Article 20 E

Travaux Préparatoires (EPC 1973)

Comment:

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Art20eTPEPC1973
Art. 20  
MPÜ  
Rechtsabteilung

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Zu M/PR/II und M/PR/G:
Der Ausschuß nimmt den Vorschlag aus M/47/I/II/III Nr. 6 an. → neuer Art. 22 a
Where the voting resulted in a tie, the objection would be deemed upheld.

113. The Norwegian delegation’s proposal provided for a procedure whereby the Boards of Appeal could take a decision on the objection even if the absence of the member objected to were to prevent the attainment of a quorum. This proposal was designed to avoid prejudging the content of the Rules of Procedure to be adopted by the Board pursuant to Article 21 (23), paragraph 4.

114. The French, German and United Kingdom delegations pointed out that this situation was covered by Rule 10 which provided for alternate members of the Boards of Appeal.

115. The Swiss delegation wondered whether Rule 10 would be sufficient to meet all eventualities; it could be argued that the alternate member could not be called until the decision on removal had been taken. Referring to its proposal in M/54/I/II/III, it wondered whether paragraph 4 should not be supplemented by a sentence providing for a procedure for automatically replacing a member objected to by his alternate.

116. To overcome this difficulty, the Austrian delegation proposed that paragraph 4 be supplemented by the following sentence: “For the purpose of taking decisions in such cases, the member objected to shall be replaced by his alternate”.

117. This proposal, which was seconded by the German delegation, was approved by the Committee and referred to the Drafting Committee.

Article 22a (20) — Legal Division

118. The Committee agreed on the German delegation’s proposal in M/47/I/II/III, point 6, and agreed to the setting up of a further department to be known as the “Legal Division”. The Committee referred the proposal to the Drafting Committee which was also instructed to make the necessary changes to Articles 15 and 105 (106).

Article 23 (25) — Technical opinion

119. The Committee considered the proposals for amendments to this Article comprising a proposal from the Netherlands delegation (M/52/I/II/III) which would enable the parties concerned to state their point of view before the European Patent Office gave its technical opinion and proposals from certain observer organisations that there should be no reference to a technical opinion (COPRICE M/16, point 5, CNIPA M/20, point 9, and UNEPA M/21, point 2).

120. The Belgian delegation supported the Netherlands delegation’s proposal.

121. The German delegation opposed the proposal. This provision concerned technical assistance to private individuals and should not involve the office in two-party proceedings, the latter being the province of legal actions concerning the validity of the patent.

122. The United Kingdom delegation also expressed objections and argued that the Netherlands delegation’s proposal would tend to create confusion between the competence of national courts and that of the European Patent Office, which latter was not entitled to give preliminary rulings.

123. The IAPIP delegate stated that disputes relating to infringement were the exclusive preserve of national courts. If they felt that a technical opinion should be sought from the European Patent Office, the opinion would certainly have a considerable bearing on the court’s decision. The only options available therefore were to delete Article 23 or to retain the technical opinion clause while providing for the holding of proceedings involving the parties concerned before the office.

124. The FICPI delegation was in favour of giving the European Patent Office power to deliver technical opinions and proposed that the procedural details be left to the Administrative Council.

125. The Swiss delegation wanted Article 23 maintained but could not accept the Netherlands delegation’s proposal which might result in a substantial increase in the incidence of proceedings before the Office.

126. The CNIPA representative was prepared to agree to the Netherlands proposal.

127. The COPRICE delegation was not convinced of the need for Article 23. It also drew attention to differences in terminology between the three languages: the term “Gutachten” did not appear to have the same scope as the corresponding English and French terms.

128. The French delegation considered that the opinion provided for in Article 23 might be useful for national courts and in no way constituted an encroachment upon their powers. The European Patent Office would not have to decide on a dispute between parties but simply deliver a technical opinion. It was prepared to support the Netherlands proposal but pointed out that, if provision for proceedings to hear opposing arguments were to be made, the opinion delivered would have to be notified, not only to the competent national court, but also to the parties who would thus be enabled to submit further written memoranda before the court.

