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COMMISSION STAFF WORKING PAPER

**A Community policy for the realisation of the Community patent in the context of a
revision of the European patent convention**

A COMMUNITY POLICY FOR THE REALISATION OF THE COMMUNITY PATENT IN THE CONTEXT OF A REVISION OF THE EUROPEAN PATENT CONVENTION

N.B. This document is a non-paper that does not bind the Commission of the European Communities. This text sets out a possible approach to realising the Community Patent within the framework of the European Patent Convention. However, it is important to note that this document does not exclude other modifications of the European Patent Convention that would be useful for the creation of the Community Patent (such as a revision of Articles 33 and 35 as well as Part IX of the Convention).

The Commission has proposed a Community patent which offers affordability, quality and adequate legal certainty. The political decisions concerning the implementation of these principles have to be taken within the framework of the European Community, even though a revision of the European Patent Convention is required for the concrete implementation of these decisions.

This document raises a number of key issues regarding the putting in place of the Community patent which should be discussed at Community level in order to arrive at some clear guidelines. This mainly concerns language arrangements, financial arrangements and the role of the national patent offices, but also the consistent development of the "acquis communautaire" and of the Convention, compliance with the "acquis communautaire" and judicial control, as well as - more generally - the role of the Community in the European Patent Organisation.

Clear guidelines are needed with regard to the Diplomatic Conference on the European Patent Convention. This Conference must take place before 1 July 2002 if the Community and its Member States are to retain the influence needed to ensure that the Convention is revised in a manner which is acceptable to them in substance.

The starting point for this document is the approach taken by the Commission in its proposal for a Regulation.

1 INTRODUCTION

The effective establishment of the Community patent does not depend solely on the adoption of the Regulation on the Community patent and on the acts adopted for its application via a comitology procedure. The proposal for a Regulation is based on the idea of a genuine "symbiosis" between the Regulation and the European Patent Convention (referred to hereinafter as the "Convention").

The basic idea is that the Convention should govern the procedure for the examination of an application for a patent designating the European Community, up to the grant of the patent. It is thus planned that the European Patent Office (referred to hereinafter as the "Office") will grant the patent. Upon grant, the patent will, under the Regulation, become a Community patent, and the Regulation will be the applicable legal framework. In principle, the Regulation will govern questions such as the effects of the patent, the rights and obligations deriving from the patent and the corresponding judicial procedures.

The Commission still considers that this is the most pragmatic and straightforward approach. In addition, it provides adequate legal certainty. It is also the most practical system for users of the patent system in Europe. It enables applicants to request at the same time a European patent for one or more of the Contracting States to the Convention and a patent for the European Community. Thus, there is a single procedural phase and the same rules are applicable.

To give practical expression to this approach, it is absolutely essential to revise the Convention. First of all, such a revision is necessary because the Convention does not currently enable the Office to grant patents for the Community, only for the individual States. What is more, a number of amendments of a technical nature have to be made to the Convention.

These amendments may not be sufficient on their own to persuade the Community and the Member States to accept linkage of the Community patent to the Convention. In this regard, the Commission has identified six key questions which deserve closer examination¹: language arrangements (1), financial arrangements (2), the role of the national patent offices (3), the consistent development of the "acquis communautaire" and of the Convention (4), compliance with the "acquis communautaire" and supervision of the Office (5), as well as the role of the Community in the European Patent Organisation (6).

1.1 Language arrangements

The affordability of the Community patent is one of the fundamental points of the Commission's proposal for a Regulation. If the Community patent is to be a tool for improving the competitiveness of European industry, it has to be attractive. Translation costs now account for a significant part of the overall cost of European patents, whereas no such costs are incurred in the United States and Japan.

The Office's system of three working languages (EN, DE, FR) works well. As a result, the Commission is not suggesting that changes be made to the language arrangements at the Office, even though it would probably make more sense from the point of view of simplicity and cost if the Office worked in English only. Nor is the Commission suggesting that any changes be made to the current system whereby the patent is granted

¹ The Commission emphasises that there is a close relationship between the proposed Regulation and the Convention. "Everything has an impact on everything else", and decisions on all important questions must therefore be taken in parallel. Depending on the approach chosen for the Convention, it may prove necessary to introduce some amendments to the proposal for a Regulation. The converse is also true.

in one of the working languages, with the claims being additionally translated into the other two languages.

In order to avoid a situation where Member States might make a patent's validity contingent on subsequent translations being provided, the Commission is merely suggesting that this matter be clarified in Article 65 of the Convention.

See drafting suggestions for *Article 65*.

1.2 Financial arrangements

The proposal for a Regulation lays down that the annual renewal fees wbe determined via a comitology procedure and be paid to the Office. It is not possible to indicate the level of the fees at present. It can nevertheless be stated that the affordability of the Community Patent should be a mainstay of the system to be created. As a result, it is self-evident that the amount of the fees must not correspond to a simple addition of the annual renewal fees of the 15 Member States.

The proposal for a Regulation lays down that the annual patent renewal fees are to be paid to the Office. However, no mention is made of how the amounts thus collected are to be used or allocated. It is proposed to create, under the Convention, a system for deciding on the use of these amounts that is proper to the Community and its Member States. The decisions would have to be taken on the basis of certain well defined criteria.

See drafting suggestions for *Articles 37, 39, 50, 149g and 149i*.

1.3 Role of the national offices

The Commission's proposal for a Regulation is based on the idea that the Office examines and grants the Community patent in accordance with the arrangements laid down by the Convention.

However, the national patent offices (hereinafter referred to as NPOs) have an important role to play in promoting innovation. In addition to the functions of NPOs as regards the examination and/or granting of national patents, these offices equally provide assistance to inventors and enterprises, particularly SMEs. It is important that NPOs retain the manpower and resources needed to continue to perform this role after the introduction of the Community patent.

