Article 100 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Art100eTPEPC1973
Art. 100
MPÖ

Grounds for opposition

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MINUTES

of the meeting of Working Party I

held at Luxembourg from 30 November to 2 December 1970

and of the meeting held on 3 December 1970 by that Working
Party, acting in its capacity as Co-ordinating Committee

1. Item 1 on the agenda (1) : Opening of the meeting and adoption
of the provisional agenda

2. The Working Party held its sixth meeting at
Luxembourg from Monday, 30 November to Wednesday,
2 December 1970, with Dr. HAERTEL, President of the German
Patent Office, in the Chair.

Representatives of the Commission of the European
Communities, WIPO-BIRPI and the International Patent
Institute took part in the meeting (2). The representative
of the General Secretariat of the Council of Europe sent
his apologies for being unable to attend.

2. The Drafting Committee, under the chairmanship of
the President of the Netherlands Octrooiraad (Patent Office),
Mr. J. B. van BEMTHEM, held its meetings directly after the
deliberations of the Working Party.

(1) For the provisional agenda (BR/GT I/62/70), see Annex I.
(2) For the list of participants, see Annex II.
Article 101 (former Article 96d) : Opposition

121. Given the new provisions of Article 97, Article 97a (new) and Article 100, and taking into account the shorter period as compared with that previously provided for in Article 100, the Working Party studied, whether it was possible to shorten the twelve-month period provided for in Article 101, paragraph 1, as the Conference had instructed.

It appeared advisable to make provision for a period for the printing of translations in the Contracting States (even for those in which the official language is one of the official languages of the Convention) and to allow time for consideration, from the time when the translations become available, of possible opposition, so as to avoid the increase of oppositions filed as a precautionary measure.

In these circumstances, the Working Party considered that a period of nine months seemed appropriate.

122. Furthermore, the Working Party noted that it might be advisable to make the provision within the Convention as in Article 47, paragraph 2, of the PCT Treaty, for the possibility of amending certain periods, fixed by the Convention, by a simpler procedure than that of revision, i.e. by a decision of the Administrative Council.

The Working Party will re-examine this matter at a later date.

Article 101a (new) : Grounds for Opposition
(BR/40/70, page 3, No. 21, first paragraph)

123. The Working Party was unable to complete the discussion of this Article, which will be re-examined during the next meeting.

At the present stage of the discussion, the Working Party noted that the grounds on which an opposition may be entered should be comparable to those for revocation. An additional ground to be borne in mind would be : poorly defined claims.
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Brussels, 26 October 1970

SECRETARIAT

MINUTES
of the meeting of Working Party I
Luxembourg, 7 - 11 September 1970

Agenda item 1 (1): Opening of the meeting and adoption of the provisional agenda

1. The fifth working meeting of Working Party I was held at Luxembourg from Monday 7 to Friday 11 September 1970, with Dr. HAERTEL, President of the German Patent Office, in the Chair.

Representatives of the Commission of the European Communities, WIPO-BIRPI and the International Patent Institute took part in the meeting (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

2. The Drafting Committee, under the Chairmanship of the President of the Netherlands "Octrooi-raad", 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 .../...
Article 101a
Grounds for opposition

Opposition may only be lodged on the grounds that:

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

(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the subject matter of the European patent extends beyond the content of the application as filed.
FIRST PRELIMINARY DRAFT
OF A CONVENTION ESTABLISHING
A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Articles drafted by Working Parties I, II, III and IV)
Article 161 - N° 10

Cette disposition est adoptée. Le Comité de rédaction contrôlera la concordance avec le numéro 1, paragraphe 2, lettre c) au article 62.

Article 161 - N° 11

La disposition est adoptée.

Article 161 - N° 12

Répondant à M. van Exter, le Président explique que ce numéro est nécessaire comme condition de la régularité d'une signification. Contrairement à la règle du numéro 9, paragraphe 2 qui vise le représentant professionnel, la signification au domicile élu, réglée par le numéro 12, n'est effectuée que lorsque plusieurs copies certifiées sont envoyées.

Article 161 - N° 13

Le groupe décide que la règle contenue dans ce numéro doit être appliquée de façon générale. La disposition est transmise au Comité de rédaction.

