Rule 60 E

Travaux Préparatoires
(EPC 1973)

Comment:
The collection represents purely an internal research tool for the purpose of Directorate Patent Law of the European Patent Office. No guarantee can be given for its completeness or correctness. The documents produced before 1969 cannot be provided in English as this was not an official language in the period before that date. These documents therefore are provided in French and German.

Rule60eTPEPC1973
### Regel 6o
### MPU
### Fortsetzung des Einspruchsverfahrens
### von Amts wegen

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185/186
5. Filing and requirements of the European patent application (Articles 73-84 and Rules 24-37)

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

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

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

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

After detailed consideration of the various arguments for and against the two approaches, the Main Committee decided by a majority to retain the solution proposed in the draft and to lay down that the micro-organism should be made available to the public at the latest at the date of publication of the European patent application. At the same time, it added provision to Rule 28, which in 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.


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

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

In so far as individual provisions of Articles 88-97 and the corresponding Rules 39-55 concerning the procedure up to grant have already been discussed in connection with language questions, identification of the inventor and the abstract, reference should be made to the appropriate Chapters 1, 3 and 5.

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

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

The provisions concerning opposition procedure gave rise to very little discussion. A proposal to delete the opposition fee in Article 98, paragraph 1, on the ground that the opponent was to be considered as a 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 in establishing 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
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
2277. The UNICE, FICPI and EIRMA delegations said that they were in favour of the Netherlands delegation's proposal.
2278. The Committee recorded its agreement to this proposal.

Rule 59 (58) — Examination of the opposition

2279. Referring to paragraph 7 of this Rule, the Finnish delegation asked whether it would not be more advisable to deliver a patent specification only when the opposition procedure was completed, since then it was no longer possible for third parties to take part in the procedure.
2280. The Swiss delegation expressed sympathy with the Finnish delegation's concern, particularly its fears of possible abuses, but did not think that this problem could be resolved by the means the Finnish delegation had proposed. In fact, when a patent was granted, it was provisionally valid and its proprietor was entitled as against third parties to be mentioned as the proprietor of the patent. Furthermore, abuses involving patent specifications could also arise later, for example where an annual fee was not paid and the patent lost its effect.
2281. The delegation of the Federal Republic of Germany said that nowhere in the Convention was there a provision empowering the European Patent Office to demand the return of a patent specification. The problem of the penalty for non-compliance with this obligation would arise immediately. This problem had already been examined at an earlier stage and the conclusion reached that there was no course open to third parties but to inspect the Register of Patents. If the patents were revoked as a result of the opposition proceedings, the date of the loss of effect would be mentioned in the Register in accordance with Rule 93, paragraph 1(p).
2282. The Finnish delegation was satisfied by this interpretation.

Rule 61 (60) — Continuation ex officio of the opposition proceedings

2283. The Committee examined a proposal submitted by the Member States of the European Communities, as given in M/14, point 16.
2284. Speaking on behalf of those States, the delegation of the Federal Republic of Germany said that this amendment was merely the consequence of the acceptance of the proposal by the Member States of the European Communities concerning Article 98. It would therefore appear logical to recognise an opponent's right to have opposition proceedings continued where a European patent had been surrendered or had lapsed while opposition proceedings were still in progress.
2285. Without disputing that this was a logical consequence of the amendment made to Article 98, the Swiss delegation was anxious to point out that as a result the opposition procedure resembled the revocation procedure more and more.
2286. The Committee recorded its agreement to this proposal.

Rule 63 (62) — Particulars to be included in the new specification

2287. The Committee agreed to entrust the Drafting Committee with the task of examining the proposal by the Member States of the European Communities as set down in M/14, point 17.

