Article 138 E

Travaux Préparatoires
(EPC 1973)

Comment:
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Art138eTPEPC1973
Art. 138
MPÜ
Nichtigkeitsgründe

<table>
<thead>
<tr>
<th>Entwurf, der dem nebenstehenden Dokument zugrunde liegt</th>
<th>Art. Nr. im Entwurf/Dokument</th>
<th>Dokument, in dem der Art. behandelt wird</th>
<th>Fundstelle im Dokument</th>
</tr>
</thead>
<tbody>
<tr>
<td>BR/48/70</td>
<td>133</td>
<td>BR/49/70</td>
<td>Rdn. 92-95</td>
</tr>
<tr>
<td>VE 1971 (Ue)</td>
<td>133</td>
<td>BR/135/71</td>
<td>Rdn. 157</td>
</tr>
<tr>
<td>BR/88/71</td>
<td>133</td>
<td>BR/125/71</td>
<td>Rdn. 76</td>
</tr>
<tr>
<td>BR/134/71</td>
<td>133</td>
<td>BR/144/71</td>
<td>Rdn. 49/50</td>
</tr>
<tr>
<td>BR/139/71</td>
<td>133</td>
<td>BR/168/72</td>
<td>Rdn. 143-145</td>
</tr>
<tr>
<td>BR/139/71</td>
<td>133</td>
<td>BR/169/72</td>
<td>Rdn. 129-132</td>
</tr>
</tbody>
</table>

Dokumente der MDK

<table>
<thead>
<tr>
<th>E 1972</th>
<th>138</th>
<th>M/9</th>
<th>S. 38</th>
</tr>
</thead>
<tbody>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/11</td>
<td>S. 68</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/14</td>
<td>S. '94</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/53/II</td>
<td>S. 4</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/98/II/R 4</td>
<td>S. 4</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/146/R 5</td>
<td>Art. 138</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/PR/I</td>
<td>S. 73/74</td>
</tr>
<tr>
<td>&quot;</td>
<td>138</td>
<td>M/PR/G</td>
<td>S. 204</td>
</tr>
</tbody>
</table>
(7 to 11 September 1970)

Prepared by Working Party I

FOR A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

PRELIMINARY DRAFT CONVENTION

SECRETARIAT

BRUSSELS, 23 September 1970

FOR THE GRANT OF PATENTS
INTER-GOVERNMENTAL CONFERENCE
The Working Party did not adopt any provision equivalent to that of paragraph 1 (c) of the 1965 Draft concerning a patent of addition, in view of the attitude adopted by the Conference with regard to Article 13 (deletion of the second variant of the First Preliminary Draft).

It was noted that sub-paragraph (b) could apply, in conjunction with Article 71, to the case raised by the British delegation concerning "speculative claims", the scope of which would only be evident at a later date, when an inventor is able to make a product covered by the patent, by a process not referred to therein.

For the wording of paragraph 2, the Working Party tried to find a more flexible solution than that contained in the 1965 Draft, so that if the national law so provides, the patent may not only be subject to a limitation corresponding to partial revocation, but also to amendment by the court trying the action. In addition, since this is a basic provision, the Working Party preferred to insert this ruling in Article 133 and not in Article 188 (new), on reservations.

Rule 134 (new) : Prior national rights

The Working Party discussed where this provision should be placed, since certain delegations had asked whether, it did not in fact constitute a special ground for revocation which would have been dealt with in Article 133 (new).

The Working Party rejected this suggestion, as Article 133 (new) lists the grounds for revocation, while Article 134 (new) refers to the national law, which may lay down, for example, a sanction other than the revocation of a European patent, which could simply be considered in the State in question as being void with regard to the national patent.
In the light of these discussions, it became evident that the provision, which relates to grounds for revocation only, does not prejudice the implementation of the provisions of national legislations relating to the lapse or forfeiture of a patent.

However, the British Delegation withheld its final judgement on the text adopted by the Working Party. The British Delegation reserved the right to submit new proposals to the Working Party with the intention of including grounds for revocation other than those at present laid down in Article 133 (new).

(b) Individual provisions

94. With reference to paragraph 1, the Working Party paid particular attention to covering the following cases in which it is necessary to provide for revocation because one of the conditions laid down, in the Convention, for the grant of a patent has not been met. This is the case in sub-paragraphs (a) and (b).

When drafting sub-paragraph (b), the Working Party took into account the balance to be sought between two kinds of problem: the public interest in knowing the exact scope of a patent, on one hand, and the continuity of the decisions taken by the European Patent Office on the other.

In addition, sub-paragraphs (c) and (d) are intended to cover cases where the protection given by the patent may be wider than that of the original application, either as a result of the translation of the application or during the examination proceedings as a result of amendments to the claims (sub-paragraph c) or after opposition proceedings (sub-paragraph d).
In a Contracting State, it would not oblige a state to revoke a European patent for one of the grounds laid down; an obligation of this kind would in fact result in the unification in the Convention, of grounds for the revocation of a European patent in all Contracting States. It would oblige the said States to apply criteria for revocation which might be unknown in their national legislation, and this would probably give rise to difficulties. In addition, such a solution would probably have led to the laying down of a certain number of other grounds for revocation drawn from the national legislations in force.

In accordance with the maximum approach adopted by the Convention, the Working Party considered that the provision met the wishes of the interested circles, which would like to have a guarantee that the European patent cannot be revoked in a Contracting State on grounds drawn from national laws alone.

The Working Party also noted that the grounds listed in Article 133 (new) could be used later as a model for the harmonisation of national laws.

The Working Party retained this system, while being aware that a European patent may be revoked in one Contracting State, while continuing to be valid in other Contracting States.