129. The United Kingdom delegation was somewhat concerned by the importance being accorded to technical opinions which could be delivered by the European Patent Office. If Article 23 were to be maintained incorporating the amendment proposed by the Netherlands delegation, there was a danger that in a considerable proportion of infringement proceedings, the parties would want to have a technical opinion from the Office thus considerably augmenting the incidence of proceedings before the Office. The United Kingdom delegation, supported by the Irish delegation, therefore proposed that Article 23 be deleted.

130. The Committee held a vote on this proposal to delete Article 23 which failed to obtain a majority in favour.

131. The Committee then voted on the Netherlands proposal which likewise failed to obtain a majority in favour.

132. The Chairman drew the Committee’s attention to two other proposals: that of the Swedish delegation in M/53/I/II, point 3, and that of the Swiss delegation in M/54/I/II/III, under both of which the power to deliver technical opinions would be conferred upon the Boards of Appeal rather than the Examining Divisions.

133. The Finnish delegation supported the Swedish delegation.

134. The Netherlands delegation and the IIB representative questioned the wisdom of providing for technical opinions to be delivered by a judicial body.

135. The French delegation also opposed such a proposal.

136. The Committee then voted on the Swedish delegation’s proposal, which failed to obtain a majority.

137. The Chairman noted that as the Swiss delegation’s proposal had not been seconded by any other delegation, it could not be considered by the Committee.

138. The Committee went on to examine the German delegation’s proposal (M/47/I/II/III, point 10) that competence to deliver technical opinions be conferred upon the members of the Examining Divisions rather than upon the collegiate body itself, the technical opinion could thus be drawn up by a single member.

139. The Netherlands delegation pointed out that this proposal would not resolve the difficulties in question should the Administrative Council avail itself of the option open to it under Article 31 (33), paragraph 1 (a) (3), of reducing the
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
Article 20

Legal Division

(1) The Legal Division shall be responsible for decisions in respect of entries in the Register of European Patents and in respect of registration on, and deletion from, the list of professional representatives.

(2) Decisions of the Legal Division shall be taken by one legally qualified member.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 1
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 1 to 26
Article 18a
Legal Division

(1) The Legal Division shall be responsible for decisions in respect of entries in the Register of European Patents and in respect of the registration of professional representatives and their deletion from the list referred to in Article 17, paragraph 1.

(2) Decisions of the Legal Division shall be taken by one legally qualified member.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Munich, 24 September 1973
M/130/II/R 6
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE II
AT THE MEETING ON 24 SEPTEMBER 1973

Articles of the Convention:

Articles
1
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16a
18a
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Implementing Regulations:

Protocol on Privileges and Immunities of the European Patent Organisation

Protocol on the Centralisation of the European Patent System and on its Introduction

Rules
9
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Article 22a (new).

"(1) The Legal Division shall be responsible for:

(a) entering professional representatives on the list and deleting them therefrom;

(b) entering particulars in the Register of European Patents and deleting them therefrom.

(2) For taking decisions the Legal Division shall consist of one legally qualified member."

Article 105

"(1) ... Examining Divisions, Opposition Divisions and the Legal Division. It shall have ..." see point 22 (Rule 9)

7. Article 16

see point 1

8. Article 22

Text for the proposal by the Government of the Federal Republic of Germany in M/11, No. 3:

(3a) A party may no longer object to a member of a Board of Appeal or of the Enlarged Board of Appeal once he has made statements to the
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 10 September 1973

M/47/I/II/III
Original: German

CONFERENCE DOCUMENT

Drawn up by: The delegation of the Federal Republic of Germany

Subject: Proposals for amendments to the draft texts
(France), submitted the report on the results of Main Committee III's proceedings to the Committee of the Whole. The text of the report is given in Annex III.

The United Kingdom delegation especially welcomed the fundamental observations relating to financial questions contained in the report.

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

IV. Results of the proceedings of the General Drafting Committee (M/145 R/1 - R/15, M/151 R/16)

16. The Committee of the Whole agreed to request the Chairman of the General Drafting Committee only to deal with those drafts in respect of which his Committee had made new proposals.