Rule 64 (63) — Costs

2288. The Committee examined the Swiss delegation's proposal concerning paragraph 5 of this Rule, that the amount provided for in Article 105, paragraph 4, be fixed at three times the amount of the opposition fee.
2289. The Swiss delegation said that during the discussion of Article 105, paragraph 4, it had noted that its proposal did not meet with the unanimous agreement of the other delegations, and it would be prepared to submit an alternative proposal that Article 105, paragraph 4, provide that the amount would be laid down in the Rules relating to Fees. This solution would have the advantage of a certain degree of flexibility and would empower the Administrative Council to fix the amount in question.
2290. The delegation of the Federal Republic of Germany said that it could agree to the Swiss delegation's second proposal.
2291. The Chairman submitted the Swiss delegation's alternative proposal to the Committee; that paragraph 5 of Rule 64 be deleted and that in Article 105, paragraph 4, reference be made to the Rules relating to Fees rather than to the Implementing Regulations.
2292. The Committee recorded its agreement to this proposal.

Rule 65 (64) — Content of the appeal

2293. The United Kingdom delegation said that its proposal, as given in M/64, page 3, had already been examined by the Drafting Committee and that it would therefore be unnecessary for the Main Committee to discuss it.

Rule 66 (65) — Rejection of the appeal as inadmissible

2294. The Committee examined the Norwegian delegation's proposal as given in M/71, page 5.
2295. The Norwegian delegation said that as it stood, Rule 66 appeared to be very hard on the appellant, since it stipulated that if the appeal did not comply with certain requirements, the Board of Appeal should reject it as inadmissible. The Norwegian delegation considered that the appellant should always be permitted to make good any deficiencies, always provided that this could be done within the time limits applicable to the appeal. For all these reasons, the Norwegian delegation considered that the appellant should be granted the same opportunities to remedy deficiencies under Rule 66 as were granted to the opponent in the opposition procedure under Rule 57, paragraph 1.
2296. The Chairman wondered what the deficiencies were that could be remedied during the course of the appeal. He did not think that the deficiencies referred in Articles 105 and 106 could be so remedied; and as regards the time limit laid down in Article 107, there was no justification for providing that acts which should have been accomplished within those time limits could be accomplished after they had expired. The Norwegian delegation's proposal seemed therefore to refer to Rule 65 alone, and here it would appear that only deficiencies as regards the requirements of (a) could be remedied as requested by the Norwegian delegation.
2297. The Netherlands delegation considered the Norwegian delegation was right to raise the problem of the relationship between this Rule and Rule 57. The present situation did not seem very logical, in that Rule 57 permitted the remedying of deficiencies while Rule 60 did not.
2298. The Chairman wondered whether it would be possible to find a solution to this problem by instructing the Drafting Committee to harmonise Rule 66 with Rule 57 as far as possible.
2299. The Committee recorded its agreement to this suggestion by the Chairman and invited the Drafting
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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 60

Continuation of the opposition proceedings
by the European Patent Office of its own motion

(1) If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months as from a notification by the European Patent Office of the surrender or lapse.

(2) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1975
M/146/R 10
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 54 to 82
Rule 61

Continuation *ex officio* of the opposition proceedings

(1) If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months as from a notification by the European Patent Office of the surrender or lapse.

(2) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued *ex officio*, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 27 September 1973
M/141/I/R 12
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
81
113
134

Implementing Regulations:

Rules
38
54
58
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67
25. Article 165
Paras 1 and 2 should be amended to read:

"(1) This Convention shall be open to accession by
   (a) the States referred to in Article 164(1); and
   (b) any other European State at the invitation of the
       Administrative Council."

26. Article 167
In paragraph 3 the words "unless the State concerned has earlier ceased to be a party to the
Convention, pursuant to Article 171, paragraph 4" should be deleted as superfluous since such effect
is automatic.

IMPLEMENTING REGULATIONS (II)

27. Rule 2
In line 7, paragraph 1, "interpreting" should be amended to
   "interpretation".

28. Rule 35
In the second sentence, paragraph 8, "These" should be amended
to read "The number".

29.
In paragraph 12, "centigrade" should be amended to read
   "Celsius".

30. Rule 61
The title should be amended to read "Continuation of the
opposition proceedings" and in paragraph 1, "ex officio"
should be amended to read "on the motion of the European
Patent Office".

.../...
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
den sollte, auf das ein Einspruch nach Artikel 99 Buchstabe b oder eine Nichtigkeitsklage nach Artikel 138 Absatz 1 Buchstabe b gestützt werden kann. Um eine solche Auslegung zu gewährleisten, ist in dem vorgeschlagenen Text neben der europäischen Patentanmeldung ausdrücklich das europäische Patent erwähnt worden.