With regard to the list of grounds for revocation, the Working Party decided to reject some grounds found in national legislations, such as the grounds of oppressive monopoly, wrongful obtaining or grant of compulsory licences not being sufficient to prevent abuses of exclusive rights, or that of the patent remaining unused. It felt it appropriate to limit itself, as a matter of principle, to only laying down grounds which would be in keeping with the criteria for patentability laid down in the Convention, for the grant of a European Patent.
Agenda item 3: Amendment of the First Preliminary Draft on the basis of decisions taken by the Inter-governmental Conference at its 3rd meeting (1) (Working document submitted to the Working Party by the Chairman: BR/GT I/49/70)

Article 2: European patent (BR/40/70, pages 2 and 3, No. 4)

90. The provision retained by the Working Party implements the "maximum approach", according to which, after the patent is granted, it is subject to the rules applicable to national patents in each Contracting State, in as far as the Convention does not rule otherwise (cf., also, Article 133 (new) for grounds for revocation, and also Article 188a (new) for reservations which Contracting States may make at the time of signing the Convention or of depositing this instrument of ratification or accession.

91. The British delegation outlined the difficulties to which a solution of this nature could give rise, in view of the amendments to national legislation which it involves (also see note to Article 188a (new).

PART VII
Revocation of the European Patent

Article 133 new: Grounds for revocation (BR/40/70, Pages 2 and 3, No. 4).

(a) General discussion

32. The Working Party had a very detailed discussion on the scope of this provision. It noted that, although Article 133 (new) contains a restrictive list of the grounds on which a European patent

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(1) Throughout the remainder of the present report references will be given, with regard to the Articles under discussion, to the instructions which the Conference gave to Working Party I, as described in the minutes of the 3rd meeting (BR/40/70).
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 26 October 1970
BR/49/70

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 Insti-
tute 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 .../...
REVOCATION OF THE EUROPEAN PATENT

Article 133

Grounds for revocation

(1) Subject to the provisions of Article 134, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

(a) if the subject-matter of the European patent is not patentable within the terms of Articles 9 to 14;

(b) if 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) if the subject-matter of the European patent extends beyond the content of the application as filed;

(d) if the protection conferred by the European patent has, contrary to Article 104, been extended during opposition proceedings.

(2) If the grounds for revocation only affect the European patent partially, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so provides, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

Article 134

Prior national rights

If, in one of the Contracting States, a national patent or application for a national patent made public on or after the priority date of a European patent has an earlier priority date than that of the European patent, the European patent shall, in that Contracting State, be treated, with regard to the prior national right, exactly as if it were a national patent.
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 —
The Working Party agreed with this proposal. It was understood that if a divisional application contained new material, the attention of the applicant should be drawn to this point so that he might remove this material. If he did not, the divisional application would be rejected for not complying with Article 83a. The applicant would always have the option, if the new material constituted an invention, to divide the application subsequently without claiming the priority of the original application for the divisional application.

157. In view of the decision taken on Article 83a, the Working Party decided also to amend Article 101a, paragraph 1(c) and Article 133, paragraph 1(c), so that extension of the subject-matter of the original application would constitute a ground for opposition or revocation where a patent had been granted on the basis of a divisional application.

Re. Article 141, No. 1, paragraph 2

158. The WIPO representative proposed that this provision be aligned on the PCT by changing the relevant event for calculating periods in the second sentence of this paragraph from the receipt of a notification to its dispatch.

The delegations discussed this proposal in the light of national experience. However, the Working Party felt that the discussion should not be taken further until it had heard the views of the interested circles, for whom the problem was fairly important. It was therefore decided to draw their attention to this point in the invitation to be sent to them for the January 1972 meeting.
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/CT I/120/71 and attached to this document as Annex II.

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

BR/135 e/71 prk
(Unrevised translation)
PART VII
REVOCATION OF THE EUROPEAN PATENT

Article 133
Grounds for revocation

(1) Subject to the provisions of Article 134, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

(a) if the subject matter of the European patent is not patentable within the terms of Articles 9 to 14;

(b) if 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) if the subject matter of the European patent extends beyond the content of the application as filed;

(d) if the protection conferred by the European patent has, contrary to Article 104, been extended during opposition proceedings.

(2) If the grounds for revocation only affect the European patent partially, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so provides, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.
FIRST PRELIMINARY DRAFT OF A CONVENTION

ESTABLISHING

A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Stage reached on 29 January 1971 -
PART VII
REVOCATION OF THE EUROPEAN PATENT

Article 133 (Grounds for revocation)

76. One delegation observed that paragraph 1 appeared to give rise to two interpretations:

(i) if the national law of a Contracting State did not recognise one of the grounds for revocation listed in this paragraph, that State might not on that ground revoke a European patent;

(ii) in any Contracting State whose system of law recognised the primacy of international law over national law, all the grounds for revocation in this paragraph ought to be considered as belonging to national legislation immediately the Convention came into force for that State, and therefore all would be applicable.

The Conference was of the opinion that only the first of these two interpretations should apply. This did not in any way rule out the possibility of each State amending its national legislation to fit in with the provisions of Article 133 of the Convention. On the contrary, progress in this direction would be extremely desirable.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP
OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

- Secretariat -

MINUTES

of the
4th Meeting of the Inter-Governmental Conference
for the setting up of a European System
for the Grant of Patents
(Luxembourg, 20 to 28 April 1971)

BR/125 e/71 ley/KM/bp
Article 133

Grounds for revocation

(1) Subject to the provisions of Article 134, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

(a) +

(b) +

(c) if 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, beyond the content of the earlier application as filed;

(d) +

(2) +
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 -

BR/134 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).

