Article 112 E

Travaux Préparatoires
(EPC 1973)

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

Art112eTPEPC1973
Art. 112
MPO
Entscheidung oder Stellungnahme der Großen Beschwerdekammer

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designated Contracting States. The valid interests of an assumed infringer in the retroactive revocation of the patent may thus be upheld. In this connection it may be noted that this amendment has raised the opposition proceedings another step towards the level of actual revocation proceedings.

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

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

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

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

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

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

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

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

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

The provision in Article 124 concerning the procedure for drawing up supplementary search reports provided a large amount of material for discussion. This Article was deleted. The Committee considered it unnecessary to impose search costs on the applicant in the event of his making necessary an additional search due to an amendment to the claims. This financial problem could be settled by slightly increasing the standard amount of the main search fee. After lengthy discussions the Committee reached the majority decision that additional fees for additional searches which were drawn up outside the procedure for international search reports under Article 156, could be dispensed with, especially since such an additional cost would have an unfavourable visual effect in the Convention. At the same time the Committee stated expressly
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
the applicant filed an appeal against the invitation to pay the additional search fee and then failed to observe a time limit. In such a case, only the appeal should be deemed to be withdrawn.

498. Summing up, the Chairman noted the Main Committee's view that Article 109, paragraph 3, should be restricted to appeals in the proceedings for grant which related to the application.

499. At a later meeting, the Main Committee discussed the following redraft of paragraph 3 submitted by the Drafting Committee:

"If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn".

500. At the request of the Austrian delegation, the Main Committee noted that paragraph 3 was not intended to cover appeals in opposition proceedings; this should be clear from the use of the word "applicant" as against "proprietor of the patent".

501. So that paragraph 3 should not be applied to cases which, in its view, were unjustified — e.g. the refusal of a request for the entry in the European Patent Register of the transfer of rights with respect to the application, the Austrian delegation proposed that it should be supplemented as follows:

"If, in proceedings against a decision of the Receiving Section or the Examining Division in the proceedings for grant, the applicant fails to reply ..." (otherwise unchanged).

502. The Swiss delegation supported the substance of this proposal and suggested that an explicit reference be made to decisions relating to the grant of the patent.

503. The United Kingdom delegation, while recognising that the Austrian delegation had a point, considered that it would be exceedingly difficult to draft paragraph 3 as to cover all appeals against decisions in the proceedings for grant, and to exclude appeals against other decisions. It therefore suggested that, since Article 120 (121) laid down the applicant's entitlement — against payment of a fee — to request the further processing of an application deemed to be withdrawn, there was no need for a detailed enumeration of the appeals to which paragraph 3 would not apply.

504. In principle, the Netherlands delegation supported the United Kingdom delegation's view, but suggested that it should be made clear that the application would not be deemed to be withdrawn if the applicant had filed an appeal against a decision of the Legal Division. It considered that, with this exception, many of the cases which the Austrian delegation justifiably wished to exclude could be excluded in this way, be excluded.

505. The Austrian delegation thought that the Netherlands suggestion would certainly help to improve the version of paragraph 3 proposed by the Drafting Committee, but would not exclude all the cases which should be excluded. By contrast, the reference to the possibility of the further processing of the application under Article 120 was inapposite, since in certain cases it was unthinkable to uphold the view, as far as the applicant was concerned, that his application was deemed to be withdrawn, and these cases therefore had to be excluded a priori.

506. The Main Committee then put the Austrian proposal to the vote, as the most far-reaching one. 9 delegations voted in favour, 9 against and there were 2 abstentions.

507. The Netherlands delegation now formulated its earlier suggestion (see point 504) as a proposal.

All delegations but one voted in favour of the proposal, whereupon it was adopted by the Main Committee.

Article 110 (111) — Decision in respect of appeals

508. The FICPI delegation asked whether the applicant could submit an amendment of a statement of claims in appeal proceedings. This question could be of great significance in practice, as was demonstrated by the following example. Suppose an applicant filed an application with a principal and a secondary claim, and the principal claim were refused by the Examining Division. Could the applicant then base himself on the secondary claim in the appeal body? If so, he would have some chance of success with his amended statement of claim in the appeal body, even if the Board confirmed the rejection of the principal claim. If not, he ought not even to risk an appeal, but would have to limit himself to the secondary claim in the examining procedure.

509. In the view of the delegation of the Federal Republic of Germany, the Convention established that secondary claims could also be submitted to the appeal body. This procedure corresponded, moreover, with practice under German patent law.

510. The Chairman noted that the Main Committee was of the same view.

Article 111 (112) — Decision or opinion of the Enlarged Board of Appeal

511. The Main Committee referred to the Drafting Committee a United Kingdom drafting proposal for paragraph 1 (M/40, point 18).

512. The IAPIP delegation expressed the wish that the parties concerned should also be allowed to take part in proceedings before the Enlarged Board of Appeal under paragraph 1(a).

513. The Netherlands delegation, which concurred, nonetheless felt that its wish was already satisfied by virtue of Article 115 (116), paragraph 4, whereby oral proceedings before the Enlarged Board of Appeal were generally public.

514. The Chairman pointed out that Articles 112 et seq. (113 et seq.) applied to all bodies of the European Patent Office and therefore also to the Enlarged Board of Appeal. In his view, this meant that the Enlarged Board of Appeal could not take any decisions without the parties concerned being able to give their views on the matter, and that the Enlarged Board of Appeal was obliged to conduct oral proceedings, if one of the parties concerned so requested.

515. The French delegation considered that, under Article 111 as it stood at present, the applicant for or proprietor of the patent was not entitled to participate in proceedings before the Enlarged Board of Appeal, although he could initiate them, and therefore could not conduct oral proceedings either. Only the Enlarged Board of Appeal could so order.

516. The Chairman noted that the Inter-Governmental Conference had previously inclined to the view that in proceedings before the Enlarged Board of Appeal under Article 111, paragraph 1(a), all parties concerned should be given the right to be heard and to request oral proceedings.

517. The Main Committee referred this issue to the Drafting Committee, requesting it to examine and if need be clarify it.

At a subsequent meeting, it adopted the version proposed by the Drafting Committee embodying the wish of the IAPIP delegation*.

518. The Main Committee referred to the Drafting Committee a drafting proposal from the Luxembourg delegation concerning paragraph 2 (M/9, point 20).

Article 113 (114) — Ex officio examination

519. The Main Committee referred to the Drafting Committee a drafting proposal from the United Kingdom delegation concerning paragraph 1 (M/40, point 19).