A conceivable approach to guaranteeing the continuation of this role would be to create the possibility within the Convention for national industrial property offices, *i.e.*, NPOs, to take part in examination and/or search procedures relating to applications for Community patents. In this regard, a mechanism could be set up whereby the Administrative Council of the European Patent Organisation (hereinafter referred to as the 'Organisation') could entrust certain tasks to the NPOs provided it was satisfied as to the quality, efficiency and affordability of the work to be carried out. The decision to grant the patent would remain the responsibility of the Office.

It would not be appropriate, by contrast, for the NPOs to be able to examine and grant Community patents independently. That would amount to introducing mutual recognition of national patents, which conflicts with the very idea of a unitary and autonomous patent.

See drafting suggestions for *Section IV of the Protocol on Centralisation*.

1.4 Consistent development of the "acquis communautaire" and of the Convention

As stated previously, it is intended that the Convention should govern the phase preceding the grant of a patent (hereinafter referred to as the 'pre-grant phase'), and the Regulation the phase following the grant of the patent (hereinafter referred to as the 'post-grant phase'). The amendments to the rules concerning the post-grant phase will therefore be introduced in the Regulation. No amendments to the Convention would be necessary.

However, it would be appropriate to provide a mechanism for the insertion into the Convention of any new "acquis communautaire" that are applicable to the pre-grant phase (for example, rules concerning the patentability of inventions).

The mechanism under Articles 33 to 35 of the Convention, which has just been revised, is supposed to guarantee the consistent and parallel development of the Convention and the "acquis communautaire". However, it will take too long for this mechanism to come into play. Moreover, a single Contracting State, including a third state, could block the insertion of "acquis communautaire" into the Convention.

To prevent such risks materialising for the Community patent and European patents designating Member States, a new part (part IXa) could be inserted into the Convention obliging the Office to respect the rules of the "acquis communautaire" whenever the Community or its Member States were designated.

See drafting suggestions for *Article 149c, 149i and 149j*.

1.5 Compliance with the "acquis communautaire", judicial control

The Convention already contains a judicial system which provides legal certainty for the parties. By acceding to the Convention, the Community accepts its system of appeals, as the Member States have already done. It is neither necessary nor appropriate to lodge subsequent appeals against decisions of the Office. Moreover, direct appeals against decisions by the Office would lead to a proliferation of appeal bodies and an unnecessary increase in the workload of the Community court. Nor is it clear whether it would be possible to introduce a system of appeals before the Community court without further amending the EC Treaty.

It is felt that the scope for appeals provided for under Articles 30 and 40 of the proposal for a Regulation sufficiently meet the requirements of judicial control by a Community court.

More flexible mechanisms could be incorporated into the Convention in order to guarantee application of Community law by the Office. For example, a provision could be included in the Convention stipulating that the Office shall respect the case law of the Court of Justice. Through the references which the Regulation makes to the Convention and through the Community's accession to it, the Convention in effect becomes part of the "acquis communautaire", and the Court of Justice will be authorised to interpret it.

See drafting suggestions for *Articles 2, 24a, 25, 131 and 149k*.

1.6 The role of the Community in the European Patent Organisation

The approach envisaged for the creation of the Community patent is based on the premise that the pre-grant phase will be governed by the Convention, while the post-grant phase will come under the scope of the future Community Regulation. Such an approach implies that the European Community will ultimately accede to the Convention.

It is therefore necessary to create a legal base for the possible accession of the Community and to address the issue of rights of participation in the Administrative Council of the Organisation. This matter requires the revision of Articles 26 and 34 to 36 of the Convention. These provisions would have to ensure that the Community is treated, like any other contracting party.

Moreover, it is also appropriate to entrust special departments of the Office with the task of managing certain issues arising in the context of the Community patent. The link between the EPC and the future Regulation will be forged by way of a new Part IXa of the Convention relating to on the European patent designating the European Community and/or its Member States. This new part of the Convention will ensure, *inter alia*, that the departments of the Office comply in full with the "acquis communautaire". Accordingly, it will also assign specific responsibilities to the Select Committee of the Administrative Council, which will be made up of representatives of the European Community and of its Member States.

See drafting suggestions for *Articles 1, 2, 15, 33, 34, 36, 149b-149k and 166*.

2 EXPLANATORY NOTES

2.1 Notes on the general and institutional provisions

(Revised Articles 1, 2, 15, 33, 79; new Articles 149d, 149e, 149f and 149i)

Article 1

1. A second paragraph should be added to Article 1 of the Convention, specifying that the term "Contracting States" also refers to the European Community. Article 1 is in Part 1,

entitled "General and Institutional Provisions", and thus enables this addition to be taken into account throughout the Convention.

Article 2

The present Article 2 of the Convention lays down that European patents have the effects of and are subject to the same conditions as national patents, unless otherwise provided in the Convention. The proposal for a Regulation on the Community patent, however, lays down that the effects of the Community patent shall be subject only to the Regulation and the general principles of Community law (Article 2). To guarantee consistency of approach, a new paragraph with the same content should be added to Article 2 of the Convention.

However, the proposal for a Regulation lays down that the opposition and appeal proceedings before the Boards of Appeal shall remain applicable to a Community patent. It would thus appear appropriate to specify this in Article 2. It should be noted that this does not, for instance, cover the new limitation procedure at the Office and the new mechanism for a request for a revision before the Enlarged Board of Appeal (which has no suspensive effect) or the *restitutio in integrum* procedure. This is for reasons of consistency and legal certainty regarding the conditions applicable. The proposal for a Regulation lays down that only the Community court can determine the effects of the Community patent (for example, its validity) and limit the patent. The proposal for a Regulation does not contain any provision concerning the *restitutio in integrum* procedure in the event of the annual renewal fees not being paid within the period prescribed. It would nevertheless appear consistent that such a rule, should it be considered necessary, be introduced into the proposal for a Regulation.

It should be noted that Article 2 refers only to the granted patent. Thus, all the procedures provided for in the Convention in respect of the pre-grant period naturally remain applicable. Of course, other provisions in the Convention which, strictly speaking, do not relate to substantive or procedural patent law, in particular those concerning the functioning of the Administrative Council and financial provisions, will also remain applicable.