La séance est levée à 13 heures 15.
Résultats de la neuvième session du groupe de travail "Brevets" qui s'est tenue à Munich du 1er au 12 juillet 1963.
Ad article 161
Numéro 10

Election de domicile commun

(1) Si une demande, une requête ou un recours sont introduits par plusieurs personnes qui n'ont pas de représentant, il doit être fait élection de domicile commun sur le territoire de l'un des États contractants. Il en va de même lorsqu'une demande, un brevet ou des droits afférents à une requête ou un recours se trouvent transférés à plusieurs personnes.

(2) S'il n'a pas été fait élection de domicile dans les cas mentionnés au paragraphe 1, l'Office européen des brevets invite les parties intéressées à le faire dans un délai à déterminer. S'il n'est pas fait élection de domicile dans ce délai, il suffit que la signification soit faite à l'une des parties intéressées.
Avant-projet

dé réglement d'application de la convention
relative à un droit européen des brevets
designated Contracting States. The valid interests of an assumed infringer in the retroactive revocation of the patent may thus be upheld. In this connection it may be noted that this amendment has raised the opposition proceedings another step towards the level of actual revocation proceedings.

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

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

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

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

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

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

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

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

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

The provision in Article 124 concerning the procedure for drawing up supplementary search reports provided a large amount of material for discussion. This Article was deleted. The Committee considered it unnecessary to impose search costs on the applicant in the event of his making necessary an additional search due to an amendment to the claims. This financial problem could be settled by slightly increasing the standard amount of the main search fee. After lengthy discussions the Committee reached the majority decision that additional fees for additional searches which were drawn up outside the procedure for international search reports under Article 156, could be dispensed with, especially since such an additional cost would have an unfavourable visual effect in the Convention. At the same time the Committee stated expressly
5. Filing and requirements of the European patent application (Articles 73-84 and Rules 24-37)

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

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

Closely connected with the substantive requirement of disclosing the invention under Article 81 was the problem of making special provisions for European patent applications covering micro-organisms. It was not contested that the relevant provision, Rule 28, should lay down that micro-organisms which are not available to the public should be deposited with a recognised culture collection no later than at the time of filing the application, that the micro-organism should be adequately described in the application, and that the culture collection should be identified either in the application itself or within a short time thereafter. It was also agreed that the disclosure of the micro-organism should be subject to certain measures to protect the applicant. Views differed, however, on the latest time at which the micro-organism should be made available to the public. Contrary to the draft of Rule 28, which provided for this to be not later than the date of publication of the application, it was proposed that the applicant should not be obliged to make the micro-organism available to the public until the time of the grant of the patent, at which point the provisional protection would be lost. The main arguments put forward in defence of this standpoint were that the approach contained in the draft laid an unfair burden on such applicants in comparison to inventors in other fields of technology by requiring the subject-matter of the invention to be deposited, and that the applicant was forced to reveal know-how, thus making it easier for his invention to be copied at a time when it was not yet definite whether or not the application would lead to the grant of a patent.

Those who advocated the approach set out in the draft argued that the public could be considered to be sufficiently informed about the subject-matter of the invention only if the micro-organism were made available to the public at the time of the publication of the application; furthermore, it was only by such a disclosure that the micro-organism could be comprised in the state of the art under Article 52, paragraph 3, with the result that this was the only means whereby duplication of patents could be avoided and legal uncertainty in relation to national patent applications could be removed.

After detailed consideration of the various arguments for and against the two approaches, the Main Committee decided by a majority to retain the solution proposed in the draft and to lay down that the micro-organism should be made available to the public at the latest date of publication of the European patent application. At the same time, it added provisions to Rule 28 which gave the applicant far-reaching guarantees against misuse of the disclosed micro-organism during the existence of the provisional protection conferred by the application and the definitive protection of the European patent. These guarantees consisted in requiring that any third party who had access to a sample of the culture would have to make certain undertakings vis-à-vis the culture collection or the applicant for or proprietor of the patent in respect of the ways in which he used the culture. On the other hand, the Main Committee decided, in the same way as in respect of Article 67, not to adopt a procedural rule which would have obliged a third party who used a micro-organism disclosed by the applicant to prove that the culture concerned was not that described in the application, even though the reversal of the burden of proof would have reinforced the legal position of the applicant even further. It was also made clear in Rule 28 that the built-in safety clauses in favour of the applicant did not prejudice any national provisions concerning compulsory licences or uses in the interest of the State. The details governing the deposit, storage and availability of cultures were left to agreements to be concluded between the President of the European Patent Office and the recognised culture collections.

