Rule 96 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Regel 96
MPU
Weitere Veröffentlichungen des EPA

<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>
</table>

Dokumente der MDK

<table>
<thead>
<tr>
<th>E 1972</th>
<th>R 97</th>
<th>M/40</th>
<th>S. 5</th>
</tr>
</thead>
<tbody>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/71/I</td>
<td>S. 7</td>
</tr>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/142/I/R 13</td>
<td>S. 12</td>
</tr>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/146/R 11</td>
<td>R 96</td>
</tr>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/PR/I</td>
<td>S. 106/100</td>
</tr>
<tr>
<td>&quot;</td>
<td>&quot;</td>
<td>M/PR/G</td>
<td>S. 205/187</td>
</tr>
</tbody>
</table>
ANNEX I
REPORT
by Mr. Paul Braendli, Lic. iur.
Vice-Director of the Federal Intellectual Property Office (Switzerland)
on the results of Main Committee I’s proceedings

ANNEX II
REPORT
by Mr. R. Bowen
Assistant Comptroller, British Patent Office
on the results of Main Committee II’s proceedings

ANNEX III
REPORT
by Mr. Fressonnet
Deputy Director of the Institut National de la Propriété Industrielle (France)
on the results of Main Committee III’s proceedings

ANNEX IV
REPORT
by Mr. A. Fernandez Mazarambroz
Head of the Spanish Patent Office
on the results of the Credentials Committee’s proceedings
with regard to full powers for signing the Convention
Rule 96 (95) — Communication of information contained in the files

2416. The Committee referred to the Drafting Committee the examination of the proposal made by the delegation of the Federal Republic of Germany, as given in M/47, point 48.

Rule 97 (96) — Additional publications by the European Patent Office

2417. The Committee referred to the Drafting Committee the examination of the proposal concerning paragraph 2 made by the Norwegian delegation, as given in M/71, page 7.

Rule 99 (98) — Inspection of files by or via courts or authorities of the Contracting States

2418. The UNICE delegation recalled the suggestion, given in M/19, point 39, that the Convention should include a provision to the effect that all bodies concerned should be obliged to observe secrecy, so that the applicant would be able to withdraw his application within the time limit of eighteen months without the invention being published.

2419. The Chairman pointed out that under Rule 99, paragraph 2 the communication of files to third parties by Courts and Public Prosecutors' Offices of the Contracting States must be effected in accordance with the conditions laid down in Article 128, namely with the consent of the applicant.

2420. The UNICE delegation was satisfied by this reply.

Rule 100 (99) — Procedure for letters rogatory

2421. The Italian delegation wondered whether paragraph 4 should not be made clearer. It would appear necessary to stipulate that, where the authority to which the letters rogatory were transmitted was not competent to execute them, they should automatically be transmitted to the central authority provided for in paragraph 1. The present wording provided for transmission to the authority in the same State which was competent. Under paragraph 1, the Member States must designate a central authority which would undertake to receive letters rogatory. It would be preferable for an authority which was not competent to return the letters rogatory to the central authority, which would then instruct the authority which was competent.

2422. The FICPI delegation, referring to paragraph 6, asked whether the parties as well as members of the departments concerned would be permitted to attend enquiries.

2423. The Chairman was of the opinion that this paragraph provided merely for the attendance of members of the department concerned, since parties' right of attendance followed from general principles of law.

2424. The Committee agreed to request the Drafting Committee to examine the wording of paragraph 4 with a view to taking account of the remarks made by the Italian delegation. It also instructed the Drafting Committee to delete from the French language text the word "judicaires", the equivalent of which did not appear in the other two language versions.

2425. When the results of the Drafting Committee's proceedings were being examined (see M/142/I R 13), the Italian delegation thought that this Rule should include a provision governing the possibility of there being no territorial competence at all. It quite frequently occurred in international practice that letters rogatory were incorrectly transmitted to an authority of a State which was not competent to execute them. In the absence of a provision specifying what was to be done with such letters rogatory, certain States could encounter difficulties.

2426. The French delegation supported this proposal.

2427. The Committee approved this proposal and agreed to instruct the Drafting Committee to incorporate an appropriate provision in this Rule.

Rule 102 (101) — Authorisations

2428. The United Kingdom delegation expounded the amendment it proposed in M/10, point 10. It thought that as it stood paragraph 8 appeared to sanction a breach of an authorisation given by the applicant to his representatives. The intention was to give the European Patent Office complete freedom in its dealings with representatives, and the United Kingdom delegation proposed that this paragraph be worded as follows: "If several representatives are appointed by the same party, the European Patent Office shall not be bound by any provision in their authorisations as to whether they shall act singly or jointly."

