Rule 106 E

Travaux Préparatoires
(EPC 1973)

Comment:

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Rule106eTPEPC1973
Regel 106

MPU

Änderungen in der Liste der Vertreter während der Übergangszeit

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Absatz 2a eingefügt durch vorgenannten Beschluß des Verwaltungsrats
that Article 156, paragraph 3, was to be interpreted as an authorisation for the Administrative Council to provide for the levy of a search fee for each and every international patent application, irrespective of whether additional searches within the meaning of this provision should be carried out in the individual cases.

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

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

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

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

The provisions of the Convention and the Implementing Regulations concerning representation before the European Patent Office were already discussed with the organisations concerned during the earlier stages of the negotiations and were, as far as possible adapted to their proposals and wishes. Fortunately this situation meant that the principles established by the Inter-Governmental Conference were no longer questioned as to their substance. In particular, the principle that during a transitional period the representatives’ status would basically be controlled by the national law of Contracting States and afterwards by European law, remained uncontested. The general principles concerning representation in Article 133 were also unchanged. The Main Committee generally considered that these principles should also be valid for the transitional period. The Committee also specified that legal persons could be represented not only by their employees — as laid down in paragraph 3 of Article 133 — but also by their departments. Such representation by their departments is regarded as a matter of course, is understood from paragraph 1 of Article 133 and does not need to be expressly laid down.

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

(a) Conditions of admission

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

(b) Restrictions on authorisation to represent

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

(c) Questions concerning place of business

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

The Greek proposal was rejected by 9 votes against, 8 in favour and 1 abstention.

65. The Greek delegation announced a new proposal along the lines mentioned by the Chairman, although it went further than suggested by some delegations, because it did not mention food and pharmaceutical products in the second half of the sentence.

66. The French delegation stated that it would have to reject this proposal because processes of manufacture of food and pharmaceutical products must at all events be protected.

67. At a subsequent meeting the Greek delegation submitted the following compromise proposal for the second half of paragraph 2 (a) of Article 167 (M/154 G):

"...; this reservation shall not affect protection conferred by the patent in so far as it involves a process of manufacture or use of chemical products or a process of manufacture of pharmaceutical or food products."

68. This proposal was adopted by the Committee of the Whole, which instructed the General Drafting Committee to include it in the existing text of the Article.

B. Implementing Regulations

Rule 28 (R/9) — Requirements of European patent applications relating to micro-organisms

69. The Committee of the Whole adopted the revised version of this Rule drawn up by the General Drafting Committee on the basis of the conclusions reached by Main Committee I.

Rule 50 (R/9) — Information about publication

70. The Committee of the Whole adopted the version of this Rule as submitted by the Drafting Committee, paragraph 2 of which was based on the proposal put forward by the Austrian delegation in Main Committee I (M/PR/I, point 2272).

Rule 65 (R/10 and M/151 R/16) — Rejection of the appeal as inadmissible

71. The Chairman of the General Drafting Committee stated that, further to a proposal by the Norwegian delegation that the procedure for remedying deficiencies in the case of appeals should be the same as that applicable in the case of opposition, Main Committee I had instructed the Drafting Committee to examine the possibility of more closely aligning Rules 65 and 56 (M/PR/I, point 2299). Bearing in mind the fact that in Article 108 Main Committee I had divided the time limit for appeal into the period within which notice of appeal must be filed (two months) and that within which a written statement setting out the grounds of appeal must be filed (four months) (M/PR/I, point 462), the General Drafting Committee proposed the following wording, which it did not however consider to be absolutely essential:

"...rejected as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired."

72. The Norwegian delegation still found this solution somewhat harsh compared with the possibilities laid down in Rule 56. It suggested that a paragraph corresponding to paragraph 2 of Rule 56 be included in Rule 65.

73. The Austrian delegation shared this view.

74. The Netherlands delegation feared that because of the shorter time limits applicable to appeals, there would not be sufficient time for arrangements along the lines of the proposed paragraph 2.

75. The Norwegian delegation considered that even in the case of appeals there would be sufficient time for remedying those minor deficiencies with which paragraph 2 was concerned.

At a subsequent meeting the Committee of the Whole first of all approved the abovementioned proposal by the General Drafting Committee for supplementing paragraph 1 of Rule 65, subject to the proviso that this provision only related to deficiencies resulting from failure to comply with the requirements of Rule 64 (b). Notwithstanding the objections of the German delegation, which considered that there should be stricter rules for appeals proceedings, it also adopted a proposal which had been submitted in the meantime by the Norwegian delegation (M/155/G) for the inclusion of a new paragraph 2 corresponding to paragraph 2 of Rule 56.

Rule 84 (R/11) — Duration of time limits

76. The Committee of the Whole approved the deletion of paragraph 2 made by the General Drafting Committee on the basis of the conclusions of Main Committee I (M/PR/I, point 2394).

Rule 93 (R/11) — Parts of the file not for inspection

77. In accordance with the discussions in Main Committee I (M/PR/I, point 2409) the General Drafting Committee specifically provided in sub-paragraph (c) that the designation of the inventor should not be disclosed where he had renounced his title as inventor.

The Committee of the Whole adopted this solution.

Rule 99 (R/11) — Procedure for letters rogatory

78. Further to a proposal by the Italian delegation (M/PR/I, point 2427) referred to it by Main Committee I, the General Drafting Committee submitted an amended version of paragraph 4 of this Rule.

This version was adopted by the Committee of the Whole.

Rule 106 (R/11) — Amendment of the list of professional representatives during a transitional period

79. The Chairman of the General Drafting Committee referred to the lengthy discussions which had been held on this Rule in Main Committee I. Although, after clarifying the interpretation to be given to this Rule, Main Committee I had concluded that the text need not be amended (M/PR/I, point 2519), the Drafting Committee had decided to refer to "other" requirements in paragraph 1 (b) instead of "further" requirements, in order to make the interpretation agreed by Main Committee I quite clear.

80. The Chairman of the Committee of the Whole confirmed that the other requirements referred to in paragraph 1 (b) were requirements other than those mentioned in paragraph 1 (a).

81. The Committee of the Whole approved the amendment submitted by the General Drafting Committee.

C. Protocol on Recognition (M/146 R/12)

82. Further to a proposal made by the IAPIP delegation in Main Committee I and the Committee's decision in this
case for treating this matter as though it were a question of principle. The basic matter in hand was to determine whether a State which had furnished a certificate could withdraw it if the representative in question changed residence by establishing himself in another Contracting State. The United Kingdom delegation considered that the certificate should not be withdrawn in cases of this nature. This in no way pre-empted any decisions which might be taken as regards other cases. Accordingly, with reference to the example given by the delegation of the Federal Republic of Germany it shared the view that the State should be at liberty to withdraw the certificate. This was a general matter of disciplinary rules. The problem currently being examined was, however, not one of disciplinary measures but a straightforward formal question concerning a change of residence.

2513. The FEMIP delegation concurred with the interpretation put forward by the Austrian and United Kingdom delegations.

2514. The UNION delegation pointed out that authorisation to act as a representative before the European Patent Office should basically be governed by the following two principles: the representative must be competent and he must be able to perform his duties. It was quite clear that a representative did not become less competent merely by changing his residence from one Contracting State to another. The UNION delegation therefore felt that in such circumstances the national certificate should not be withdrawn and that moreover this problem would be resolved by applying Article 134, paragraph 7.

2515. The IAPIP delegation endorsed the point of view put forward by the UNION delegation.

2516. The Netherlands delegation said that, on reflection, it would have to side with the opinion held by the United Kingdom delegation, which it understood as meaning that no State could withdraw a certificate merely on account of a change in the representative's place of business. In such circumstances the representative in question would remain subject to his national offices and to its disciplinary rules.

2517. The Chairman considered that on the basis of this interpretation Rule 107, paragraph 1, would constitute an amendment to national law. One example of this would be where a German representative who had lost his nationality would still be entitled to act as a representative before the German Patent Office even though this was at variance with German law.

2518. The delegation of the Federal Republic of Germany considered that the words "any further" would have to be deleted from Rule 107, paragraph 1(b). This would mean that it would be for the national law of the State of origin to deal with this situation. If, for example, there were no requirements as regards residence or place of business under United Kingdom law, British patent agents who, for instance, established themselves at Munich or The Hague would not be affected by subparagraph (b). If, on the other hand, as was the case under German law, authorisation to act before the German Patent Office was conditional upon the requirement that the representative have a place of business within the territory of the Federal Republic of Germany, a German patent agent who established a place of business in London would no longer be entitled to act as a representative before the German Patent Office and would ipso facto lose the right to be entered on the European list of professional representatives.

2519. The Chairman felt that the Committee should now decide on this matter. He called for a vote on the viewpoint put forward by the United Kingdom, French, Austrian and Swedish delegations whereby Rule 107, paragraph 1(b), would not apply where one of the requirements referred to in sub-paragraph (a) was satisfied. This meant that a professional representative who changed his place of business would remain on the list even if he were no longer entitled to act before his national office. The central industrial property office of the host State would therefore not furnish a certificate.