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

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

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

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

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

The Working Party adopted neither of these proposals.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING-UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 16 December 1971
BR/144/71

SECRETARIAT

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 133

Grounds for revocation

(1) Subject to the provisions of Article 134, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

(a) +

(b) +

c) if 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 16, beyond the content of the earlier application as filed;

d) if the protection conferred by the European patent has, contrary to Article 137b, paragraph 5, been extended during opposition proceedings;

e) if the proprietor of the European patent is not entitled under Article 15.

(2) +
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 6 December 1971
BR/139/71

- Secretariat -

DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -

BR/139 e/71
Article 129 (Renewal fees for European patent applications) and Article 132 (Renewal fees for European patents)

142. The Conference rejected the suggestions of IFI regarding a readjustment of the system of fees (cf. BR/165/72, point 128).

Article 133 (Grounds for revocation)

143. The Conference rejected the proposal by certain organisations that sub-paragraph (b) should be deleted; it also rejected a suggestion that an additional ground for revocation be added concerning the conformity of the claims with the conditions laid down in Article 71a.

144. The Conference agreed that the expression "sufficiently clear and complete for it to be carried out by a person skilled in the art" contained in sub-paragraph (b) should be interpreted in the sense that ordinary mental comprehension was sufficient for the condition to be fulfilled, this being necessary, particularly in those branches of the art requiring extremely complex equipment. An interpretative declaration to this effect could be adopted at the Diplomatic Conference.

145. The Drafting Committee of the Conference was instructed to examine whether the wording of sub-paragraph (c) could be improved in such a way as to make clear that any additional factors included in the priority document could not be invoked under this ground.

BR/168 e/72 eld/KM/prk
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)
by the courts and tribunals of the various Contracting States and the risk of differing interpretations could not therefore be ruled out.

One organisation (ICC), and minorities of CNIPA and EIRMA, on the contrary declared themselves in favour of the retention of (b), especially as a similar provision was given as grounds for opposition in Article 101a and these two provisions should be kept aligned.

130. The ICC expressed reservations about the wording "sufficiently clear and complete for it to be carried out by a person skilled in the art" contained in (b). It proposed the following wording "sufficiently clear and complete for it to be understood by a person skilled in the art". This observation was also valid for Article 71.

131. Two delegations (CNIPA and UNEPA) asked for new grounds for revocation to be added, namely failure of claims to comply with the requirements laid down in Article 71a. Similar grounds should be provided for in Article 101a in respect of opposition.

132. UNEPA asked whether (c) might also be invoked in respect of those parts of the application outside the scope of the priority document.

It was specified that this provision referred only to the patent application as filed and did not cover the priority document.
Article 124 (Request for the application of national procedure)

127. Both EIRMA and ICC were in favour of deleting the provision contained in Article 124, paragraph 1(b), arguing that this provision would give rise to a very lengthy period of uncertainty for third parties. Furthermore, Article 6 already enabled those concerned to limit their risks if they had any doubts about their chances of success in applying for a European patent.

Article 129 (Renewal fees for European patent applications)

128. Pointing to a need for a general approach which would encourage scientific development and citing other patent systems as examples, IFIA argued in favour of changes in the fees system so that the obligation to pay fees would apply only to a few really fundamental points of procedure. More specifically, it proposed that renewal fees for the filing of a European patent application should be abolished and that renewal fees for the European patent should be paid almost entirely to the European Patent Office.

Article 133 (Grounds for revocation)

129. Two organisations (CNIIPA and EIRMA) supported the deletion of (b) in paragraph 1, on the grounds that the vague wording might endanger the legal security of the proprietor of a patent. It was stressed that this danger was all the more real since the provisions of Article 133, unlike those of Article 107a, would be applied
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)
Artikel 139
Ältere Rechte und Rechte mit gleichem Anmelde- oder Prioritätstag


Kapitel III
Sonstige Auswirkungen

Artikel 140
Nationale Gebrauchsmuster und Gebrauchszertifikate

Die Artikel 64, 123, 135 bis 137 und 139 sind in den Vertragsstaaten, deren Recht Gebrauchsmuster oder Gebrauchszertifikate vorsieht, auf diese Schutzrechte und deren Anmeldungen entsprechend anzuwenden.

Artikel 141
Jahresgebühren für das europäische Patent

Jahresgebühren für das europäische Patent können nur für die sich an das in Artikel 84 Absatz 4 genannte Jahr anschließenden Jahre erhoben werden.

(2) If the grounds for revocation only affect the European patent partially, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.

Article 139
Rights of earlier or the same date

(1) In any designated Contracting State a European patent application and a European patent shall have with regard to a national patent application and a national patent the same prior right effect as a national patent application and a national patent.

(2) A national patent application and a national patent in a Contracting State shall have with regard to a European patent in which that Contracting State is designated the same prior right effect as they have with regard to a national patent.

(3) Any Contracting State may prescribe whether and on what terms an invention disclosed in both a European patent application or patent and a national application or patent having the same date of filing or, where priority is claimed, the same date of priority, may be protected simultaneously by both applications or patents.

Chapter III
Miscellaneous effects

Article 140
National utility models and utility certificates

Article 64, Article 123, Articles 135 to 137 and Article 139 shall apply to utility models and utility certificates and to applications for utility models and utility certificates registered or deposited in the Contracting States whose laws make provision for such models or certificates.

Article 141
Renewal fees for European patents

Renewal fees in respect of a European patent may only be imposed for the years which follow that referred to in Article 84, paragraph 4.
gezeichneten Vertragsstaaten weiter. Die in Artikel 64
geschränkte Wirkung erlischt, wenn der Antrag nicht
innerhalb von zwanzig Monaten nach dem Anmeldetag
oder, wenn eine Priorität in Anspruch genommen
wird, nach dem PrioritätsTag weitergeleitet wird.