* See Article 112, paragraph 2, of the Convention.
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
(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the Board of Appeal rejects the request, it shall give the reasons in its final decision;

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) In the cases covered by paragraph 1(a) the parties to the appeal proceedings shall be parties to the proceedings before the Enlarged Board of Appeal.

(3) The decision of the Enlarged Board of Appeal referred to in paragraph 1(a) shall be binding on the Board of Appeal in respect of the appeal in question.
MUNICH DIPLOMATIC CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- 1973 -

Munich, 30 September 1973
M/ 146/R 5
Original: English/French/German

CONFERENCE DOCUMENT

Drawn up by: General Drafting Committee

Subject: Convention: Articles 112 to 139
Article 111
Decision or opinion
of the Enlarged Board of Appeal

(1) Unchanged from 1972 published text.

(a) the Board of Appeal shall, during proceedings on a case
and either of its own motion or following a request from a
party to the appeal, refer any question to the Enlarged Board
of Appeal if it considers that a decision is required for the
above purposes. If the Board of Appeal rejects the request,
it shall give the reasons in its final decision;

(b) Unchanged from 1972 published text.

(1a) In the cases covered by paragraph 1(a) the parties to the
appeal proceedings shall be parties to the proceedings before
the Enlarged Board of Appeal.

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

- 1973 -

Munich, 17 September 1973
M/88/I/R 3
Original: English/French/German

TEXTS DRAWN UP BY
THE DRAFTING COMMITTEE OF MAIN COMMITTEE I
AT THE MEETING ON 15 SEPTEMBER 1973

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Rules of the Implementing Regulations:

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14. Article 63  The comma in line 2, paragraph 1, should be deleted.
15.  Paragraph 3 should read "...deemed to be void ab initio in that State".
16. Article 69  In line 3, paragraph 2, "determines" should be amended to read: "constitute the basis for determining".
17. Article 72  The word "Contracting" in the penultimate line should be deleted.

18. Article 111  In paragraph 1(a), "ex officio" should be amended to read "of its own motion".
19. Article 113  The title should be amended to read "Examination by the European Patent Office of its own motion" and in paragraph 1, "ex officio" should be amended to read "of its own motion".
20. Article 121  In line 2, paragraph 5, "specified" should be amended to read "referred to" since the time limit of Article 74(3) is in fact not specified in that Article but in the Implementing Regulations.

21. Article 131  In paragraph 1, the word "for" in line 1 should be deleted and the first sentence should read, "...Contracting States shall on request give assistance....opening files for inspection".
22. Article 139  "prior right" should be amended to read "prior art".
23. Article 146  Paragraph 1, last sentence, should be amended to read:
   "Article 37, paragraphs 3 and 4, and Article 39 shall apply mutatis mutandis".
24. Article 155  In sub-paragraphs (3)(a) and (b) "is to" should be amended to read "shall".

.../...
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
Die AIPPI begrüßt die Einberufung der Münchner Diplomatischen Konferenz für den Herbst 1973 als den erfolgreichen Abschluß langjähriger Bemühungen um die Errichtung eines europäischen Patentsystems. Sie weiß die an sie ergangene Einladung zur Teilnahme an dieser Konferenz zu schätzen.

Die AIPPI stellt mit Befriedigung fest, daß in den der Konferenz unterbreiteten Texten einer großen Zahl der von ihr geäußerten Wünsche entsprochen worden ist.

Sie gestattet sich jedoch, an einige ihrer Wünsche zu erinnern, denen nicht in der von ihr erhofften Weise stattgegeben wurde, obwohl ihnen ihres Erachtens große Bedeutung beizumessen ist.

Ihre Ansicht nach sollten nichtveröffentlichte Unterlagen nicht zum Stand der Technik gehören und nur dann neuheitsüblich sein, wenn sie nicht von ein und demselben Anmelder stammen. Da diese Bedingung nicht angenommen worden ist, rechnet die AIPPI darauf, daß die Beurteilung der alleinigen Neuheit gegenüber früheren Anmeldungen nicht im Wege der Auslegung ausgedehnt und daß der Schluß von Artikel 54 sehr streng angewendet wird.

AIPPI hätte gewünscht, daß ein supranationales Rechtsprechungsorgan eingesetzt wird; jedenfalls müßten ihres Erachtens, falls die Beschwerdekammer die Große Beschwerdekammer befaßt hat, die Parteien, die keine Beschwerde eingelegt haben, am Verfahren vor der Großen Beschwerdekammer beteiligt werden (Artikel 111 Absatz 1 Buchstabe a).

Die AIPPI ist nach wie vor der Ansicht, daß die Aufnahme eines Prüfers, dem die Sache bereits bekannt ist (Artikel 18 Absatz 2), in die Prüfungsabteilung allgemein anerkannten Grundsätzen widerspricht.

Schließlich erkennt die AIPPI zwar an, daß die in Artikel 166 vorgesehenen Vorbehalte zweckmäßig sind, um den Beitritt einer möglichst großen Zahl von Staaten zu bewirken, vertritt jedoch die Auffassung, daß ein Interesse daran besteht, die Dauer der zur Zeit auf 10 Jahre festgesetzten Übergangszeit zu verkürzen.

Die AIPPI behält sich schließlich die Möglichkeit vor, durch ihre Delegierten auf der Diplomatischen Konferenz weitere Bemerkungen nicht so grundlegender Natur vorzutragen.

With the convening of the Munich Diplomatic Conference in Autumn 1973, IAPIP welcomes the conclusion of several years' work for the setting up of a European patent system. It would express its gratitude for the invitation extended to it to attend the Conference.

It notes with satisfaction that a large number of the suggestions which it has put forward have been taken up in the texts submitted to the Conference. It would however recall certain suggestions which have not been followed up as it had hoped, in spite of the importance which it attaches to them.

In its opinion, unpublished documents should not be comprised in the state of the art and should not be invoked against the current application except where they originate from different applicants. Since this condition has not been adopted IAPIP considers that the assessment of novelty alone in relation to prior applications will not be extended by way of interpretation and the result will be a strict application of the last part of Article 54.

IAPIP expressed the wish for a supra-national court to be set up, and now considers that in the absence of a right to appeal by the parties concerned, the latter should be able to take part in proceedings before the Enlarged Board of Appeal where a question has been referred to it by a Board of Appeal (Article 111, paragraph 1, sub-paragraph (a)).