Article 15

A new division of the Office will be set up to administer the future Community patents (responsible for receiving annual renewal fees, keeping the register of Community patents and publishing the Community Patent Bulletin).

Article 15 has been amended in order to integrate this new division into the organisational set-up of the Office.

Article 33

The new Article 149j grants exclusive competences to the Select Committee of the Administrative Council for the implementation, particularly by regulatory means, of the

proposed new Part IXa of the Convention. These special competences have therefore been withdrawn from those assigned to the Administrative Council itself.

Article 79

The proposal for a Regulation on the Community patent lays down that, on applying for a European patent, an applicant shall not obtain both a Community patent and one or more national patents issued for Member States of the European Community. However, since the reform of the Office fees in 1997, all contracting parties have been deemed to be designated in the request for grant of a European patent. The new paragraph inserted in Article 79 lays down that, at the time of the grant of the European patent at the latest, all EC Member State designations competing with the Community patent shall be deemed to have been withdrawn.

2.2 Notes concerning judicial control

(Revised articles 2, 24a, 25 & 131, new Article 149k)

Article 24a

It is not necessary to set up a system of judicial control at Community level for decisions taken by the Office. It will nevertheless be appropriate to lay down that the Office shall, when applying the Convention, take due account of the case law of the Court of Justice.

The proposed Article lays down that the Office, particularly the departments referred to in Article 15 of the Convention, shall interpret the Convention in the light of the judgements of the Court of Justice of the European Communities relating to the Convention or to the provisions of Community instruments which are identical to those of the Convention.

Article 25

As a Community court will have jurisdiction over disputes concerning validity and infringement of the Community patent, and as the Commission will be the authority charged with granting compulsory licences, the Office should be obliged to provide technical opinions in these cases. [It should be examined whether it is appropriate for the Office to receive fees in such situations and, if so, whether that also applies to the Community court and the European Commission?]

Article 131

This Article concerns administrative and legal co-operation in which the Office participates. Paragraph 1 ensures that this co-operation also applies in relations between the Office and the Commission of the European Communities. No amendment would appear necessary in order to ensure that the Article also applies to the Community court.

However, as such co-operation cannot function if it is subject to national legislation, a new paragraph 2 has been added.

Article 149k

This Article concerns the Office's obligation to implement decisions taken at Community level. It may be a matter, for example, of entering in the Register of Community Patents a decision by the Community court to limit a patent, or a decision by the Commission concerning the grant of a compulsory licence [or, to introduce the "*restitutio in integrum*" mechanism into the Regulation on the Community patent, or to respect a decision of the Community court granting to a patent proprietor, on request, a period of grace in which to pay annual renewal fees which he had not paid by the set time limit].

2.3 Notes concerning voting rights

(Revised Articles 34, 36 & 166)

Article 34

Article 34 lays down that each Contracting State shall have one vote in the Administrative Council. Under Article 1(2), the European Community is treated as a Contracting State and thus also has the right to vote.

Article 36

Article 36 addresses a different scenario. Where the Administrative Council has to take a decision which will have a financial impact on the European Patent Organisation, the method of calculating the number of votes given to each of the parties differs. It is based on a weighting system set out in Article 40 (based on the number of patent applications filed in the States which are parties to the Convention). In this type of calculation, it is impossible to clarify the share to be assigned to the European Community. For this reason, a third paragraph has been added. Based on Article 17 of the PLT, it offers an alternative to the European Community and its Member States:

- either the European Community exercises its right to vote, in which case it has all the votes attributed to the Member States;
- or one the Member States exercises its right to vote, in which case only the Member States may exercise their votes.

Article 166

A new paragraph has been inserted in Article 166 in order to allow the accession of the European Community to the European Patent Organisation..

2.4 Explanatory Notes concerning the financial arrangements, the financial provisions of Part 1, Chapter V

(Revised Articles 37, 39 and 50; new Articles 149g and 149i)

Article 20 of the Luxembourg Convention was based on a concept adopted in Article 146 of the Convention, which laid down that, where Member States of the European Community had given additional tasks to the European Patent Office for the purposes of a unitary patent, they had to bear the expenditure incurred as a result.

However, the approach currently envisaged in the draft Regulation on the Community patent includes the accession of the European Community to the Convention. Therefore, the European Community should be treated like any other contracting party as regards coverage of the expenditure incurred by the European Patent Organisation.

Under these conditions, it is proposed in accordance with new Article 149g, paragraph 2, that the administration division responsible for receiving renewal fees shall pay a share of the sum received to the Office, according to the services provided by it, and the surplus to the Member States of the European Community.

It is further proposed that a Select Committee of the Administrative Council set up under new Article 149j oversees the distribution of funds carried out by the Administration Division for the Community Patent.

2.5 Notes concerning Language Arrangements

(Revised Article 65)

Article 65

It would appear appropriate to add a new paragraph to Article 65 in order to remove all ambiguity concerning the scope for Member States of the European Community to require that the specification of the patent, or the claims only, be translated into one of their official languages.

Thus, under this new paragraph 2, it cannot be required that the Community patent, once granted, be translated into one of the languages of the European Community in order for it to have effects vis-à-vis third parties.

A choice should be made between the terms "Contracting State" and "Member State of the European Community". It would appear desirable, however, to retain as far as possible the terminology used in the Convention. Moreover, this formulation has no effect whatsoever on states which are not members of the European Community, as the future Community patent will have no effect on their territory.

2.6 Explanatory Notes on Part IXa of the European Patent Convention (dealing with the role of the Community in the European Patent Organisation)

(Revised Article 33, New Articles 149b to 149k)

It was made clear both during drafting of the draft Regulation on the Community patent and during the discussions which took place in the Patents Working Party of the Council that the "acquis communautaire" had to be applied at every level of the Office.

Articles 33 and 35 of the Convention, as amended in November 2000, should allow these concerns to be addressed. However, since a unanimous vote is required to incorporate the "acquis communautaire" into the Convention, the possibility of a veto by a non-member country cannot be ruled out. In order to respond to this situation it would be appropriate to make provision for this in the Convention.