2429. The Netherlands delegation supported this proposal.

2430. In reply to an observation by the Austrian delegation, the Chairman said that the principal difference between the text as it stood at present and the version proposed by the United Kingdom delegation was as follows: the present wording provided that if a number of representatives was appointed, each of them was empowered to act, even if the authorisation provided otherwise. Under the United Kingdom delegation's proposal, it would be a matter for the discretion of the European Patent Office to determine whether, in such a case, it would require all the representatives to act jointly or whether it would suffice if they acted separately.

2431. The delegation of the Federal Republic of Germany expressed its preference for the present version, since it sought to protect third parties in cases where more than one representative was appointed. Moreover, since the PCT included a similar provision, it would be regrettable if different rules were to apply in this matter.

2432. The Committee rejected the United Kingdom delegation's proposal by seven votes to three, with two abstentions.

Rule 103 (102) — Deletion of the professional representative from the list

2433. The Chairman disclosed that two proposals for amendments had been submitted: one was by the delegation of the Federal Republic of Germany, given in M/47, point 34, and the other by the French delegation, given in M/112, page 4. Since the proposal by the Federal Republic of Germany involved greater changes in the present text, the Chairman proposed that it be discussed first.

2434. The delegation of the Federal Republic of Germany explained that its proposal was for a new paragraph 2, the purpose of which was to permit the deletion of professional representatives from the list provided for in Article 134, paragraph 1, in circumstances other than those at present specified by Rule 103. Such deletion would be carried out in the three circumstances specified in (a), (b) and (c) of the proposal by the delegation of the Federal Republic of Germany, namely death or legal incapacity of the representative, his failure to satisfy the nationality requirement, and no longer having his place of business or employment within the territory of a Contracting State.

2435. One delegation supported the proposal by the delegation of the Federal Republic of Germany.

2436. The Chairman indicated that the third ground for
<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</td>
<td>25</td>
</tr>
<tr>
<td>(M/PR/V)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee I</td>
<td>27</td>
</tr>
<tr>
<td>(M/PR/I)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee II</td>
<td>109</td>
</tr>
<tr>
<td>(M/PR/II)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of Main Committee III</td>
<td>155</td>
</tr>
<tr>
<td>(M/PR/III)</td>
<td></td>
</tr>
<tr>
<td>Minutes of the proceedings of the Committee of the Whole</td>
<td>163</td>
</tr>
<tr>
<td>(M/PR/G)</td>
<td></td>
</tr>
<tr>
<td>Report on the meeting of the Plenary Final Meeting</td>
<td>199</td>
</tr>
<tr>
<td>(M/PR/K/2)</td>
<td></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
Rule 96

Additional publications by the European Patent Office

(1) The President of the European Patent Office may provide that, and in what form, the data referred to in Article 128, paragraph 5, shall be communicated to third parties or published.

(2) The President of the European Patent Office may provide for the publication of new or amended claims received after the time mentioned in Rule 49, paragraph 3, the form of such publication and the entry in the European Patent Bulletin of particulars concerning such claims.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 83 to 106
Rule 97
Additional publications by the European Patent Office

(1) Unchanged from 1972 published text.

(2) The President of the European Patent Office may provide for the publication of new or amended claims received after the time mentioned in Rule 50, paragraph 3, the form of such publication and the entry in the European Patent Bulletin of particulars concerning such claims.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973
M/ 142/I/R 13
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 59
162

Rules of the Implementing Regulations:

Rules 51
59
70
73
85
89
91
97
100
103
107


Articles 3
6

Recommendation on preparations for the opening of the European Patent Office

Decision on Training Staff for the European Patent Office
PROPOSAL ON RULE 97

For the sake of clarification it is proposed to amend Rule 97, paragraph 2, as follows:

(2) The President of the European Patent Office may provide for the publication of new or amended claims received after the time mentioned in Rule 50, paragraph 3, and the entry in the European Patent Bulletin of particulars concerning such claims.
MUNICH DIPLOMATIC CONFERENCE

FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 12 September 1973

M/71/1

Original: English

CONFERENCE DOCUMENT

Drawn up by: Norwegian delegation

Subject: Proposals for amendments to Articles 124, 130, 153, 155 and 157 of the Convention and Rules 66, 67, 69 and 97 of the Implementing Regulations
31. Rule 97 In paragraph 2, "entry" should be amended to read "publication".

32. Rule 106 In paragraph 1, "entered" should be amended to read "published".

PROTOCOL ON RECOGNITION OF DECISIONS (M3)

33. Title The title should be amended to read "Protocol on Jurisdiction and the Recognition of Decisions...".

34. Article 6 "ex officio" should be amended to read "of their own motion".

PROTOCOL ON PRIVILEGES AND IMMUNITIES (M4)

35. Article 3 In paragraph 1(b), "damages" should be amended to "damage" and a comma should be introduced after "on behalf of".