The Chairman noted that the Committee voted in favour of this interpretation by a majority of eleven votes to seven, with one abstention. The Chairman considered that the text need not be amended and that it was sufficient to record in the Minutes that the words "any further*" meant other than the cases referred to in subparagraph (a).

Draft Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent

3001. The Committee examined this draft Protocol.

Article 1

3002. The Austrian delegation withdraw its proposed amendment to Article 1 (see M/41).

Article 3

3003. The Committee agreed to refer to the Drafting Committee, for examination, the proposal by the delegation of the Federal Republic of Germany contained in M/11, point 13.

3004. The Swiss delegation asked why the delegation of the Federal Republic of Germany wanted to change "right to the grant of the European Patent" to "right to the European patent". The delegation felt that the whole of the Protocol in question covered only the right to the grant of the patent.

3005. The delegation of the Federal Republic of Germany shared the Swiss delegation's view that the Protocol covered only the right to the grant of the European patent. However, Article 3 covered a special case i.e. the legal competence referred to by the second sentence of Article 58, paragraph 1, which referred to the right to the European patent. There was therefore some justification for referring in Article 3 to the "right to the European patent", which had a wider sense than the expression "right to the grant of a European patent". The reference merely meant that the court competent to hear a case relating to a European patent under Article 58 of the Convention was also competent with regard to the right to the grant of a European patent.

Article 5

3006. The IAPIP delegation wondered whether the rules laid down in this Article, which stipulated the circumstances in which the courts of the Federal Republic of Germany would have jurisdiction, might not be replaced by a provision which drew finer distinctions. A distinction should be made between two eventualities. Firstly, there might be a dispute between two parties not resident in Europe, in which case the jurisdiction of the German courts seemed justified. The second possibility was that of a dispute between a European claimant and a peasant not resident in Europe. In such a case there seemed to be no justification for giving the German courts jurisdiction; it should rather be given to the court of the place of residence of the European plaintiff. Although, as a general rule of procedure, the competent court in a dispute should be that of the defendant's place of residence, in cases where the defendant was not resident in the territory, the competent court should be that in the place of residence of the plaintiff. There was no reason to give jurisdiction to a court which was not of the plaintiff's State, any more than to give it to a court of the defendant's State.

* Translator's note: In the first text of the Convention the English wording is "any other".
employment in one of the Contracting States. However, account also had to be taken of Rule 107, paragraph 1(b), which stated that the central industrial property office was bound to withdraw the certificate if any further requirements of the national law of the Contracting State concerned in respect of the grant of the certificates were no longer fulfilled. The Chairman felt that in the specific example referred to by the Irish delegation, the Irish Office should inform the European Patent Office that it had withdrawn the certificate. The question in point was the situation of the professional representative in such cases. If, under German law, he was entitled to establish himself in Germany, he would be granted a certificate by the competent German authorities. If this were not the case, authorisation to act as a representative before the European Patent Office would have to be withdrawn. To sum up, any change in place of business from one Contracting State to another during the transitional period could, under certain circumstances, entail deletion from the list of professional representatives.

2500. The Austrian delegation said that it had understood Rules 103 and 107 as meaning that where there had been a change of place of business or nationality within the Contracting States, the certificate furnished by the original State should continue to constitute a basis for entitlement to act as a professional representative before the European Patent Office. The Austrian delegation therefore felt that Rule 107, paragraph 1(b), should specify that the arrangements set out under sub-paragraph (a) were in no way prejudiced by the provisions of sub-paragraph (b).

2501. The Chairman did not agree with this interpretation on the grounds that a person who changed his place of business and was not entered on the list of professional representatives within the new State would cease to be subject to any supervision by a disciplinary authority. It had been the very aim of Article 162 to make provision for supervision of professional representatives by a national authority: should such supervision cease to exist, it seemed logical that the authorisation to act as a representative should likewise cease to exist.

2502. The Netherlands delegation shared the opinion expressed by the Chairman.

2503. The French delegation pointed out that under the arrangements adopted by the Committee, the professional representative would be dependent during the transitional period upon the certificate furnished by the central industrial property office of his own country.

2504. The FICPI delegation considered it highly important that a solution be adopted whereby professional representatives could not lose their authorisation to act before the European Patent Office by the simple fact of changing their place of business. Accordingly, it called upon the Committee to amend the current text by stipulating that the State in which the professional representative established his new place of business should automatically recognise the certificate furnished by the country of origin as being adequate for the purposes of acting as a representative before the European Patent Office.

2505. The delegation of the Federal Republic of Germany was in favour of maintaining the text as it stood, on the grounds that professional representatives would be obliged to retain their place of business in their country of origin during the transitional period if they wished to establish a second place of business in another Contracting State. Contact would have to be maintained with the authorities in the country of origin during the transitional period, as otherwise the professional representative would totally escape any supervision by any authority.

2506. The Chairman contended that the problem was of a somewhat theoretical nature, inasmuch as the Interim Committee would presumably draw up the provisions referred to in Article 134, paragraph 7, as quickly as possible in order to enable the institute mentioned in that Article to come into operation immediately after the entry into force of the Convention.

2507. The United Kingdom delegation concurred with the viewpoint expressed by the Austrian and French delegations, on the premise that a professional representative who changed his place of business continued to fulfil the conditions set out in Rule 103, paragraph 2. It interpreted the words "any further requirements" in Rule 107, paragraph 1(b) as referring to the conditions laid down in paragraph 1(a).

2508. The Chairman considered that the Committee should first of all decide on the content of the arrangements to be adopted and should leave aside the matter of drafting for the moment. His understanding of the situation was that the Austrian, French and United Kingdom delegations were in favour of the certificate being maintained even where there had been a change of place of business, whereas the German and Netherlands delegations held the opposite view.

2509. The Austrian delegation said that its initial intention was to remove any possibility of ambiguity in the text. Article 152 only laid down the conditions under which a professional representative could be entered on the list during the transitional period. It did not, however, stipulate what was to happen subsequently in the course of the transitional period, which meant that the Implementing Regulations would have to be very precisely formulated. The Austrian delegation felt that Rule 107 as it now stood was not very clear. Furthermore, it shared the Chairman's opinion as regards the theoretical nature of the matter.

2510. In reply to a point made by the Netherlands delegation, the French delegation stated that it did not feel that there was any incompatibility between Article 162 and Rule 107. Article 162, paragraph 1(b), stipulated that for a professional representative to be entered on the list, he must be entitled to act as a representative in patent matters within the territory of the State in which he had his place of business or employment. Rule 107 dealt with the withdrawing authorisation for him to act as a representative before the European Patent Office, at least so far as the transitional period was concerned.

2511. The delegation of the Federal Republic of Germany drew the Committee's attention to the implications of the interpretation put forward by the United Kingdom and French delegations. For instance a German patent agent who had misappropriated his client's funds and had been deleted from the list in the Federal Republic of Germany, would be free to establish his place of business, for example in London, and would no longer be subject to any supervision by a disciplinary organisation for his profession. There would be no possibility of withdrawing authorisation for him to act as a representative before the European Patent Office, at least so far as the transitional period was concerned.

The German delegation's interpretation of the words "any further" in paragraph 1(b) differed from that of the United Kingdom and French delegations, in that it did not feel that the requirements laid down by national law were restricted by Rule 103, paragraph 2. On the basis of Rule 107, paragraph 1(b), and Rule 103, paragraph 3, a professional representative was required to have a place of business in one of the Contracting States and the delegation of the Federal Republic of Germany considered that on the basis of Rule 107, paragraph 1(b), he could also be required, by virtue of national law, to have a place of business in a specific Contracting State.

2512. The United Kingdom delegation felt that there was no
refer in so many words to national law in connection with
deletion, and it was hard to see why representatives who had
benefited from the transitional provisions should be treated
differently from those approved under Article 134.

2487. The UNION delegation saw no justification for
adopting a system which discriminated between representa-
tives entered on the list as a result of a qualifying examination
and those entered on the basis of national certificates. The
purpose of such national certificates was, in fact, to compensate
for the fact that no examinations would be sat during the
transitional period. If national offices declared that certain
persons were professionally competent, there was no reason
why there should be any grounds for their deletion other than
those adopted by the institution provided for on a European
rather than national basis in Article 134, paragraph 7.

2488. The Irish delegation declared that it shared the view
expressed by the United Kingdom and French delegations.

2489. The FICPI delegation agreed with the remarks made
by the UNION delegation, and drew the Committee's attention
to the following possibility: during the definitive period, a
German national might take the examination for patent agents
laid down by German law. Subsequently, he might take the
European qualifying examination. Supposing that, in certain
circumstances, the qualification to act before the German
Patent Office were withdrawn, it was inconceivable that this
should also affect the qualification to act before the European
Patent Office. Since in this case there were no repercussions
for the European qualification, the question arose why there should
be a link with the national qualification in the other case. The
restrictive interpretation advocated by the Chairman would
result in the creation of two categories of patent agents, which
would be hard for the professional organisations to accept.

2490. The Austrian delegation would be able to agree with an
arrangement based on the principles enunciated by the French
delegation.