6. Questions of priority (Articles 85-87/Rule 38)

Apart from the amendment to Article 85, paragraph 5, already dealt with above in the chapter on "language questions", the provisions of Articles 85-87 concerning priority led to few amendments. It may be mentioned that the extension of the priority right to States which are not members of the Paris Convention, in accordance with an amendment decided upon by the Committee in the interests of the Contracting States, will apply only if international reciprocity is granted not only in relation to European but also in relation to national applications by Contracting States.

7. Procedure up to grant (Articles 88-97/Rules 39-55)

In so far as individual provisions of Articles 85-97 and the corresponding Rules 39-55 concerning the procedure up to grant have already been discussed in connection with language questions, identification of the inventor and the abstract, reference should be made to the appropriate Chapters 1, 3 and 5.

During the discussion of Articles 93/94 the Committee confirmed the specified period within which requests for examination may be filed and also the possibilities for extending the time limits, both of which are the result of well thought out compromises. The Committee refused in particular to lay down in Article 94 an absolute right for third parties to request examination in the event of the Administrative Council extending a time limit. The need for such a right for third parties depends largely on the length of time by which the period is extended.

8. Opposition procedure (Articles 98-104/Rules 56-64)

The provisions concerning opposition procedure gave rise to very little discussion. A proposal to delete the opposition fee in Article 98, paragraph 1, on the ground that the opponent was to be considered as a person helping to establish the legal facts of the matter, was rejected by the majority. If the fee were to be dispensed with, dilatory opposition would be encouraged. Furthermore, the interests of the opponent are his main incentive and lastly, pursuant to Article 114, any person who wishes to help to establish the legal facts of the matter may present, free of charge, observations concerning the patentability of an invention in respect of which an application has been filed. By a vast majority the Committee also refused to shorten to six months the nine-month opposition period laid down in Article 98, paragraph 1, which had been adopted as a compromise solution at an earlier stage in the negotiations.

In Article 98 and in Rule 61 the Committee added new provisions which also make possible the filing of notice of opposition and consequently the continuation of opposition proceedings when the proprietor has completely surrendered the European patent or when it has lapsed for all the
Minutes of the proceedings of the Committee of the Whole

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

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

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

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

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

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

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

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

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

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

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

II. Report on the work of Main Committee II

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

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

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

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

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

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

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

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

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

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

15. Main Committee III's rapporteur, Mr. Fressonnet, Deputy Director of the National Industrial Property Office
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
420. The EIRMA delegation suggested that Article 104 (105) be completely deleted. Discussion of the length of time to be allowed for filing opposition had shown that nobody wanted to extend this period more than was necessary for legal certainty. There was a danger here in the case of intervention that the opposition procedure might be held up. At the moment, however, there was no need to provide for intervention since the assumed infringer could both file opposition within the permitted period and/or initiate an action for revocation in national courts.

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

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

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

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

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

**Article 105 (106) — Decisions subject to appeal**

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

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

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

427. With the support of the Netherlands and Austrian delegations, the Swedish delegation suggested that in paragraph 4, because of the minimum permitted amount for an appeal against a decision fixing the amount of costs, no reference be made to the Implementing Regulations; the minimum amount should be fixed by the Convention itself or — a second possibility — by the Rules relating to Fees (see M/54/1/II/III, page 16).

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

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

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

430. The delegation of the Federal Republic of Germany did not think that the minimum permitted amount for an appeal should be linked to the opposition fee. The opposition fee could be fixed in accordance with widely differing criteria and might perhaps in the course of time undergo changes. Moreover, it would be preferable not to fix a minimum payment in the Convention so that it might be more easily changed. For these reasons the delegation of the Federal Republic of Germany could not support the Swiss delegation's main proposal.