Vgl. Regeln 70 (Bestellung eines Rechtsverlustes) und 104
(Unterrichtung der Öffentlichkeit bei Umwandlungen)

Artikel 137
Formvorschriften für die Umwandlung

(1) Eine europäische Patentanmeldung, die nach Artikel 136 übermittelt worden ist, darf nicht solchen
Formenfordernissen des nationalen Rechts unterworfen
werden, die von denen abweichen, die im Übereinkommen vorgesehen sind oder über sie hinausgehen.

(2) Die Zentralbehörde für den gewerblichen Rechts-

schutz, der die europäische Patentanmeldung übermittelt
werden, kann verlangen, dass der Anmelder innerhalb

einer Frist, die nicht weniger als zwei Monate betragen
darf,
a) die nationale Anmeldegebühr entrichtet und
b) eine Übersetzung der europäischen Patentanmeldung
in eine der Amtssprachen des betreffenden Vertrags-

staats einreicht, und zwar in der ursprünglichen Fassung

der Anmeldung und gegebenenfalls in der im Verfahren
davor dem Europäischen Patentamt geänderten Fassung,
die der Anmelder dem nationalen Verfahren zugrunde zu
legen wünscht.

Kapitel II
Nichtigkeit und ältere Rechte

Artikel 138
Nichtigkeitgründe

(1) Vorbehaltlich Artikel 139 kann aufgrund des

Rechts eines Vertragsstaats das europäische Patent mit

Wirkung für das Hoheitsgebiet dieses Staats nur für

nichtig erklärt werden, wenn
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,
en, wenn das Patent auf einer europäischen Teilanmeldung
oder einer nach Artikel 59 eingereichten neuen euro-

päischen Patentanmeldung beruht, über den Inhalt der
früheren Anmeldung in der ursprünglich eingereichten
Fassung hinausgeht;
d) der Schutzbereich des europäischen Patents im Ein-
spruchsverfahren entgegen Artikel 122 Absatz 3 er-
weitert worden ist;
e) der Inhaber des europäischen Patents nicht nach
Artikel 58 berechtigt ist.

144

Artikel 137

Formal requirements for conversion

(1) A European patent application transmitted in
accordance with Article 136 shall not be subjected to
formal requirements of national law which are different
from or additional to those provided for in this
Convention.

(2) Any central industrial property office to which the
application is transmitted may require that the applicant
shall, within not less than two months:
(a) pay the national application fee, and
(b) file a translation in one of the official languages of
the State in question of the original text of the
European patent application and, where appropriate, of
the text, as amended during proceedings before the
European Patent Office, which the applicant wishes
to submit to the national procedure.

Chapter II
Revocation and prior rights

Article 138
Grounds for revocation

(1) Subject to the provisions of Article 139, a Euro-

pean patent may only be revoked under the law of a

Contracting State, with effect for its territory, on the

following grounds:
(a) if the subject-matter of the European patent is not

patentable within the terms of Articles 50 to 55;
(b) if the European patent does not disclose the inven-
tion in a manner sufficiently clear and complete for it to
be carried out by a person skilled in the art;
(c) if 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;
(d) if the protection conferred by the European patent
has, contrary to Article 122, paragraph 3, been extended
during opposition proceedings;
(e) if the proprietor of the European patent is not
entitled under Article 58.
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
ministration peut prévoir ... d'autres personnes morales qui ont leur siège sur le territoire ...”.

**Begründung:**

Die vorgeschlagene Ausdrucksweise soll sicherstellen, daß der englische und der Französische Text dem im deutschen Text verwendeten Ausdruck „Sitz” entsprechen.

b) Im englischen Text sollte in der letzten Zeile des Absatzes 3 der Ausdruck „economic links” durch den Ausdruck „economic connections” ersetzt werden.

**Artikel 138 Absatz 1 Buchstabe d**

Diese Bestimmung sollte wie folgt formuliert werden:

„d) der Schutzbereich des europäischen Patents erweitert worden ist;”

**Begründung:**


**Artikel 141**

Es sollte ein neuer Absatz 2 folgenden Wortlauts angefügt werden:


**Artikel 138, paragraph 1(d)**

It is proposed that this sub-paragraph be worded as follows:

“If the protection conferred by the European patent has been extended;”

**Reason:**

The deletion of the words “contrary to Article 122, paragraph 3” and “during opposition proceedings” would authorise each Contracting State to include as a ground for revocation in its national law any extension of the protection conferred by the European patent, in particular by amendment to the claims, during national revocation or limitation proceedings. The Member States of the European Communities wish to make use of this possibility in the Second Convention by providing as a ground for revocation of a Community patent not only any extension of the protection during the opposition proceedings but also any extension of protection, in particular by an amendment to the claims, during the limitation or revocation proceedings which will be centralised and take place before the special departments of the European Patent Office. However, unless such a possibility is open to them under Article 138 of the First Convention, they will be unable to apply such a measure.

**Artikel 141**

It is proposed that a second paragraph worded as follows, be added:

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

DER MITGLIEDSTAATEN DER EUROPÄISCHEN GEMEINSCHAFTEN

COMMENTS

BY THE MEMBER STATES OF THE EUROPEAN COMMUNITIES

PRISE DE POSITION

DES ÉTATS MEMBRES DES COMMUNAUTÉS EUROPÉENNES
das Wort „sofortige Beschwerde“ eine bestimmte, hier nicht passende technische Bedeutung hat.