For this purpose, a new Part IXa will need to be inserted in the Convention to take account of the specific nature of the future Community patent. When the European Patent Convention was originally negotiated during the 1970s, Part IX entitled "Special agreements" was included against the day when a Community patent came into being. However, it is now clear that the provisions it set out are no longer appropriate to the Community patent. Even so, it seemed necessary to keep that text, since it has served as the basis for a unitary patent between Switzerland and Liechtenstein and might be required again.

The protocol is aimed at the future Community patent, but also the national patents granted for the member States of the European Community which will continue to be granted through European channels. It seemed essential that the "acquis communautaire" should apply not only to the future Community patent, but also to national patents, whether granted nationally or by the European Patent Office.

It seemed worthwhile listing all the Community legal instruments needing to be taken into account when an application for a European patent is dealt with in the Office. This listing will be made in an Annex to be added to the Convention. By virtue of (new) Article 149j of the Convention, the Select Committee of the Administrative Council has the authority to amend the list and add to it secondary Community instruments on patents. Case law must also be taken into account by the Office's departments when examining European patents or applications designating the European Community or the territory of any or all of its Member States.

By virtue of Articles 25, 56 and 57 of the future Community patent Regulation, the Office will be responsible for charging the renewal fees for Community patents after their grant, and for maintaining a Register of Community Patents and a Bulletin of Community Patents. These tasks clearly fall outside the grant phase, and the Office must therefore be given the authority to perform them. An Administration Division for the Community Patent must accordingly be set up within the Office in order to accomplish the tasks associated specifically with the Community patent (Article 149e). This Division will have to be the channel for transmission between the European Community and the European Patent Office.

Article 25 of the draft Regulation on the Community patent provides for annual renewal fees in respect of Community patents to be paid to the Office in accordance with the implementing regulations referred to in Article 60 of the draft Regulation. However, if the decisions regarding the level of fees are to be taken in the framework of the Community institutions, it would, in order to ensure coherence between the European Patent Convention and the future Regulation on the Community patent, seem necessary to have some body within the European Patent Organisation with the power to have Community decisions implemented. The Select Committee of the Administrative Council would fulfil this role.

It may be noted that special accounts will be set up at the Office to permit the Administration Division for the Community Patent to manage the renewal fees for the Community patent.

This Division, whilst it forms part of the European Patent Office, will report to a new body, the Select Committee of the Administrative Council representing the European Community within the European Patent Organisation (in accordance with Article 149i and substantially inspired by Article 11 of the European Patent Convention). The Restricted Committee's flexible supervisory role over the Administration Division for the Community Patent should allow it to operate smoothly and at the same time allow strict observance of the relevant "acquis communautaire".

In addition, certain principles regarding the scale for distribution of renewal fee income between Member States of the European Union are also set out in this new Part of the convention.

Any dispute arising from the Administration Division for the Community Patent's handling of its tasks will be heard by the Boards of Appeal of the European Patent Office and if appropriate by the Enlarged Board of Appeal in accordance with the procedure applicable within the Office.

It seemed unnecessary to allow the possibility of an appeal to the Community Intellectual Property Court. Such an appeal would of necessity be important and would probably have the effect of overloading this future jurisdiction. Furthermore, following the creation of new Part IXa, the "acquis communautaire" should be applied both by the Administration Division for the Community Patent and by the Boards of Appeal of the Office.

2.7 Explanatory Note on the proposal for changes to the Protocol on Centralisation

2.7.1 Context

Section IV of the Protocol on Centralisation specifically relates to the arrangements for the search and examination of European patent applications prior to the granting of the application. A number of amendments to this Protocol are proposed to allow NPOs to perform work on behalf of the European Patent Office. The amendments are based on the assumption that the pre-grant search and examination of a patent application will still be carried out under the responsibility of the European Patent Office and according to current European Patent Organisation rules. NPOs were involved in performing work on behalf of the EPO during the initial years of its operation (limited to a maximum of 15 years after the Office opened). However, although these measures were essentially regarded as transitional, they do provide a precedent for suitably qualified NPOs to carry out work on the behalf of the European Patent Office.

2.7.2 Changes to Section IV, Paragraph 1, regarding examination

Paragraph 1 of Section IV concerns the arrangements for the examination of European patent applications and states that the Administrative Council of the Organisation has the authority to entrust work to the central industrial property offices, *i.e.*, NPOs, of contracting states. Decisions to entrust work by the Administrative Council must take

into account matters such as timeliness, *i.e.*, how long it is taking to grant Community patents; and the cost effectiveness of such entrustment arrangements. The Administrative Council must also ensure that appropriate arrangements to monitor the quality of work from an entrusted NPO are in place. The standards of work expected will be equivalent to those required at the European Patent Office. The Office will produce an annual report for the Administrative Council of the European Patent Organisation on the operation of such arrangements especially referring to how effective the monitoring arrangements have been in operation and giving a summary of the results obtained. The European Patent Organisation and the NPO to which work is entrusted will conclude a special agreement containing provisions which ensure that the work carried out by the NPO will be of a standard of quality equal to that of the European Patent Office; that work will be completed within specific deadlines; and that effective means for the control of quality will be put in place.

The three-member examining division structure required by Article 18, paragraph 2, of the Convention, will be retained, but one or two members of the examining division would be technical examiners based at the NPO, while the other member or members of the examining division would be European Patent Office examiners. In keeping with Article 18, paragraph 2, the examination prior to a final decision should, most likely, in practice, be the responsibility of a single NPO-based examiner. An Office examiner would always be the chairman of the examining division.

2.7.3 Changes to Section IV, Paragraph 2, regarding search

Paragraph 2 of Section IV concerns the arrangements for the searching of European patent applications and also refers to the language arrangements to be used when carrying out the search. The most important consideration with regard to the search is the operational requirement to be able to read and interpret the specification and claims of the application. This requirement would be met in practice if the NPO is able to conduct proceedings in the language of the application, irrespective of the official language of the State in which the NPO is located. A decision by the Administrative Council of the Organisation to entrust search tasks to an NPO would take into account the ability to conduct proceedings in one of the official languages of the Organisation, as well as the issues of timeliness, cost effectiveness and quality of work as referred to in Paragraph 1 above.