16 Regel 61

Es sollte ein neuer Absatz folgenden Wortlauts eingefügt werden, die jetzige Regel 61 würde Absatz 2 werden:

„(1) Hat der Patentinhaber für alle benannten Vertragsstaaten auf das europäische Patent verzichtet oder ist das europäische Patent für alle Vertragsstaaten erloschen, so kann das Einspruchsverfahren auf Antrag des Einsprechenden fortgesetzt werden, der Antrag ist innerhalb von zwei Monaten nach dem Tag zu stellen, an dem ihm das Europäische Patentamt den Verzicht oder das Erlöschen mitgeteilt hat.“

Begründung:


17 Regel 63

Der Titel dieser Regel sollte wie folgt geändert werden:

„Form der neuen Patentschrift im Einspruchsverfahren“

Begründung:

Der vorgeschlagene neue Titel ist an den Titel der Regel 50 angegliedert worden, auf die übrigen in der Regel 63 verwiesen wird.

disclose the invention in a sufficiently clear and complete manner, which therefore forms grounds for opposition proceedings to be filed under Article 99 (b) or revocation proceedings to be instituted under Article 138, paragraph 1(b). In the proposed text the European patent is expressly mentioned in addition to the European patent application, in order to ensure that this provision is so interpreted.

16 Rule 61

It is proposed that a new paragraph worded as follows be inserted, with the present text of Rule 61 becoming paragraph 2:

“(1) If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent in writing within two months from a notification by the European Patent Office of the surrender or lapse.”

Reason:

This proposal supplements the proposal for the insertion of a new paragraph 2a in Article 98 (see point 4 above). The Member States of the European Communities considered that if any party interested is granted the right to institute proceedings against a European patent which has been surrendered or which has lapsed for all the designated States, it would logically be necessary to grant the opponent the right to have the opposition proceedings continued where the European patent is surrendered or lapses whilst the proceedings are taking place.

17 Rule 63

It is proposed that the title of this Rule be amended as follows:

“Form of the new specification in opposition proceedings”

Reason:

The new title proposed is based on the title of Rule 50 to which Rule 63 refers.
STELLUNGNAHME

DER MITGLIEDSTAATEN DER EUROPÄISCHEN GEMEINSCHAFTEN

COMMENTS

BY THE MEMBER STATES OF THE EUROPEAN COMMUNITIES

PRISE DE POSITION

DES ÉTATS MEMBRES DES COMMUNAUTÉS EUROPÉENNES
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTERTeilungsverfahrens 1973
(München, 10. September bis 6. Oktober 1973)

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

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

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

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

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

1973
(6) In der Mitteilung der Einspruchsabteilung nach Absatz 5 werden die benannten Vertragsstaaten angegeben, die eine Übersetzung nach Artikel 63 Absatz 1 verlangen.

(7) In der Entscheidung, durch die das europäische Patent in geändertem Umfang aufrechterhalten wird, ist die der Aufrechterhaltung zugrundeliegende Fassung des europäischen Patents anzugeben.

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Vgl. Artikel 63 (Übersetzung der Patentschrift), 100 (Prüfung des Einspruchs), 101 (Widerruf oder Aufrechterhaltung) und 104 (Beteiligung des vermeintlichen Patentverletzers)

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Regel 60
Anforderung von Unterlagen

Werden im Einspruchsverfahren von einem Beteiligten Unterlagen genannt, die im Europäischen Patentamt nicht vorhanden sind, so kann das Europäische Patentamt die Nachreicherung der Unterlagen innerhalb einer von ihm zu bestimmenden Frist verlangen. Werden die Unterlagen nicht rechtzeitig eingereicht, so braucht das Europäische Patentamt das darauf gestützte Vorbringen nicht zu berücksichtigen.