29 Außerdem wird angeregt zu prüfen, ob Satz 2 nicht mit Rücksicht auf Artikel 107 Satz 1 entbehrlich ist.

since the term “sofortige Beschwerde” has a specific technical meaning which is not appropriate here.

29 In addition it should be examined whether the 2nd sentence is really necessary in view of the 1st sentence of Article 107.

Artikel 116

30 In Absatz 1 Buchstabe g ist die „Abgabe einer eidesstattlichen Versicherung“ als Beweismittel genannt. Nach informellen Gesprächen mit der britischen Delegation handelt es sich jedoch bei dem im englischen Text stehenden „sworn statement in writing“ um eine Erklärung, die vor einer zuständigen Stelle unter Eid abgegeben wird. Die deutsche Fassung von Buchstabe g sollte daher lauten: „die Abgabe einer schriftlichen Erklärung, die unter Eid abgegeben worden ist“.

30 In the German text of paragraph 1(g) “Abgabe einer eidesstattlichen Versicherung” is referred to as a means of giving or obtaining evidence. Informal discussions with the United Kingdom delegation have, however, established that the “sworn statements in writing” referred to in the English text are statements made under oath before a competent authority. The German version of (g) should therefore read: “die Abgabe einer schriftlichen Erklärung, die unter Eid abgegeben worden ist”.

Artikel 134


31 (a) In the interests of clarity it would appear desirable to replace in the German version the term “zugelassene Vertreter” by “geschäftsmäßige Vertreter” (professional representatives) along the lines of the English version.

32 b) In Absatz 1 sollte ein Vorbehalt mit Rücksicht auf Absatz 6 gemacht werden, da die Vertretung vor dem Europäischen Patentamt auch von jedem Rechtsanwalt, der die erforderlichen Voraussetzungen erfüllt, wahgenommen werden kann.

32 (b) Paragraph 1 should state that its provisions are subject to the provisions of paragraph 6, since representation before the European Patent Office may be undertaken by any legal practitioner fulfilling the necessary requirements.

33 c) Absatz 3 sollte gestrichen werden, da er neben Absatz 1 entbehrlich zu sein scheint.

33 (c) Paragraph 3 should be deleted since it seems unnecessary in addition to paragraph 1.

Artikel 138

34 Im deutschen Text sollte in Absatz 1 Buchstabe b das Wort „danach“ in Anpassung an Artikel 81 gestrichen werden.

34 In the German text the word “danach” in paragraph 1(b) should be deleted, to correspond with Article 81.

II.
AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN

Regel 29

35 Im deutschen Text von Absatz 1 Satz 1 sollte das Wort „fetzulegen“ durch „anzugeben“ ersetzt werden.

35 In the German text of the 1st sentence of paragraph 1 the word “fetzulegen” should be replaced by “anzugeben”.

II.
IMPLEMENTING REGULATIONS
TO THE CONVENTION

Rule 29
STELLUNGNAHME

DER REGIERUNG DER BUNDESREPUBLIK DEUTSCHLAND

COMMENTS

BY THE GOVERNMENT OF THE FEDERAL

REPUBLIC OF GERMANY

PRISE DE POSITION

DU GOUVERNEMENT DE LA

RÉPUBLIQUE FÉDÉRALE D'ALLEMAGNE
Artikel 131 – Rechtshilfe

26 Absatz 1

Die Verwendung des Ausdrucks „sur requête“ („auf Antrag“) würde nach französischer Terminologie einen schriftlichen Antrag erfordern; dies ist aber nicht gemeint („quod non!“). Für die Antragstellung ist wohl keine besondere Form vorgeschrieben.

Vorschlag:

Statt des Ausdrucks „sur requête“ sollte „à la requête“ oder „à la demande“ stehen.

Artikel 138 – Nichtigkeitsgründe

27 Absatz 2

Der Inhalt des Wortes „partiellement“ („teilweise“) sollte geklärt werden. Aus dem Entwurf geht nämlich scheinbar hervor, daß der Fall gemeint ist, in dem nur einige von mehreren Nichtigkeitsgründen auf das Patent zutreffen; dies würde sicher nicht dem eigentlichen Sinn dieser zweifellos sehr nuancierten Vorschrift entsprechen.

Vorschlag:

Der Beginn dieses Absatzes könnte folgende Fassung erhalten: „Si les motifs de nullité n’affectent le brevet européen qu’en partie ...“ oder „n’affectent que partie du brevet ...“ („Treffen die Nichtigkeitsgründe nur auf einen Teil des europäischen Patents zu, ...“).

Artikel 150 – Anwendung des Zusammenarbeitsvertrags

28 Absatz 2

Der Begriff „procédure“ läßt im Französischen ausschließlich an die Form und nicht an den Inhalt eines Vorgangs denken, wie dies im Deutschen und im Englischen bei den Ausdrücken „Verfahren“ und „proceedings“ doch wohl der Fall ist, die ein bestimmtes Objekt bei einer gerichtlichen Instanz abdecken. Auf jeden Fall muß verhindert werden, daß die Vorstellung Raum gewinnt, der Zusammenarbeitsvertrag sei nur auf Verfahrensfragen anwendbar.

Vorschlag:

In Satz 2 sollte es anstatt „Dans ces procédures“ („In diesem Verfahren“) heißen: „À ces demandes“ („Auf diese Anmeldungen“).

this Convention and to be observed vis-à-vis the authorities of such State), or: “... au droit d’un Etat contractant... quant aux délais...” (English text unchanged) (the first version would be preferable).

Article 131 – Legal co-operation

26 Paragraph 1

The expression “sur requête” (on request) (5th line) would in French require a written act (quo non!). Here, however, no special form would seem to be necessary for the submission of the request.