It continues to feel that the inclusion in the Opposition Divisions of an examiner who is already familiar with the case (Article 18, paragraph 2) is contrary to generally accepted principles.

Finally, whilst recognising the desirability of the reservations laid down in Article 166 in order to enable as many States as possible to accede to the Convention, it considers that the length of the transitional period, at present fixed at 10 years, should be reduced.

IAPIP reserves the right to submit other comments of a less fundamental nature at the Diplomatic Conference through its delegates.
STELLUNGNAHME DER
AIPPI
Association Internationale pour la Protection
de la Propriété Industrielle

COMMENTS BY
IAPIP
International Association for the Protection
of Industrial Property

PRISE DE POSITION DE
L'AIPPI
Association internationale pour la protection
de la propriété industrielle
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

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

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

________________________

1973
20 Aus Absatz 2 ergibt sich indirekt, daß das Verfahren nach Absatz 1 Buchstabe a eine Verweiskzwecks Vorabentscheidung darstellt. Diese vom allgemeinen Verfahrensrecht abweichende Konzeption ist zu gründlich, als daß sie so gedeckt werden dürfte, daß man sie nur erahnen kann, und sollte deshalb deutlich zum Ausdruck gebracht werden; die Einzelheiten dieser Verweisung wären in der Ausführungsordnung zu regeln.

Vorschlag:

Es sollte im Text zum Ausdruck kommen, daß die Beschwerdekammer die Entscheidung aussetzt und die Große Beschwerdekammer mit der Frage befaßt, aber die abschließende Entscheidung über die Zulässigkeit und die Begründetheit der Beschwerde selber trifft.

21 Durch die Verwendung des Begriffs „procédure orale“ im französischen Text wird eine falsche Vorstellung vermittelt; es kann sich nämlich nur um ein mündliches Verfahrensgericht handeln (vgl. deutschen Text) und nicht um ein gesondertes Verfahren.

Vorschlag:

Im französischen Text sollte es statt „procédure orale“ „débat oral“ heißen.

22 Absätze 4, 5 und 6

In diesem Artikel sind die Beweismittel aufgeführt. Da die Beteiligten, Zeugen und Sachverständigen ihren Wohnsitz im allgemeinen nicht am Sitz der Beschwerdekammer haben und da dem Europäischen Patentamt und seinen Prüfungsbehörden keine Zwangsmittel zur Verfügung stehen, werden diese Personen unter bestimmten Umständen von den nationalen Gerichten vernommen. Im Bereich des Patentwesens wäre es aber zweckmäßig, wenn Beteiligte, Zeugen und Sachverständige einander gegenübergestellt werden könnten, doch dieses äußerst nützliche Verfahren ist nicht im Privatrecht aller Vertragsstaaten vorgesehen. Es erhebt sich sogar die Frage, ob es nicht möglich sein sollte, eine solche Gegenüberstellung auf den Fall auszudehnen, in dem der eine Beteiligte oder Zeuge vom Patentamt und der andere von einem nationalen Gericht vernommen würde. Eine solche Vorschlag sollte eigentlich in das Übereinkommen und nicht nur in die Ausführungsordnung aufgenommen werden.

20 It is implicit in paragraph 2 that the procedure described in paragraph 1 (a) constitutes a reference for a preliminary ruling. This principle, which deviates from normal procedural law, is too fundamental to be left to be guessed at and should be expressed formally, it being understood that it is for the Implementing Regulations to lay down the details for such reference.

Proposal:

It should be stated that the Board of Appeal shall suspend judgment, that it shall refer the question to the Enlarged Board of Appeal, but shall give a definitive judgment as to the admissibility and the foundation of the appeal.

21 In speaking of an oral „procédure“ (proceedings), the French text gives a misleading impression since the reference can only be to incidental oral proceedings (German text: mündliche Verhandlung), and not to a separate form of proceedings.

Proposal:

Replace „procédure orale“ (oral proceedings) by „débat oral“ (English text unchanged).

22 Paragraphs 4, 5 and 6

This Article lays down the rules for the taking of evidence. Since they often reside far away from the Board of Appeal and since, in addition, the European Patent Office and its Examining Divisions have no coercive measures at their disposal, parties, witnesses and experts will, in certain cases, be heard by national courts. In the patents field it would be useful if it were possible to confront parties, witnesses and experts; however, in private law this very useful measure is not laid down in all the national laws which might be called upon to apply it. The same problem arises where such confrontation is provided for but may not be extended to cases where one party or one witness has been heard by the European Patent Office and the other by the national court. An appropriate provision to this effect should be included in the Convention and not only in the Implementing Regulations.

Proposal:

Add: “The European Patent Office may request the
STELLUNGNAHME
DER LUXEMBURGISCHEN REGIERUNG

COMMENTS
BY THE LUXEMBOURG GOVERNMENT

PRISE DE POSITION
DU GOUVERNEMENT LUXEMBOURgeois
MÜNCHNER DIPLOMATISCHE KONFERENZ
ÜBER DIE EINFÜHRUNG EINES EUROPÄISCHEN
PATENTTERTEILUNGSVERFAHRENS 1973
(München, 10. September bis 6. Oktober 1973)

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

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

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

COMMENT
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
Stelle durch die rechtliche Beurteilung der Beschwerdekammer, die der Entscheidung zugrunde gelegt ist, gebunden, soweit der Tatbestand derselbe ist. Ist die angefochtene Entscheidung von der Eingangsstelle erlassen worden, so ist die Prüfungsabteilung ebenfalls an die rechtliche Beurteilung der Beschwerdekammer gebunden.

Vgl. Regeln 68 (Rückzahlung der Beschwerdegebühr), 69 (Form der Entscheidungen) und 90 (Berichtigung von Fehlern in Entscheidungen)

**Artikel 111**
Entscheidung oder Stellungnahme der Großen Beschwerdekammer

(1) Zur Sicherung einer einheitlichen Rechtsanwendung oder wenn sich eine Rechtsfrage von grundsätzlicher Bedeutung stellt,

a) befaßt die Beschwerdekammer, bei der ein Verfahren anhängig ist, von Amts wegen oder auf Antrag eines Beteiligten die Große Beschwerdekammer, wenn sie hierzu eine Entscheidung für erforderlich hält. Weist die Beschwerdekammer den Antrag zurück, so hat sie die Zurückweisung in der Endentscheidung zu begründen;

b) kann der Präsident des Europäischen Patentamts der Großen Beschwerdekammer eine Rechtsfrage vorlegen, wenn zwei Beschwerdekammern über diese Frage voneinander abweichende Entscheidungen getroffen haben.

