**Participation des tiers à la procédure d'examen**

Le groupe examine alors le point 6 de l'ordre du jour relatif à une proposition établie par la délégation allemande à la participation des tiers à la procédure d'examen (doc. 9075 du 27.7.1964).

M. Pfenner explique les réticences du texte proposé. Lors de la session de février 1964, il est apparu que les milieux intéressés critiquaient fortement l'intervention des tiers dès le début de la procédure. En effet, à ce moment-là, ils se voyaient obligés de participer à la procédure alors qu'ils ne savaient point encore si le brevet serait confirmé.

.../...
GROUPE DE TRAVAIL
"Brevets"

Résultats de la quinzième session
du groupe de travail "Brevets"
qui s'est tenue à Bruxelles
du 19 au 29 octobre 1964

COMPTES RENDUS
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(1) Within a period of three months from the date of the publication referred to in Article 96, paragraph 2, any person may give notice to the European Patent Office of opposition to the confirmation of a provisional European patent. 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 examination proceedings with the proprietor of the patent.

(3) The Examining Division shall notify the proprietor of the patent of any opposition raised 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.
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

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