36. In paragraph 1(c), "award under Article 24" should be amended to read "award made under Article 24".

37. Article 4 In paragraph 1, "In the exercise of" should be amended to read "Within the scope of", the wording used in Article 5 of the ESRO Protocol.

38. In paragraph 2, "to reimburse" should be amended to read "to remit or reimburse".

39. Article 6 This Article defines the "official activities" of the Organisation and should be placed either at the beginning or the end of the Protocol. At present the Article follows certain Articles (eg Article 3, 4 and 5) and precedes others (eg Article 10) which refer to the "official activities".

40. Article 10 The words "undertake to" are superfluous and should be deleted.

41. Article 11 In paragraph 1, "the most favourable treatment" should be amended to read "treatment not less favourable than that", the wording used in Article 12(1) of the ESRO Protocol.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Brussels, 13 August 1973
M/ 40
Original: English

PREPARATORY DOCUMENT

Drawn up by: The United Kingdom Government

Subject: Proposed amendments concerning the Draft Convention, the Draft Implementing Regulations, the Draft Protocol on Recognition and the Draft Protocol on Privileges and Immunities
gen, daß von der Möglichkeit der Akteneinsicht Gebrauch gemacht wird, wenn dies im Hinblick auf den Umfang der zu erteilenden Auskünfte zweckmäßig erscheint.

Regel 97
Weitere Veröffentlichungen des Europäischen Patentamts

(1) Der Präsident des Europäischen Patentamts kann bestimmen, daß und in welcher Form die in Artikel 128 Absatz 5 vorgesehenen Angaben Dritten mitgeteilt oder veröffentlicht werden.

(2) Der Präsident des Europäischen Patentamts kann bestimmen, daß und in welcher Form neue oder geänderte Patentansprüche veröffentlicht werden und daß ein Hinweis auf Einzelheiten solcher Ansprüche im Europäischen Patentblatt veröffentlicht wird.

Kapitel IX
Rechts- und Amtshilfe

Regel 98
Verkehr des Europäischen Patentamts mit Behörden der Vertragsstaaten

(1) Bei Mitteilungen, die sich aus der Anwendung des Übereinkommens ergeben, verkehren das Europäische Patentamt und die Zentralbehörden für den gewerblichen Rechtsschutz der Vertragsstaaten unmittelbar miteinander. Das Europäische Patentamt und die Gerichte sowie die übrigen Behörden der Vertragsstaaten können miteinander durch Vermittlung der Zentralbehörde für den gewerblichen Rechtsschutz verkehren.

(2) Die Kosten, die durch die in Absatz 1 genannten Mitteilungen entstehen, sind von der Behörde zu tragen, die die Mitteilungen gemacht hat; diese Mitteilungen sind gebührenfrei.

Regel 99
Akteneinsicht durch Gerichte und Behörden der Vertragsstaaten oder durch deren Vermittlung

(1) Die Einsicht in die Akten einer europäischen Patentanmeldung oder eines europäischen Patents durch Gerichte und Behörden der Vertragsstaaten wird in das Original oder in eine Kopie gewährt; Regel 95 ist nicht anzuwenden.

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Rule 97
Additional publications by the European Patent Office

(1) The President of the European Patent Office may provide that, and in what form, the data referred to in Article 128, paragraph 5, shall be communicated to third parties or published.

(2) The President of the European Patent Office may provide for the publication of new or amended claims and the entry in the European Patent Bulletin of particulars concerning such claims.

Chapter IX
Legal and administrative co-operation

Rule 98
Communications between the European Patent Office and the authorities of Contracting States

(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the above central industrial property offices.

(2) Expenditure in respect of communications under paragraph 1 shall be chargeable to the authority making the communications, which shall be exempt from fees.

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Cf. Articles 130 (Exchanges of information) and 131 (Legal and administrative co-operation)

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Rule 99
Inspection of files by or via courts or authorities of the Contracting States

(1) Inspection of the files of European patent applications or of European patents by courts or authorities of Contracting States shall be of the original documents or of copies thereof; Rule 95 shall not apply.
ENTWURF EINER AUSFÜHRUNGSORDNUNG
ZUM ÜBEREINKOMMEN
ÜBER EIN EUROPÄISCHES PATENTERTEILUNGSVERFAHREN

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

PROJET DE RÈGLEMENT D'EXÉCUTION
DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN PATENTVERTEILUNGSVERFAHRENS 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
élabores 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
that Article 156, paragraph 3, was to be interpreted as an
authorisation for the Administrative Council to provide for the
levy of a search fee for each and every international patent
application, irrespective of whether additional searches within
the meaning of this provision should be carried out in the
individual cases.