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Vgl. Artikel 100 (Prüfung des Einspruchs)

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Regel 61
Fortsetzung des Einspruchsverfahrens von Amts wegen

Stirbt ein Einspruchender oder verliert er seine Handlungsfähigkeit, so kann das Einspruchsverfahren auch ohne die Beteiligung seiner Erben oder gesetzlichen Vertreter von Amts wegen fortgesetzt werden. Das Verfahren kann auch fortgesetzt werden, wenn der Einspruch zurückgenommen wird.

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Vgl. Artikel 98 (Einspruch)

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Regel 62
Rechtsübergang des europäischen Patents

Regel 20 ist auf einen Rechtsübergang des europäischen Patents während der Einspruchsfrist oder der Dauer des Einspruchsverfahrens entsprechend anzuwenden.

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Vgl. Artikel 98 (Einspruch)

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(6) The communication of the Opposition Division under paragraph 5 shall indicate the designated Contracting States which require a translation pursuant to Article 63, paragraph 1.

(7) The decision to maintain the European patent as amended shall state which text of the European patent forms the basis for the maintenance thereof.

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Cf. Articles 63 (Translation of the European patent specification), 100 (Examination of the opposition), 101 (Revocation or maintenance of the patent) and 104 (Intervention of the assumed infringer)

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Rule 60
Requests for documents

If during opposition proceedings a party refers to documents which are not available in the European Patent Office, the European Patent Office may require that those documents be filed within such period as it may specify. If such documents are not filed in good time, the European Patent Office may decide not to take into account any evidence based on them.

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Cf. Article 100 (Examination of the opposition)

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Rule 61
Continuation ex officio of the opposition proceedings

In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued ex officio, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

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Cf. Article 98 (Opposition)

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Rule 62
Transfer of the European patent

Rule 20 shall apply mutatis mutandis to any transfer of the European patent made during the opposition period or during opposition proceedings.

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Cf. Article 98 (Opposition)

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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
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
This does not alter the fact that as soon as the European Patent Office finds a deficiency of this nature, it will be morally obliged to bring it to the attention of the opponent so that the latter may rectify it in due time. This is the meaning that the Sub-Committee intended to give to the words: "unless these deficiencies have been remedied before expiry of the opposition period."

Paragraph 2 states that the deficiencies which do not affect the validity of the notice of opposition and which may be rectified even after the opposition period has expired. Nonetheless, if no rectification has taken place within the specified period, the Office is obliged to inform the opponent of the deficiency. The Office will reject the opposition as inadmissible.

Re. Article 101, No. 4 - Continuation ex officio of the opposition proceedings

28. The majority of the Sub-Committee considered it necessary to lay down that the European Patent Office has the right to continue the opposition proceedings in the event of death, legal incapacity or even withdrawal. It may in fact be necessary to withdraw or amend a patent in the public interest. The right - and not the obligation - provided will enable the European Patent Office to assess whether or not the public interest is concerned.

The United Kingdom delegation expressed a provisional reservation on the actual principle of the continuation ex officio of the opposition proceedings.

BR/60 e/70 ley/KM/prk

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

1. The third working meeting of the Sub-Committee instructed by Working Party I to draw up draft Implementing Regulations to the Convention was held at Luxembourg, from Tuesday 20 to Friday 23 October 1970, with Mr. PRESSONNET, Deputy Director, French Industrial Property Institute, in the Chair.

In addition to the national delegations represented in the sub-Committee, the meeting was attended by BIRFI and the International Patents Institute (IIB) (1).

(1) See the list of participants in Annex I.

BR/60 e/70 oyd/EM/prk
Such procedural steps as may already have been taken shall be deemed to be fully valid.

Within the provisions of Article 112 of the Convention, the proceedings shall be continued ex officio.

(2) If the opposition division notes, once the opposition proceedings have begun, that the opposition was lodged by a third party who was legally incapacitated or not represented in accordance with the provisions of Article 112 of the Convention, the opposition shall be withdrawn.

(1) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued ex officio, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

Text drawn up by the sub-committee

Continuation ex officio of the opposition proceedings

No. 4 (new)

(former Article 96d)

Re. Article 101
Preliminary Draft Implementing Regulations

(20 to 23 October 1970)

Outcome of the work of the "Implementing Regulation" sub-committee of Working Party I
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 152, 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