(2) Die in Absatz 1 Buchstabe a vorgesehene Entscheidung der Großen Beschwerdekammer ist für die Entscheidung der Beschwerdekammer über die anhängige Beschwerde bindend.

Vgl. Regeln 69 (Form der Entscheidungen) und 90 (Berichtigung von Fehlern in Entscheidungen)

are the same. If the decision which was appealed emanated from the Receiving Section, the Examining Division shall similarly be bound by the ratio decidendi of the Board of Appeal.

Cf. Rules 68 (Reimbursement of appeal fees), 69 (Form of decisions) and 90 (Correction of errors in decisions)

**Article 111**
Decision or opinion of the Enlarged Board of Appeal

(1) In order to ensure uniform application of the law, or if an important point of law arises:

a) the Board of Appeal shall, during proceedings on a case and either ex officio or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes. If the Board of Appeal rejects the request, it shall give the reasons in its final decision;

b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) The decision of the Enlarged Board of Appeal referred to in paragraph 1(a) shall be binding on the Board of Appeal in respect of the appeal in question.

Cf. Rules 69 (Form of decisions) and 90 (Correction of errors in decisions)

118
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
64. The Working Party did not however adopt the proposals submitted to it whereby the Enlarged Board of Appeal would only have resorted to oral proceedings if it considered it necessary. Although the Enlarged Board of Appeal would take decisions on questions of law and not of fact, the Working Party saw no reason to limit the possibility for parties to make oral statements before it, to those cases alone where the Enlarged Board of Appeal considered it to be useful.

Furthermore, the Working Party did not adopt a proposal according to which the Enlarged Board of Appeal would have to take a decision within a limited period taking effect from the time when the question had been referred to it.

65. With regard to paragraph 1(b) which refers to a case where there are no parties to a proceeding, it was noted that the Rules of Procedure of the Enlarged Board of Appeal, provided for in Rec. Article 57, No. 1, could lay down that this authority may appeal to experts.

Article 123 (Publication of the international application)
Article 34 (Languages)

66. With regard to languages, the Working Party, in accordance with the mandate given to it by the Conference at its fifth Meeting, examined the following two problems:

(a) the search for a solution to the problem of the incompatibility of Article 123, paragraph 5, with the PCT and the repercussions which the solution adopted for international applications would have on the system applicable to the translation of the claims of European applications (Article 35, paragraph 5);
Article 115 (Decision in respect of appeals)

62. The Working Party was presented with a proposal by the French delegation (BR/GT I/154/72). Amendments were made to this Article to take account of the problem raised by paragraph 2, in the case where all or part of the application or of a patent was not jeopardised by the decision to reject the appeal. To solve this problem, the Working Party merged paragraphs 2 and 3; the new wording of paragraph 2 lays down that the Board of Appeal shall decide on the appeal. In the light of its decision, whether total or partial rejection of the appeal, the text of paragraph 2 covers the possibility which appeared to be excluded in the former wording.

Article 116 (Decision or opinion of the Enlarged Board of Appeal on certain points of law)

63. The Working Party was presented with suggestions by the Chairman (BR/GT I/145/72) and a proposal by the French delegation concerning requests by interested parties to make it possible for parties to participate in proceedings before the Enlarged Board of Appeal.

It was explicitly laid down, in paragraph 1(e), that the Board of Appeal may, at the request of a party, refer a question to the Enlarged Board of Appeal. Since this reference is not automatic, the Working Party adopted a wording by which the Board of Appeal must, with its final decision, give reasons if it rejected the request. This was considered necessary to provide the parties with a certain guarantee, on the one hand, and to enable a certain degree of standardisation of the jurisprudence of the Boards of Appeal on the other.

BR/177 e/2 nen/KM/gc .../...
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

Brussels, 13 April 1972
BR/177/72

SECRETARIAT

REPORT

on the 11th meeting of Working Party I
held in Luxembourg from 28 February to 3 March 1972

1. Working Party I held its 11th meeting in Luxembourg from 28 February to 3 March 1972 with Dr Haertel, President of the Deutsches Patentamt in the Chair.

Representatives of the Commission of the European Communities, the IIB and WIPO attended the meeting as observers. The Representatives of the Council of Europe sent apologies for absence. Those present at the 11th meeting are listed in Annex I to this report.

2. Working Party I adopted the provisional agenda as contained in BR/GT I/143/72; it was agreed that Articles 153 and 154 would be dealt with by the Co-ordinating Committee at its next meeting scheduled for 15 to 19 May 1972. The provisional agenda is contained in Annex II to this report.

3. The Drafting Committee of Working Party I was chaired by Mr van Benthem, President of the Octrooiraad.

The results of the Drafting Committee's work were circulated under reference BR/176/72.

BR/177 e/72 cyd/AH/prk
Article 116

Decision or opinion of the Enlarged Board of Appeal on certain points of law

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) +

Note to Article 116, paragraph 1(b):
- deleted -
DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -
118. In addition, the same organisations asked that the parties should have the opportunity to be heard by the Enlarged Board or to intervene before it, regardless of whether it was they or the Board of Appeal that referred the point in question to the Enlarged Board of Appeal.

119. IAPIP hoped that the parties would be able to intervene before the Enlarged Board of Appeal, and pointed out that its preference was for a supranational court, such as the maximum approach would indicate. IAPIP expressed anxieties regarding the consequences that referral to the Enlarged Board by the parties could have on the duration of the proceedings.

120. FICPI suggested that in the event of a referral to the Enlarged Board of Appeal by the President of the European Patent Office, the interested professional circles might be heard.

121. At the end of the hearing UNICE submitted a drafting proposal (Working Document No. 7 of 27 January 1972).

Article 122 (International search report) and Article 160a (Application of Article 122)

122. IAPIP pointed out that the PCT did not oblige national authorities to recognise the PCT international search report. For the purposes of the PCT, the First Convention constituted a regional treaty which would have the same status in its Contracting States as their national laws. Working on this assumption, the deletion of Article 122 as such, or at least an amendment to the wording to make such recognition optional rather than compulsory ("may take the place of" instead of "shall take the place of"), could be envisaged.