2491. The UNICE delegation drew the Committee's attention
to the fact that after the end of the transitional period
there would be numerous changes of place of business.
The Committee had just agreed that a change of place of business
within the Contracting States should not constitute a ground
for deletion. One was therefore entitled to ask how national
central offices would be able to exercise any control over
representatives who had received certificates from them.

2492. The Chairman suggested that the Committee first of all
settle the problem raised by the United Kingdom delegation,
on the grounds that it gave rise to the least difficulty. He noted
that the Committee had agreed that an addition be made to
Rule 107, whereby professional representatives who had been
entered on the list during the transitional period and
subsequently deleted as a result of the withdrawal of the
certificate from the national authorities, could be re-instated. If
the conditions for withdrawal did not apply during the
definitive period, it should be possible to restore representa-
tives to the list without obliging them to take the qualifying
examination. The Chairman proposed that discussion on the
point of principle be held over.

2493. At a later meeting, the Chairman stated that on the
basis of the arguments put forward by the UNION and FICPI
delegations, he had reached the conclusion that the view that
the certificate furnished by the national authorities should be of
no further consequence following the transitional period so far
as entry on the European list of professional representatives
was concerned appeared to be justified. Accordingly, it was his
opinion that during the definitive period deletion from the list
could be based on the grounds laid down in Article 134 or Rule
103.

2494. The Committee agreed to this interpretation and
delegated the responsibility for finding an appropriate wording
to the Drafting Committee.

2495. The FICPI delegation asked the Committee whether it
felt that it was really necessary that provision should be made
during the transitional period for such a direct link between the
national certificate and entry on the European list of professional
representatives. In this connection the FICPI
delegation pointed out that difficulties would arise as a result of
variations in national rules on the matter, to the extent that
during the transitional period professional representatives
would be subject to different obligations if they wished to
remain on the European list.

The FICPI delegation asked whether these difficulties could
not be alleviated by stipulating that the link between the
national certificate and entry on the European list would cease
to apply prior to the expiry of the transitional period as soon as
the institute referred to in Article 134, paragraph 7, had been
set up.

2496. In reply to those comments the Chairman pointed to
the fact that it had been the intention to apply the national
provisions of individual Contracting States during the
transitional period with the very aim of providing an interim
solution pending adoption of common European rules. It
was therefore self-evident that as soon as the measures under
Article 134, paragraph 7, had been implemented, national
provisions on the matter need no longer be applied.

2497. In the course of the examination of the outcome of the
Drafting Committee's discussions (M/142, page 16), the Irish
delegation raised a problem as regards the interpretation of
paragraph 1 (b). This sub-paragraph referred to "further
requirements of the national law ... in respect of the grant of
the certificate". Irish law however stipulated that professional
representatives were obliged to have their place of business
and their residence in Ireland. The Irish delegation therefore
wished to have the assurance that where professional
representatives with a place of business in Ireland established
themselves for example in Munich, there was no obligation
under this rule to withdraw the certificate furnished by the Irish
central industrial property office. The Irish delegation
considered that the scope of paragraph 1 (b) was confined to
circumstances other than changes of residence or place of
business.

2498. The French delegation concurred with this interpreta-
tion, and went on to point out that Rule 107, paragraph 1(a),
referred to the cases covered by Rule 103, paragraph 2. The
latter provision did in fact refer expressly to a representative
being a national of one of the Contracting States and not of the
Contracting State in which he had obtained his certificate. Rule
103, paragraph 2, also referred to a place of business or
employment within the territory of one of the Contracting
States and not within the territory of the Contracting State
which furnished the certificate. Consequently, the French
delegation considered that where a French professional
representative changed his place of business by establishing
himself in another Contracting State, he would continue to fulfil
the conditions referred to in Rule 103 even though the
certificate furnished by the French authorities would be
withdrawn upon his acquiring a place of business in another
Contracting State.

2499. The Chairman pointed out that the Committee was
now faced with the question of principle which it had been
unable to settle when examining Rule 103. With reference to
the example adduced by the Irish delegation, the basic question
in point was whether or not the Irish authorities were obliged
to withdraw the certificate. Under Rule 103 it should not be
possible to withdraw the certificate since the professional
representative would retain his place of business or
a representative gave up his place of business in his country of origin in order to establish himself in one of the States where proceedings before the European Patent Office took place. In such circumstances, the certificate of the national office was no longer valid, since the person concerned no longer had his place of business within the territory of the State concerned. The United Kingdom delegation's proposal sought to ensure that as a result the person concerned was not deleted from the list.

2472. The Chairman supported this view and suggested that the Committee include a provision to this effect in the new Rule 107.

2473. The UNION delegation thought that it should be clearly specified that Rule 107 was applicable only during the transitional period, and that the loss of the qualification to act as a representative after the end of the transitional period in the country of origin would not entail deletion from the list.

2474. The Chairman said that at first sight this last consequence did not appear to be in keeping with the system envisaged. His interpretation was that persons who were entered on the list during the transitional period under Article 162 were subject in the same way, during the definitive period, to the special arrangements provided for in Article 162, which authorised them to act as representatives at European level because they were so authorised at national level. If they ceased to be so qualified at national level, they should be deleted from the European Register.

2475. The UNION delegation said that this interpretation seemed to entail unacceptable consequences. Firstly, if qualification were acquired during the transitional period, there was no reason why it should be lost subsequently. Secondly, this interpretation introduced discrimination as regards European representatives on the list after the end of the transitional period. Finally, insoluble problems would be encountered when an attempt was made to organise a disciplinary authority at European level by implementing Article 134, paragraph 7. It would in fact be impossible to draw up a single set of disciplinary rules, since some representatives would remain subject to their national rules.

2476. The FICPI delegation supported the UNION delegation's view.

2477. Detecting a source of conflict, the Chairman invited the Governmental delegations to state their views on this question.

2478. The French delegation said that it had understood the present rules to mean that once representatives had been entered on the list, they would all be treated in the same way, so it did not seem fair that the qualification of these representatives to act before the European Patent Office should be dependent on what happened at national level.

2479. It seemed to the Chairman that a distinction should be drawn between the transitional period and the time thereafter. During the transitional period, the link between national and European qualification was established by the present texts, since the basis for entry on the European list was constituted by the national certificate under Article 162, paragraph 2. The problem arising was whether a person deleted from the national list during the transitional period should be automatically deleted from the European list.

2480. The United Kingdom delegation agreed with the Chairman's interpretation of the transitional period. On the other hand, as regards the definitive period, the United Kingdom delegation thought that the only body to decide on the deletion of representatives should be the one provided for in Article 134, paragraph 7. Deletion at national level did not seem necessarily to entail deletion at European level. In support of this interpretation, the United Kingdom delegation pointed out that the opposite interpretation would cause grave injustice, particularly in the case of a representative who had practised for five years during the transitional period on the basis of a national certificate, and who ceased to benefit from this certificate as a result, for example, of practising his profession in a third country. If such a person returned to practise his profession in the European procedure and the transitional period had in the meantime expired, it did not seem natural to make him take the qualifying examination.

2481. The Netherlands delegation supported the Chairman's view in principle, but wondered whether a solution would not have to be found to the problem brought up by the United Kingdom delegation: it ought to be possible to re-enter on the list a representative who had been on it for a certain period and had subsequently been deleted from it on grounds such as those mentioned by the United Kingdom delegation.

2482. The Chairman said that there were two different situations. The first, brought up by the United Kingdom delegation, was where a representative had been entered on the list of European representatives during the transitional period on the basis of the national certificate and then relinquished the national certificate, for example where he had established his place of business outside the territory of the Contracting States. If, after the expiry of the transitional period, this person were to establish himself once more within the territory of one of the Contracting States, it would appear to be in accordance with the system to agree to his reinstatement on the list. If the present texts did not offer this possibility, the Committee should insert an appropriate provision. The second situation involved a question of principle which went beyond the possibility described above. This question of principle was the problem whether those who had been entered on the list during the transitional period on the basis of a certificate issued by the central authority would, during the definitive period, lose their qualification to act as representatives before the European Patent Office if the national authority withdrew that certificate.

2483. The Swiss delegation said that on this last point it subscribed to the Chairman's interpretation. It had understood Article 162, paragraph 7, to mean that entry on the European list was linked with the issue of a national certificate. Any other interpretation would mean that of the representative who had been entered on the list on the basis of a national certificate and who had not practised his profession regularly during the definitive period would remain on the list of European representatives for the rest of his life. Such a conclusion did not appear to be justified. The Chairman's interpretation seemed to follow from paragraph 7, where two exceptions were specified, namely that representatives were not obliged to take the European qualifying examination, and that they need not have the nationality of one of the Contracting States. It followed that the other conditions, to which no exceptions were specifically permitted, had to be fulfilled.

2484. The delegation of the Federal Republic of Germany supported the view of the Swiss delegation.

2485. The United Kingdom delegation said that it had never interpreted this Article in that fashion. Once the transitional period had come to an end, anyone entered on the list on the basis of a national certificate should remain on the list as of right and all links with the past should be severed. Any other interpretation would, for example, require the institution of a system for the annual issue of national certificates, which would be absurdly costly.