431. After the Swiss delegation had withdrawn its main proposal in a subsequent meeting, the Main Committee accepted its alternative proposal that the minimum permitted amount for appeals be fixed in the Rules relating to Fees; at the same time it deleted Rule 64 (63), paragraph 5.

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

432. The Main Committee referred drafting proposals by the Luxembourg (M/9, point 18) and Swiss (M/54/1/II/III, page 17) delegations to the Drafting Committee.

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

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

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

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

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

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

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

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

403. The Netherlands delegation pointed out that the time allowed for providing translations of specifications under Article 63(60), paragraph 1, started from the moment when an applicant was informed by the European Patent Office of the form which it was intended the grant of a patent would take. Only after these three months, which were to be extended to five, could mention of the grant be made in the European Patent Bulletin. The period allowed for filing opposition only began with the publication of that mention. In all, that amounted to fourteen months and it would therefore be quite justifiable to reduce the period allowed for filing opposition to, for instance, seven months.

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

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

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

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

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

409. The Main Committee adopted this proposal.

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

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

**Article 99 (100) — Grounds for opposition**

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

**Article 100 (101) — Examination of the opposition**

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

**Article 101 (102) — Revocation or maintenance**

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

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

**Article 103 (104) — Costs**

**Article 104 (105) — Intervention of the assumed infringer**

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

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

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

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

* For an explanation of these Articles, see points 2012, 2015 and 2016.
Minutes of the proceedings of the Committee of the Whole

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

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

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

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

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

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

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

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

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

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

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

II. Report on the work of Main Committee II

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

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

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

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

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

13. The Austrian delegation suggested that in the English version of point 22, in the middle of page 14, the words "some search work" be used so as not to prejudice the question of the amount of such search work, which had deliberately been left open. The text would therefore read: "difficulties resulting from a renunciation under Section I.2, to entitle some search work to national offices whose language is ... ."

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

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

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

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

15. Main Committee III's rapporteur, Mr. Fressonnet, Deputy Director of the National Industrial Property Office
MINUTES
OF THE
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING
UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

(Munich, 10 September to 5 October, 1973)

published by the
Government of the Federal Republic of Germany
Article 99

Grounds for opposition

Opposition may only be filed on the grounds that:

(a) Unchanged from 1972 published text

(b) Only concerns German text

(c) Unchanged from 1972 published text
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

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

Articles of the Convention:

| Articles | 53 | 54 | 55 | 56 | 57 | 58 | 59 | 60 | 61 | 62 | 63 | 64 | 65 | 66 | 67 | 68 | 69 | 70 | 71 | 72 | 73 | 74 | 75 | 76 | 77 | 78 | 79 | 80 | 81 | 82 | 83 | 84 | 85 | 86 | 87 | 88 | 89 | 90 | 91 | 92 | 93 | 94 | 95 | 96 | 97 | 98 | 99 | 100 | 101 | 102 | 103 | 104 | 105 | 106 | 107 | 108 | 109 | 110 | 111 | 112 | 113 | 114 | 115 | 116 | 117 | 118 | 119 | 120 | 121 | 122 | 123 | 124 | 125 | 126 | 127 | 128 | 129 | 130 | 131 | 132 | 133 | 134 | 135 | 136 | 137 | 138 | 139 | 140 | 141 | 142 | 143 | 144 | 145 | 146 | 147 | 148 |

Rules of the Implementing Regulations:

| Rules | 13 | 16 | 52 | 59 |
Article 100

Grounds for opposition

Opposition may only be filed on the grounds that:

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

(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

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

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee
Subject: Convention: Articles 84 to 111
Artikel 58

22 Aus Gründen der besseren Übersichtlichkeit wird vorgeschlagen, Absatz 1 Satz 3 zu einem neuen Absatz auszugestalten.

Artikel 62

23 Um das Verhältnis zwischen Artikel 62 und Artikel 67 klarzustellen, wird vorgeschlagen, Artikel 62 wie folgt zu ändern:

„Vorbehaltlich Artikel 67 gewährt das europäische Patent seinem Inhaber . . . .“

Artikel 74

24 In Absatz 2 des deutschen Textes sollte in der letzten Zeile das Wort „gegebenenfalls“ gestrichen werden.

Artikel 92

25 In Regel 50 Absatz 1 Satz 2 der Ausführungsordnung wird davon ausgegangen, daß die Zusammenfassung veröffentlicht wird. Da Artikel 92 die Einzelheiten der Veröffentlichung der europäischen Patentanmeldung regelt, sollte in Absatz 2 die Zusammenfassung aufgenommen werden.