2.7.4 Situation regarding simultaneous search and examination

The proposed changes to the Protocol on Centralisation would allow NPOs to carry out case work under the 'BEST' programme of the Office, whereby search and examination are performed at the same time by the same examiner who would be assimilated into both the Search Division and the Examining Division.

3 PROPOSED AMENDMENTS TO THE EUROPEAN PATENT CONVENTION

CURRENT WORDING

REVISED WORDING

PART I

PART I

GENERAL AND INSTITUTIONAL PROVISIONS

GENERAL AND INSTITUTIONAL PROVISIONS

Chapter I

Chapter I

General provisions

General provisions

Article 1

European law for the grant of patents

Article 1

European law for the grant of patents

A system of law, common to the Contracting States, for the grant of patents for invention is hereby established.

1) Unchanged

2) For the purposes of this Convention, “Contracting States” means the [Parties] [States] referred to in Article 166, [together with the European Community].

Article 2

European patent

Article 2

European patent

1) Patents granted by virtue of this Convention shall be called European patents.

1) Unchanged

2) The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same

2) Unchanged

conditions as a national patent granted by that State, unless otherwise provided in this Convention.

3) Notwithstanding the provisions of paragraph 2, after the European patent granted for the European Community has been issued by the European Patent Office, it is subject to an independent system as set out in the measures taken by virtue of the Treaty establishing the European Community.

4) Nonetheless, the provisions of Part V of the Convention on the opposition procedure and those of Part VI of the Convention on the appeals procedure before the Board of Appeal are applicable.

The European Patent Office

Article 15

The departments charged with the procedure

For implementing the procedures laid down in this Convention, there shall be set up within the European Patent Office:

- a) a receiving section;
- b) search divisions;
- c) examining divisions;
- d) opposition divisions;
- e) a legal division;
- f) boards of appeal;
- g) an Enlarged Board of Appeal.

The European Patent Office

Article 15

The departments charged with the procedure

For implementing the procedures laid down in this Convention, there shall be set up within the European Patent Office:

- a) a receiving section;
- b) search divisions;
- c) examining divisions;
- d) a patent administration division for the Community Patent;**
- e) opposition divisions;
- f) a legal division;
- g) boards of appeal;
- h) an Enlarged Board of Appeal.

Article 24a

Consistent interpretation

With regard to the interpretation and application of this Convention, the European Patent Office shall take due account of the principles laid down by any relevant rulings of the Court of Justice of the European Communities which concern the

interpretation of this Convention or of such provisions adopted pursuant to the Treaty establishing the European Community, which are identical in substance to the provisions of this Convention.

Article 25

Technical opinion

At the request of the competent national court trying an infringement or revocation action, the European Patent Office shall be obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The Examining Division shall be responsible for the issue of such opinions.

Article 25

Technical opinion

At the request **of the competent court trying** an infringement or revocation action, **or of the Commission of the European Communities examining an application for a compulsory licence**, the European Patent Office shall be obliged, [against payment of an appropriate fee,] to give a technical opinion concerning the European patent which is the subject of the action. The Examining Division shall be responsible for the issue of such opinions.

The Administrative Council

The Administrative Council

Article 33

Article 33

Competence of the Administrative Council

Competence of the Administrative Council

in certain cases

in certain cases

1. The Administrative Council shall be competent to amend the following provisions:

1. The Administrative Council shall be competent to amend the following provisions:

a) the time limits laid down in this Convention;

a) the time limits laid down in this Convention;

b) parts II to VIII and part X of this convention, to bring them into line with an international treaty relating to patents or European Community legislation relating to patents;

b) parts II to VIII and part X of this convention, to bring them into line with an international treaty relating to patents or European Community legislation relating to patents;

c) the Implementing Regulations.

c) the Implementing Regulations, **subject to the provisions of Article 149i, paragraph 2.**

Article 34

Article 34

Voting rights

Voting rights

(1) The right to vote in the Administrative Council shall be restricted to the Contracting States.

(1) The right to vote in the Administrative Council shall be restricted to the Contracting States.

(2) Each Contracting State shall have one vote, subject to the application of the provisions of Article 36.

(2) Each Contracting State [**and the European Community**] shall have one vote, subject to the application of the provisions of Article 36.

Article 36

Weighting of votes

(1) In respect of the adoption or amendment of the Rules relating to Fees and, if the financial contribution to be made by the Contracting States would thereby be increased, the adoption of the budget of the Organisation and of any amending or supplementary budget, any Contracting State may require, following a first ballot in which each Contracting State shall have one vote, and whatever the result of this ballot, that a second ballot be taken immediately, in which votes shall be given to the States in accordance with paragraph 2. The decision shall be determined by the result of this second ballot.

(2) The number of votes that each Contracting State shall have in the second ballot shall be calculated as follows:

a) the percentage obtained for each Contracting State in respect of the scale for the special financial contributions, pursuant to Article 40, paragraphs 3 and 4, shall be multiplied by the number of Contracting States and divided by five;

b) the number of votes thus given shall be rounded upwards to the next higher whole number;

c) five additional votes shall be added to this number;

d) nevertheless, no Contracting State shall have more than 30 votes.

Article 36

Weighting of votes

(1) unchanged

(2) unchanged

(3) The European Community may take part in the vote which is provided for in paragraph 2 in lieu of its Member States and with the same number of votes as those Member States. The European Community shall not vote if one of its Member States exercises its right to vote, and vice versa.

Chapter V

Financial provisions

Article 37

Budgetary funding

The budget of the Organisation shall be financed:

- a) by the Organisation's own resources;
- b) by payments made by the Contracting States in respect of renewal fees for European patents levied in these States;
- c) where necessary, by special financial contributions made by the Contracting States;
- d) where appropriate, by the revenue provided for in Article 146.