11. Information to the public of official authorities,
legal and administrative co-operation (Articles
127-132, Rules 93-100)

Only a few amendments were made to these provisions. The
inspection of files under Article 128 was supplemented so as to
provide more precise information for the general public; thus,
before the publication of the European patent application, not
only the date of filing may be made known to third parties, but
also the date, State and file number of any application of which
the priority is claimed. The provisions of Articles 130/132 were
drafted more generally so that the European Patent Office
could make agreements concerning exchanges of information
and exchanges of publications not only with States which were
not a party to the Convention and with international patent
granting authorities, such as WIPO, but also with any other
organisations, especially documentation centres such as INPADOC. It was also specified at the same time that the
substantive content of applications which had not yet been
published could not be the subject of such exchanges of
information. In addition, the Administrative Council was
authorised in Article 130, paragraph 3, to make provisions in
respect of exchanges of information with the last-named
organisations which derogated from the restrictions on the
inspection of files, in so far as the confidential treatment of the
information was guaranteed.

While dealing with the provisions of Article 131, the Main
Committee discussed a proposal which, in the light of the
procedure laid down in the Protocol on Recognition, aimed to
supplement the prescribed legal co-operation between the
European Patent Office and the Contracting States by an
obligation for the Contracting States to provide legal
assistance amongst themselves. This interesting idea was
rejected generally because the proposed extension was
considered to be an intrusion into international legal aid
between Contracting States and also an obligation which far
exceeded the purpose of the Convention. A further idea to
allow the European Patent Office to intervene as an
international notification authority in certain proceedings
concerning European patents, also found little approval.

12. Representation (Articles 133-134, 162/Rules
101-103, 107)

The provisions of the Convention and the Implementing
Regulations concerning representation before the European
Patent Office were already discussed with the organisations
concerned during the earlier stages of the negotiations and
were, as far as possible adapted to their proposals and wishes.
Fortunately this situation meant that the principles established
by the Inter-Governmental Conference were no longer
questioned as to their substance. In particular, the principle that
during a transitional period the representatives' status would
basically be controlled by the national law of Contracting
States and afterwards by European law, remained uncontested.
The general principles concerning representation in Article 133
were also unchanged. The Main Committee generally
considered that these principles should also be valid for the
transitional period. The Committee also specified that legal
persons could be represented not only by their employees — as

laid down in paragraph 3 of Article 133 — but also by their
departments. Such representation by their departments is
regarded as a matter of course, is understood from paragraph 1
of Article 133 and does not need to be expressly laid down.

However, material for discussion was provided by the
following points: the uninterrupted change from the transition-
al period to the permanent arrangements, in particular with
reference to the continued effects of national requirements, the
reasons for the deletion of professional representatives from the
list, questions concerning place of business and other
individual problems. The following is a report on the main
questions:

(a) Conditions of admission

The Main Committee again discussed the question raised in
the earlier negotiations concerning possession of the
nationality of a Contracting State as a condition of entry on the
list of professional representatives. The majority concluded
that this condition should be laid down in Article 162 not only in
respect of the permanent solution, but also in respect of the
transitional period, in order to avoid the improper acquisition
of representation rights after the publication of the
Convention. The status quo was taken into account in so far
that failure to have the nationality of a Contracting State would
not prevent entry on the list, if the representative had a place of
business or employment and the right of representation in a
Contracting State on 5 October 1973, i.e. at the time of the
signing of the Convention.

(b) Restrictions on authorisation to represent

The question arose as to whether restrictions on
representation arising from national law should also be valid in
respect of proceedings before the European Patent Office
during the transitional period. The Committee unanimously
considered that such restrictions based on specific rules of
national law, in particular on the legislation of the Federal
Republic of Germany, are not justified in respect of European
proceedings. The corresponding provisions of Article 162,
paragraphs 2 and 6, were therefore deleted.

(c) Questions concerning place of business

Article 134 provided that the representatives entered on the
list were entitled to establish a place of business in the Federal
Republic of Germany and the Netherlands for the purpose of
practising their profession before the European Patent Office.
In view of proceedings before national authorities carrying out
duties on behalf of the European Patent Office, as provided for
in the Protocol on Centralisation, the Main Committee
supplemented Article 134 accordingly. Professional
representatives should consequently also be able to establish a place of
business in the Contracting States concerned. There was also
discussion of a provision which would have expressly granted
the right to practise a profession to a professional
representative, his associates, employees and colleagues and
the right of establishment to these persons including their
families. It was said in reply to the advocates of such a
provision, who considered it to be a necessary adjunct to the
right of residence, that this would be to bring a "foreign body"
into the Convention and might possibly conflict with existing
agreements in the field of public law. The Committee
thereupon rejected the proposed supplement, but noted on the
other hand that the stipulated right to a place of business in
accordance with Article 134, paragraphs 3 and 4, would be
meaningful only if its recognition were dealt with sensibly. A