2486. The French delegation declared its complete agreement with the view expressed by the United Kingdom delegation. It pointed out, furthermore, that during the definitive period, representatives on the European list would in all probability also be qualified to act before the national industrial property office. Article 134, paragraph 7, did not
2454. The Chairman pointed out that the representatives referred to in Article 162 were entered on the basis of certificates furnished by the central industrial property offices of the appropriate States. Such representatives must be deleted in accordance with Rule 107 when the grounds for such certificates no longer existed, namely when the persons concerned could no longer exercise their profession as representatives in accordance with their national law.

2455. The delegation of the Federal Republic of Germany thought the difficulty was to distinguish between the two cases. It therefore seemed advisable to add a provision to Rule 103 to the effect that representatives entered on the list under Article 162 would be subject to the conditions for deletion laid down in Rule 107.

2456. The Chairman explained to the Committee the possible form of the new Rule 103 resulting from these discussions. The present Rule 103 would become paragraph 1. Paragraph 2 would consist of the proposal by the delegation of the Federal Republic of Germany, subject to the complementary proposal by the Finnish delegation. A new paragraph 3 would provide that a professional representative would be re-entered on the list upon request as soon as he satisfied the conditions laid down in Article 134, paragraph 2, once again. A new paragraph 4 would provide that the representatives to whom Rule 107 applied could also be deleted under that Rule.

2457. The COPRICE delegation referred to the possibility of deleting a representative as a result of loss of place of business or employment within the territory of a Contracting State, and said that a distinction should be made between independent representatives and those in salaried employment. The situation of representatives in salaried employment was more delicate in that they could lose their employment and then not exercise their profession, even for a considerable period of time. The problem was therefore to establish at what stage the European Patent Office would have to decide to delete the person concerned.

2458. The Chairman noted that, subject to an examination of the Finnish delegation's proposal, the Committee agreed to the new form of Rule 103 as described above.

He therefore proposed that the Finnish delegation's proposal be discussed. It covered two possibilities, the second of which was already dealt with by Rule 107. The Committee therefore had to consider the case where a decision by a national court disqualified a person from acting as a professional representative before the European Patent Office. The Chairman wondered whether such a situation was possible in practice, since there were some doubts whether a national court was competent to decide whether a person could act as a representative before the European Patent Office. A decision of this nature would appear to be the preserve of the body provided for in the last paragraph of Article 134.

2459. The United Kingdom delegation subscribed to the opinion expressed by the Chairman, since it did not think that provisions concerning a matter which should be decided by the body provided for in Article 134, paragraph 7, ought to be included in the Implementing Regulations.

2460. The Finnish delegation declared itself satisfied with the remarks made by the Chairman and withdrew its proposal.

2461. The FICP1 delegation thought that a final decision on this Rule should be postponed until the Committee had considered Rule 107.

2462. The Chairman noted that subject to this reservation the Committee agreed to the new version of Rule 103.

2463. When examining the results of the Drafting Committee's proceedings (M/142, page 15), the Committee agreed, in support of a comment made by the Austrian delegation, that where the institute referred to in Article 134, paragraph 7, decided to introduce grounds for deletion other than those laid down in the Implementing Regulations, it would be for the Administrative Council to amend paragraph 2 of this Rule accordingly.

2464. During that examination, the Chairman put to the Committee the question whether the text produced by the Drafting Committee covered the decisions taken by the Committee or whether a sentence should be added to paragraph 3 stipulating that Rule 107, paragraph 4, should also apply after the end of the transitional period.

2465. The French delegation did not think that such an addition was necessary. First of all, paragraph 1 of that Rule stated that it was applicable to any "professional representative", regardless of his origins. Secondly, paragraph 1 of Rule 107 stipulated that that rule was only valid for the duration of the transitional period. The French delegation therefore thought that the present texts made it sufficiently clear that as regards deletion after the transitional period all representatives would be treated in the same way.

2466. The delegation of the Federal Republic of Germany was also of the opinion that the possibility referred to by the Chairman was already covered by the present wording on the grounds that Article 162, paragraph 7, provided that after the expiry of the transitional period persons whose names had been entered on the list of professional representatives during that period should be entered on it again, provided that they fulfilled the requirements of paragraph 1 (b), which referred to the place of business or employment alone.

2467. The Committee subscribed to this interpretation.

Rule 107 (106) — Withdrawal of the certificate enabling a representative to be entered on the list

2468. The Committee examined the French delegation's proposal, as given in M/112, page 4, that this Rule be deleted.

2469. The French delegation said that as a result of the discussions of Rule 103, and in particular the clarifications given by the Chairman, it had decided to withdraw its proposal for the complete deletion of this Rule. Instead, it would prefer Rule 107 to be amended to provide that the withdrawal of the certificate by the central industrial property office would be effected in the same circumstances and for the same reasons as those enumerated in Rule 103 for the definitive period.

2470. The Chairman said that as a result of the amendments made to Article 162 by the Committee, entry on the list during the transitional period required fulfilment of the following three conditions: the nationality of one of the Contracting States, a place of business or of work within the territory of one of the Contracting States, and the qualification to act before the national patent office.

Rule 107, which was intended to lay down the grounds for deletion from the list during the transitional period covered only the third of those conditions at present. In fact, the withdrawal of national qualification, under the appropriate national law, resulted in the professional representative's being deleted from the list of professional representatives before the European Patent Office.

The Committee had therefore to decide whether this Rule should be extended to include the two other conditions mentioned in Article 162. Furthermore, it should be provided that where these conditions were again fulfilled, the person concerned was entitled to reinstatement on the list.

The Chairman asked the Committee whether it could agree to this approach, which also took account of the United Kingdom delegation's proposal as given in M/64.

2471. The United Kingdom delegation said that the intention of its proposal was to cover another eventuality as well, where
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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
Amendment of the list of professional representatives during a transitional period

(1) During the transitional period provided for in Article 163, paragraph 1, the central industrial property office shall withdraw a certificate furnished in accordance with Article 163, paragraph 2:

(a) in the cases referred to in Rule 162, paragraph 2;

(b) if any requirements of the national law of the Contracting State concerned in respect of the grant of the certificate are no longer fulfilled.

(2) The central industrial property office shall inform the European Patent Office of the withdrawal of the certificate. The European Patent Office shall thereupon automatically delete the entry of the professional representative from the list of professional representatives, except where Article 163 paragraph 4(b) or paragraph 5 is applied.

(3) The provision of Rule 162, paragraph 1, shall apply mutatis mutandis.

(4) A person whose entry has been deleted shall, upon request, be re-entered in the list of professional representatives if he supplies a certificate furnished by the central industrial property office stating that the conditions for the withdrawal of the certificate under paragraph 1 no longer exist.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/146/R 11
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Implementing Regulations: Rules 83 to 106
Rule 107

Amendment of the list of professional representatives during a transitional period

(1) During the transitional period provided for in Article 162, paragraph 1, the central industrial property office shall withdraw a certificate furnished in accordance with Article 162, paragraph 2:

(a) in the cases referred to in Rule 103, paragraph 2;

(b) if any further requirements of the national law of the Contracting State concerned in respect of the grant of the certificate are no longer fulfilled.

(2) The central industrial property office shall inform the European Patent Office of the withdrawal of the certificate. The European Patent Office shall thereupon automatically delete the entry of the professional representative from the list of professional representatives, except where Article 162, paragraph 4(b) or paragraph 4a is applied.

(3) The provisions of Rule 103, paragraph 1, shall apply mutatis mutandis.

(4) A person whose entry has been deleted shall, upon request, be re-entered in the list of professional representatives if he supplies a certificate furnished by the central industrial property office stating that the conditions for the withdrawal of the certificate under paragraph 1 no longer exist.
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 27 September 1973

M/ 142/I/R 13

Original: English/French/German

TEXTS DRAWN UP BY

THE DRAFTING COMMITTEE OF MAIN COMMITTEE I

AT THE MEETING ON 27 SEPTEMBER 1973

Articles of the Convention:

Articles 59

162

Rules of the Implementing Regulations:

Rules 51

69

70

73

85

89

91

97

100

103

107


Articles 3

6

Recommendation on preparations for the opening of the European Patent Office

Decision on Training Staff for the European Patent Office
Article 162:

Insert the following new paragraph between paragraphs (4) and (5):

"The President of the European Patent Office may in special circumstances grant exemption from the requirement of paragraph 1(a). Exemption shall always be granted for persons whose main occupation at the time up to 5 October 1973 was that of acting as representatives before the central industrial property office of a Contracting State."

Article 162, paragraph 6:

Add the following:

"This provision shall not affect the applicability of Article 134, paragraph 3."

Rule 107:

In line 3 between "or" and "has" insert "for reasons other than change of place of business or employment".

Rule 107:

Add the following paragraph:

"If a representative ceases to fulfil the condition of Article 162, paragraph 1(b)*, the European Patent Office shall suspend him from the list provided for in Article 134, paragraph 1. If at a later time, before or after the expiry of the transitional period provided for in Article 162, paragraph 1, the representative again fulfils the condition of Article 162, paragraph 1(b)*, he shall have the right to be re-entered without having to take the European Qualifying Examination."