Artikel 99

26 In Anpassung an Artikel 81 sollte im Buchstaben b das Wort „danach“ gestrichen werden.

Artikel 104

27 Um mögliche Mißverständnisse zu vermeiden, wird vorgeschlagen, die Worte „Antrag auf Beitritt“ zu streichen und statt dessen eine Fassung zu wählen, die zum Ausdruck bringt, daß der Beitritt innerhalb der Dreimonatsfrist erklärt werden muß.

Artikel 105

28 In Absatz 2 sollte im deutschen Text das Wort „sofortige“ durch „gesonderte“ ersetzt werden, da

practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to substances or compositions intended for use in any of the above-mentioned methods."

Article 58

22 For the sake of greater clarity it is proposed that the third sentence of paragraph 1 should form a separate paragraph.

Article 62

23 In order to make the relationship between Article 62 and Article 67 clear, it is proposed that Article 62 should be amended as follows:

„Subject to Article 67, a European patent shall confer on its proprietor . . . .“

Article 74

24 In the German text the word „gegebenenfalls“ should be deleted in the last line of paragraph 2.

Article 92

25 Rule 50, paragraph 1, 2nd sentence, of the Implementing Regulations assumes that the abstract will be published. Since Article 92 lays down the details for the publication of a European patent application, the abstract should be included in paragraph 2.

Article 99

26 In the German text, sub-paragraph (b), the word „danach“ should be deleted so that the text corresponds with Article 81.

Article 104

27 In order to avoid possible misunderstandings it is proposed that the words “notice . . . of intervention” be deleted and a wording used which makes it clear that the intervention must be filed within the three-month period.

Article 105

28 In the German text of paragraph 2 the word „sofortige“ should be replaced by „gesonderte“
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
MÜNCHNER DIPLOMatische KONFERENZ
ÜBER DIE Einführung EINES EUROPäISCHEN
PatenTerteilungsVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Munich, 10 September to 6 October 1973)

CONFÉRENCE DIPLOMATIQUE DE MUNICH
POUR L'INSTITUTION D'UN SYSTèME EUROPéEN
DE DélIVRANCE DE BREVETS
(1973)
(Munich, 10 septembre - 6 octobre 1973)

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

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

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

1973
FÜNFTER TEIL
EINSPRUCHSVERFAHREN

Artikel 98
Einspruch


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

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


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

Artikel 99
Einspruchsgründe

Der Einspruch kann nur darauf gestützt werden, daß
a) der Gegenstand des europäischen Patents nach den Artikeln 50 bis 55 nicht patentfähig ist;

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

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

PART V
OPPOSITION PROCEDURE

Artikel 98
Opposition

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

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

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

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

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

Artikel 99
Grounds for opposition

Opposition may only be filed on the grounds that:
(a) the subject-matter of the European patent is not patentable within the terms of Articles 50 to 55;

(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 59, beyond the content of the earlier application as filed.

Artikel 100
Prüfung des Einspruchs

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

Artikel 100
Examination of the opposition

(1) If the opposition is admissible, the Opposition Division shall examine whether the grounds for opposition laid down in Article 99 prejudice the maintenance of the European patent.
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTEILUNGSVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS, 1973
(Munich, 10 September to 6 October 1973)

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

VORBEREITENDE DOKUMENTE
ausgearbeitet von der
Regierungskonferenz über die Einführung eines europäischen Patenterteilungsverfahrens
herausgegeben von der
Regierung der Bundesrepublik Deutschland

PREPARATORY DOCUMENTS
drawn up by the
Inter-Governmental Conference for the setting up of a European System for the Grant of Patents
and published by the
Government of the Federal Republic of Germany

DOCUMENTS PRÉPARATOIRES
élaborés par la
Conférence intergouvernementale pour l'institution d'un système européen de délivrance de brevets
et publiés par le
Gouvernement de la République fédérale d'Allemagne

1972
of the question that this period might be adapted. In conclusion, the Conference decided to adopt a period of nine months.