BR/169 e/72 ley/PB/prk
Article 116 (Decision or opinion of the Enlarged Board of Appeal on certain points of law)

117. Several organisations (ICC, CEIF, COPRICE, EIRMA, FICPI, UNEPA and UNICE) asked for a provision that the parties, as well as the Board of Appeal, may refer questions to the Enlarged Board of Appeal, without this necessitating the lodging of a further appeal. They considered that if the opportunity to refer points to the Enlarged Board of Appeal for an interlocutory decision, as provided in paragraph 1(a), were to be restricted to the Board of Appeal, the desired aim, which was to ensure the uniform application of the law or to clarify a fundamentally important point of law, would not be fully achieved.

Firstly, the Boards of Appeal would not necessarily always realise when they were up against a fundamentally important point of law, and secondly, failure to refer points to the Enlarged Board would not be subject to sanctions.

So as to avoid abuses, the Enlarged Board would have the discretionary power to accept or refuse referral. It would not have to state the grounds for its decision, which would have to be given within quite a short space of time, such as two or three months. If no decision were given within that period, the referral would be deemed to have been refused.

The Board of Appeal concerned would have to stay its decision and would be bound by the interlocutory decision of the Enlarged Board.

BR/169 e/72 ley/PB/prk .../...
INTER-GOVERNMENTAL CONFERENCE  
FOR THE SETTING UP OF A EUROPEAN  
SYSTEM FOR THE GRANT OF PATENTS  

- Secretariat -  

Brussels, 15 March 1972  
BR/169/72  

MINUTES  
of the  

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

Part II.  

Hearing of the non-governmental international organisations  
on the Second Preliminary Draft of a Convention  
establishing a European System for the  
Grant of Patents  

(Luxembourg, 26 January to 1 February 1972)  

BR/169 e/72 ley/KM/prk
Article 116

Decision or opinion of the Enlarged Board of Appeal on certain points of law

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) +

Note to Article 116, paragraph 1(b):
-
-deleted-

BR/139 e/71 prk
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

Brussels, 6 December 1971
BR/139/71

- Secretariat -

DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -

BR/139 e/71
Delegations considered that the parties should only have the right to ask a Board of Appeal to refer the matter to the Enlarged Board of Appeal; the Boards of Appeal would, however, be free either to accept or to reject that request.

With regard to the possibility of parties being heard before the Enlarged Board of Appeal, two delegations were in favour, one stating that in its opinion Article 140 already allowed for this possibility. On the other hand, another delegation thought that it was inappropriate to follow up this request, but that the possibility of submitting a written statement could be provided for.

The request of one organisation to lay down that the interested circles could be consulted in the case provided for in paragraph 1(b) was rejected.


Some delegations asked that sub-paragraph (b) of paragraph 1 be deleted since in their opinion it was of no help to ask the Enlarged Board of Appeal to give decisions outside proceedings on a case.

The Conference did not adopt this proposal.
Appeal. In this respect, some delegations confessed their perplexity as to the consequences which could arise from the texts in their present form. In fact, these delegations wondered, with regard to paragraph 2, what would happen if either all or part of the patent application or patent was not affected by the decision in respect of the appeal. For such cases these delegations thought it would be useful to lay down the same rights as those provided for in paragraph 3.

The Conference agreed that this problem should be examined again by Working Party I.

135. Reservations were made concerning paragraph 4 by the Swedish and United Kingdom delegations, the latter being opposed to the possibility, implicit in that paragraph, that an authority which has to settle an inter partes dispute should be bound by an ex parte decision.

Article 116 (Decision or opinion of the Enlarged Board of Appeal on certain points of law)

136. The Conference discussed the comments submitted by the organisations concerned, relating to the right of the parties to refer any question to the Enlarged Board of Appeal and to be heard before it.

With regard to the parties' right of reference, one delegation said it was in favour of such a possibility, while limiting it nevertheless to points of law of fundamental importance and on the understanding that the Enlarged Board of Appeal would have the power to accept or refuse the question referred. On the other hand, several
INTER-GOVERNMENTAL CONFERENCE FOR THE SETTING UP OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

MINUTES of the

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

Parts 1 and 3

(Luxembourg, 24-25 January and 2-4 February 1972)
Article 116

Decision or opinion of the Enlarged Board of Appeal on certain points of law

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) +

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Note to Article 116, paragraph 1(b):
- deleted -
DOCUMENT CORRECTING

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

FIRST PRELIMINARY DRAFT
OF THE IMPLEMENTING REGULATIONS

and

FIRST PRELIMINARY DRAFT
OF THE RULES RELATING TO FEES

- Stage reached on 26 November 1971 -
Article 116 - Decision or opinion of the Enlarged Board of Appeal on certain points of law

45. With regard to paragraph 1(b), the Working Party agreed by a majority that the President of the European Patent Office may only call upon the Enlarged Board of Appeal when two Boards of Appeal have given different decisions on the same question; the more widely drafted first sub-section of this sub-paragraph was therefore deleted. The Netherlands delegation voted against this deletion, as it considered the wider wording more suitable.

Re. Article 135 IR - Membership of the Boards of Appeal

46. The French delegation proposed that those members of the Board of Appeal who had a previous interest in the matter should not participate, although they would be permitted to make statements. The Working Party considered that it was not desirable to extend the grounds for exclusion of members of the Boards and this proposal was not accepted.

47. The question was raised as to whether a member of a Board of Appeal who considered that he came under one of the grounds for exclusion given in Article 135, paragraph 1, could nevertheless take part, subject to the agreement of the parties. The retention of such a member might in fact prove quite useful in view of his special knowledge of a case in point.
INTER-GOVERNMENTAL CONFERENCE Brussels, 28th October 1971
FOR THE SETTING UP BR/132/71
OF A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

MINUTES

of the meeting of Working Party I,
held in Luxembourg from 14 to 17 September 1971

Opening of the meeting and adoption of the agenda

1. The Working Party held its 8th meeting in Luxembourg from
   Tuesday 14 to Friday 17 September 1971, with Dr HAERTEL,
   President of the German Patent Office, in the Chair.

   This meeting, which was devoted primarily to the exami-
   nation of certain legal problems connected with the provisions
   being drawn up, was also attended by legal experts from the
   countries of the delegations to Working Party I.

   Representatives from the Commission of the European
   Communities, WIPO and the IIB were also present at the meet-
   ing (1). The representative of the General Secretariat of
   the Council of Europe sent his apologies for being unable
   to attend.

   The Working Party adopted the provisional agenda (2).

(1) See Annex I for list of those attending.
(2) See Annex II for the provisional agenda (BR/GT 1/109/71)
    and the list of the provisions of the Second Preliminary
    Draft Convention and the First Preliminary Draft Imple-
    menting Regulations to be examined at the meeting
    (BR/GT 1/111/71).