* Article 162, paragraph 1(a) of present text.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 20 September 1973
M/115/I
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: CNIPA, FICPI and UNEPA

Subject: Joint recommendation for Articles 133, 134 and 162 of the Convention and for Rule 107 of the Implementing Regulations
Article 162 (continued)

before the central industrial property office of the Contracting State in which they exercise their profession.

(7) Unchanged

IMPLEMENTING REGULATIONS

Rule 103

Provisional or definitive deletion
of the professional representative
from the list

(1) Upon his own request, the professional representative shall be deleted provisionally or definitively from the list provided for in Article 134, paragraph 1.

(2) A professional representative who ceases to have his place of business or place of employment within the territory of one of the Contracting States shall be deleted from the list provided for in Article 134, paragraph 1. Upon his own request, he shall automatically be re-entered on this list as soon as he again satisfies the conditions of Article 134, paragraph 2(b), or of Article 162, paragraph 1(a), as amended above.

Rule 107

- deleted -

M/112/I kin/HM/mb
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 20 September 1973

M/112/I

Original: French

CONFEREECE DOCUMENT

Drawn up by: French delegation

Subject: Representation - Articles 133, 134 and 162 - Rules 103 and 107
Article 144  Professional representation before special departments

The group ... States. They may also provide that the Contracting States referred to in Article 133 shall be limited to the Contracting States of the group.

Rule 43  Late-filed or missing drawings

(1) If ... withdrawn the drawings: any references to them in the application shall be deemed to be deleted.

(2) and (3) Unchanged

Rule 55  Content of the appeal

(1) The notice of appeal shall contain:

(a) Unchanged

(b) Unchanged

(2) The statement of grounds shall contain the grounds on which the amendment or cancellation of the decision is requested.

Rule 107  Withdrawal of the certificate enabling a representative to be entered on the list

The ... does not fulfil or, for reasons other than change of place of business or employment to the Federal Republic of Germany or Netherlands, has ceased to fulfil ... Article 134, paragraph 1.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973
M/64/I
Original: English

CONFERENCE DOCUMENT

Drawn up by: United Kingdom delegation
Subject: Further proposals for Articles 107, 108, 120, 130, 133, 144 of the Convention and for Rules 43, 65 and 127 of the Implementing Regulations
Rule 51 Paragraph 2

The proposal made under No. 34 of the Comment M/21 UNEPA is withdrawn in view of Article 120.

Rule 69 Paragraph 2

The proposal made under No. 35 of the Comment M/21 UNEPA is withdrawn in view of Article 120.

NOTES

1. The greater part of the above proposals is essentially in line with proposals made in Comments delivered by others. However, the above proposals do contain further desirable amendments.

The UNEPA agrees, without further proposal for amendment, with a great number of proposals contained in Comments delivered by others. These are particularly the following proposals:

| Article 67               | M/18 No. 7, 8  |
| Article 86 Paragraph 1   | M/32 No. 16    |
| Article 105 Paragraph 1  | M/14 No. 6     |
| Article 141              | M/14 No. 10    |
| Article 157 Paragraph 2  | M/14 No. 13    |
|                          | M/19 No. 23    |
|                          | M/32 No. 23    |
| Article 162              | M/11 No. 7     |
| Rule 107                 | M/15 No. 15    |
| Rule 108                 | M/15 No. 21    |
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 11 September 1973
M/62/I/II
Original: German/English/French

CONFERENCE DOCUMENT

Drawn up by: Union of European Patent Agents (UNEPA)

Subject: Additional comments
43. Art. 162 (2), (3) and (6). The French government in M/26, points 21-22, pages 32a-1, objects to the term "mandataire agréé" in the French text of Art. 162 (2), (3) and (6), because in many countries there are no regulations governing entitlement to represent and therefore there could not be any "mandataire agréé" on the national level. The French government therefore proposes to cancel the word "agréé". This is of course correct, but it may be considered whether the word "professionelle" should be inserted instead, as in the English text. It should then also be considered whether the word "beruflich" should be inserted in the German text.

44. Art. 162 (7). The UNEPA proposes in M/21, point 21, pages 224-5, to cancel the last part of Art. 162 (7) beginning with the words "without having to ....".

The FICPI does not agree that the passage in question is superfluous because it has in fact been proposed from various quarters at various times that representatives admitted to the list of representatives under the transitional provisions and not having passed a national qualifying examination should take the European Qualifying Examination within a certain number of years as a condition for remaining on the list.

45. 1. Comments and proposals of the FICPI in M/15.

These previous comments and proposals are not affected by the present memorandum, except (marginally) where expressly referred to above.
35. The FICPI supports the British proposal, but suggests that an express reference should be made in Art. 144 not only to Art. 133 but also to Art. 134.

H. Editorial questions.

36. Art. 134. It is pointed out by the German government in M/11, point 31, pages 68–69, that the term "zugelassene Vertreter" of the German version is not in accordance with the term "professional representatives" of the English version. The German government therefore proposes to change "zugelassene" to "geschäftsmäßige".

37. The same observation is made by the UNICE in M/19, point 25, pages 176–7, the CIFE in M/22, point 43, pages 266–7, and the FEMIPI in M/23, point 4, pages 282–3, but the correction proposed by these organizations is the opposite, viz. to insert a marginal note to the effect that the term "professional representatives" comprises both persons exercising the profession on a self-employed basis and persons working on a salarital basis.

38. In the opinion of the FICPI it is not usual to refer to the profession as "Geschäft", but the FICPI has no objections to the amendment proposed by the German government, if this is considered useful for clarification.

39. As regards the marginal note proposed by the UNICE, the CIFE and the FEMIPI, such an explanation is hardly called for, but at any rate care should be taken not to introduce an interpretation incompatible with the German word "zugelassene" which means persons entitled to represent parties other than their employer.

There might of course alternatively be a possibility of finding an English expression corresponding to "zugelassene", e.g. "licensed", "recognized" or "acknowledged".

41. Art. 134 (3). The German government proposes in M/11, point 32, pages 68–69, to cancel Art. 134 (3). The CNIPA in M/20, point 30, pages 208–9, makes a similar observation but points to the possible significance of Art. 134 (3) as applicable to persons mentioned in Art. 162 (6). In this connection the attention is drawn to the proposal of the FICPI in M/15, points 31–32, pages 118–9, where it is proposed to add at the end of Art. 162 (6)

"The provision shall not affect the applicability of Art. 134 (3)."

42. This proposal thus depends on the maintenance of Art. 134 (3), and if the latter is cancelled, its substance should therefore preferably be taken up in Art. 162 (6). But why not leave things as they are? It is also observed that if Art. 134 (3) is amended as proposed by the FICPI in M/15, point 27, pages 116–7, it will no longer be superfluous in respect of Art. 134 as such.
would positively prescribe the adoption of provisions regarding group representation by the Administrative Council if no such provisions are adopted by the Diplomatic Conference itself, and the possibility that there may be found no need for such provisions is left out of consideration. In the opinion of the FICPI it is preferable to leave the matter entirely to the Administrative Council, as in the official text, because the adoption of provisions for which there is no need, or extending beyond the needs which may be found to exist, just because of a prescription in the Convention, would be regrettable. If the question of group representation is left to the Administrative Council, this will be just one of the many points on which we shall all have to trust the Administrative Council for competence and fairness if the European Patent Convention is to work at all.

The CEEP in M/3a, point 21, page 6 (not included in the printed volume) does not make any precise proposals, but urges that Art. 133 (3), second sentence should be extended so as also to deal with the representation of legal persons not having their registered place of business within the territory of one of the Contracting States, but having economic links with such legal persons. In this respect, the CEEP goes further than the UNICE, the CIFE and the FEMIP1. Such an extension must be opposed by the FICPI, because it would come very close to a complete undermining of the fundamental provisions of Art. 133 (2) and 134 (1).

F. Art. 162 (8) – new paragraph.

The German government proposes in M/11, point 6, pages 56-57, to adopt a new paragraph (8) to Art. 134 prescribing that if a person whose name appears on the list of professional representatives repeatedly and seriously infringes the laws of the Federal Republic of Germany or of the Netherlands, the competent authorities of these States shall be authorized, after consulting the President of the European Patent Office, to deprive such person of the right to establish a place of business pursuant to paragraph 4.

The FICPI agrees that there should be such a sanction, but would prefer to have it adopted as an express item of the disciplinary measures laid down in Rule 108 as proposed by the FICPI, if it is found that the situation is not already covered by the proposed Rule 108.

G. Proposals of the British government and the CNIPA in respect of Art. 144.

It has been suggested by the British government in M/10, point 9, pages 44-45, to extend Art. 144 so as also to apply to representatives referred to in Art. 133 (3). A similar observation is made by the CNIPA in M/20, point 28, pages 208-9.
Probably, the reason of the Intergovernmental Conference for leaving this question to the Administrative Council was that it is difficult to determine at the present time, what the need will be for group representation through persons not on the list in order to make it possible for the patent departments of industries to continue their activity. As long as this need cannot be determined, it is extremely difficult to draw up a provision covering that need, but not going beyond it. The proposal of the UNICE and the CIFE for Art. 161 bis is in fact a very good illustration of that difficulty.