125. The Conference agreed with the idea that, in so far as it concerned the opposition, the problem of a change of proprietor by virtue of a legal decision arose in different terms than for the procedure for the grant of a patent. In fact, granted patents will be entered in the national patent registers and those listed as proprietors in these registers will be recognised as such by the European Patent Office.

Article 101a (Grounds for opposition)

126. In reply to a question raised by the delegation, it was stated that the fact that the ground for revocation referred to in Article 133, paragraph 1(e), was not adopted as a ground for opposition under Article 101a was explained by the consideration that matters concerning the right to a European patent according to the terms of Article 15 must come within the scope of national legal systems alone.
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 15 March 1972
BR/168/72

MINUTES

of the

5th Meeting of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents

Parts 1 and 3

(Luxembourg, 24–25 January and 2–4 February 1972)

BR/168 e/72 eld/KM/gc
Article 101a

Grounds for opposition

Opposition may only be lodged on the grounds that:

(a) +

(b) +

(c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 16, beyond the content of the earlier application as filed.
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 -
The Conference noted that the wording of Article 101a allows third parties to lodge opposition on the grounds of lack of novelty of the invention which constitutes the subject-matter of a European patent, provided that the priority on which the European patent application was based has been refuted.

Article 101b (Examination of opposition)

The Norwegian delegation wondered whether it was advisable to provide in paragraph 2 that the Opposition Division may disregard fresh facts or evidence. This seemed contrary to the spirit of paragraph 1, which laid down that the Opposition Division is to examine the facts.

In this connection it was pointed out that the Opposition Division would probably use its discretion in exercising this right which, moreover, may be exercised to counteract any delaying tactics employed by parties to opposition proceedings.

The Norwegian delegation reserved the right to submit a proposed amendment to this provision before the next Meeting of the Conference.
CHAPTER III
Opposition procedure

Article 101a (Grounds for opposition)

With regard to this Article, certain delegations raised the question of whether it might be possible to envisage extending the rules of Article 16 to a European patent during the period within which opposition may be lodged.

It was pointed out, in this connection, that if such a possibility were provided for, the provisions of the Convention would in the Contracting States' national law, which in principle must alone govern a European patent from the moment that it is granted.

On the other hand, it was pointed out that any solution could be considered unsatisfactory which requires that the person who has obtained legal recognition of his right to obtain a European patent should bring an action to this effect in each of the States designated in the patent granted to the unauthorised person.

Taking into account the complexity of the problem, the Conference instructed Working Party I to continue examination of this question with the government legal experts (1).

(1) On this problem, cf. also the observations relating to Re. Article 16, Nos. 1 bis and 2 bis of the Implementing regulations.

BR/125 8/71 pj .../...
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 101a
Grounds for opposition

Opposition may only be lodged on the grounds that:

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

(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) the subject matter of the European patent extends beyond the content of the application as filed.
FIRST PRELIMINARY DRAFT OF A CONVENTION

ESTABLISHING

A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Stage reached on 29 January 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 132, 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/GT I/120/71 and attached to this document as Annex II.

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

Artikel 101 a
Einspruchsgründe
Der Einspruch kann nur darauf gestützt werden,
a) daß der Gegenstand des europäischen Patents nach den Artikeln 9 bis 14 nicht patentfähig ist;
b) daß das europäische Patent die Erfindung nicht so deutlich und vollständig offenbart, daß ein Fachmann sie danach ausführen kann;
c) daß der Gegenstand des europäischen Patents weiter ist als der Inhalt der eingereichten Patentanmeldung.