17. The Chairman of the General Drafting Committee, Mr. van Benthem (Netherlands), stated that in his presentation of the Drafting Committee's work, he would not deal with simple drafting amendments which had been made when the texts were being co-ordinated and the terminology checked. He did however point out to the Committee of the Whole that the title of the Convention had been altered by the Drafting Committee.

The Committee of the Whole approved the new title which reads as follows in the three languages:

— Übereinkommen über die Erteilung europäischer Patente
— Convention on the Grant of European Patents
— Convention sur la délivrance de brevets européens.

18. Chapters A to F below deal with the proposals for amendments submitted to the Committee of the Whole by the Chairman of the General Drafting Committee or the delegations.

A. Convention

Article 10 and Article 33 (R/1 and R/2) — Direction of the EPO and competence of the Administrative Council in certain cases

19. The General Drafting Committee requested the Committee of the Whole to confirm that the term "inter-governmental organisations" in Article 33, paragraph 4, also covered organisations such as the Commission of the European Communities.

20. The French delegation thought that this was the case. The term would have to include all inter-governmental organisations including bodies which, although not actually inter-governmental, were set up by governments.

21. The Committee of the Whole confirmed the General Drafting Committee's interpretation whereby the term "inter-governmental organisations" as used in Article 33 also included the Commission of the European Communities.

22. In this connection and in response to a further request from the Drafting Committee for clarification, the Committee of the Whole confirmed that the President of the European Patent Office only required the authorisation of the Administrative Council for negotiations concerning the conclusion of agreements with States or inter-governmental organisations and that he was empowered to conclude agreements with private organisations or other international organisations under Article 10 without requiring special authorisation from the Administrative Council.

Article 20 — Legal Division

23. The United Kingdom delegation pointed out that in Article 20, Main Committee I had made registration on, and deletion from, the list of professional representatives the prerogative of the Legal Division and that in accordance with the conclusions of Main Committee II, decisions on these matters were to be taken by one legally qualified member. However, in Article 134, paragraph 8(c), all questions relating to disciplinary matters had been left open as it had been considered premature to lay down provisions of this nature at this stage. The United Kingdom delegation accordingly felt that a general clause should be inserted in Article 20 enabling the Legal Division to take further decisions concerning registration on the list of professional representatives.

24. The German delegation stated that Article 134 had been drafted on the assumption that disciplinary powers would not necessarily be exercised by the European Patent Office but that a European disciplinary board might be created to exercise such powers.

25. The Netherlands delegation argued that the above-mentioned questions might not in every case fall within the purview of the Legal Division. Situations could arise where the Boards of Appeal and perhaps even a body outside the European Patent Office would have to give decisions. Consequently, any new wording should be very flexible.

26. The Chairman suggested that any proposed amendment to cover the eventuality of the European Patent Office being able to implement disciplinary measures in addition to deciding on entries on and deletions from the list should be drawn up with reference to all measures relating to professional representatives.

27. The Committee of the Whole instructed the General Drafting Committee to examine any proposal which the United Kingdom delegation might submit and to refer the matter back to it only if difficulties were encountered.

Article 70 (R/3) — Authentic text of a European patent application or European patent

28. The Committee of the Whole approved the action taken by the Drafting Committee which, on the basis of a majority decision of Main Committee I (see M/PR/I, point 171), had aligned the English and French versions of paragraph 3, as regards the protection conferred by translations, on the German text.

Article 76 (R/3) — European divisional applications

29. For greater clarity, the General Drafting Committee had condensed the prerequisites for the filing of a divisional application — previously set out in two separate paragraphs — into paragraph 1 of Article 76.

The Committee of the Whole agreed to this change.

Article 110 (R/4) — Examination of appeals

30. The Committee of the Whole approved the extension made by the Drafting Committee in response to a majority decision of Main Committee I (see M/PR/I, point 507), whereby in the case of this Article, the application would not be deemed to be withdrawn if the decision under appeal was taken by the Legal Division.

Article 116 (R/5) — Oral proceedings

31. In this case also, the Committee of the Whole accepted the amendment made by the Drafting Committee in response to a suggestion made by the United Kingdom and Netherlands delegations in Main Committee I (see M/PR/I, point 528). Under the new text of paragraph 1 a request for further oral