Proposal:

Replace “sur requête” by “à la requête” or “à la demande” (in English all three mean: on request).

Article 138 – Grounds for revocation

27 Paragraph 2

The exact meaning of the word “partially” should be specified. The text of the draft would seem to refer more to the case of only some grounds out of several affecting the patent, which obviously is not the true meaning of this provision which has a very special sense.

Proposal:

State: “If the grounds for revocation only affect the European patent in part...” or “only affect a part of the patent...”.

Article 150 – Application of the Patent Cooperation Treaty

28 Paragraph 2

In French the term “procédure” (proceedings) has a special meaning which relates it exclusively to the form and not to the content of the proceedings as seems to be the case of the German and English terms “Verfahren” and “proceedings”, which also cover the actual court in that it has a specific object. In any event the impression must be avoided that the Patent Cooperation Treaty is only applicable to procedural aspects.

Proposal:

Replace (2nd sentence) the words “Dans ces procédures...” (In such proceedings) by “À ces demandes, les dispositions... sont applicables” (The provisions... shall be applied to such applications).
STELLUNGNAHME
DER LUXEMBURGISCHEN REGIERUNG

COMMENTS
BY THE LUXEMBOURG GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT LUXEMBOURGEOIS
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
after the date of priority be inspected on request, subject to the exceptions provided for in the Implementing Regulations.

The corresponding amendments should be made in paragraphs 2, 3 and 5.

**Article 134**

8. There seem to be no strong reasons for requiring that professional representatives must be nationals of the Contracting States. Thus paragraphs 2 (a) and 5 should be deleted.

**Article 138**

9. The present wording of paragraph 2 seems to allow that during revocations proceedings and if national law so provides, claims in a patent can be substituted for new claims based on the content of the description and the drawings. Such new claims have not been examined by the EPO nor is it within the competence of national courts to examine such claims. This is not a satisfactory solution. Furthermore this way of limiting a patent leads to unsecurity for third parties regarding the scope of patents.

The last sentence of paragraph 2 should therefore be substituted by the following. "Such a limitation shall as regards the patent claims be restricted to the deletion of one or more claims."

**Rule 85**

10. The period of four months seems to be rather short. It is too short in respect of applicants in distant countries or those with none of the working languages at the EPO as an official language. For instance the communications between the EPO and such applicants involves translations in two directions.

We therefore propose the upper limit in rule 85 to be amended to six months.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973
M/53/I/II
Original: English

CONFERENCE DOCUMENT

Drawn up by: Swedish delegation
Subject: Proposals for amendments to the draft texts
Chapter II
Revocation and prior rights

Article 138
Grounds for revocation

(1) \}

(2) \}
Unchanged from 1972 published text.

(3) \}

(4) Only concerns German text.

(c) Unchanged from 1972 published text.

(d) if the protection conferred by the European patent has been extended;

(e) if the proprietor of the European patent is not entitled under Article 58, paragraph 1.

If the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 18 September 1973
M/98/I/R 4
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 17 SEPTEMBER 1973

Articles of the Convention:

Articles 50
130
137
138
139
141
144
148
153
157
Chapter II
Revocation and prior rights

Article 138

Grounds for revocation

(1) Subject to the provisions of Article 139, a European patent may only be revoked under the law of a Contracting State, with effect for its territory, on the following grounds:

(a) if the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;

(b) if 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) if 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 61, beyond the content of the earlier application as filed;

(d) if the protection conferred by the European patent has been extended;

(e) if the proprietor of the European patent is not entitled under Article 60, paragraph 1.

(2) If the grounds for revocation only affect the European patent in part, revocation shall be pronounced in the form of a corresponding limitation of the said patent. If the national law so allows, the limitation may be effected in the form of an amendment to the claims, the description or the drawings.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 5
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 112 to 139
Annex I

provision was also adopted to authorise the national authorities of the host country to withdraw the right to a place of business for reasons of "ordre public".

(d) Deletion from the list of professional representatives

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

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

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

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

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

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

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

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

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

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

With regard to material content, the amendment made by the Main Committee to Article 157 concerning the effects of the publication of the international application on proceedings before the European Patent Office should be noted. A consequence of the previous text of paragraph 1, according to which publication of the international application by the International Bureau of WIPO takes the place of the publication of a European patent application, would have been that, in each case, the published international application would have formed part of the state of the art, pursuant to Article 52, paragraph 3. This legal consequence was regarded as unjustified where an application, which has not been published in an official language of the European Patent Office, is withdrawn before its communication to the European Patent Office. Therefore, the Committee, after a thorough examination of the relevant provisions of the PCT, decided by a large majority to take account of this case by providing that an international application published pursuant to Article 21 of the
therefore proposed that the last sentence of paragraph 2 be replaced by the following: "Such a limitation shall as regards the patent claims be restricted to the deletion of one or more claims".

The United Kingdom and Netherlands delegations could not agree to this proposed amendment. The Draft Community Patent Convention allowed the applicant to re-submit his claims provided that they were not broader than the claims originally filed. It was essential that an applicant should be able to submit more limited claims in any form he wished and that he should not be bound by the terms of the claims as originally filed and based on an assessment of the state of the art as it stood at the time the application was filed.

The UNEPA and FICPI representatives were opposed to the Swedish proposal. They pointed out that if it were accepted, applicants would submit a large number of claims from the outset in order to be in a position subsequently to withdraw a number of them.

The Swedish delegation stated that its proposals reflected the opinions of the interested circles in Sweden but agreed to withdraw its proposal.

856. The Belgian delegation wondered whether the grounds for revocation listed in Article 138 should not also include the case provided for in Article 63, paragraph 3, i.e. failure to supply a translation of the European patent specification.