It seems in fact probable that the patent departments conducting group representation to-day would have no difficulty in immediately getting a sufficient number of employees on the list of representatives in order to continue group representation without any change of their manner of operation. They would probably have ample opportunities of supplementing by employing people already on the list, and as soon as the European Qualifying Examination is established the employees of patent departments would have the same opportunity as persons in the free profession of being entered on the list by taking that examination, whereafter they could conduct group representation at their pleasure. It therefore may well be that the need for group representation through persons not on the list will be very small. The experience under the systems of the U.K. and the Netherlands seems to indicate that patent departments of industries may very well thrive without group representation through employees not on the list. The organizations of industries have not supplied any analysis of the needs for such group representation and have not succeeded in proposing workable provisions allowing for such group representation.

Therefore, it seems as if the possibilities of the Diplomatic Conference to determine the needs for group representation through persons not on the list and drawing up provisions in accordance therewith are just as small to-day as they were at the time when the Intergovernmental Conference decided to leave the question to the Administrative Council, so it is probably better to leave things as they are.

If, however, the Diplomatic Conference should decide to formulate definitive rules for group representation through persons not on the list, then it goes without saying that Art. 133 (3), second sentence would have to be cancelled, though this has not been pointed out by the UNICE and the CIFE.

The FEMIPI has not made any proposals similar to Art. 161 bis, but in M/23, point 10, pages 286-7, proposes to amend Art. 133 (3), second sentence so as to provide that the Implementing Regulations shall determine on which conditions group representation (through persons not on the list) shall be permissible. In this form, Art. 133 (3), second sentence,
"acquired rights" or "vested rights", and since the English translation was furnished by the CIFE itself, it seems as if the CIFE makes no distinction between "existing rights" and "acquired rights".

However, such a distinction has to be made, because the European Patent Convention obviously could not and should not respect all existing rights. E.g. the whole population of most of the Convention countries (all those where there are no regulations governing entitlement to represent) are to-day entitled to represent any party before their national patent offices, and this right is taken away from them on the European level by the Convention and is only maintained for the small number of them who have exercised the right for at least five years.

Now, analyzing the provision proposed by the CIFE (and identically proposed by the UNICE in M/19, point 41, pages 184-5), it will be noted that this amounts to a statement of certain existing rights, with no requirement that these rights should have been exercised and thereby have become acquired rights.

Besides, the provision, as formulated by the UNICE and the CIFE, is so broad that it says in fact that in countries where there are no regulations governing representation, any person who is an employee of a legal person should be entitled to represent any other legal person having its seat within any of the Contracting States before the European Patent Office, no matter whether the two legal persons have any connection with one another, no matter whether his employment has anything to do with patents, and no matter whether he has ever tried to act in patent matters before. E.g. a French postman would be entitled to represent a Norwegian company before the European Patent Office. A French patent expert who happens not to be an employee of a legal person would not be so entitled, unless he could prove that he had habitually acted as a professional representative for at least five (5) years. Naturally, it has not been the intention of the organizations that the provision should be interpreted to have this breadth, but the interpretation is incontestable.

If a transitional provision regarding group representation has to be adopted, the proposal of the two organizations would therefore at least have to be supplemented by statements as to the existence of economic links between the legal persons, and the exercise of the relevant right of representation before the entry into force of the Convention, or even before the signing of the Convention.

However, in the opinion of the FICPI it is not true that "the present right that in some States companies have to represent other companies has been forgotten", seeing that Art. 133 (3), second sentence, has been adopted by the Intergovernmental Conference exactly to take care of that right to the extent that it exists as an acquired right.
D. Proposals of various parties in respect of Art. 162 (7).

12. The UNICE in M/19, point 4a, pages 182-3, and the CIFE in M/22, point 44, pages 268-9, propose to provide in Art. 162 (7) that if a person has been entered on the list of professional representatives with restrictions on his entitlement to act, these restrictions should automatically be lifted at the end of the transitional period.

13. The FEMIPI in M/23, point 12, pages 290-1, also proposes such lifting of the restrictions, but subject to the condition that the qualifications of the representative have been recognized by the certificate furnished by the central industrial property office pursuant to Art. 162 (2) and (3).

The CEEP in M/3a, point 28, page 7 (not included in the printed volume) proposes that the restrictions should remain unchanged after the transitional period.

15. The German government in M/11, point 7, pages 56-57, proposes that the restrictions should be lifted not only during the transitional period, but also after the transitional period if the restrictions are lifted on the national level.

16. The proposals of the UNICE, the CIFE and the FEMIPI suffer from the drawback that situations may occur where a representative, by the mere expiry of the transitional period, will obtain more comprehensive rights of representation before the European Patent Office than he has before his national patent office, which will constitute an improper interference with established national regulations and institutions, particularly so when the amendment proposed by the organizations is seen in conjunction with the proposals of these organizations in respect of Art. 162 (1) (b) and (3). Besides, the proposals of the three organizations obviously go beyond the principle of acquired rights.

17. On the other hand, the proposal of the CEEP seems to be too restrictive.

18. The proposal of the German government seems to be well balanced and fair and is fully supported by the FICPI.

E. Art. 161 bis proposed by the UNICE and the CIFE, and other proposals pertaining to group representation.

19. The CIFE in M/22, point 45, pages 268-9, points to the desire of the Conference of Experts to respect during the transitional period existing rights and situations without extension or reduction, and then in point 46 goes on to say that in this context the present right that in some states companies have to represent other companies has been forgotten.

20. The term used in the French text of the CIFE comment is "droits acquis" and in the German text "erworbene Rechte". The correct English translation of that would have been
concerned, whether inventors or enterprises not having a patent department, or the patent
departments of industries.

But until the time when this goal can be achieved, compromises must be accepted.
There must be representatives available to applicants right from the beginning in all Con-
tracting States including those where there is not even any possibility of checking their
qualifications on the national level (5 years of practice under Art. 162 (3) is of course no
guarantee of qualification). Patent departments of industries must be able to continue their
activities under the new system. People who have made it their living to handle patent work,
must not be deprived of the possibility of continuing their professional existence under the
new system.

In order not to jeopardize the achievement of the final goal of Art. 134, the
transitional provisions should go no further than necessary for serving the needs specified
above. They should not be taken as an alternative method of determining with any degree of
certainty who is competent and who is not, or who is more competent than whom.

C. Proposal of the FEMIPI for a new Art. 162 (2).

It is not at all a bad idea to add a special paragraph dealing with the countries
where representation is governed by national regulations, as proposed by the FEMIPI in M/23,
point 12, pages 288-9. It is observed, however, that owing to the ambiguity of the word "act",
as used by the FEMIPI, it is unclear to which countries, if any, paragraph (2) as proposed by
the FEMIPI would be applicable. On the other hand, the proposed provision is too strict in
specifying the passing of a special qualifying examination as an absolute requirement. If a
country recognizes, or during a transitional period has recognized, other evidence of qualifi-
cation as equivalent to the passing of a qualifying examination, this must be respected for the
purpose of admission to the European list of representatives.

In fact, a provision of the type wanted by the FEMIPI could be quite simple, e.g. as follows (taking the official version of Art. 162 (1) and (2) as the point of departure):
"(2 bis). When, in any Contracting State, entitlement to act as a professional
representative before the central industrial property office of that State is
conditional upon the requirement of special professional qualifications, the
certificate furnished by the central industrial property office must indicate
that the applicant fulfils this requirement."
clearly constitute an improper interference with established national regulations and institutions.

4. Therefore, the FICPI must oppose the amendment to Art. 162 (1) (b) and 162 (3) proposed by the UNICE and the CIFE and must maintain that Art. 134 and therefore also Art. 162 must be understood as dealing with entitlement to represent natural and legal persons of which the representative is not an employee (which of course does not exclude that such a representative may be an employee provided that he has a broader entitlement to represent).

B. Proposal of the FEMIPI in respect of Art. 162 (1) (b) and (3).

What has been said about the proposals of the UNICE and the CIFE, also applies to those of the FEMIPI in M/23, point 12, pages 288-9, but the FEMIPI has further extended the concept of "acting". In the FEMIPI version of Art. 162 (1) (b) "acting* need no longer be "before the central industrial property office", but may be any form of "acting in patent matters", and Art. 162 (3) as formulated by the FEMIPI even expressly refers to "acting in patent matters in some other manner". It seems as if this could mean anything and probably extends much further than visualized by the FEMIPI. It could include persons who have never had anything to do with the preparation, filing and prosecution of patent applications, e.g. persons dealing only with patent policy and the commercial exploitation of patents, patent brokers, inventors or research people who take an active part in the patenting procedure but have their actual patent work handled by professional representatives, persons who have specialized on the collection and dispatch of filing orders for exotic geographical areas, persons who conduct watch and search services in the patent field, etc. It is recognized that the proper conduct of many of these activities may require high actual qualifications, but such activities are completely unaffected by the Convention and therefore need not be considered in the Chapter on representation before the European Patent Office.

6. It should be remembered that it is not the object of the transitional provisions on representation to classify people according to actual qualifications and to reward them accordingly, but just to make the exceptions to Art. 134 strictly necessary for the running-in period of the European Patent System.