BR/132 e/71 ley/KM/ad
(2) Si la chambre de recours, à la suite de l'examen prévu à l'article 113, paragraphe 1, considère qu'il ne peut être fait droit au recours, elle le rejette comme non fondé.

(3) S'il peut être fait droit au recours, en tout ou en partie, la chambre de recours annule en tout ou en partie la décision attaquée. Elle peut, soit poursuivre elle-même la procédure jusqu'à la notification prévue à l'article 97, paragraphe 1, ou à l'article 105, paragraphe 3, inclusivement, ou décider de la délivrance, de la confirmation ou de la révocation du brevet européen, soit, si elle l'estime nécessaire en l'état de la procédure, renvoyer l'affaire pour suite à donner à l'instance qui a pris la décision attaquée.

(4) Si la chambre de recours renvoie l'affaire pour suite à donner devant l'instance qui a pris la décision attaquée, celle-ci doit conformer sa décision ultérieure sur l'affaire à celle de la chambre de recours. Si la décision attaquée émane de la section d'examen, la division d'examen est également liée par la décision de la chambre de recours.

**Article 116**

Décision ou avis de la Grande Chambre de recours sur des questions de droit déterminées

(1) Afin d'assurer une application uniforme du droit ou si une question de droit d'importance fondamentale se pose :

a) la chambre de recours saisit en cours d'instance la Grande Chambre de recours lorsqu'une décision est nécessaire à cet effet;

b) le Président de l'Office européen des brevets peut :
   [- à tout moment, à l'exception des cas où une instance est en cours, saisir pour avis la Grande Chambre de recours]  
   -- soumettre une question de droit à la Grande Chambre de recours lorsque deux chambres de recours ont rendu des décisions divergentes sur cette question.

(2) La décision de la Grande Chambre de recours à laquelle il est fait référence au paragraphe 1, lettre a), lie la chambre de recours pour le recours en instance.

**CHAPITRE V**

Demande internationale conformément au Traité de Coopération en matière de brevets

**Article 117**

Application du Traité de Coopération en matière de brevets

SECOND PRELIMINARY DRAFT OF A CONVENTION
ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT OF PATENTS
with
FIRST PRELIMINARY DRAFT OF THE IMPLEMENTING REGULATIONS TO THE
CONVENTION ESTABLISHING A EUROPEAN SYSTEM FOR THE GRANT
OF PATENTS
and
FIRST PRELIMINARY DRAFT OF THE RULES RELATING TO FEES

SECOND AVANT-PROJET DE CONVENTION INSTITUANT UN
SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
ainsi que
PREMIER AVANT-PROJET DE RÈGLEMENT D'EXÉCUTION DE LA CONVENTION
INSTITUANT UN SYSTÈME EUROPÉEN DE DÉLIVRANCE DE BREVETS
et
PREMIER AVANT-PROJET DE RÈGLEMENT RELATIF AUX TAXES
(w) Articles 152 to 154 - Professional representation, compulsory representation and authorisation

The question of representation should be discussed later (see point 78 above).

(x) Article 159 - Period within which a request for examination may be made during a transitional period

Should the Administrative Council's option be maintained of shortening the period for making the request for examination, the length of which still has to be specified for a transitional period? (Article 159, paragraph 1, second sentence) (CPCI, FICPI)

81. Item 6 on the agenda: Discussion of procedure for the 4th Meeting of the Intergovernmental Conference from 20 to 30 April 1971

The Working Party discussed the question of how the results of their work and of the work of the Sub-Committees should profitably be dealt with at the next Meeting of the Conference. In this connection it considered that the delegations to the Intergovernmental Conference should be requested to submit in writing any requests for amendments to the texts.

Item 7 on the agenda: Other business

82. The Working Party agreed as follows for its future programme of work:

The reports of the delegations of Working Party I and of the General Rapporteur on amendments to the published First Preliminary Draft of 1970, which were to be submitted to the Conference, should reach the Secretariat by

BR/94 e/71 aut/KM/prk
(t) **Article 116 - Decision or opinion of the Enlarged Board of Appeal on certain points of law**
The Working Party considered that the question of which text of paragraph 1(b) was preferable, should be discussed with the government legal experts. (See observations by the ICC and CPCCI)

(u) **Article 122 - International search report**
Should the international search report completely replace the report on the state of the art to be drawn up by the IIB? Should the European Patent Office or the IIB decide on the need for a supplementary report on the state of the art? Should the IIB prepare in every case a report on the state of the art and only consider any international report that might be available? (ICC, CNIPA, CEIF, EIRMA, FICPI, UNEPA, UNICE)

Should fees be levied for any necessary additional report drawn up by the IIB? Could a proportion of the fees be refunded to the applicant if necessary? (CNIPA, FICPI)

(v) **Article 137 - Supplementary report on the state of the art**
Should a fee be levied for a supplementary report on the state of the art or should it be incorporated into the fee for the main report on the state of the art or even into the filing fee? (FICPI)

BR/94 e/71 aut/KM/prk  

.../...
(p) Article 79 - Obtaining of the report on the state of the art

(i) With regard to the question on combining the filing fee with the search fee, see under point (1) on Article 66.

(ii) With regard to the question, whether the report on the state of the art should be replaced by the international search report for PCT-applications, see under point (u) on Article 122.

(q) Article 80 - Transmission of the report on the state of the art

Should the report on the state of the art be transmitted by the IIB to the European Patent Office and to the applicant simultaneously? (CNIPA, IFIA)

(r) Article 88 - Request for examination

The Working Party considered that the question of whether a request for examination might in future be lodged by a third party, notwithstanding the new text of Article 88, paragraph 2, or whether this possibility should hold good for a transitional period, was one which should be discussed further with the interested circles. (See observations by the FICPI)

(s) Article 111 - Time-limit and form of appeal

Should the period within which the grounds for appeal could be set out in greater detail (Article 111, third sentence) be extended? Should it, if necessary, be fixed by the Board of Appeal? (FICPI, IFIA, UNEPA)
(m) Articles 66 to 68
Questions on organisation of the procedure: see under (o) on Articles 77 and 78.

(n) Article 74 - Effect of priority right
Should there be a reference in Article 74 to Article 21, paragraph 1? See under (g) on Article 21.