It was pointed out by the Netherlands delegation that in cases where a translation had not been filed it would not be necessary to declare the patent void since it would automatically be deemed ineffective.

The Chairman noted that the Belgian delegation was satisfied with this interpretation.

Article 139 — Rights of earlier date or the same date

857. The Norwegian delegation explained its proposed amendment to paragraph 3 as set forth in M/71. The present wording of this paragraph left the Contracting States free to prescribe whether and on what terms an invention disclosed in both a European patent application or patent and a national application or patent having the same date of filing or, where priority is claimed, the same date of priority, could be protected simultaneously by both applications or patents. The Norwegian proposal was intended to achieve two objectives. Firstly, it was aimed at clarifying this provision which did not deal with the case where Contracting States made no arrangements on the matter. Since the Convention had adopted the "whole day" principle, it would seem logical for the invention to be protected simultaneously by both applications or patents. This would be the general rule. However, the Contracting States would remain free to prohibit simultaneous protection. But in this case only the national application or patent could be revoked.

858. The Netherlands delegation considered that two distinct situations could arise. The first was one where a European patent application and a national patent application were filed on the same date by two completely different inventors. In this case it should be possible for both applications or patents to be effective. The same applied in the case of two European patent applications having the same date of filing submitted by two different inventors. The second situation was that of a European patent application and a national patent application having the same date of filing submitted by one and the same inventor. In this case the Norwegian proposal followed the same principles as those which had induced the Member States of the European Communities to provide in Article 77 of the Community Patent Convention that the Community patent should remain in force and that the national patent should be ineffective. The Netherlands delegation could therefore support the Norwegian proposal but wondered whether its adoption would not tend to overcomplicate Article 139 and whether it would not therefore be preferable to leave this point to be dealt with under national law on the assumption that non-member States of the EEC would probably choose an arrangement similar to that laid down in Article 77 of the Community Patent Convention.

859. The United Kingdom delegation was opposed to the Norwegian proposal, which it considered to be unnecessary. The text as it stood allowed the Contracting States complete discretion on this point and it was desirable that, apart from the Community Patent Convention, there should be the least possible interference with countries' patents sovereignty.

860. The Finnish delegation supported the amendment proposed by the Norwegian delegation.

861. The Chairman pointed out that the text submitted by the Norwegian delegation appeared to go beyond the second objective which that delegation sought to achieve in that, as noted by the Netherlands delegation, it was not intended to revoke either of two applications or patents where they were filed by different inventors.

862. The United Kingdom delegation wondered whether acceptance of the Norwegian proposal, even in amended form in the light of the last comment made by the Chairman, would not give rise to difficulties in applying Article 77, paragraph 4, of the Community Patent Convention. If, for instance, a European patent application were filed on the same date as a national patent application a situation might arise where it was impossible to grant a European patent whilst the national patent application was still being examined. Under the proposal by the Norwegian delegation the State in question could decide either that both applications should remain valid or that the European patent application should become ineffective. On the other hand Article 77, paragraph 4, of the Community Patent Convention left the Contracting States free to decide how the national patent application should be dealt with in such cases.

863. The Swedish delegation pointed out that in spite of the option of a European patent, there would still be a number of applicants seeking national patents. The Norwegian proposal would, however, have the effect of making a national patent a less viable proposition than a European patent. The Swedish delegation would prefer the two possibilities to be treated on an equal footing.

864. The Chairman requested the Committee to vote on whether the flexible arrangements at present contained in paragraph 3, which left the question of simultaneous protection to be dealt with entirely under national law, should be retained or whether a more rigid provision should be introduced requiring the Contracting States to follow one particular policy, as proposed by the Norwegian delegation.

865. The Committee voted in favour of retaining the present text by eleven votes against 2 with 3 abstentions.

866. The Committee decided to refer to the Drafting Committee the drafting comment by the Netherlands delegation concerning the English title of this Article.

867. The United Kingdom delegation withdrew its proposed amendment contained in M/40, point 22.

Article 141 — Renewal fees for European patents

868. The delegation of the Federal Republic of Germany explained to the Committee the proposal submitted by the Member States of the European Communities for a second paragraph to be added to this Article (see M/14, point 10).
this possibility to be retained mainly in case it proved impossible to bring British law into line with the Convention in time.

841. The delegation of the International Chamber of Commerce welcomed the request made by the French delegation. It considered that the amendment proposed was not only logical but also necessary if a clear legal situation were to be created within a feasible period of time, and that it would make for uniform legal protection in all the designated Contracting States.

842. The CEIP delegation supported the French delegation's request in so far as it was intended to exclude the option of conversion in the case of withdrawn or refused applications and revoked patents. It would not be desirable for a procedure which had already been concluded in the European Patent Office to be renewed before the national authorities. However, conversion should remain possible where the application was deemed to be withdrawn due to negligence on the part of the applicant (see M/22, point 9).

843. The Swiss delegation was in favour of maintaining paragraph 1(b) as it stood. It considered that it was solely for the Contracting States to decide whether applications which were unsuccessful in the European procedure could be pursued at national level. An exception to this principle had, up to now, only been made for the cases mentioned in paragraph 1(a). It concluded by pointing out that Switzerland did not intend, at least initially, to make use of the powers available under paragraph 1(b).

844. For much the same reasons as those of the German delegation, the Austrian delegation was in favour of maintaining paragraph 1(b).

845. The UNION delegation felt that the possibility of conversion should not be dropped. It regarded paragraph 1(b) as a kind of fall-back provision which could be very useful for applicants as long as there was uncertainty as to how the European procedure would function. The possibility of conversion could be advantageous not only where the patent failed for formal reasons but also where it did so on grounds of substantive law.