7. By Art. 134 it is the clear intention of the Convention to provide for the establishment of a profession offering the maximum possible guarantees of qualified services to everybody

*) oddly enough the German translation, which has apparently not been made by the FEMIPI itself, uses the word "Vertretung", which is an example of the fragility of the "acting/representing" distinction.
DRAFT

MEMORANDUM A

on

Representation before the European Patent Office

for presentation to the Munich Diplomatic Conference.

A. Proposals of the UNICE and the CIFE in respect of Art. 162 (1) (b) and 162 (3).

The main feature of the proposal of the UNICE and the CIFE for an amended version of Art. 162 is that they have transferred the word "agir" from the official text of Art. 133 (3) (French version), dealing with the instances where representation by a person on the list of Art. 134 is not required, to Art. 162 dealing with persons on that list. In the English translation furnished by the CIFE, the word "act" is used for "agir". In the German translation not furnished by either of the organizations, the word "auftreten" is used, but it can be taken for granted that this is intended to have the same significance as the word "handeln" used in the official text of Art. 133 (3), thus referring to the instances where representation by a person on the list of Art. 134 is not required. Also the word "act" used in the English translation of the UNICE-CIFE proposal will therefore be taken to have that significance.

The declared purpose of the amendment is, according to M/22, point 44, second paragraph, pages 266-7, to obtain a clarification which only concerns those countries where the choice of representative is free. It is doubtful, however, whether the amendment is in fact so limited, or will also extend to countries where the choice of representative is not free, i.e. where there are regulations governing representation. That will be the case if "acting" is to be interpreted as including "acting on behalf of an employer, and nobody else" (and if that is not the intended interpretation, what else could it be?).

It should not be forgotten that there are countries having regulations governing representation but where an employee can nevertheless always act on behalf of his employer. Examples of such countries are Germany and Austria, and there may be others. Now, if "acting" is to be understood as stated above, the condition of Art. 162 (1) (b) as formulated by the UNICE and the CIFE will be fulfilled by the whole population of Germany and Austria, and Art. 162 (3) will apply to these countries with no consideration whatsoever for the national rules governing representation. That is against the declared intention of the CIFE and would
Attached are:

Memorandum A  on representation before the European Patent Office,
   Art. 133, 134, 144, 162, Rules 103, 107.

Memorandum B  on evidence of transfer of the inventor's right,
   Art. 58, 79, 90, Rules 14, 42.

Memorandum C  on multiple priorities and partial priorities,
   Art. 86.

Memorandum D  on withdrawal of the European patent application,
   Art. 58, Rules 14, 49.

Memorandum E  on extension of periods, Rule 85, as related to
   language problems, Art. 14 (4) and Rule 6 (2).
MUNICH DIPLOMATIC CONFERENCE

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

- 1973 -

Munich, 10 September 1973
M/ 48/I
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: FICPI

Subject: Memoranda on:

- representation
- evidence of transfer of the inventor's right
- multiple priorities and partial priorities
- withdrawal of the European patent application
- extension of periods as related to language problems
31. Rule 97  In paragraph 2, "entry" should be amended to read "publication".

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

PROTOCOL ON RECOGNITION OF DECISIONS (M3)

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

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

PROTOCOL ON PRIVILEGES AND IMMUNITIES (M4)

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

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

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

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

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

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

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

- 1973 -

Brussels, 13 August 1973
M/40

Original: English

PREPARATORY DOCUMENT

Drawn up by: The United Kingdom Government

Subject: Proposed amendments concerning the Draft Convention, the Draft Implementing Regulations, the Draft Protocol on Recognition and the Draft Protocol on Privileges and Immunities
und Verurteilung wegen einer Straftat schließen die Ausübung der Vertretung aus und sind beispielsweise Gründe für die Löschung in der Liste.

Artikel 134 – Regel 107


Artikel 141

35 Da der genaue Termin der Erteilung nicht mit Bestimmtheit vorausgesagt werden kann, entsteht ein Problem, wenn er auf einen Tag fällt, der nahe am Jahrestag der europäischen Patentanmeldung liegt. Es wird empfohlen, den nationalen Behörden zu untersagen, Jahresgebühren, die innerhalb von drei Monaten nach der Erteilung fällig werden, vor Ablauf von drei Monaten nach der Erteilung zu erheben.

Artikel 162 Absatz 2

36 Es wird empfohlen, die gleiche Bedingung wie nach Artikel 134 Absatz 2 Buchstabe a vor den Artikel 162 Absatz 1 Buchstabe a einzufügen. Ferner sind ähnliche Ausnahmen wie nach Artikel 134 Absatz 5 erforderlich. Es wird nicht gewünscht, vorhandene Kollegen zu diskriminieren, sondern die Erfordernisse des Artikels 134 Absatz 2 Buchstabe a so früh wie möglich zur Anwendung zu bringen. Dementsprechend sollten Ausnahmen im Falle von Vertretern vorgeschrieben werden, die die Bedingungen für die Eintragung in die Liste zum Zeitpunkt der Unterzeichnung des Übereinkommens erfüllt haben.

Artikel 162 Absatz 2

37 Es ist nicht klar, worauf sich das Wort „Umfang“ bezieht. Bezieht es sich auf Gruppen oder Kategorien von Anmeldern, für die er handeln kann, auf die Abteilungen der Zentralbehörde für den gewerblichen Rechtsschutz, vor denen er auftreten kann, oder auf die Anzahl der Anmeldungen, die er einreichen kann? Es wird empfohlen, daß dieser Absatz sowie Artikel 162 Absatz 6 die Anwendbarkeit des Artikels 134 Absatz 3 nicht beeinträchtigen dürfen.

rendering unfit to represent are examples of reasons for such removal.

Article 134 – Rule 107

34 To prevent unfair removal, it is recommended that, in line 3 between “or” and “has”, there be inserted the words “for reasons other than change of place of business or employment”.

Article 141

35 As the exact date of grant cannot be accurately predicted, there is a problem when it falls close to the anniversary date of the European patent application. It is recommended to deny to national authorities the right to collect renewal fees falling due within 3 months of grant until 3 months from grant has elapsed.

Article 162 (1)

36 It is recommended to have the same condition (a) from Article 134 (2) inserted before Article 162 (1) (a). There is a need for exemptions in a similar manner to Article 134 (5). It is not desired to discriminate against existing colleagues but to make the requirements of Article 134 (2) (a) apply as soon as possible. Accordingly, such exemptions should be mandatory in the case of representatives who fulfilled the conditions for entry at the time of signature of the Convention.

Article 162 (2)

37 It is not clear to what “extent” reference is made. Is it to the groups or categories of applicant for whom he can act, the departments of the central industrial property office before whom he can appear, or the number of applications he can file. It is recommended that this paragraph and paragraph 162 (6) should not affect the applicability of Article 134 (3).
STELLUNGNAHME DES

CNIPA
Committee of National Institutes of Patent Agents

COMMENTS BY

CNIPA
Committee of National Institutes of Patent Agents

PRISE DE POSITION DU

CNIPA
Committee of National Institutes of Patent Agents
Sitzverlegungen von Vertretern, denen sie Bescheinigungen ausstellten, zu überwachen.

17 Es wird angenommen, daß durch die Regel 107 tatsächlich beabsichtigt war, Fälle zu erfassen, wonach ein Vertreter seine Vertretungsrechte vor dem nationalen Patentamt aus Gründen wie grob ungehöre Verhaltensweise, strafrechtliche Verurteilung oder Konkurs verliert. In diesem Lichte gesehen, scheint die Regel 107 annehmbar zu sein.

18 Die Möglichkeit, derartige disziplinäre Maßnahmen von der nationalen Ebene auf die europäische Ebene zu verlegen, besteht immerhin nicht mehr für Vertreter, die gemäß den endgültigen Bestimmungen des Art. 134 eingetragen wurden; weder die Artikel noch die Regeln des Vertrages sagen darüber irgend etwas aus. Tatsächlich hat es sogar den Anschein, daß eine Person das Recht haben würde, in die Liste eingetragen zu werden, wenn sie die Bedingungen des Art. 134(2) entspricht, auch dann, wenn sie sich in Konkurs befand oder eines Verbrechens oder einer ungehöre Verhaltensweise schuldig befunden wurde, minderjährig ist oder wahnsinnig erklärt wurde (Umstände, die nicht notwendigerweise ein Hindernis für das Bestehen der europäischen Patentanwaltsprüfung bilden müßten).

19 Dies ist offensichtlich nicht der beabsichtigte Sinn und es wurde innerhalb der FICPI diskutiert, ob es angezeigt wäre, einige weitere Bedingungen in Art. 134(2) anfügen (der ursprünglich von der FICPI selbst formuliert worden war).

20 Nach weiteren Überlegungen kam die FICPI zu dem Schluß, dem Art. 134(2) keine weiteren Bedingungen anfügen, da es für einen Bewerber um Aufnahme schwierig sein könnte, Beweise über die obengenannten weiteren Bedingungen vorzulegen, und auch deshalb, weil es einfacher ist, solche Bedingungen anpassbar zu machen, wenn sie in Form von durch Art. 134(7) gegebenen disziplinären Maßnahmen in den Regeln enthalten sind.