(o) Article 77 - Examination of the European patent application for formal and obvious deficiencies

Article 78 - Notification and refusal of the application
(i) Who should be responsible for carrying out the formal examination provided for in Article 77, paragraph 1: the EPO, the national receiving Office (in the case of Article 64, paragraph 1(b)), or the IIB? Which parts of the formal examination should be undertaken by which authorities if the work is divided up among them? (ICC, CNIPA, CEIF, EIRMA, UNICE)

(ii) Should the EPO carry out alone the examination for obvious deficiencies provided for in Article 77, paragraph 2, or should the IIB undertake a share of this examination, e.g. examination of unity of invention?(1) (ICC, CNIPA, CEIF, EIRMA, FICPI, UNICE)

(iii) Should not the EPO only enter the proceedings when the IIB has drawn up the search report? (ICC, CNIPA, CEIF, EIRMA, UNICE)

(iv) Would it be advisable to organise co-ordination of the EPO departments responsible for the novelty search with the IIB departments, which were preparing the search reports? (UNICE)

(1) The majority of the Working Party refused to abandon altogether the examination for obvious deficiencies.
of the opinion that it would suffice to insert in Article 74 a reference to Article 21, paragraph 1. (CNIPA, EIRMA, FICPI, UNICE)

(h) Article 22 - Unitary character of the European patent application
Is it perfectly clear from this provision that a European patent application can be filed jointly by several applicants and that rights limited to certain countries can be assigned to different assignees in proceedings before the European Patent Office? (CEIF)

Apart from this question, the equivalence of the texts in the three languages should be examined. (CEIF)

(i) Article 23 - Assignment of a European patent application
Should the Convention specify that an entry in the European Patent Register had the same effect at national level as an entry in the national register? (CEIF)

(k) Article 28 - Contractual licensing of a European patent application
Should protection be granted to the licensee recorded in the European Patent Register against the proprietor of the application? (CEIF)

(l) Article 66 - Requirements of the application
Should the filing fee be combined with the fee for obtaining the report on the state of the art (Article 79)? (ICC, CNIPA, EIRMA, FICPI)
(d) **Article 15 - Right to the grant of a European patent**
If several people had made an invention independently of each other and had filed applications at different times, should the first application be deemed non-existent if it has been withdrawn or refused before publication? A provision of this nature would (according to EIRMA) make it possible for the person filing the second application to receive a patent notwithstanding Article 11, paragraph 3.

This would not be achieved (according to EIRMA) by deleting the third sentence of Article 15, paragraph 1.

(e) **Article 19 - Rights conferred by a European patent application after publication**
Should there be a provision, corresponding to Article 29 PCT, that a published European patent application should be accorded at least the same provisional protection as national applications? (CNIPA)

(f) **Article 20 - Extent of the protection conferred by a European patent**
There should be an examination of the equivalence of the texts in the three languages concerning the words "Inhalt der Ansprüche", "terms of the claims" and "teneur des revendications" - also with reference to Article 8 of the Strasbourg Convention of 27.11.1963; if necessary, a legal definition might be introduced. (ICC, CNIPA, EIRMA, UNICE).

(g) **Article 21 - European patents of addition**
Should the beginning of the period for filing an application for a European patent of addition be based on the date of priority of the application for a national patent of addition? Several organisations were
Apart from the textual amendments referred to under point 79, the Working Party decided to undertake no immediate amendment to the Preliminary Draft on the basis of the observations made by the international organisations, but to adopt the procedure set out under point 77 (recommendation to the Inter-Governmental Conference). The points on which the Working Party recommends acceptance or rejection of the proposals made by the international organisations can be found in the above-mentioned document BR/100/71. The only problems set out below are those for which the Working Party is to recommend further examination.

(a) Article 9 - Patentable inventions
Possible new text for Article 9, paragraph 2, especially sub-paragraphs (a), (b) and (e) (observations by CEIF and UNICE);

(b) Article 11, paragraphs 2 and 3 - Novelty
Should the expression "contents of earlier applications for European patents" in Article 11, paragraph 3 be aligned more closely on the Strasbourg Convention of 27.11.1963, by being replaced by "contents of applications for European patents, which have earlier filing dates ..."? (FICPI)

(c) Article 11, paragraph 3 - Novelty
Should an earlier European application form an obstacle to the grant of a European patent under Article 11, paragraph 3 even where the inventor is the same person in both cases? (So-called Self-collision (FICPI))

The Swedish delegation was asked in this connection to establish by the next meeting whether real difficulties had arisen in the Scandinavian countries in this context.
MINUTES

of the 7th meeting of Working Party I
held at Luxembourg from 26 to 29 January 1971

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

1. The Working Party held its seventh meeting at Luxembourg from Tuesday 26 to Thursday 28 January 1971 with Dr. HAERTEL, President of the German Patent Office, in the Chair.

   The meeting was attended by representatives of the Commission of the European Communities, WIPO/OMPI and the International Patent Institute (2). The representative of the General Secretariat of the Council of Europe sent his apologies for being unable to attend.

2. The Drafting Committee, under the Chairmanship of the President of the Netherlands "Octrooiraad", Mr J.V. VAN BENTHEM, held its meetings directly after the deliberations of the Working Party, and also on the morning of 29 January 1971.

(1) For the provisional agenda (BR/GT I/101/71), see Annex I.
(2) For the list of those attending the meeting of the Working Party, see Annex II.

BR/94 e/71 son/KM/prk
Article 116 (former Article 112a)

Decision or opinion of the Enlarged Board of Appeal on certain points of law

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may:

- at any time ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case;

- refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) The decision of the Enlarged Board of Appeal referred to in paragraph 1(a) shall be binding on the Board of Appeal in respect of the appeal in question.

Note to Article 116(1)(b):

The Conference agreed that the President should in any event have the power to ask the Enlarged Board of Appeal for an opinion in the case referred to in the second sub-section of sub-paragraph (b). On the other hand, there was no agreement on the question whether the President should also be given such a power in the other cases referred to in the first sub-section, which are not covered by the second sub-section. If an affirmative answer is given to this question at a later date, the text of the second sub-section could be deleted.

BR/70 e/70 gc
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN SYSTEM
FOR THE GRANT OF PATENTS

- Secretariat -

Brussels, 21 December 1970
BR/70/70

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

(Articles drafted by Working Parties I, II, III and IV)

BR/70 e/70 gc
in so far as such decisions prejudiced the final decision. The Conference accepted, however, that in its present form, paragraph 2 offered the advantage of avoiding any drawing out of the proceedings. Nonetheless, it reserved the possibility of reconsidering this matter after consultations with the interested circles.