846. The CNIPA delegation was in favour of maintaining paragraph 1(b). If it were retained, an applicant who could foresee that he would be unsuccessful in the European Patent Office procedure would be able to apply one or more national procedures in due course without losing too much time. It would otherwise be necessary to continue the European procedure right to the end, and this would have the effect of leaving competitors, in a state of uncertainty for a longer period of time.

847. The EIRMA delegation was in favour of deleting paragraph 1(b) since the legal situation might otherwise remain uncertain for too long. It felt that it should be possible to find some solution to the constitutional problems encountered by certain States.

848. In the subsequent vote 3 delegations were in favour of and 10 delegations were against deleting paragraph 1(b); there were 5 abstentions.

849. After the vote the Netherlands delegation stated that it had voted in favour of the French proposal because it felt that the option of conversion referred to in Article 135, paragraph 1(b), was contrary to the principle of a uniform European System for the Grant of Patents. It was therefore very pleased that the delegation of the Federal Republic of Germany, of whose constitutional problems it was well aware, had stated that Germany did not at present intend to make use of the option available under this provision.

850. After the vote the delegation of the International Chamber of Commerce suggested that the powers granted to the Contracting States to provide for conversion pursuant to Article 135, paragraph 1(b), should be in the form of a reservation — as in the case of the reservations under Article 166 (167) — but without a time limit being applied. This would make the legal situation with regard to the European procedure clear and no Contracting State would be able to change its legal provisions unilaterally.

851. The Chairman, however, pointed out that this solution would not be logical since, under paragraph 1(b), the Contracting States would not be making reservations with respect to the Convention but would only be empowered to provide for a subsequent national procedure.

Article 138 — Grounds for revocation

852. The Committee referred the comments by the delegation of the Federal Republic of Germany concerning paragraph 1(b) (see M/11, point 34) to the Drafting Committee for examination.

853. The Committee then examined a proposal by the Member States of the European Communities concerning paragraph 1(d).

On behalf of these States the German delegation explained that it was proposed to delete from the existing text of paragraph 1(d) the words "contrary to Article 122, paragraph 3 and "during opposition proceedings". The protection conferred by the European patent might also be extended during national revocation or limitation proceedings or during limitation proceedings as provided for in the Draft Community Patent Convention. The Member States of the European Communities wished extension of protection in such cases to constitute possible grounds for revocation and therefore wanted Article 138 to give them legal authority to do so as regards Community patents.

The Austrian delegation stated that it could support this proposal. However, it wondered whether the Drafting Committee should not mention the criterion for deciding whether protection had been extended or not, as had been done in Article 99, sub-paragraph (c).

The Netherlands delegation considered that there was a difference between sub-paragraph (c) and (d) of paragraph 1 of Article 138. Sub-paragraph (c) was intended to deal with the situation where the subject-matter of the European patent extended beyond the content of the application as filed. Sub-paragraph (d) stipulated an additional condition in that a patent once granted could not subsequently be extended. The protection conferred could thus not extend beyond that conferred by the patent as granted.

The Chairman noted that no delegation was opposed to this proposal by the Member States of the European Communities and it was therefore adopted.

854. The Committee agreed to refer the Luxembourg comment on paragraph 2 to the Drafting Committee for examination (see M/9, point 27).

855. The Swedish delegation explained the reasons behind its proposed amendment to paragraph 2 as set forth in M/53, page 3. The present wording of the second sentence of this paragraph stipulated that if the national law so allowed, the limitation of the European patent could be effected in the form of an amendment to the claims. It therefore appeared that the claims of a European patent could be replaced by new claims based on the content of the description and the drawings. However, such new claims would not have been examined by the European Patent Office nor would such examination be within the competence of national courts. Furthermore, to limit a patent in this way would lead to inadequate security for third parties regarding the scope of patents. The Swedish delegation
<table>
<thead>
<tr>
<th>Contents</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Introduction</td>
<td>7</td>
</tr>
<tr>
<td>Report on the meeting of the Plenary Opening Meeting</td>
<td>9</td>
</tr>
<tr>
<td>(M/PR/K/1)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of the Credentials Committee (M/PR/V)</td>
<td>25</td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee I (M/PR/I)</td>
<td>27</td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee II (M/PR/II)</td>
<td>109</td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee III (M/PR/III)</td>
<td>155</td>
</tr>
<tr>
<td>Minutes of the proceedings of the Committee of the Whole (M/PR/G)</td>
<td>163</td>
</tr>
<tr>
<td>Report on the meeting of the Plenary Final Meeting (M/PR/K/2)</td>
<td>199</td>
</tr>
<tr>
<td>List of participants</td>
<td>211</td>
</tr>
</tbody>
</table>
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
decoration of the drawings.
so provided, the limitation may be effected in the form of an amendment to the claims, the
pronounced in the form of a corresponding limitation of the said patent. If the national law
(2) If the grounds for revocation only affect the patent partitively, revocation shall be
during opposition proceedings.
(4) If the protection conferred by the patent has, contrary to Article 104, been extended
patent application as filed!
(6) If the subject matter of the European patent extends beyond the content of the
and complete, for it to be carried out by a person skilled in the art;
(6) If the European patent does not disclose the invention in a manner sufficiently clear
9 to 14!
(6) If the subject matter of the patent is not patentable within the terms of Article 3
under the law of a contracting State, with effect for its territory, on the following grounds:
(7) Subject to the provisions of Article 104, a European patent may only be revoked

Text drawn up by the Working Party

Grounds for revocation

Article 133 new

REVOCATION OF THE EUROPEAN PATENT

PART V11