Artikel 101 b
Prüfung des Einspruchs
(1) Ist der Einspruch zulässig, so erforscht die Einspruchsabteilung den Sachverhalt im Rahmen der in Artikel 101 a vorgesehenen Einspruchsgründe von Amts wegen; diese Prüfung ist weder auf das Vorbringen noch auf die Anträge der Beteiligten beschränkt.
(2) Die Einspruchsabteilung braucht neue von den Beteiligten vorgebrachte Tatsachen und Beweismittel nicht zu berücksichtigen, die nicht in der Einspruchs begründung oder in der Erwiderung auf den Einspruch enthalten sind.

Artikel 102
Prüfungsbescheid im Einspruchsverfahren
Ist die Einspruchsabteilung nach Prüfung des Einspruchs der Auffassung, daß das europäische Patent nicht hätte erteilt werden dürfen, so ist Artikel 95 entsprechend anzuwenden. Der Prüfungsbescheid und die Stellungnahme des Patentinhabers werden den übrigen Beteiligten mitgeteilt.

Artikel 103
Stellungnahme der Beteiligten
Die Einspruchsabteilung fordert die übrigen Beteiligten auf, sich innerhalb einer von ihr zu bestimmenden Frist zu Stellungnahmen des Patentinhabers zu äußern, sofern diese wesentliches neues Vorbringen enthalten oder die Einspruchsabteilung dies aus anderen Gründen für sachdienlich hält.

(3) The Opposition Division shall notify the proprietor of the patent of any opposition lodged and shall invite him to present his observations within a period to be fixed by the Division. The observations of the proprietor of the patent shall be communicated to the other parties concerned.

Article 101a
Grounds for opposition
Opposition may only be lodged on the grounds that:
(a) the subject-matter of the European patent is not patentable within the terms of Articles 9 to 14;
(b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
(c) the subject-matter of the European patent extends beyond the content of the application as filed.

Article 101b
Examination of opposition
(1) If the opposition is admissible, the Opposition Division shall examine the facts, in so far as they lie within the grounds for opposition laid down in Article 101a; this examination shall not be restricted to the facts, evidence and arguments provided by the parties and the relief sought.
(2) The Opposition Division may disregard fresh facts or evidence submitted by the parties concerned, which were not included in the statement of grounds for opposition or in the reply to the opposition.

Article 102
Notification of the result of the examination in opposition proceedings
If, after having examined the opposition, the Opposition Division considers that the European patent should not have been granted, Article 95 shall apply mutatis mutandis. Tha result of the examination and the observations of the proprietor of the patent shall be communicated to the other parties concerned.

Article 103
Reply of the parties concerned
The Opposition Division shall invite the other parties concerned to comment, within a period to be fixed by the Division, on the observations of the proprietor of the patent in so far as these contain substantial new elements or in so far as the Opposition Division considers this expedient for other reasons.
ZWEITER VORENTWURF EINES ÜBEREINKOMMENS ÜBER EIN EUROPÄISCHES PATENTerteilungsVERFAHREN

sowie
ERSTER VORENTWURF EINER AUSFÜHRUNGSORDNUNG ZUM ÜBEREINKOMMEN ÜBER EIN EUROPÄISCHES PATENTerteilungsVERFAHREN

und
ERSTER VORENTWURF EINER GEBÜHRENORDNUNG

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

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

and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION DE LA CONVENTION INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS

et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES

— 1971 —
Article 101a (new): Grounds for opposition

6. The Working Party was unanimous that, in principle, the grounds for opposition correspond in substance to the grounds for revocation (Article 133) and that their wording should be brought into line with these.

7. The United Kingdom delegation further held that lack of clarity in the claims should constitute another ground for opposition.

Several delegations countered this by saying that deficiencies of this kind in the formulation of the claims were already largely covered by Article 133 paragraph 1(b), which provides that a European Patent may be revoked if it 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. It would not be wise to introduce a more far-reaching ground for opposition, particularly as the carefully conducted procedure for grant might then be unfairly delayed, simply as the result of an assertion by a third party.

The United Kingdom delegation reserved the right to return to Article 101a as soon as the wording of the Implementing Regulations was established with respect to disclosure of the invention (Article 71).

8. Following a proposal from the German delegation, the Working Party also agreed to lay down in the Implementing Regulations that persons lodging opposition must state not only the grounds, but also the facts, on which the opposition is based.