36. The Conference postponed to a later stage the decision to be taken as regards the text between brackets in Article 112a (b).

Several delegations expressed doubts on the provision in question, particularly since it would involve the risk of obliging the Enlarged Board of Appeal to take decisions on abstract questions, which might hinder it later when it came to consider concrete questions of a similar nature, and also because the Enlarged Board of Appeal, notwithstanding the rules governing its composition, cannot be totally likened to a judicial body.

On the other hand, other delegations believed the provision in question could be most useful, especially during the running in period of the European Patent Office, during which a number of questions of interpretation were bound to occur, on which it would be expedient for the President to be able to obtain the opinion of the Enlarged Board of Appeal.

Finally, the Conference considered that it would be particularly useful to receive the opinions of the national legal advisers before taking a final decision on this problem.
MINUTES

of the

2nd MEETING

held at Luxembourg on 13 to 16 January 1970

Item 1 on the agenda (BR/14/69) (1)

OPENING OF THE MEETING

1. The Conference began its work at 10.00 a.m. on Tuesday 13 January at the Kirchberg European Centre, Luxembourg, with Dr. HAERTEL, President of the German Patent Office, in the Chair (2).

Item 2 on the agenda

ADOPTION OF THE PROVISIONAL AGENDA

2. The Conference adopted the provisional agenda submitted by the President.

(1) The agenda is given in Annex I
(2) The list of those attending the 2nd meeting is given in Annex II.
Article 112a (new)
Decision or opinion of the Enlarged Board of Appeal on certain points of law

Working Party text

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may:

- at any time ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case;

- refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) The decision of the Enlarged Board of Appeal referred to in paragraph 1 (a) shall be binding on the Board of Appeal in respect of the appeal in question.

Note:
The Working Party points out that the second subsection of sub-paragraph (b) limits the President's power to refer a matter to the Enlarged Board of Appeal. The Working Party was unable to agree on the advisability of giving the President the power provided for in the first sub-section of sub-paragraph (b). This question must be re-examined in consultation with the national legal advisers.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

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

Articles 88 to 152
prepared by Working Party I
(24 to 28 November 1969)

compared synoptically with

- the 1962 and 1965 versions of the Draft Convention as established by the EEC "Patents" Working Party and

- the Draft of an open European Patent Convention drawn up by the Member States of the European Free Trade Association
Appeal had given an opinion on an abstract question it would not depart from this in subsequent specific cases; There was no need to give the Enlarged Board of Appeal powers of this type, since the President of the Patent Office could first ask the Legal Department of the European Patent Office for an opinion on any questions arising for the first time; The President could also ask a member of the Enlarged Board of Appeal to give an opinion in his own name.

Other members of the Working Party did not share these objections. They thought that it ought to be possible, particularly in the early years of the European Patent Office's activities, to promulgate guidelines which were not connected with a specific case. It was certainly true that the question whether these guidelines should be published, and should thus be made evident to the outside world, should be carefully examined.

The Working Party found it impossible to reach a unanimous opinion on this point. It therefore decided to include 2 sub-paragraphs in the Draft under (b) for the time being, and to re-examine the question later with the legal experts. It was pointed out in this connection that the second sub-paragraph in fact constitutes a specific application of the first sub-paragraph and could therefore be deleted, if the Working Party were to agree on the first sub-paragraph at a later date.

**Article 115 - Further appeal to the European Patent Court**

56. No comment.

BR/12 e/69 crn/PA/mk ...
...

It thought it was enough to provide that a hearing should take place whenever any party requested it, and that the Board of Appeal should also be able to order a hearing on its own initiative if it considers this to be expedient.

Article 112 - Decision in respect of appeals

54. No comment.

Article 112 a (new) - Decision on opinion of the Enlarged Board of Appeal on certain points of law

55. Serious objections were brought forward against the possibility, provided for in paragraph 1 b, of the President of the European Patent Office asking the Enlarged Board of Appeal for an opinion on questions not arising in proceedings on a case: It was said that such a possibility would seriously impair the judicial character of the Enlarged Board of Appeal; Courts could not give an opinion on abstract questions put to them by administrative authorities but had to decide specific individual cases; If abstract questions are put to them for a decision they are recognized as having a quasi-legislative power; There was the danger that when the Enlarged Board of
MINUTES
of the meeting of Working Party I
(Luxembourg, 24 to 28 November 1969)

I.

1. The third working meeting of Working Party I was held at Luxembourg from Monday 24 to Friday 28 November 1969, with Dr. HAERTHEL, President of the German Patent Office, in the Chair.

The Commission of the European Communities, BIRPI, the General Secretariat of the Council of Europe and the International Patent Institute took part in the meeting (1).

2. The Working Party agreed to appoint the following as rapporteurs:

- a member of the German delegation for Articles 88 to 96 (Examination procedure) (2),

(1) See Annex for list of those attending the meeting of the Working Party.

(2) It was originally agreed at the October meeting that the German delegation should produce a report for Articles 88 to 104.
Article 112a (new)

Decision or opinion of the Enlarged Board of Appeal on certain points of law

Working Party text

(1) In order to ensure uniform application of the law, or if an important point of law arises:

(a) the Board of Appeal shall, during proceedings on a case, refer any question to the Enlarged Board of Appeal when a decision is required for the above purposes;

(b) the President of the European Patent Office may:

- at any time ask the Enlarged Board of Appeal for an opinion on any question, except where such question arises in proceedings on a case;

- refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question.

(2) The decision of the Enlarged Board of Appeal referred to in paragraph 1 (a) shall be binding on the Board of Appeal in respect of the appeal in question.

Note:

The Working Party points out that the second sub-section of sub-paragraph (b) limits the President's power to refer a matter to the Enlarged Board of Appeal. The Working Party was unable to agree on the advisability of giving the President the power provided for in the first sub-section of sub-paragraph (b). This question must be re-examined in consultation with the national legal advisers.
INTER-GOVERNMENTAL CONFERENCE
FOR THE SETTING UP OF A EUROPEAN
SYSTEM FOR THE GRANT OF PATENTS

- Secretariat -

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

Articles 88 to 152

prepared by Working Party I

(24 to 28 November 1969)

compared synoptically with

- the 1962 and 1965 versions of the Draft Convention as established by the EEC "Patents" Working Party and

- the Draft of an open European Patent Convention drawn up by the Member States of the European Free Trade Association
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