Article 39

Payments by the Contracting States in respect of renewal fees for European patents

(1) Each Contracting State shall pay to the Organisation in respect of each renewal fee received for a European patent in that State an amount equal to a proportion of that fee, to be fixed by the Administrative Council; the proportion shall not exceed 75 per cent and shall be the same for all Contracting States. However, if the said proportion corresponds to

Chapter V

Financial provisions

Article 37

Budgetary funding

The budget of the Organisation shall be financed:

- a) by the Organisation's own resources;
- b) by payments made by the Contracting States in respect of renewal fees for European patents levied in these States;
- c) where necessary, by special financial contributions made by the Contracting States;
- d) where appropriate, by a portion of the revenue provided for in Article **149i, paragraph 2d).**

Article 39

Payments by the Contracting Parties in respect of renewal fees for European patents

(1) unchanged

an amount which is less than a uniform minimum amount fixed by the Administrative Council, the Contracting State shall pay that minimum to the Organisation.

(2) Notwithstanding paragraph 1, the provisions of Article 149i, paragraph 2d) shall apply to the European patent granted by the European Community.

(2) Each Contracting State shall communicate to the Organisation such information as the Administrative Council considers to be necessary to determine the amount of its payments.

(2) becomes (3), unchanged

(3) The due dates for these payments shall be determined by the Administrative Council.

(3) becomes (4), unchanged

(4) If a payment is not remitted fully by the due date, the Contracting State shall pay interest from the due date on the amount remaining unpaid.

(4) becomes (5), unchanged

Article 50

Financial Regulations

The Financial Regulations shall in particular establish:

- a) the procedure relating to the establishment and implementation of the budget and for the rendering and auditing of accounts;
- b) the method and procedure whereby the payments and contributions provided for in Article 37 and the advances provided for in Article 41 are to be made available to the Organisation by the Contracting States;
- c) the rules concerning the responsibilities of accounting and paying officers and the arrangements for their supervision;
- d) the rates of interest provided for in Articles 39, 40 and 47;
- e) the method of calculating the contributions

Article 50

Financial Regulations

The Financial Regulations shall in particular establish:

- a) the procedure relating to the establishment and implementation of the budget and for the rendering and auditing of accounts;
- b) the method and procedure whereby the payments and contributions provided for in Article 37 and the advances provided for in Article 41 are to be made available to the Organisation by the Contracting States;
- c) the rules concerning the responsibilities of accounting and paying officers and the arrangements for their supervision;
- d) the rates of interest provided for in Articles 39, 40 and 47;

payable by virtue of Article 146;

e) is revoked

f) the composition of and duties to be assigned to a Budget and Finance Committee which should be set up by the Administrative Council.

f) becomes e), unchanged

PART II

SUBSTANTIVE PATENT LAW

Chapter III

Effects of the European patent and the European patent application

Article 65

Translation of the specification of the European patent

(1) Any Contracting State may prescribe that if the text, in which the European Patent Office intends to grant a European patent or maintain a European patent as amended for that State, is not drawn up in one of its official languages, the applicant for or proprietor of the patent shall supply to its central industrial property office a translation of this text in one of its official languages at his option or, where that State has prescribed the use of one specific official language, in that language. The period for supplying the translation shall end three months after the date on which the mention of the grant of the European patent or of the maintenance of the European patent as amended is published in the European Patent Bulletin, unless the State concerned prescribes a longer period.

PART II

SUBSTANTIVE PATENT LAW

Chapter III

Effects of the European patent and the European patent application

Article 65

Translation of the specification of the European patent

(1) unchanged

(2) A [Contracting State] [Member State of the European Community] cannot invoke paragraph 1 for a European patent granted for the European Community.

(2) Any Contracting State which has adopted provisions pursuant to paragraph 1 may prescribe that the applicant for or proprietor of the patent must pay all or part of the costs of publication of such translation within a period laid down by that State. **(2) becomes (3), unchanged**

(3) Any Contracting State may prescribe that in the event of failure to observe the provisions adopted in accordance with paragraphs 1 and 2, the European patent shall be deemed to be void ab initio in that State. **(3) becomes (4), unchanged**

PART III

APPLICATION FOR EUROPEAN PATENTS

Chapter I

Filing and requirements of the European patent application

Article 79

Designation of Contracting States

(1) All the Contracting States party to this Convention at the time of filing of a European patent application shall be deemed to be designated in the request for grant of a European patent.

(2) The designation of a Contracting State may be subject to the payment of the designation fee.

(3) The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent.

PART III

APPLICATION FOR EUROPEAN PATENTS

Chapter I

Filing and requirements of the European patent application

Article 79

Designation of Contracting States

(1) **unchanged**

(2) **unchanged**

(3) **unchanged**

(4) When an application for a European patent designates both the European Community and the territory of one or more Member States of the European Community, the latter designations shall be deemed to be withdrawn when the European patent is granted.

PART VII

COMMON PROVISIONS

Chapter II

Information to the public or official authorities

Article 131

Administrative and legal cooperation

(1) Unless otherwise provided in this Convention or in national laws, the European Patent Office and the courts or authorities of Contracting States shall on request give assistance to each other by communicating information or opening files for inspection. Where the European Patent Office lays files open to inspection by courts, Public Prosecutors' Offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 128.

(2) Upon receipt of letters rogatory from the European Patent Office, the courts or other competent authorities of Contracting States

PART VII

COMMON PROVISIONS

Chapter II

Information to the public or official authorities

Article 131

Administrative and legal cooperation

(1) Unless otherwise provided in this Convention or in national laws, the European Patent Office and the courts or authorities of Contracting States shall on request give assistance to each other by communicating information or opening files for inspection. Where the European Patent Office lays files open to inspection by courts, **the Commission of the European Communities**, Public Prosecutors' Offices or central industrial property offices, the inspection shall not be subject to the restrictions laid down in Article 128.

(2) National legislation shall not preclude the application of paragraph 1 to the relations between the Office and the Community court and the Commission of the European Communities.