21 Es wird daher vorgeschlagen, eine neue Regel 108 folgen zu lassen, die etwa wie folgt lauten könnte:

"Regel 108
Wenn ein Vertreter
a) die Bedingungen des Art. 134(2)(a) und (b) vorbehaltlich Art. 134(5) oder Art. 162(1)(a) und (b) vorbehaltlich Art. 162(4a) nicht erfüllt oder
b) nicht berechtigt ist, über sein Eigentum zu verfügen, oder
c) in letzter Instanz eines Vergehens schuldig befunden wurde, das ihn für eine bestimmte Zeit oder für immer ungeeignet erscheinen läßt, ein Vertrauen zu genießen, wie dies einem Vertreter in Patentangelegenheiten zukommen sollte,
repre sentatives to whom they have furnished certificates.

21 It is therefore proposed to add a new Rule 108 reading approximately as follows:

"Rule 108
If a representative
(a) does not fulfill the conditions of Art. 134(2)(a) and (b) subject to Art. 134(5), or Art. 162(1)(a) and (b), subject to Art. 162(4a), or
(b) is not entitled to dispose of his property, or
(c) has been found guilty, without further recourse, of an offence making him unfit, for a limited period or forever, for the confidence which a representative in patent matters should enjoy, the European Patent Office shall refuse to enter the
Vertretung vor nationalen Patentämtern, die europäische Patentanmeldungen für das Europäische Patentamt prüfen

10 Es wird vorgeschlagen, entweder dem Art. 134 oder dem Protokoll M/S einen neuen Absatz etwa wie folgt anzufügen:


11 Im Hinblick darauf, daß gemäß Dokument M/S ein großer Teil der Prüfungsarbeit im Zusammenhang mit europäischen Patentanmeldungen für eine verhältnismäßig lange Zeit durch nationale Patentämter, die bestimmten Bedingungen entsprechen, durchzuführen sein könnten, erscheint eine derartige Bestimmung notwendig.

Streichung von Vertretern aus der Liste

12 Gemäß Regel 107 wird ein Vertreter, der in die Liste kraft einer durch das nationale Patentamt nach Art. 162 ausgestellten Bescheinigung eingetragen wurde, aus der Liste gestrichen, wenn der Vertreter die Voraussetzungen für das Ausstellen der Bescheinigung nicht oder nicht mehr erfüllt.


14 Soweit solche Länder in Betracht kommen, werden die für die Ausstellung einer Bescheinigung erforderlichen Bedingungen nicht mehr erfüllt, wenn der Vertreter seinen Geschäftssitz oder Arbeitsplatz in einen anderen Vertragsstaat verlegt. Der Regel 107 liegt nun kaum die Absicht zugrunde, daß ein Vertreter unter diesen Umständen aus der Liste gestrichen werden sollte.

15 Um dies zu klären, wird vorgeschlagen, in die Regel 107, Zeile 4, zwischen „oder“ und „nicht“ einzufügen „aus anderen Gründen als dem Wechsel des Geschäftssitzes oder Arbeitsplatzes“.

16 Es wird auch darauf hingewiesen, daß man nationalen Patentämtern kaum zumuten kann, mögliche

Representation before National Patent Offices conducting Examination of European Patent Applications on behalf of the European Patent Office

10 It is proposed to add a new paragraph worded roughly as follows either to Art. 134 or to Protocol M/S:

"All provisions of Art. 133 and Art. 134 regarding representation or action before the European Patent Office shall also apply to representation or action before any national office conducting examination of European patent applications on behalf of the European Patent Office, as far as such European patent applications are concerned. Paragraph 4 of Art. 134 shall also apply to Contracting States in which such national offices are located."

11 Such a provision seems to be necessary in view of the fact that under Document M/S a large proportion of the examination work in connection with European patent applications may for a relatively long period be conducted by national patent offices fulfilling certain conditions.

Deletion of Representatives from the List

12 Under Rule 107 a representative who has been entered on the List on the strength of a certificate furnished by a national patent office under the provisions of Art. 162 shall be deleted from the List if the representative does not fulfil or has ceased to fulfil the conditions required for the grant of the certificate.

13 The main condition required for the grant of the certificate by a national patent office is that of Art. 162(1)(b), viz. that the representative must be entitled to represent natural or legal persons in patent matters before the patent office in question. In many countries the entitlement to represent before the national patent office is conditional upon domicile in the country in question (in fact that is frequently the only condition).

14 As far as such countries are concerned, the conditions required for the grant of the certificate will no longer be fulfilled if the representative moves his place of business or employment to another Contracting State. It is hardly the intended meaning of Rule 107 that a representative should be deleted from the List in these circumstances.

15 To clarify this point it is proposed to add in Rule 107, line 3 between “or” and “has” “for reasons other than change of place of business or employment”.

16 It is also observed that national patent offices can hardly be expected to watch possible migrations of
STELLUNGNAHME DER

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

COMMENTS BY

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

PRISE DE POSITION DE LA

FICPI

Fédération Internationale des Conseils en Propriété Industrielle

(1) Deutsche Übersetzung vorgelegt von FICPI
(2) La traduction française a été fournie par la FICPI
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)

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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
Rule 107
Withdrawal of the certificate
enabling a representative to be entered on the list

The central industrial property office shall withdraw a certificate furnished in accordance with Article 162, paragraph 2, if the representative does not fulfil or has ceased to fulfil the conditions required for the grant of the certificate, and shall inform the European Patent Office of such withdrawal. The European Patent Office shall then delete the representative from the list provided for in Article 134, paragraph 1.

Cf. Articles 134 (Professional representatives) and 162 (Professional representatives during a transitional period)
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
Re. Article 171, No. 1 - Deletion of the representative from the list

61. When this provision was adopted, the United Kingdom delegation noted that the application of paragraph 2 and that of Article 171(2) of the Preliminary Draft Convention could not fail to raise serious difficulties in countries in which the power to appoint or to delete patent agents from the list was conferred upon a professional body or organisation. It was agreed that it would be necessary to re-examine these provisions after consulting the interested circles. (See BR/49/70, point 41 et seq.).

Re. Article 173, No. 1 - Authorisations

62. The purpose of this provision is to provide the European Patent Office with proof that a given representative has been regularly appointed and with particulars of the extent of his mandate. So as to simplify the task of the European Patent Office, provision has been made, in all cases where a general authorisation has been granted (and especially in that of compulsorily appointed representatives) for the President to be able to impose the use of a standard form.

Re. Article 173, No. 2 - Time limit for lodging authorisations

63. No comments.

Re. Article 180, No. 1 - Responsibility as regards the opinion of the European Patent Office

64. No comments.

Re. Article 186, No. 1 - Determining the areas of technology

65. No comments.

BR/58 e/70 ett/KGl/fm
MINUTES

of the 4th meeting of Working Party I Sub-Committee

on "Implementing Regulations"

(Luxembourg, 23–27 November 1970)

I.

1. The fourth meeting of the Sub-Committee instructed by Working Party I to draw up draft Implementing Regulations to the Convention was held at Luxembourg, from Monday 23 to Friday 27 November 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 WIPO and the International Patent Institute (1).

(1) See the list of participants in Annex I.
Ad article 171

Numéro 1

Radiation du représentant

(1) Sur sa requête, le représentant est radié de la liste prévue à l'article 171, paragraphe 1 de la Convention.

(2) Le service central de la propriété industrielle procède au retrait des attestations délivrées conformément à l'article 171, paragraphe 2 de la Convention si le représentant ne remplit pas ou cesse de remplir les conditions requises pour la délivrance de l'attestation. Si l'attestation est retirée, l'Office européen des Brevets radie le représentant de la liste prévue à l'article 171, paragraphe 1 de la Convention.
Groupe de travail "BREVETS"

Bruxelles, le 20 janvier 1964
CONFIDENTIEL

VE AO 1964

Avant-projet
de règlement d'application de la convention
relative à un droit européen des brevets
Zu Artikel 171
Nummer 1
Lösung des Vertreters

(1) Der Vertreter wird auf seinen Antrag in der Liste gemäß Artikel 171 Absatz 1 des Abkommens gelöscht.

(2) Die nationale Zentralbehörde für den gewerblichen Rechtsschutz hat eine gemäß Artikel 171 Absatz 2 des Abkommens erteilte Bescheinigung zurückzunehmen, wenn der Vertreter die Voraussetzungen für die Erteilung der Bescheinigung nicht oder nicht mehr erfüllt. Wird die Bescheinigung zurückgenommen, so löscht das Europäische Patentamt die Eintragung des Vertreters in der in Artikel 171 Absatz 1 des Abkommens vorgesehenen Liste.
4419/IV/63-D

Brüssel, den 20. Januar 1964

VERTRAULICH

Vorentwurf

einer Ausführungsordnung zum Abkommen über
ein europäisches Patentrecht
provision was also adopted to authorise the national authorities of the host country to withdraw the right to a place of business for reasons of 'ordre public'.

(d) Deletion from the list of professional representatives

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

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

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

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

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

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

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

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

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

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

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