(2) becomes (3), unchanged

shall undertake, on behalf of that Office and within the limits of their jurisdiction, any necessary enquiries or other legal measures.

PART IXa

**PROVISIONS RELATING TO THE
EUROPEAN PATENT DESIGNATING
THE EUROPEAN COMMUNITY AND/OR
ITS MEMBER STATES**

Article 149b

**European patent designating the European
Community**

The European Community may lay down that the European patents granted for the European Community have a unitary character throughout the whole of its territory.

Article 149c

**Respect for the established body of
community law**

(1) In the case of an application for a European patent designating the territory of one or more of the member States or the entire European Community, the departments of the European Patent Office are required to respect the established body of Community law.

(2) Particular attention shall be paid to the Community law as disclosed in the annex to this Convention concerning the established body of Community law in relation to patents.

Article 149d

Special departments of the European Patent Office

(1) In accordance with the Implementing Regulation relating to the provisions of this Part, the European Community may entrust additional tasks to the European Patent Office for the administration of the Community patent granted for the European Community.

(2) The tasks referred to in paragraph 1 will be entrusted to the Administration Division for the Community Patent (hereinafter referred to as the “Administration Division”) as provided for in Article 15d) The President of the European Patent Office shall be responsible for this division. The provisions of Article 10, paragraphs 2 and 3, shall apply.

(3) Pursuant to the Implementing regulation, the Administration Division shall be responsible for all acts of the European Patent Office relating to European patents granted for the European Community, insofar as these acts are not the responsibility of other departments of the Office.

(4) Pursuant to the Implementing Regulation, the Administration Division shall be responsible for receiving and making available to the public the optional translations which may be submitted for European patents granted for the European Community.

Article 149e

Register of Community patents

(1) A Register for European patents granted for the European Community called the “Register of Community Patents” is hereby set up.

(2) Article 128 is applicable to the Register of Community Patents.

(3) The Administration Division is responsible for decisions in respect of entries to be made in the Register of Community Patents. It reports its activities to the Select Committee of the Administrative Council referred to in Article 149i.

(4) The Implementing Regulation relating to the provisions of this Part describes the entries to be made in the Register of Community Patents.

Article 149f

Community Patent Bulletin

(1) A Bulletin for Community patents granted for the European Community called the “Community Patent Bulletin” is hereby created.

(2) The Administration Division is responsible for all decisions to be made in respect of entries in the Community Patent Bulletin. It reports on its activities to the Select Committee of the Administrative

Council referred to in Article 149i.

(3) The Implementing Regulation relating to the provisions of this Part describes the entries to be made in the Community Patent Bulletin.

Article 149g

Fees for the renewal of European patents granted for the European Community.

(1) Fees for the renewal of European patents granted for the European Community are administered by the Administration Division, in accordance with the Implementing Regulation.

(2) The income from fees paid in accordance with [the Implementing Regulation adopted pursuant to the Regulation of the Council of the European Communities on the Community Patent], shall, after deduction of the payments to the European Patent Organisation pursuant to Article 149i, paragraph 2d) of the Convention, be distributed among the Member States of the European Community in accordance with the distribution scale referred to in paragraph 3

(3) The Select Committee of the Administrative Council shall determine the distribution scale, particularly according to:

a) the criteria laid down in Article 40, paragraph 3, of the Convention;

b) the number of designations for each Member State of the European Community in the European patent applications for the year preceding the entry into force of the Community instruments

concerning the Community Patent.

The distribution scale may be amended by decision of the Select Committee of the Administrative Council, acting on a proposal from the Commission of the European Communities wherein Article 149i, paragraph 5 is applicable.

Article 149h

Appeals procedure

The decisions of the Administration Division made under the procedures referred to in Articles 149e, 149f and 149g are subject to appeal before the boards of appeal.

Article 149i

Select Committee of the Administrative Council

(1) The European Community and its Member States shall set up a Select Committee of the Administrative Council. It shall be composed of representatives of the European Community as well as representatives of the Member States.

(2) The Select Committee of the Administrative Council shall be solely competent to adopt and amend:

a) the provisions of the Implementing Regulation relating to this Part, notwithstanding Article 33;

b) its Rules of Procedure; Article 31 is applicable;

c) measures applying to budgetary matters;

d) the percentage of the income

from renewal fees in respect of European patents designating the European Community that is to be paid to the Organisation;

e) the distribution between the member states of the European Community referred to in Article 149g, paragraph 2;

f) the entries to be made in the register of Community patents;

g) the entries to be made in the Community Patent Bulletin.

(3) The European Community, by means of the Select Committee of the Administrative Council, shall ensure that the relevant Community law is complied with within the framework of procedures before the European Patent Office. Within the framework of the procedures referred to in Articles 149e, 149f, and 149g, it may make observations with a view to the effective application of the relevant Community law.

(4) When votes are held within the Select Committee of the Administrative Council, the European Community shall have a single vote, as shall each Member State. The provisions of Article 36 shall not apply to this Part.

(5) The decisions of the Select Committee of the Administrative Council shall be arrived at according to the internal rules on the majorities required in the European Community.

(6) The European Patent Office shall place at the disposal of this Committee such staff, premises and equipment as may be necessary for the performance of its duties.

The President of the Office shall be responsible for the activities of the Administration Division before the Select Committee.

Article 149j

**Development of the Established body of
Community law**

The Select Committee of the Administrative Council alone has the competence to amend the annex referred to in Article 149c, paragraph 2, in order to take fully into account any developments in the established body of Community law on the date of entry into force of the legislative act, or, if the act allows a period of time for its transposition, on the date this period expires.

Article 149k

**Relations between the European Patent
Office and the Community Institutions**

Within the limits of its own competence, the European Patent Office shall ensure that the decisions of the Commission of the European Communities and the Community court concerning the Community patent are implemented.

PART XII

FINAL PROVISIONS

Article 166

Accession

(1) This Convention shall be open to accession by:

a) the States referred to in Article 165, paragraph 1;

b) any other European State at the invitation of the Administrative Council.

(2) Any State which has been a party to the Convention and has ceased so to be as a result of the application of Article 172, paragraph 4, may again become a party to the Convention by acceding to it.

(3) Instruments of accession shall be deposited with the Government of the Federal Republic of Germany

PART XII

FINAL PROVISIONS

Article 166

Accession

(1) This Convention shall be open to accession by:

a) the States referred to in Article 165, paragraph 1;

b) any other European State at the invitation of the Administrative Council.

c) of the European Community.

(2) unchanged

(3) unchanged

PROTOCOL ON CENTRALISATION

ORIGINAL TEXT

REVISED TEXT

SECTION IV

SECTION IV

Paragraph 1

Paragraph 1

(1)(a) For the purpose of facilitating the adaptation of the national patent offices of the States parties to the Convention to the European Patent system, the Administrative Council may, if it considers it desirable, and subject to the conditions set out below, entrust the central industrial property offices of such of those States in which it is possible to conduct the proceedings in one of the official languages of the European Patent Office with tasks concerning the examination of European patent applications drawn up in that language which, pursuant to Article 18, paragraph 2, of the Convention, shall, as a general rule, be entrusted to a member of the Examining Division. Such tasks shall be carried out within the framework of the proceedings for grant laid down in the Convention; decisions on such applications shall be taken by the Examining Division composed in accordance with Article 18, paragraph 2.

(1)(a) [...]The Administrative Council may, if it considers it desirable, and subject to the conditions set out below, entrust the central industrial property offices of such of those States in which it is possible to conduct the proceedings in one of the official languages of the European Patent Office with tasks concerning the examination of European patent applications drawn up in that language which, pursuant to Article 18, paragraph 2, of the Convention, shall, as a general rule, be entrusted to a member of the Examining Division. Such tasks shall be carried out within the framework of the proceedings for grant laid down in the Convention; decisions on such applications shall be taken by the Examining Division composed in accordance with Article 18, paragraph 2.

(b) Tasks entrusted under sub-paragraph (a) shall not be in respect of more than 40% of the total number of European patent applications filed; tasks entrusted to any one State shall not be in respect of more than one-third of the total number of European patent applications filed. These tasks shall be entrusted for a period of 15 years from the opening of the European Patent Office and shall be reduced progressively (in principle by 20% a year) to zero during the last five years of the period.

(b) of the original version is deleted and replaced by a new paragraph (b).

(b) The Administrative Council shall decide upon the nature, origin and number of the European patent applications in respect of which examining tasks may be entrusted to the central industrial property office of each of the Contracting States mentioned above. Considerations of timeliness and cost-effectiveness shall be taken into account in deciding upon the justification for and extent of any measures to entrust work in accordance with this paragraph.

(c) The Administrative Council shall decide, while taking into account the provisions of subparagraph (b) upon the nature, origin and number of the European patent applications in respect of which examining tasks may be entrusted to the central industrial property office of each of the Contracting States mentioned above.

(c) Before taking any decision to entrust tasks in accordance with the provisions of subparagraph (a) above, the Administrative Council shall satisfy itself that adequate arrangements are in place for monitoring the quality of work done in connection with tasks so entrusted as measured against the standards set for work done in the European Patent Office. Annually during the course of any period in which tasks are entrusted under this section, the Office shall prepare for the Administrative Council a report on the operation of such arrangements, including an assessment of the effectiveness of the monitoring and a summary of the results obtained.

(d) For the purposes of Article 18 of the convention, up to two members of the Examining Division responsible for examination of an application which has been entrusted to the central industrial property office of a Contracting State may be substituted by technical examiners from the central industrial property office of that Contracting State. The chairman of the examining division should in all cases be a technical examiner of the European patent Office.

(d) The above implementing procedures shall be set out in a special agreement between the central

(e) The above implementing procedures shall be set out in a special agreement between the

industrial property office of the Contracting State concerned and the European Patent Organisation.

central industrial property office of the Contracting State concerned and the European Patent Organisation. **Any such agreement must include provisions *inter alia* requiring that the work entrusted is performed to a standard of quality equal to that of the European Patent Office, stipulating deadlines for completion of tasks entrusted, and for enabling an effective control of quality to be carried out.**

(e) An office with which such a special agreement has been concluded may act as an International Preliminary Examining Authority under the Patent Cooperation Treaty, until the expiry of the period of 15 years.

(f) An office with which such a special agreement has been concluded may act as an International Preliminary Examining Authority under the Patent Cooperation Treaty [.....].

Paragraph 2

(2)(a) If the Administrative Council considers that it is compatible with the proper functioning of the European Patent Office, and in order to alleviate the difficulties which may arise for certain Contracting States from the application of Section I, paragraph 2, it may entrust searching in respect of European patent applications to the central industrial property offices of those States in which the official language is one of the official languages of the European Patent Office, provided that these offices possess the necessary qualifications for appointment as an International Searching Authority in accordance with the conditions laid down in the Patent Cooperation Treaty.

(b) In carrying out such work, undertaken under the responsibility of the European Patent Office, the central industrial property offices concerned shall adhere to the guidelines applicable to the drawing up of the European search report.

Paragraph 2

(2)(a) The Administrative Council may, if it considers it desirable, and subject to the conditions set out below, entrust the central industrial property offices of such of those States in which it is possible to conduct the proceedings in one of the official languages of the European Patent Office with tasks concerning the searching of European patent applications drawn up in that language provided that said central industrial property offices are capable of acting as an International Searching Authority in accordance with the conditions laid down in the Patent Cooperation Treaty

(b) unchanged

(c) The provisions of sub-paragraphs (b), (c) and (e) of paragraph 1 of this Section shall apply *mutatis mutandis* to this paragraph.

ANNEX CONCERNING THE ESTABLISHED BODY OF COMMUNITY LAW IN RELATION TO PATENTS

The Community law referred to in Article 149c of the European Patent Convention comprises, in particular, the following measures:

- a) Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions.**
- b) Council Regulation (EEC) No 1768/92 of 18 June 1992 concerning the creation of a supplementary protection certificate for medicinal products.**
- c) Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products.**